

O/616/20

TRADE MARKS ACT 1994

IN THE MATTER OF
TRADE MARK APPLICATION NO. 3263343
BY MACKENZIE FLY FISHING LIMITED
TO REGISTER

The logo consists of the letters 'FX1' in a bold, italicized, sans-serif font. The 'F' and 'X' are connected, and the '1' is slightly offset to the right. The entire logo is rendered in a light grey color.The logo consists of the letters 'FX1' in a bold, italicized, sans-serif font. The 'F' and 'X' are connected, and the '1' is slightly offset to the right. The entire logo is rendered in a bright orange color.

(SERIES OF TWO)

AS TRADE MARKS IN CLASSES 25 AND 28
AND OPPOSITION THERETO UNDER NO. 412264
BY FOX INTERNATIONAL GROUP LIMITED

Background and Pleadings

1. Mackenzie Fly Fishing Limited (“the applicant”) applied for the trade marks set out on the title page as a series of two marks on 13 October 2017. The marks were published in the Trade Marks Journal on 26 January 2018 and registration is sought for the following goods:

Class 25: *Clothing; headgear; footwear; fishing smocks; fishing vests; fishing jackets; fishing boots; fishing waders.*

Class 28: *Sporting articles for use in fishing; fishing equipment; fishing tackle; fishing creels; fishing floats; fishing hooks; fishing gaffs; fishing lines; fishing reels; fishing rods; fishing spinners; fishing weights; fishing poles; lures for fishing; floats for fishing; hooks for fishing; artificial fishing bait; artificial fishing worms; bags for fishing; bite indicators for fishing; freeze-dried fishing bait; bite sensors for fishing.*

2. On 20 April 2018, Fox International Group Limited (“the opponent”) opposed the application. The grounds were initially based upon Sections 5(2)(a) and (b) of the Trade Marks Act 1994 (“the Act”) and the opponent initially relied on its earlier European Union Trade Mark (EUTM) 14278501 for the mark shown below which has a filing date of 18 June 2015 and a registration date of 15 January 2017:



3. At the time when the notice of opposition was filed, the mark was registered for goods in classes 18, 20 and 28. However, on 12 February 2019, the applicant informed the Tribunal that the opponent’s earlier EUTM14278501 was subject to an application for a declaration of invalidity before the EUIPO. The proceedings were consequently suspended until the outcome of the invalidity could be known.

4. On 1 November 2019, the opponent informed the Tribunal that 1) the invalidity proceedings against the earlier EUTM14278501 were concluded; 2) the class 28 specification had been deleted from the earlier EUTM14278501; 3) the opponent had requested a partial conversion of the earlier EUTM14278501 into a UK mark with the goods to be converted being limited to class 28 only and 4) it was the opponent's understanding that the UK mark resulting from the conversion "*stands as part of the mark relied upon in [these proceedings]*".

5. On 12 December 2019, the Tribunal responded by saying that the opponent had until 27 December 2019 to file an amended notice of opposition (Form TM7) to include the converted UK mark as the basis of the opposition. That was duly done, and the opponent filed an amended Form TM7 on 14 December 2019, no longer relying on its earlier EUTM14278501, but instead relying on trade mark application no. UK00003437283 which resulted from the conversion of the earlier EUTM14278501 into a UK right. The claim under Section 5(2)(a) was also dropped with the opposition being now limited to Section 5(2)(b) only.

6. The applicant did not object to the conversion and filed an amended counterstatement on 23 January 2020 denying the claims.

7. The opposition proceedings were suspended until the end of the opposition period for the registration of the opponent's converted trade mark application. This completed its registration process on 7 August 2020. On 10 September 2020, the Tribunal wrote to the parties informing them that the UK00003437283 mark was registered and that the case would proceed to a hearing as per the applicant's request.

8. Neither party filed evidence in these proceedings, although the opponent filed submissions on 5 September 2018, prior to the filing of the amended Form TM7. A hearing took place via video link on 15 October 2020; the opponent was represented by David Crouch of Broomhead Johnson and the applicant by Peter Cornford of Stevens Hewlett & Perkins.

DECISION

9. Section 5(2)(b) of the Act is 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”.

10. The UK00003437283 mark resulting from the conversion of the opponent’s earlier EUTM14278501 enjoys, in respect of the UK, the same date of filing of the earlier EUTM14278501, i.e. 18 June 2015 and, as such, it qualifies as an earlier mark under the provision of Section 6 of the Act. As this earlier trade mark had not been registered for more than five years at the publication date of the mark in issue, it is not subject to the proof of use provisions.

Section 5(2) – case law

11. 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 impression 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 greater 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 to mind the earlier mark, 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

12. In the judgment of the Court of Justice of the European Union (CJEU) in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

13. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance

whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

14. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the General Court (GC) stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

15. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

16. Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

17. In *Gérard Meric v OHIM*, Case T-133/05, the GC stated:

“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 as follows:

The applicant's goods	The opponent's goods
<p>Class 25: <i>Clothing; headgear; footwear; fishing smocks; fishing vests; fishing jackets; fishing boots; fishing waders.</i></p> <p>Class 28: <i>Sporting articles for use in fishing; fishing equipment; fishing tackle; fishing creels; fishing floats; fishing hooks; fishing gaffs; fishing lines; fishing reels; fishing rods; fishing spinners; fishing weights; fishing poles; lures for fishing; floats for fishing; hooks for fishing; artificial fishing bait; artificial fishing worms; bags for fishing; bite indicators for fishing; freeze-dried fishing bait; bite sensors for fishing.</i></p>	<p>Class 28: <i>Fishing equipment; namely fishing rods and fishing reels.</i></p>

19. With regard to the goods in class 28, one of the points taken by Mr Cornford, acting for the applicant, was that the opponent's case should be limited to the claim that the applicant's goods in class 28 are identical (but not similar) to the opponent's goods in the same class, in the sense that the opposition is understood to be limited to identical goods only in the class 28 sought by the applicant. To construe the opponent's case more broadly would, as it was put in Mr Cornford's written skeleton argument, “represent an unacceptable widening” of the opponent's pleadings “as shown in its

amended Form TM7". Based on Mr Cornford's reading of the opponent's pleadings, the opposition "*can only fail*" in respect of the applicant's goods that are not identical to the opponent's goods, that is to say, all of the goods listed in the class 28 specification, save for *fishing rods* and *fishing reels* which, Mr Cornford conceded, are identical to the opponent's goods.

20. In support of his argument, Mr Cornford relied on what was stated by the opponent in response to Question 5 of the Form TM7, which reads: "*Use this space to supply any further information about why you consider there is a likelihood of confusion and e.g. why you consider the respective marks and goods and/or services to be similar*". The applicant responded to that question in exactly the same manner in both the original and in the amended Form TM7, which is as follows:

FX is a prominent part of both marks, so that they are confusingly similar. All of the goods listed under class 28 of the opposed mark are fishing equipment, so that those goods are identical to the class 28 goods of the mark relied upon, and similar to the goods of the mark relied upon listed under classes 18 and 20. Some of the goods listed under class 25 of the mark opposed relate explicitly to fishing, so that to that extent they are similar to the goods of the mark relied upon, especially those under class 28, and the other goods under class 25 of the opposed mark, namely "Clothing; headgear; footwear", cover such goods for fishing, and to that extent are similar to the goods of the mark relied upon, especially those under class 28. Hence the class 28 goods of the opposed mark are identical to the class 28 goods of the mark relied upon, and are similar to the goods of classes 18 and 20 thereof, and the class 25 goods of the opposed mark are similar to the goods of the mark relied upon, especially those under class 28.

21. Mr Crouch, acting for the opponent, accepted in his oral submissions that the amended Form TM7 indeed contained an error in that the reference to class 18 and class 20 should have been removed because, although these classes were covered by the specification of the EUTM on which the opposition was originally based, they are no longer present in the specification of the UK mark on which the opponent now relies. He argued that the idea that the answer to Question 5 defines the scope of the opposition is unreasonable, that it is instead the answer to Question 4 which defines the scope of the opposition and that it is clear from the way that Question 4 is posed that it relates both to whether the goods are identical or similar. At Question 4 of the Form TM7 the opponent was asked "*Which goods or services in the application you are opposing do you claim are identical or similar to those covered by the earlier mark which you have listed at Q1 or Q3a (whichever is applicable)?*" and ticked the box saying "*All goods and services*".

22. I accept that it was the opponent's representative's responsibility to ensure that the Form TM7 was correctly amended to reflect the fact that the specification of the converted UK mark was different from that of the EUTM previously relied upon, in that the classes 18 and 20 were removed and the class 28 specification was restricted from "fishing equipment" (under the EUTM) to "Fishing equipment; namely fishing rods and fishing reels" (under the UK mark). Although it is unfortunate that the opponent's representatives have 'copied and pasted' the answer to Question 5 in this way, it is sufficiently clear from the answer to Question 4 that the opponent's intention is to oppose all of the goods in class 28, not only the ones that are self-evidently identical to the goods covered by the earlier UK mark. This is all the more since 1) it is clear from the first Form TM8 and counterstatement, which were filed by the applicant prior to the amendment, that the applicant itself understood the opposition to be directed to all of the contested goods in class 28, as it stated "*It is admitted that the class 28 goods "fishing equipment" under the application are identical and similar to the class 28 goods under the Earlier Registration*" so there is no widening of the scope of the opposition; 2) even if I were to interpret the opponent's claim as limited to the claim that all of the contested goods in class 28 are identical to the earlier goods in the same class, that would not prevent me from reaching the conclusion that the goods, although not identical, are still similar to some degree. I therefore refuse to construct the opponent's pleadings in the way suggested by Mr Cornford.

The scope of the opponent's specification

23. The opponent's specification includes the word "namely". The addendum to the Trade Mark Registry's Classification Work Manual contains the following:

"Including, for example, namely, as well as, in particular, specifically i.e. While not desirable in specifications since it encourages tautology, such wording should usually not be changed. Such terms are not allowable in Class 35 (with the exception of "namely" see below) for specifications covering retail services as they do not create the legal certainty that is required. However, in other class the terms may be allowed. For example we would allow:

Biocides including insecticides and pesticides Paper articles of stationery in particular envelopes Dairy products namely cheese and butter

Note that specifications including “namely” should be interpreted as only covering the named Goods, that is, the specification is limited to those goods. Thus, in the above “dairy products namely cheese and butter” would only be interpreted as meaning “cheese and butter” and not “dairy products” at large. This is consistent with the definitions provided in Collins English Dictionary which states “namely” to mean “that is to say” and the Cambridge International Dictionary of English which states “which is or are”.

24. The parties also filed a copy of the EUIPO decision invalidating the opponent’s EUTM, in which it was explained that the presence of a semicolon rather than a comma was the result of an error. Approached on that basis, the opponent’s specification is to be read as *fishing equipment, namely fishing rods and fishing reels*, and interpreted as covering only *fishing rods and fishing reels* (but not fishing equipment at large).

Class 28

25. ***Sporting articles for use in fishing; fishing equipment; fishing tackle; fishing reels; fishing rods.*** As the applicant accepted, *fishing reels* and *fishing rods* in the contested specification are self-evidently identical to the opponent’s *Fishing equipment; namely fishing rods and fishing reels*. *Sporting articles for use in fishing* and *fishing equipment* in the contested specification are broad enough to encompass the opponent’s goods, so they must be regarded as identical on the principle outlined in *Meric*. The same goes for *fishing tackle* which is defined as “*equipment required for the sport of catching fish, typically including a rod and line*” and includes the opponent’s goods.

26. ***Fishing floats; fishing hooks; fishing lines; fishing spinners; fishing weights; lures for fishing; floats for fishing; hooks for fishing; artificial fishing bait; artificial fishing worms; bite indicators for fishing; freeze-dried fishing bait; bite sensors for fishing.*** These goods are fishing gear and equipment which are used together with the opponent’s fishing rods. The goods are indispensable or important

for the use of the other in such a way that the relevant public are liable to believe that responsibility for the goods lies with the same undertaking. The goods serve the same fishing purpose and target the same end users. At the hearing Mr Cornford argued that there is no evidence of the goods being sold through the same trade channels, however, it is this tribunal's practice that Hearing Officers routinely make factual finding regarding the similarity of goods and the purchasing decision without evidence being filed. In *Brewdog (O/48/18)*, Prof. Phillip Johnson, sitting as the Appointed Person stated:

"13. Hearing Officers routinely rely on their own experience when making findings of fact. Indeed, as the quality of evidence filed by parties is sometimes so poor (or there is none at all), Hearing Officers are often compelled to make findings of fact without evidence at all as otherwise the outcome of oppositions might be arbitrary or capricious. For instance, in the instant case, a finding was made as to the usual places where the relevant goods are sold without any evidence being led (see paragraph 31 for instance).

14. The basis for this aspect of tribunal practice was considered at length by Daniel Alexander QC, sitting as the Appointed Person, in *O2 Holdings Ltd's Trade Mark Application [2011] RPC 22*. Where, after setting out the authorities, he summarised the position at paragraphs 49 and 50:

"While none of these cases is conclusive, they do reflect a discernable trend in cases of diverse kinds, involving the assessment of the meaning and significance of representations made in trade, to be fairly generous in the latitude given to tribunals of fact to determine such issues for themselves, while at the same time suggesting caution where the determination involves issues far from the tribunals' day to day experience.

The cases also underline the need to proportionality in this regard and reflect degree of underlying unease as to whether the quality of decision-making is improved by over-egging of the evidential pudding. If the approach to exactly what is required by way of evidence in this area were

more pernicky and if the courts had shown themselves to be systematically mistrustful of tribunals' abilities to make the relevant determinations for themselves, one would expect actual evidence from real people of this kind to be treated with greater reverence. Instead, quite often it is viewed as a costly distraction, sometimes doing no more than teaching an otherwise competent tribunal to suck eggs."

27. In my view, it is entirely reasonable and logical to conclude that since the respective goods are all types of fishing equipment, they would be sold in the same stores for fishing products. The goods are similar to a high degree.

28. **Fishing creels; fishing gaffs; fishing poles.** A fishing creel is a wickerwork basket used for holding fish or a wickerwork trap for catching lobsters. A fishing gaff is a pole with a point or hook at one end, which is used for catching large fish. A fishing pole is a long pole made of wood, plastic, etc. with a line attached to it and a hook at the end of the line, used for catching fish. The purpose of the goods is the same as that of the opponent's rods, i.e. fishing, the goods target the same end users and are normally sold in the same stores for fishing products. Although not complementary, the goods are in competition insofar as they are all types of equipment used for fishing and are alternatives to one another. The goods are similar to a high degree.

29. **Bags for fishing.** I understand these goods to be bags for carrying fishing gear. The goods are complementary to those covered by the earlier mark, as they are used together in such a way that customers may think that the responsibility for those goods lies with the same undertaking. Further, they target the same users and are sold in the same shops for fishing products. The goods are similar to a medium degree.

Class 25

30. **Fishing smocks; fishing vests; fishing jackets; fishing boots; fishing waders.** These goods are items of clothing and footwear designed for fishing. Although the nature of the goods is completely different, there is a complementary relationship between these goods and the opponent's *fishing equipment; namely fishing rods and fishing reels*, because the use of one is indispensable for the use of the other and the

relevant public may think that the production of these goods lies with the same undertaking. In addition, the goods share the same public and distribution channels. In my view, these goods are similar to a low degree.

31. **Clothing; footwear.** Insofar as the terms *Clothing* and *footwear* encompass the aforementioned *Fishing smocks; fishing vests; fishing jackets; fishing boots; fishing waders* they are also similar to the opponent's goods to a low degree.

32. **Headgear.** Although there is no evidence that the term *headgear* includes items specifically designed for fishing, the TMClass database operated by the EUIPO includes the term *fishing headwear* as a sub-category of goods in class 25. Although I do not rely exclusively on that definition, it does support my understanding that the term *headgear* includes hats and caps which are marketed specifically for angling and fishing. For the similar reasons to those outlined above, I find that the goods are similar to a low degree.

Average consumer and the nature of the purchasing act

33. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. 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.”

34. The average consumer of the goods at issue are likely to be those with an interest in fishing, from beginners to angling enthusiasts or fishermen. The goods will be selected visually from specialized shops for fishing products and from retailers of sporting goods or their online equivalent. However, I do not discount aural considerations completely. The goods may be selected with an above average degree of care and attention, taking into account the requirements of the specific products purchased.

Comparison of the marks

35. 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.”

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

The applicant's marks	The opponent's mark
	

Preliminary issue

37. In his skeleton argument, Mr Cornford pointed out that the mark representation showing on the UK Register resulting from the conversion of the EUTM does not contain the image of a fox's head. Mr Crouch agreed that the mark needs correcting and both parties were content for me to proceed on the basis that the representation of the UK mark relied upon by the opponent was the same as that of the EUTM from which the UK mark had been converted. I proceed on that basis.

Overall impression

38. The applicant's marks consist of the capital letters 'F' and 'X' directly followed by the number 1 with the first mark of the series being presented in grey and the second in orange. Both the letters and the number are written in slightly stylised and slanting characters and the letter 'X' has gaps within it. The letters 'FX' are conjoined and separated by a space from the number 1. Although the mark contains two identifiable elements, namely the letters 'FX' and the number 1, in my view, no one element visually dominates the other, since they are of the same size, colour and font. The letter 'FX' and the number 1 contributes more weight to the overall impression, with the stylisation and the colours playing a lesser role.

39. The earlier mark is a composite arrangement of letters and a figurative element. The first element of the mark consists of a black trapezoid with one right angle in which

the word 'FOX' is positioned before a device consisting of the silhouette of a fox's head. Both the word 'FOX' and the device are presented in white. The word 'FOX' is written in bold capital letters, in slanting characters and is significantly larger than the device. Toward the right of the trapezoid element are the letters 'F' and 'X' written in black, in bold capital letters in a font which is graphically much larger than that of the word 'FOX'. All these elements are placed within a rectangular border of which the four angles are rounded. The fox's head has a small visual impact due to its size, although it does reinforce the meaning of the word 'FOX' which precedes it. Mr Cornford submitted that *"the dominant and distinctive feature of the opponent's mark is the word FOX supported by the device of a fox's head"*. Whilst the word 'FOX' and the device are the elements which give the earlier mark a clear conceptual value, I do not think that the word 'FOX' is more distinctive than the letters 'FX'. In my view, due to its size, the sequence 'FX' plays, together with the word 'FOX', the greater role in the overall impression, with the borders, stylisation and the fox's head device all playing a lesser role¹.

Visual similarity

40. Visually, the marks coincide in the presence of the letters 'F' and 'X' which represent the larger elements in both marks. They differ in the addition of the number 1, the stylisation (which is minimal) and the colours in the applicant's marks, and the presence of the word 'FOX', the device and the contrasting backgrounds in the opponent's mark. In my view, the marks are visually similar to a degree between low and medium.

Aural similarity

41. Aurally, the marks coincide in the pronunciation of the letters 'F' and 'X', which is identical in both marks. They differ in the presence of the number 1 in the applicant's

¹ Although not binding upon me, Mr Cornford referred me to the EUIPO decision No 14 349 C which invalidated the opponent's EUTM, insofar as the EUIPO rejected the opponent's argument that the letters FX were the dominant element of the earlier mark. However, the EUIPO also found in that decision that the element FX was co-dominant and occupied rather the same proportion of the opponent's mark as the trapezoidal shape containing the term FOX and the fox's head.

marks and the word 'FOX' in the opponent's mark. In my view, the marks are aurally similar to a degree between low and medium.

Conceptual similarity

42. In his oral submissions Mr Crouch conceded that conceptually the letters 'FX' "*are not as strong as the word FOX*" and submitted that they are considered more generally to refer to "*foreign exchange*" or "*special effects*". However, he also accepted that in the context of the opponent's mark the letters 'FX' are the first and last letter of the word FOX and might be seen as the word 'FOX' extended.

43. Conceptually, the opponent's mark will convey the concept of a fox, that concept being conveyed by two elements, namely the word 'FOX' and the image of the head of an animal with the features of a fox. I agree with Mr Crouch that some consumers may see a link between the letters 'FX' and the word 'FOX', in which they recognise 'FX' as being an abbreviation of the word 'FOX'. However, there is no evidence that the letters 'FX' are used for (or will be seen as meaning) "*foreign exchange*" or "*special effects*". The other likely alternative is, in my view, that the letters 'FX' will convey no particular meaning to the average consumer.

43. The combination 'FX 1' in the applicant's marks is, in itself, meaningless. The number 1 in the applicant's marks will, of course, be recognised as a number and has no counterpart in the opponent's mark. If there is any conceptual similarity between the marks, it will be based upon the common presence of the letters 'FX', but this does not give rise to a strong degree of conceptual similarity as a whole.

Distinctive character of the earlier trade mark

44. 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-2779, 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)."

45. No claim to enhanced distinctiveness has been made. In terms of inherent characteristics, the earlier mark is composed of the word 'FOX', the image of a fox's head and the letter combination 'FX', all of which are placed within a rectangular background. It makes no allusions towards the goods for which it is registered and, indeed, the reference to a fox in the context of fishing equipment is somewhat fanciful. Irrespective of how the letters 'FX' are viewed in the opponent's mark (as an abbreviation of the word 'FOX' or as a string of letters with no meaning), they have distinctive character in themselves and have an independent distinctive role within the meaning of the judgment in *Medion*. I accept that the element 'FX', being a combination of only two letters, do not enjoy a particularly high degree of distinctive character, given that the use of initials and abbreviations is relatively common. Accordingly, I consider that the element 'FX' in the earlier mark has a modest degree of distinctive character and the earlier mark, as a whole, has an above medium degree of distinctive character.

Likelihood of confusion

46. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective goods and vice versa. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has retained in his mind.

47. Confusion can be direct or indirect. This distinction was summed up by Mr Iain Purvis Q.C. sitting as the Appointed Person in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

“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).”

48. The main points from my analysis above may be summarised broadly as follows:

- I have found the parties’ goods to range from being identical to similar to a high, medium and low degree;
- The average consumer is someone interested in fishing, who will purchase the goods primarily by visual means (although I do not discount aural considerations). An above medium degree of attention will be paid during the purchasing process;
- The element ‘FX’ in the earlier mark has a modest degree of distinctive character and the earlier mark, as a whole, has an above medium degree of inherent distinctive character;
- The marks are visually and aurally similar to a degree between low and medium; conceptually, the letters ‘FX’, common to both marks, give rise to some conceptual similarity, although it is not particularly strong, whereas the word ‘FOX’ and the device (in the opponent’s mark) and the number 1 (in the applicant’s marks) convey additional (and different) concepts;

- The letters 'FX' in the opponent's mark have distinctive character in themselves and have an independent distinctive role.

49. Notwithstanding the principle of imperfect recollection, I consider that the visual and aural differences between the marks are sufficient to avoid them being likely to be mistaken for one another. I am satisfied that there is no likelihood of direct confusion.

50. However, in my view, the presence in the applicant's marks of the pair of capital letters 'FX', is sufficient, at least in the context of the applicant's goods which I found to be identical and/or similar to a high and medium degree, to create a likelihood of indirect confusion with the opponent's mark. As I have said, the combination 'FX' has its own distinctiveness within the opponent's mark and even if the average consumer perceives it as an abbreviation for the word 'FOX', that association is not such as to prevent the combination 'FX' (which constitutes the common element of the marks at issue) from being perceived and remembered separately, given its position and large size within the opponent's mark. There is, all in all, a risk that that the average consumer - who is aware of the existence of the opponent's mark and has encountered that mark on specific items of fishing equipment in class 28 (namely fishing rods and fishing reels) - in seeing the applicant's mark used in relation to a whole range of goods all of which fall into the same category of *fishing equipment*, will ascribe to the sequence 'FX' in the applicant's marks the same meaning as that of the opponent's mark and, therefore, associate it with the same commercial origin. But, even if no meaning is conveyed, the common letters will still be seen as an indication of the same commercial origin. The fact that the average consumer will, as Mr Cornford pointed out, pay an above average degree of attention does not prevent, in those circumstances, a likelihood of indirect confusion.

51. While the applicant's marks also include the number 1, this is not sufficient to divert the consumer's attention from the similarities created by the presence, in the applicant's marks, of the sequence 'FX'. This sequence is likely to be perceived as a combination of letters which is clearly distinct from the numerical element of the mark itself and the presence of the number 1 is not sufficiently distinctive, *per se*, to indicate a different origin. For example, the number 1 might be seen as indicating a new product range from the same provider or the additional device and word 'FOX' might

be seen as a house brand being used with the sub brand 'FX'. The fact that opponent's mark was, as Mr Cornford said, not revealed when the trade mark examiner conducted her relative grounds search, is neither here nor there.

52. As regards the other goods which I found to be similar only to a low degree, given that there is only between a low and medium degree of visual and aural similarity between the marks and that any conceptual similarity created by the letters 'FX' is not particularly strong, the interdependency principle means that the marks are far enough apart to avoid a likelihood of (direct and) indirect confusion where the similarity between the goods is less pronounced. The differences between the goods are sufficient to tip the balance against a finding of likelihood of confusion. This is all of the more since the common element 'FX' is inherently distinctive only to a modest degree and there is no evidence of acquired distinctiveness through use.

OUTCOME

53. The opposition is successful, and the application is refused in relation to the following goods:

Class 28: *Sporting articles for use in fishing; fishing equipment; fishing tackle; fishing creels; fishing floats; fishing hooks; fishing gaffs; fishing lines; fishing reels; fishing rods; fishing spinners; fishing weights; fishing poles; lures for fishing; floats for fishing; hooks for fishing; artificial fishing bait; artificial fishing worms; bags for fishing; bite indicators for fishing; freeze-dried fishing bait; bite sensors for fishing.*

55. The opposition fails in relation to the following goods which can proceed to registration:

Class 25: *Clothing; headgear; footwear; fishing smocks; fishing vests; fishing jackets; fishing boots; fishing waders.*

COSTS

56. As both parties have achieved what I regard as a roughly equal measure of success, I direct that both parties should bear their own costs.

Dated this 9th day of December 2020

T Perks

For the Registrar,

the Comptroller-General