

O-645-18

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NO 3266923
BY JONATHAN TURNER
TO REGISTER THE FOLLOWING TRADE MARK IN CLASSES 18, 25 AND 35:**

Equality

AND

**OPPOSITION THERETO (NO. 411672) BY
CBM CREATIVE BRANDS MARKEN GMBH**

Background and pleadings

1. On 30 October 2017 Jonathan Turner (“the applicant”) applied to register the trade mark “Equality” (“the applied for mark”) for goods and services in classes 18, 25 and 35 (shown in paragraph 13 below). The application was published for opposition purposes on 17 November 2017.
2. CBM Creative Brands Marken GmbH (“the opponent”) oppose registration under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon European Union Trade Mark (“EUTM”) registration EU012011797 (“the earlier mark”), for goods and services in classes 18, 25 and 35 (shown in paragraph 13 below). The earlier mark was filed on 24 July 2013 and registered on 18 December 2013. The earlier mark is as follows:



3. The opponent filed a notice of opposition and statement of grounds on 16 February 2018. The applicant filed a notice of defence and counterstatement on 1 March 2018. Neither party filed evidence or requested a hearing. Both parties filed written submissions and I will return to the parties’ respective arguments raised in their pleadings and written submissions at the appropriate places in this decision. This decision is reached following a careful consideration of the papers.
4. The applicant represents himself. The opponent is represented by Bird and Bird LLP.

Section 5(2)(b)

5. Section 5(2)(b) of the Act states:

“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.”

6. An earlier trade mark is defined in section 6 of the Act, which states:

“6. - (1) In this Act an “earlier trade mark” means –
(a) a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,
(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

7. The opponent’s earlier mark qualifies as an earlier trade mark under section 6(1). In his counterstatement the applicant put the opponent to proof of use in respect of its earlier mark, however, as the earlier trade mark had not been registered for five years or more at the publication date of the opposed application, it is not subject to the proof of use provisions contained in section 6A of the Act. As a consequence, the opponent is entitled to rely upon its earlier trade mark in relation to the goods and services it has identified without proof of use.

Section 5(2)(b) – The Principles

8. The following principles are gleaned from the decisions of the courts of the European Union in *Sabel BV v Puma AG, Case C-251/95*, *Canon Kabushiki Kaisha v Metro- Goldwyn-Mayer Inc, Case C-39/97*, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V. Case C-342/97*, *Marca Mode CV v Adidas AG & Adidas Benelux BV, Case C-425/98*, *Matratzen Concord GmbH v OHIM, Case C-3/03*, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH, Case C-120/04*, *Shaker di L. Laudato & C. Sas v OHIM, Case C-334/05P* and *Bimbo SA v OHIM, Case C-591/12P*:
- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
 - (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
 - (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
 - (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
 - (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
 - (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent

- distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
 - (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
 - (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
 - (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
 - (k) if the association between the marks creates a risk that the public 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 and services

9. When making a comparison, all relevant factors relating to the goods and services in issue should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the Court of Justice of the European Union (“CJEU”) stated at paragraph 23 of its judgment:

“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.”

10. Guidance on this issue has also come from Jacob J in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

“(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.”

11. In relation to understanding what terms used in specifications mean/cover, the case-law informs me that “in construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of the trade.”¹ I also note the judgment of Mr Justice Floyd (as he then was) in *YouView TV Limited v Total Limited* where he stated:

“...Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IPTRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless, the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning

¹ See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

of "dessert sauce" did not include jam, or because the ordinary and natural description of jam was not "a dessert sauce". Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

12. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05, the General Court ("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 the trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 Oberhauser v OHIM – Petit Liberto (Fifties) [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 Vedial v OHIM – France Distribution (HUBERT) [2002] ECR II- 5275, paragraphs 43 and 44; and Case T- 10/03 Koubi v OHIM – Flabesa (CONFORFLEX) [2004] ECR II-719, paragraphs 41 and 42)."

13. The competing goods and services are as follows:

Opponent's goods and services	Applicant's goods and services
<p>Class 18: Leather and imitation of leather, and goods made of these materials and not</p>	<p>Class 18: Leather and imitations of leather; animal skins and hides; luggage and carrying</p>

<p>included in other classes; Animal skins, hides; Trunks and travelling bags; Umbrellas and parasols; Walking sticks; Whips, harness and saddlery.</p>	<p>bags; umbrellas and parasols; walking sticks; whips, harness and saddlery; collars, leashes and clothing for animals.</p>
<p>Class 25: Clothing, footwear, headgear.</p>	<p>Class 25: Clothing, Footwear, Headgear; Adhesive bras; After ski boots; Aikido suits; Aikido uniforms; Albs; Aloha shirts; American football bibs; American football pants; American football shirts; American football shorts; American football socks; Anglers' shoes; Ankle boots; Ankle socks; Anklets [socks];Anoraks; Anoraks [parkas];Anti-perspirant socks; Anti-sweat underclothing; Anti-sweat underwear; Apres-ski boots; Apres-ski shoes; Aprons; Aprons [clothing]; Aqua shoes; Arm warmers [clothing]; Army boots; Articles of clothing; Articles of clothing for theatrical use; Articles of clothing made of hides; Articles of clothing made of leather; Articles of outer clothing; Articles of sports clothing; Articles of underclothing; Ascots; Ascots (ties);Athletic clothing; Athletic footwear; Athletic shoes; Athletic tights; Athletic uniforms; Athletics footwear; Athletics hose; Athletics shoes; Athletics vests; Babies' clothing; Babies' outerclothing; Babies' pants [clothing]; Babies' pants [underwear];Babies'</p>

	<p>undergarments; Babushkas; Baby bodysuits; Baby boots; Baby bottoms; Baby clothes; Baby doll pyjamas; Baby layettes for clothing; Baby pants; Baby sandals; Baby tops; Balaclavas; Ball gowns; Ballet shoes; Ballet slippers; Ballet suits; Ballroom dancing shoes; Bandanas; Bandanas [neckerchiefs]; Bandeaux [clothing]; Barber smocks; Baseball caps; Baseball caps and hats; Baseball hats; Baseball shoes; Baseball uniforms; Baselayer bottoms; Baselayer tops; Basic upper garment of Korean traditional clothes [Jeogori]; Basketball shoes; Basketball sneakers; Bath robes; Bath sandals; Bath shoes; Bath slippers; Bathing caps; Bathing costumes; Bathing costumes for women; Bathing drawers; Bathing suit cover-ups; Bathing suits; Bathing suits for men; Bathing trunks; Bathrobes; Bathwraps; Beach clothes; Beach clothing; Beach cover-ups; Beach footwear; Beach hats; Beach robes.</p>
<p>Class 35: Advertising; Business management; Business administration; Office functions; Retailing, including via websites and teleshopping, of clothing, footwear, headgear, bleaching preparations and</p>	<p>Class 35: Advertising; business management; business administration; office functions.</p>

<p>other substances for laundry use, cleaning, polishing, scouring and abrasive preparations, soaps, perfumery, essential oils, cosmetics, hair lotions, dentifrices, sunglasses, precious metals and their alloys and goods in precious metals or coated therewith, jewellery, precious stones, horological and chronometric instruments, leather and imitations of leather, and goods made of these materials, animal skins, hides, trunks and travelling bags, bags, handbags, pocket wallets, purses, key cases, backpacks, pouches, umbrellas and parasols, walking sticks, whips, harness and saddlery; Arranging and conducting of advertising events and customer loyalty programmes</p>	
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14. The opponent submits that the respective goods and services are either identical or similar. The applicant has not commented on the issue of similarity of goods and services.

15. The parties' class 35 services are clearly identical as there are direct counterparts for "Advertising; business management; business administration; office functions" in the applicant's specification compared with the opponent's equivalent specification.

16. The respective class 25 specifications of "Clothing, Footwear, Headgear" are also clearly identical. The remainder of the class 25 goods within the applicant's specification are also identical as they fall within the broad terms of the opponent's "Clothing, Footwear, Headgear" under the *Meric* principle.

17. The majority of the applicant's class 18 specification is again identical with the opponent's equivalent specification as there are direct counterpart terms in play. The first difference is the applicant's "luggage and carrying bags" which in my view would be identical (or, if not, they would undoubtedly be highly similar) to the opponent's "Trunks and travelling bags."
18. The remaining difference is the "collars, leashes and clothing for animals" within the applicant's specification. Where collars, leashes and clothing for animals are made of leather or imitation leather they would clearly be identical under the *Meric* principle to the opponent's broader term of "Leather and imitation of leather, and goods made of these materials and not included in other classes." Further, collars and leashes of any material would be highly similar to "harnesses" within the earlier mark on account of their nature, purpose and channels of trade. Collars and leashes not made of leather or imitation leather would also be highly similar to the opponent's "Leather and imitation of leather...goods...not included in other classes" bearing in mind I have already found this broad term must include collars and leashes made of leather/imitation leather. Such products would have the same nature, purpose and channels of trade and are, in effect, the same goods but simply made of different materials.
19. I have found above that the term "leather and imitation of leather...goods... not included in other classes" includes leather and imitation leather clothing for animals. Non leather/imitation leather clothing for animals must be highly similar to leather/imitation leather clothing for animals bearing in mind the nature, purpose and channels of trade. It follows that such clothing must be highly similar to the broader term of leather/imitation leather goods in class 18. Alternatively, a comparison can be made with the broad term "clothing" in class 25, which is focussed on clothing for humans. There are obvious differences between the end users, but "clothing" in class 25 and "clothing for animals" do share similar functions, purpose and purchasers. The channels of trade will not, however, have a significant overlap. There is no competitive or complementary relationship.

There is therefore a medium level of similarity between the earlier mark's clothing in class 25 and clothing for animals.

The average consumer and the nature of the purchasing act

20. As the case law above indicates, it is necessary for me to determine who the average consumer is for the goods/services at issue; I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. 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.”

21. In *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03 the GC stated:

“50. The applicant has not mentioned any particular conditions under which the goods are marketed. Generally, in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will

generally take place prior to purchase. Accordingly the visual aspect plays a greater role in the global assessment of the likelihood of confusion.”

22. The applicant has not commented on the question of the average consumer and the purchasing process. The opponent submits the average consumer will be the general public, paying a normal degree of attention when carrying out the purchasing process.
23. I agree that where the goods in classes 18 and 25 are concerned the average consumer will be a member of the general public. The goods are generally not overly expensive and are purchased fairly frequently which suggests a purchasing process that is no higher or lower than the norm. The goods are likely to be selected from retail outlets or from websites, brochures or catalogues. The manner of selection indicates that the visual impact of the marks will take on more importance. That said, such goods may also be the subject of, for example, word-of-mouth recommendations or oral requests to sales assistants and aural considerations therefore must also be born in mind. For goods such as saddlery, the purchasing process may be slightly more considered as such goods are purchased less frequently and may be more expensive than other goods within those classes.
24. The average consumer of the class 35 services “Advertising; business management; business administration; office functions” is more likely to be a professional user seeking to purchase advertising (although a member of the public could also buy advertising services), or business administration services and services which provide particular office functions. The selection process is likely to again be primarily visual, involving, for example, perusal of websites or brochures, although I do not discount the consideration that there may be some aural element through oral recommendations. Some contracts which involve a more substantial investment in, for example, business management services, may well also involve some oral negotiation, although there will invariably be written

dealings too, so that here too the selection process is likely to be largely visual. Some selection processes may therefore involve a slightly higher than average degree of attention when selecting the services at issue. Overall, however, there will be at least an average degree of attention paid to the selection of all the services.

Comparison of trade marks

25. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by them, 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.”

26. It would be wrong, therefore, artificially to dissect the trade marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions they create. The trade marks to be compared are:

Applicant's trade mark	Opponent's trade mark
Equality	

27. The applicant argues that his applied for mark is in lower case except for the initial “E” and standard, non bold font (as depicted above) and this reduces or prevents any visual similarity and risk of confusion. The applicant further argues that “Equality” and the earlier mark are very different visually. He submits that the average consumer would instantly recognise and understand the word “Equality” whereas the opponent’s figurative mark would have to be examined more carefully as their logo is interrupted within the “=” sign. He also argues that the earlier mark could be interpreted as an equation and assumed to be a mathematical term. The applicant provides a dictionary definition of the word equal. The applicant also submits that he chose the word “Equality” for his brand by reference to the definition of equality within the Equality Act 2010 on the basis that it covers everyone regardless of their protected characteristics.
28. The opponent argues that visually the respective marks are almost identical with the addition in the applied for mark of the suffix “ity” to the adjective “equal” to make the noun “equality”. The opponent submits that the addition in their earlier mark of the “=” symbol itself means equal or equality and that its role simply reinforces visually and conceptually the distinctive “EQUAL” word element in their mark. The opponent submits the average consumer is unlikely to notice this additional figurative element and the word component of the mark will usually have a stronger impact on the public than the figurative component. They argue the most dominant and distinctive part to both marks is the word element “EQUAL”. They state that as consumers naturally attach more importance to the beginning portion of any mark, the prefix “Equal” would take on a dominant role in the applied for mark. They further submit that the words are likewise aurally highly similar. Conceptually, they provide a dictionary definition of “equality” and argue that the

words within the respective marks are common English words and are the noun and the adjective for the same word. They argue there is conceptual identity or a high degree of similarity.

29. In terms of overall impression, the earlier mark consists of the word “EQUAL” presented in block capital letters in a bold font together with the mathematical symbol “=”. The letters making up the word “EQUAL” are divided across two lines and are also segmented by the “=” symbol. The first line is constructed of the letters “EQ” followed by the “=” symbol. The second line comprises the letters “UAL” such that overall there are three characters on each line. In my view, the average consumer is likely to see the word “EQUAL” within the mark. However, the stylisation and presentation of the mark, including the dividing of the letters over two lines and the inclusion of the “=” symbol within the mark which effectively inserts the “=” in the middle of the word, also make a strong contribution to the overall impression and are likely to be noticed by the average consumer when considering the mark as a whole. As set out below, I consider it unlikely that the average consumer would have an overall impression of the mark being a mathematical equation of “E-Q equals/= U-A-L”.
30. The applied for mark consists of the word “Equality”. That is the overall impression it will convey and where its distinctiveness lies.
31. Visually, the first five letters of the applied for mark are the first five letters (and indeed all of the letters) in the earlier mark – “E-Q-U-A-L”. There is a rough rule of thumb that more attention is normally paid by the average consumer to the beginnings of words/marks². However, the case law is also clear this is not conclusive in every case and that each case must be decided on its own merits. The common element of those five letters at the start of the respective words/marks is a visual similarity. However, the complexity and form of

² See *El Corte Ingles v OHIM [Mundicolor]* T-183/02 and T-184/03 at [81] and *L’Oreal v OHIM – Revlon [FLEXI AIR]* T-112/03 at [64] and [65], compared with, for example, *Grupo El Prado Cervera SL v OHIM [CHUFAPIT]* T-117/02.

presentation of the earlier mark and the additional letters in the applied for mark do create some significant visual differences.

32. First, there is the addition of the three letters “ity” to the applied for mark after the letters “Equal” which produces a longer word. Second, there is a noticeable stylisation to the earlier mark with the addition of the symbol “=”, and the dividing of the 5 letters (and 6 characters overall) between two lines such that the overall mark is made up of a balance of 3 characters on each line. These figurative elements of the earlier mark do produce together a visual effect that is memorable in design and quite striking. I therefore find the marks are visually similar to a low degree.
33. I should add that the applicant’s argument that a distinguishing feature is that his applied for mark is in lower case (other than the initial “E”) and is not in bold font has not been a factor in my assessment. A word trade mark registration protects the word itself written in any normal font and irrespective of capitalisation or highlighting in bold.³ If registration of the applied for mark were allowed, the applicant under notional and fair use would be able to present the mark in any normal font or capitalisation and therefore his current chosen presentation cannot be used as a distinguishing feature when comparing marks.
34. When considered from an aural perspective, there are two main ways in which the earlier mark could be articulated. The first is as the two syllable word “EE- KWAL”, with the “=” symbol or the space between the syllables not being vocalised. The second way would be for the mark to be vocalised as a mathematical equation of “E- Q-equals-U-A-L”. This is the aural articulation that the applicant favours and produces the greatest aural difference. However, I find the applicant’s suggestion to be the most unlikely articulation as the average consumer is most likely to

³ see *Present-Service Ullrich GmbH & Co. KG v. OHIM*, T-66/11 at [57]

articulate the mark in a way that resembles a common word known to him⁴. As I have found that the average consumer will see the word EQUAL in the earlier mark, it is my view that the average consumer will most likely articulate the mark in the first way I have described.

35. “Equality” will be articulated as the four syllable word “EE- KWOLL – I – TEE”. Again, there is a rule of thumb that aurally the attention of the consumer is usually directed to the beginning of the word⁵ but that conclusion is not inevitable in every case. Here the applied for mark differs from the earlier mark in its syllabic longer length. The addition of “ity” also changes the pronunciation of “equal” as it softens the second syllable “KWALL” to a “KWOLL.” Overall, in my view, there is a medium degree of similarity between the articulation of the earlier mark and the applied for mark.
36. Conceptually, I note the applicant’s argument that the average consumer would have to look at the earlier mark more carefully to take a meaning from it, as the word is interrupted by its spacing and the insertion of the “=”. In my view, however, I consider the average consumer is still likely to understand that the earlier mark contains the word “EQUAL” notwithstanding those figurative complexities. The average consumer is, in my view, unlikely to understand the mark as instead being a mathematical equation of “EQ equals/= UAL” because, as explained above, the average consumer, whilst perceiving a mark as a whole, will also generally look for something that suggests a concrete meaning or a word known to them. The addition of the “=”, whilst on the one hand disrupts the word due to its positioning in the mark, does also reinforce the concept of “EQUAL” as the average consumer will recognise it as the mathematical symbol meaning “equals.”
37. Overall, the average consumer is likely to see that the earlier mark contains the word “EQUAL.” The average consumer is not likely to analyse the mark to unpick

⁴ *Vitakraft-Werke Wurhmann v OHIM – Krafft [Vitacraft]* [2004] T-356/02

⁵ *El Corte Ingles SA v OHMI [Mundicolor]*

a particular focussed conceptual meaning for “EQUAL” and it is likely to convey a broad, general notion of something being the same as something else (for example, in amount, number (giving a mathematical significance), size, standard or importance). Due to the inclusion of the “=” symbol, some average consumers will focus more on the mathematical significance, others on the word more generally.

38. The average consumer will recognise the word “Equality” as a standard English word. They will not, in my view, understand the word in the sense of the technical definition contained within the Equality Act 2010 as put forward by the applicant. But, in my view, the average consumer is still likely to understand “Equality” as referring to a concept of treating different people in the same way, or fairly, or giving them the same opportunities. In my view, the average consumer is therefore likely to see “Equality” as relating to people. Whereas they will see “EQUAL” as a far broader, general concept not specifically focused upon people. There is therefore some conceptual similarity between the competing marks in the sense of the notion of “ending up the same”. But, the average consumer will not engage in a detailed unpicking of the respective conceptual meanings or their grammatical relationship and will not, in my view, identify the marks as being the noun and adjective for the same word, as propounded by the opponent. Overall, there is a degree of conceptual similarity at a level between low and medium. For those average consumers that focus on the mathematical connotations of the word, the conceptual similarity will certainly be low.

Distinctive character of the earlier trade mark

39. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, based either on inherent qualities or because of use made, the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). 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, count 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).”

40. There is no evidence of enhanced distinctiveness to be considered. This leaves the question of inherent distinctive character. The opponent submits that its earlier mark has a high inherent capacity to identify the goods and services for which it is registered as coming from the opponent. The applicant has not made submissions on the issue. The word EQUAL per se is not an invented word and whilst it is not allusive of any of the relevant goods or services, or a characteristic of them, I do not consider its level of distinctiveness to be particularly striking. The presentation might add to the distinctiveness, however, as this is something which is not present in the applied for mark, this will not increase the likelihood of

confusion.⁶ In my view, overall, the mark is possessed of an average degree of inherent distinctive character.

Likelihood of confusion

41. The factors considered above have a degree of interdependency (*Canon* at [17]), so that a higher degree of similarity between the goods and services may offset a lower degree of similarity between the marks, and vice versa. I must make a global assessment of the competing factors (*Sabel* at [22]), considering them from the perspective of the average consumer and deciding whether the average consumer is likely to be confused. In making my assessment, I must keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).
42. Confusion can be direct (which effectively 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/goods down to the responsible undertakings being the same or related).
43. Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10 explained:

“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

⁶ See *Kurt Geiger v A-List Corporate Limited*, BL O-075-13 where Mr Iain Purvis Q.C. at [38] to [39] held that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said: “if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

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 recognised 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.

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).

44. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr. James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made simply because the two marks share a common element. In this

connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

45. The applicant submits that the difference between the respective marks is such that the average consumer would not be confused. The opponent argues that given a high level of similarity between the marks and identity or high similarity between the respective goods and services, the average consumer is likely to be confused and believe the goods and services come from the same or economically linked undertaking.
46. Earlier in this decision I concluded:
- The respective goods and services are identical, highly similar or similar to a medium degree;
 - They cover a wide range of goods and services for which the average consumer will be a member of the public or a business user paying a least a medium level of attention during the selection and purchasing process;
 - The selection process is likely to be primarily visual, though I do not overlook an aural element;
 - There is a medium degree of aural similarity, low degree of visual similarity and low to medium degree of conceptual similarity between the marks;
 - The earlier mark has an average degree of inherent distinctive character.
47. In terms of direct confusion, even taking into account imperfect recollection, I do not consider it likely that the average consumer, with overall impressions in mind, will mistake the applicant's mark for the opponent's. I bear in mind here, that the visually memorable figurative elements of the earlier mark do play a strong role in the overall impression of the earlier mark and that visual considerations are likely to dominate the purchasing process. The differences in overall impressions are sufficient to ensure that the marks will not be misremembered or mistakenly recalled as the other by the average consumer, even when considered in relation to identical goods or services. There is therefore no likelihood of direct confusion.

48. This leaves the question of indirect confusion. I have borne in mind that the examples given by Mr Purvis in *L.A. Sugar* were intended to be illustrative in the context of that case, and not to impose rigid rules.⁷ The categories of case where indirect confusion may be found are not closed. Each case must be assessed on its own facts, and my assessment must take account of the overall impression created by the marks. I must try to envisage the instinctive reaction in the mind of the average consumer when encountering the later mark with an imperfect recollection of the earlier, or vice versa. I must assess whether the average consumer will make a connection between the marks of the type that would lead them to assume that the goods or services in question are from the same or economically linked undertakings.
49. The common element here is “equal” (although it forms just part of the applied for mark) which is far from strikingly distinctive and I do not consider the average consumer would assume that no one else, other than the brand owner, would be using it as part of a trade mark. I also do not consider that the fact, grammatically speaking, “equality” may be a derivative of “equal” would mean that the average consumer would consider the mark as a whole to be a variant or sub-brand of the opponent’s mark which, as part of the composite mark, contains the word “EQUAL.” As explained above, the average consumer is not likely to see the respective marks as being a noun and adjective of the same word and it also does not strike me that the average consumer would see this as a normal way in which a sub or variant brand or brand extension would be presented.
50. The figurative elements of the earlier mark play a strong role in its overall impression, quite different from the simpler, word only, applied for mark. There is a conceptual difference as the average consumer will see “EQUAL” in the earlier mark as being a broad, general concept, whereas they are likely to see “Equality” as relating to people in particular. This conceptual difference will be starker for

⁷ See *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17 at paragraphs [81] to [82]

those average consumers who see a mathematical connotation to the earlier mark. This strong contrast in graphic treatment, considered together with the longer word at play with “Equality” and the conceptual difference, amount to differences which, in my view, in the context of the marks viewed a whole, will preclude an instinctive impression by the average consumer that the goods and services originate from economically linked undertakings.

51. For completeness sake I will also address the argument raised by the applicant that there are other trade marks owned by third parties containing the word “equal” or “equality” which have not been opposed by the opponent. I do not consider this “state of the Register” evidence is of any assistance to the dispute in question⁸ as there is nothing to show that such marks are in use and that they have had any impact on the consumer. I have therefore not taken those arguments into account when reaching my decision above.

Conclusion

52. The opposition fails. Subject to appeal, the applicant’s mark may proceed to registration.

Costs

53. Under cover of a letter dated 21 July 2018 the applicant was sent a costs proforma which he was directed to complete and return by 6 August if he intended to request an award of costs. The letter informed the applicant that if the proforma was not

⁸ See for example *British Sugar [1996] RPC 281* at 305 where Jacob J said: “In particular the state of the register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led the registrar to put the marks concerned on the register. It has long been held under the old Act that comparison with other marks on the register is in principle irrelevant when considering a particular mark tendered for registration, see e.g. *MADAME Trade Mark* and the same must be true under the 1994 Act. I disregard the state of the register evidence.”

completed and returned no costs would be awarded other than any official fees paid. The proforma has not been returned and I therefore do not make any costs award in favour of the applicant. There are no official fees to reimburse.

Dated this 12th day of October 2018

Rachel Harfield

For the Registrar,

The Comptroller-General