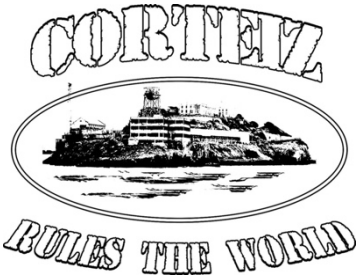
BLO/683/21

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO.
UK00003362432



IN THE NAME OF CLINTON OGBENNA
(Proprietor/Appellant)

AND

IN THE MATTER OF AN APPLICATION FOR
INVALIDATION THEREOF
UNDER NO. 503057 BY
NIKE INNOVATE C.V.
(Cancellation Applicant/Respondent)

AND

IN THE MATTER OF
AN APPEAL TO THE APPOINTED PERSON
AGAINST DECISION NO. O/171/21
OF Ms. S. WILSON DATED
16th MARCH 2021

MR. ANDREW MARSDEN of Wilson Gunn appeared for the Proprietor/Appellant.

MR. JULIUS STOBBS of Stobbs appeared for the Applicant/Respondent.

Hearing date: Thursday 10th June 2021

DECISION

Introduction

1. This is an appeal against a decision of Ms. Stephanie Wilson, sitting as a Hearing Officer on behalf of the Registrar of Trade Marks, dated 16th March 2021. By that decision the Hearing

Officer granted Invalidity Application No.503057 brought by Nike Innovate C.V. ("the Respondent") against Mr Clinton Ogbenna's ("the Proprietor") trade mark registration No.3362432 in its entirety, declaring the same to be invalid. The Hearing Officer ordered the Proprietor to pay to the Respondent £1850 as a contribution towards costs. The Proprietor now appeals against that decision.

Background

Contested Mark

2. The details of the Proprietor's Mark are as follows:

Mark: 

No. 3362432

Registration Date: 20/12/2018

Class: 25

Specification: Clothes

("the Contested Mark")

Earlier Trade Marks

3. The Respondent filed its application for a declaration of the Contested Mark's invalidity on 6/3/2021. Citing section 47 of the Trade Marks Act 1994 ("the Act"), the Respondent initially relied on sections 5(2)(b) and 5(3) of the Act and on the following earlier trade marks:

a) Mark: CORTEZ

EUTM No. 6402432

Filing date 30 October 2007

Registration date 11 September 2009

b) Mark: COR72Z

EUTM No. 7585003

Filing date 6 February 2009

Registration date 15 September 2009

c) Mark: CORTEZ
UKTM No. 1114342

Filing date 15 May 1979

Registration date: 15 May 1979

Pleaded Cases in Summary

4. The Respondent contended that under S. 47 (2) (a)/S. 5 (2) (b) of the Act, there was a likelihood of confusion because the parties' respective marks are similar, and the goods are identical or similar.

5. Further, under section 5(3) the Respondent claimed a reputation in respect of all goods for which the Earlier Mark is registered. The Respondent claimed that use of the Contested Mark would, without due cause, take unfair advantage of, or be detrimental to, the distinctive character and/or reputation of the Earlier Mark.

6. The Proprietor essentially denied these claims entirely (along with the "Proof of Use" challenge referred to above).

Proof of Genuine Use

7. All of the Respondent's trade marks have extensive specifications. However, the marks are also all of an age that brought them within the "Proof of Use" requirements of S. 47 (2A) of the Act. The Proprietor duly put the Respondent to proof of the marks' genuine use.

8. As a result of evidence filed and the submissions of the Parties, the Hearing Officer concluded that the Respondent had shown relevant genuine use of, and could only rely on, EUTM No. 6402432 CORTEZ for a fair specification of "trainers" in class 25 ('the Earlier Mark"). There is no appeal against this finding, so I need say no more about the Respondent's other trade marks.

Evidence & Submissions

9. Only the Respondent filed evidence. Neither side requested a Hearing, but both filed written submissions in lieu. In particular, the Respondent submitted that the evidence it had filed demonstrated reputation under S. 5 (3) and enhanced distinctive character for the purposes of the assessment under S. 5 (2) (b).

The Hearing Officer's Decision

10. In her Decision, Ms. Wilson determined that the application for invalidity succeeded in its entirety on the basis of the Earlier Mark and the Contested Mark was to be declared invalid in respect of all goods for which it is registered. Under section 47(6) of the Act, the registration was to be deemed never to have been made.

11. The Hearing Officer's Decision as regards proof of use and the consequent limitation of the Respondent's case to the Earlier Mark has been noted. That aside, in summary, the Hearing Officer held as follows:

S. 5 (2) (b)

a. The respective goods *clothes* and *trainers* were similar to a medium degree [38-40].

b. The average consumer for the goods would be a member of the general public, with a medium degree of attention being paid [41-43].

c. The overall impression of the Earlier Mark was simply the word CORTEZ, whereas in the Contested Mark the word CORTEIZ plays the greater role. The device was held to play a slightly lesser role. The words RULES THE WORLD were also held to play a lesser role in the overall impression because they were likely to be seen as a laudatory slogan [47].

d. Visually, the marks coincided in the first five letters CORTE -. The ending of the word in the First Earlier Mark is -Z whereas in the Contested Mark it is -IZ. The oval pictorial device and the words RULES THE WORLD in the Contested Mark were a point of visual difference. The Hearing Officer considered the marks to be visually similar to between a low and medium degree [48].

e. Aurally, the marks were considered to be similar to a medium-high degree depending on whether the words RULES THE WORLD were pronounced in the Contested Mark [49].

f. Conceptually it was held that both CORTEZ and CORTEIZ will be viewed as invented or foreign language words which will be conceptually neutral. The words RULES THE WORLD and the device element in the Contested Mark would act as points of conceptual difference [51].

g. The distinctive character of the earlier mark was inherently high and, on the evidence, enhanced through use to a very high degree [55].

h. The differences in the marks negated a likelihood of direct confusion, even allowing for imperfect recollection [58].

i. Nevertheless, the elements CORTEZ/CORTEIZ were likely to be misremembered and, taking all the factors into account (in particular the highly distinctive character of the Earlier Mark), the Contested Mark would be likely to be viewed as an alternative mark being used by the same or economically linked undertaking, such that there was a likelihood of indirect confusion [59].

j. The application for invalidation based upon section 5(2)(b) of the Act therefore succeeded in its entirety.

S. 5 (3)

k. The Respondent had proven its mark had a strong reputation [67].

l. Given the similarities between the marks and the goods, the high inherent and enhanced distinctiveness of the Earlier Mark and the strength of its reputation, it was likely that a link would be made by a significant part of the relevant public [69].

m. There was a risk of "image transfer" which would take an unfair advantage of the Earlier Mark [73].

n. Therefore "the opposition *(sic)* based upon section 5(3) succeeds in its entirety" [75].

The Appeal/Standard of Review

12. The Proprietor filed an appeal to the Appointed Person under S. 76 of the Act on 13 April 2021.

13. It is by now trite that an appeal is by way of review, not a rehearing. The relevant principles are set out in cases such as *TT Education Ltd v Pie Corbett Consultancy* [2017] RPC 17, *Actavis Group PTC EHF v ICOS Corporation* [2019] UKSC 15, *Apple Inc. v Arcadia Trading Ltd* [2017] EWHC 440 (Ch) and *Abanka D.D. v. Abanca Corporación Bancaria S.A.* [2017] EWHC 2428 (Ch). Neither surprise at a Hearing Officer's conclusion nor a belief that she or he has reached the wrong decision will justify interference. Interference is justified only if the Appointed Person is satisfied that there was a distinct and material error of principle in the decision below or that the Hearing Officer was wrong to such an extent that she or he was not entitled to come to the decision, or that no reasonable tribunal would have come to the decision. The bar for intervention is accordingly set at a high level.

14. The appeal hearing was held by video conference on 10 June 2021. Mr. Andrew Marsden of Wilson Gunn appeared for the Proprietor/Appellant. Mr. Julius Stobbs of Stobbs appeared for the Applicant for Invalidity/Respondent. I am grateful to both for the written and oral submissions and their patience in the light of technical issues/interruptions.

The Grounds of Appeal

15. The grounds of appeal ran to 12 paragraphs and more than a few of these were focussed mostly on the issue of the weight given by the Hearing Officers to various factors in the overall assessments, which (as observed by Mr Iain Purvis QC sitting as the Appointed Person in BL O/106/20 *GREYBOX* at [23] is something "the Courts have consistently rejected as a proper ground of Appeal".

16. However, by the time the Hearing came on, the Appellant had focused its appeal on two principal issues, both of which emerged from the assessment conducted under S. 5 (2) (b) of the Act.

17. First, it was said that the Hearing Officer had "artificially dissected" the Appellant's trade mark by failing to take proper account of the device element and the words RULES THE WORLD.

18. Secondly, it was said that the Hearing Officer failed to take in to account the conceptual differences in the marks, in particular the geographical concept of the Contested Mark imbued by the device element and the words RULES THE WORLD.

19. As to S. 5 (3), for the most part the Appellant complained that the Hearing Officer's decision was flawed for the same reasons. At the hearing Mr Marsden (for the Appellant) conceded that in those respects the S. 5 (3) appeal stood or fell with the S. 5 (2) grounds.

Amendment to the Grounds of Appeal

20. In its skeleton argument, but *not* in its pleaded grounds of appeal, the Appellant also sought to call into question the Hearing Officer's assessment of the Respondent's evidence of reputation/enhanced distinctive character. This led Mr Marsden to explore the possibility of amending the Grounds of Appeal to include, and then make submissions in respect of, these grounds.

21. In his skeleton argument for the Appellant, when dealing with the case under S. 5 (3) of the Act, Mr Marsden argued:

    "The hearing officer finds that the evidence shows significant use of CORTEZ for 'trainers', in making this finding the hearing officer has made assumptions that the amount of use is significant despite the fact that Nike has not provided any market share information or evidence. Further, the hearing officer has assumed that there has been significant use for 'trainers' despite the fact that none of the evidence provides a breakdown of the goods sold…

    The hearing officer was wrong to make certain assumptions about market share and use having been significant upon the goods 'trainers'. The evidence is not there to support these assumptions. Whilst a reputation may exist and the earlier mark may be distinctive, it is wrong to find that the degree of distinctiveness is of a "very high degree" as stated by the hearing officer at para 55. Whether this makes any material difference I am not sure, but the point must be raised. At para 67 the hearing officer finds that the earlier mark has a "strong reputation", this is again based on assumptions rather than specific evidence. We acknowledge that NIKE is a well-known entity, but we must in these proceedings make findings on the basis of the evidence filed and not on the basis of assumptions or personal knowledge".

22. When it was pointed out that this argument was not foreshadowed in the pleaded grounds of appeal, Mr Marsden asked if it was possible for it "to be admitted into the discussion".

23. For his part, for the Respondent Mr. Stobbs staunchly resisted the introduction of these arguments on the basis that there would be prejudice to the Respondent (in that it would have prepared its case differently) and that the ground, being an attack on findings of fact, had no prospect of success in any event.

24. I refused Mr Marsden's request and said I would give my reasons more fully in my written decision. Accordingly, I deal with that now.

25. Whilst there is a discretion to allow new grounds even at such a late stage, it is a discretion which should not be exercised lightly. In this case:

    a. No formal written amendment was presented.
    b. The Appellant had conceded the existence, if not the precise degree of, the Respondent's reputation in CORTEZ for footwear in its written submissions in lieu of a hearing below.
    c. The Appellant did not raise the issue of "market share" or the significance of the use made of the Earlier Mark as regards distinctive character before the Hearing Officer.

d. Other than taking a point about the absence of invoices or other documentation to confirm sales of goods in the United Kingdom, the evidence before the Hearing Officer was unchallenged.
e. The Hearing Officer had conducted a review of the evidence in the round (at [29], [55] and [67]). The Hearing Officer acknowledged she had no market share figures but set this against the unchallenged extent of very substantial use. The Hearing Officer was fully entitled – indeed, was required – to draw inferences (in effect, the "assumptions" complained of) as to reputation/enhanced distinctive character from the evidence and arguments before her. Since the Appellant chose not to make this an issue below, the Hearing Officer could not realistically be criticised for drawing her own conclusions as best she could.
f. As observed by Lewison LJ in *Fage UK Ltd v. Chobani UK Ltd* [2014] EWCA Civ 5 at paragraphs [114] and [115]: "*Appellate courts have been repeatedly warned, by recent cases at the highest level, not to interfere with findings of fact by trial judges, unless compelled to do so. This applies not only to findings of primary fact, but also to the evaluation of those facts and to inferences to be drawn from them"*
g. It would clearly have been prejudicial to the Respondent – and the Tribunal – to have to re-orient themselves to an unexpected review of the evidence, even to the extent of a possible adjournment.
h. Mr Marsden himself accepted before me that the point would be unlikely to make any material difference.
i. Finally, the issue was, in reality, no more than a disagreement with the Hearing Officer's conclusion.

26. Thus, this new "ground" lacked *prima facie* merit or any other saving grace justifying the exercise of my discretion to allow it to be run.

S. 5 (2) (b)

The First Ground of Appeal - "Artificial Dissection" of the Contested Mark

27. The Appellant acknowledged that the Hearing Officer had set out (at [36-37]) the correct law and tests pertaining to the assessment under S. 5 (2) (b) of the Act.

28. The Appellant complained, however, that:

"*The hearing officer has artificially dissected the marks, dismissing the image and the words RULES THE WORLD in the appellant's mark. Consequently, material errors have been made in the application of the legal tests by the hearing officer thereby resulting in an incorrect finding of similarity sufficient to give rise to a likelihood of confusion under Section 5(2)(b) and a link under 5(3) of the Act.*

It is wrong that the hearing officer simply separates out the words RULES THE WORLD and dismisses them claiming that the words are merely laudatory. This is wrong, the words do not stand alone, they are inextricably linked to the word CORTEIZ and to the image, and so the mark should be compared in its entirety to the earlier mark CORTEZ."

29. Mr Marsden developed this in submissions, saying that the image and the words RULES THE WORLD had been dismissed as having no real impact and were "set aside as not really being

relevant" with the result that the focus was on a comparison of CORTEIZ alone with CORTEZ. Furthermore, he argued that in the context of the Contested Mark

"CORTEIZ is (an) invented place and that RULES THE WORLD. So it is the whole thing together".

30. The Hearing Officer was clearly alive to the risks of dissection. She had set out the standard summary of the tests for comparing trade marks at [37] and this included the usual admonishments in this regard at [37(c)- (f)].

31. The Hearing Officer then began the assessment process at [44], saying:

44. 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 the trade 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."

45. 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.

32. It is clear from this that in the case of composite marks there is no rule that the individual elements must be interpreted to have a single, over-riding unitary impression. Each element and its contribution must be assessed according to its role in the overall mark, and those individual roles can differ in their effect on and perception by consumers even when they are viewing the marks as wholes.

33. Dealing first with "overall impression", the Hearing Officer said:

"47. ...The Contested Mark consists of the word CORTEIZ presented above an oval pictorial device, which itself appears above the words RULES THE WORLD. The wording is presented in a white slightly stylised font and outlined in black. The word CORTEIZ plays the greater role in the overall impression due to its size and the fact that the eye is naturally drawn to elements that can be read. The device plays a slightly lesser role. The words RULES THE WORLD play a lesser role in the overall impression because they are likely to be seen as a laudatory slogan".

34. It seems to me that this is a well-reasoned conclusion as to the overall impression of the Contested Mark. It is true that in identifying the words "RULES THE WORLD" as a "slogan" the Hearing Officer appears to be treating them as a separate element rather than being

grammatically bound to CORTEIZ in the way Mr Marsden would like it to be seen, and it is the case that others might differ and see all the words as part of a unitary phrase (indeed, both sides had submitted as much), but nevertheless it was open to the Hearing Officer to reach the interpretation that she did.

35. Besides, separated or not, it made no real difference - far from dismissing the device element and the words "RULES THE WORLD" it can be seen that the Hearing Officer has accorded them due significance – their role is acknowledged as "lesser", but not non-existent, which is an entirely reasonable conclusion given that no matter how those words are perceived, they have a subordinate, qualifying role both in size and language.

36. As regards the Appellant's specific contention that "*the hearing officer simply separates out the words RULES THE WORLD and **dismisses** them claiming that the words are merely laudatory" (emphasis added)* it is manifestly clear that there was no such dismissal. On the contrary, the Hearing Officer clearly gave them due weight, combining all the elements of the Contested Mark together notwithstanding her view that the words in question had laudatory significance. Note that the Appellant did not dispute the finding that the words "RULES THE WORLD" were laudatory *per se.*

37. Turning to a visual comparison, the Hearing Officer said at [48]:

    *"Visually, the marks coincide in the first five letters – CORTE. The ending of the word in the First Earlier Mark is -Z whereas in the Contested Mark it is -IZ. The oval pictorial device and the words RULES THE WORLD in the Contested Mark are also a point of visual difference, as they have no counterpart in the First Earlier Mark. **Taking all of this into account**, I consider the marks to be visually similar to between a low and medium degree."* (Emphasis added).

38. Again, therefore, the Hearing Officer can be seen to be properly engaged in the task of applying the *BIMBO S.A.* test.

39. The inclusive approach of the Hearing Officer can also be seen in her consideration of the phonetic comparison at [49]:

    "49. Aurally, the First Earlier Mark is likely to be pronounced CORE-TEZ. The Contested Mark may be attributed a number of different pronunciations, but is most likely to be pronounced CORE-TEE-EZZ or CORE-TEEZ. As the words RULES THE WORLD are likely to be seen as a descriptive slogan they may not be pronounced. If that is the case, then the marks will be aurally similar to between a medium and high degree. If they are pronounced, then they will be aurally similar to no more than a medium degree."

    Notwithstanding she contemplated alternative scenarios, the Hearing Officer clearly takes into account – in the Appellant's favour – that, if pronounced, the words "RULES THE WORLD" will have an active role in the phonetic comparison, reducing the level of similarity to a base level of "medium".

40. As to the role of the oval device and the words "RULES THE WORLD" in the conceptual comparison, the Hearing Officer had this to say at [51]:

"The words RULES THE WORLD in the Contested Mark will be seen as a laudatory slogan, promoting the prominence of the brand. The oval device will be recognised as depicting a particular place, as buildings are visible, but I consider it unlikely that the location will be recognised. Nonetheless, as submitted by the proprietor, these will act as points of conceptual difference".

41. Again, far from dismissing these elements and leaving them out of account, the Hearing Officer is completely "on task" in weighing up their contribution to the Contested Mark. If anything, her statement that "*The words RULES THE WORLD in the Contested Mark will be seen as a laudatory slogan, promoting the prominence of the brand…"* tends to show that the Hearing Officer interpreted the phrase to be grammatically subordinate but connected to CORTEIZ, notwithstanding this might have been better expressed.

42. Moving on to the task of "global appreciation" the Hearing Officer begins at [57] by summing up her conclusions about the marks' comparison, including:

"I have found the words CORTEZ and CORTEIZ to be conceptually neutral, but the oval pictorial device and words RULES THE WORLD in the Contested Mark, act as points of conceptual difference."

43. Moving on to the assessment of direct confusion at [58] (the findings in respect of which are not in dispute) the Hearing Officer expressly invokes the device element as sufficient to distinguish the marks.

44. Again, therefore, the Hearing Officer is drawing together the individual threads, conducting *"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."*

45. This leaves the assessment of indirect confusion. In this respect the Hearing Officer said at [59]:

"I must now consider whether there is a likelihood of indirect confusion. I consider it likely that the words CORTEZ and CORTEIZ will be misremembered. This is particularly the case given that there is no conceptual hook to assist the average consumer in distinguishing between them. Given the high degree of distinctiveness of the First Earlier Mark (both inherently and through use), I consider that the additional elements in the Contested Mark are likely to be viewed as an alternative mark being used by the same or economically linked undertaking. The device is likely to be seen as a different mark that might be used on packaging or advertising, when the word only version (as in the First Earlier Mark when the words are misremembered) might be seen as one used in text or in publications. The additional words RULES THE WORLD will be viewed as a laudatory slogan being used by the same business. Taking all of this into account, I consider there to be a likelihood of indirect confusion for those goods that I have found to be similar to a medium degree."

46. This is perhaps the clearest example of what the Appellant seeks to portray as "artificial dissection", submitting that *"It is clear that in the assessment the hearing officer is focusing on these words only and is giving little or no weight or consideration to the words RULES THE WORLD and the image in the Appellant's mark*".

47. I do not agree. On the contrary, the Hearing Officer has clearly considered *all* aspects of the Contested Mark, as she must do for non-negligible elements of a composite mark. The weight a Hearing Officer gives to those elements is a matter with which is not a proper one for appeal. In any event, the Hearing Officer was stating no more than the obvious – the core of the Contested Mark, its subject and that element which will most immediately resonate with an average consumer taking the Contested Mark as they find it, is CORTEIZ, the other elements being there in its support. While those other elements clearly have roles to play, these were duly acknowledged and assessed and having properly applied her mind to the marks in suit, it was entirely open to the Hearing Officer to reach the conclusions that she did.

48. It follows that I cannot discern any error of principle or other flaw in the Hearing Officer's reasoning and **the first ground of appeal therefore fails.**

The Second Ground of Appeal – Failure to consider the Geographical Concept of the Contested Mark

49. The Appellant contended that:

"…the hearing officer discusses the conceptual comparison. The hearing officer says that the image and the words RULES THE WORLD are points of conceptual difference, but says that the words CORTEZ / CORTEIZ are conceptually neutral. The hearing officer incorrectly dismisses the claim that the Appellant's mark will have a concept of a location named CORTEIZ ruling the world. This concept is a possibility and the hearing officer should have taken due account of this and made a finding in this regard".

50. In his skeleton Mr Marsden submitted that:
"The hearing officer has failed to acknowledge the concept of the appellant's mark. It is clear that the appellant's marks is to be viewed in its entirety, the appellent's (sic) mark is not CORTEIZ with additional non-distinctive matter. The mark is CORTEIZ followed by an image of what will immediately be perceived by the average consumer, as a location called 'corteiz' and the words RULES THE WORLD, these words hang together with the word CORTEIZ because they inform the consumer that the invented place 'corteiz' rules the world. The hearing officer has not addressed this in the comparison of the marks and has therefore failed to acknowledge the conceptual meaning of the appellant's mark and the fact that this renders the marks conceptually dissimilar".

51. The Hearing Officer noted the Appellant's case on concept at [50]:

"50. In relation to the conceptual comparison, the proprietor submits as follows:
"The proprietor's mark conveys a concept completely different to any concept conveyed by the earlier mark.

The inclusion of the logo/image of a geographical place in the proprietor's mark combined with the wording CORTEIZ RULES THE WORLD creates a concept of a location call (sic) 'CORTEIZ' ruling the world.
…

The average consumer in the UK is most likely to understand CORTEZ as being a word of Spanish/Latin American origin representing a surname. The average consumer in the UK is less likely to understand CORTEZ as being a geographical location.

Furthermore, the image in the proprietor's mark and the words RULES THE WORLD, provide that mark in its entirety with a different concept to any possible concept that could be derived from CORTEZ".

52. The Hearing Officer, however, must form her own view of the concept of the mark and having acknowledged the Appellant's submission, she determined as follows:

"51. Conceptually, I consider it unlikely that either mark will be identified as a name, whether a surname or a place name. In my view, it is more likely that both CORTEZ and CORTEIZ will be viewed as invented or foreign language words which will be attributed no meaning by the average consumer. They will, therefore, be conceptually neutral. The words RULES THE WORLD in the Contested Mark will be seen as a laudatory slogan, promoting the prominence of the brand. The oval device will be recognised as depicting a particular place, as buildings are visible, but I consider it unlikely that the location will be recognised. Nonetheless, as submitted by the proprietor, these will act as points of conceptual difference"

53. In effect, and whilst it might have been better expressed, the Hearing Officer does not accept that the image in the Contested Mark of an unrecognisable location is sufficient to imbue the mark, and in particular the element CORTEIZ, with a geographical significance or concept. The additional elements are acknowledged to play some role in conceptual differentiation but not to the extent pressed by the Appellant. This accords with how consumers see marks, taking them as they find them, rather than engaging in detailed enquiry, which is what would be required here for the consumer to work out that CORTEIZ was supposed to be a place.

54. This feeds through into the Hearing Officer's finding on indirect confusion at [59]:

"I consider it likely that the words CORTEZ and CORTEIZ will be misremembered. This is particularly the case given that there is no conceptual hook to assist the average consumer in distinguishing between them"

55. The Appellant's answer to this is that there *is* a conceptual hook, namely that CORTEIZ RULES THE WORLD is an invented place.

56. The difficulty for the Appellant is that an error of principle does not emerge from just gainsaying the Hearing Officer. The Hearing Officer received the argument below but did not agree with it. She formed her own view of the Contested Mark, as she was entitled to do, and no flaw in her reasoning has been identified by the Appellant beyond its mere disagreement.

57. Consequently, **the second ground of appeal also fails.**

S. 5 (3)

58. Mr Marsden having accepted that the Appeal under S. 5 (3) was dependent on success under S. 5 (2) (b), and the Appeal having failed entirely under that section, there is no need for me to consider the ground of appeal under S. 5 (3) of the Act.

Conclusion on the Appeal

59. The Appeal has failed in its entirety. The Hearing Officer's Decision stands.

Costs

60. The Appeal having failed the Respondent is entitled to a contribution to its costs. The parties indicated that they were content for costs to follow the usual scale.

61. The Hearing Officer made an award of £1,850 as a contribution towards the costs of the Respondent. So far as the costs of the Appeal are concerned, I order the Appellant to pay £800 by way of contribution to the costs incurred by the Respondent in dealing with this Appeal. Therefore, the Appellant must pay to the Respondent or its representatives the total sum of £2,650 within 21 days of the date of this decision.

Philip Harris
Appointed Person
17 September 2021