

O/918/22

TRADE MARKS ACT 1994

IN THE MATTER OF
TRADE MARK APPLICATION NO. 3609279
BY EL CORTE INGLÉS, S.A.
TO REGISTER THE TRADE MARK:

The logo consists of the word 'KIDS' in a large, bold, black, hand-drawn style font. Below it, the words 'El Corte Inglés' are written in a smaller, black, cursive script font.

IN CLASSES 3, 14, 18, 25 & 35

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 425896
BY SMART GARDEN PRODUCTS LIMITED

Background and pleadings

1. On 4 December 2020,¹ El Corte Inglés, S.A. (“the applicant”) applied to register the trade mark displayed on the cover page of this decision in the UK, under trade mark number 3609279 (“the contested mark”). The contested mark was published in the Trade Marks Journal for opposition purposes on 4 June 2021. Registration is sought for the following goods and services:

- Class 3: Bleaching preparations and other substances for laundry use; Cleaning, polishing, scouring and abrasive preparations; Soap; Perfumery, essential oils, cosmetics, hair lotions; Dentifrices.
- Class 14: Chronometric instruments; Semi-precious stones; Precious metals and their alloys; Precious stones; Jewellery; Time instruments.
- Class 18: Luggage, bags, wallets and other carriers; Walking sticks; Whips; Covers for animals; Animal skins; Harnesses; All-purpose carrying bags; Saddlery; Leather and imitations of leather; Umbrellas and parasols.
- Class 25: Clothing; Footwear; Headgear.
- Class 35: Advertising; Business management; Business administration; Wholesale services and retail services via global computer networks in relation to the following goods: Perfumery, cleaning preparations and cosmetics, Precious metals and their alloys, jewellery, Timepieces, Leather and imitation leather, Animal skins, hides, baggage, Handbags, Wallets and other carrier bags, Trunks, Suitcases, umbrellas, Parasols, Walking sticks, harness

¹ On 1 January 2021, the UK left the EU after the expiry of the transition period. Under Article 59 of the Withdrawal Agreement between the UK and EU, applications for EUTMs made before the end of the transition period that had received a filing date can form the basis of a UK application with the same filing date as the corresponding EUTM, provided they were filed within 9 months of the end of the transition period. The applicant’s EUTM number 18349433 was filed at the EUIPO on 4 December 2020, whereas its UK application was filed on 12 March 2021. Accordingly, the UK application was given the same filing date as its EUTM.

and saddlery, Linen for animals, Clothing, Footwear and Headgear.

2. On 30 July 2021, Smart Garden Products Limited (“the opponent”) filed a notice of opposition. The opposition is brought under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and is directed against the goods in class 25 of the application. To support its claim, the opponent relies upon its comparable UK trade mark number 915543747² (“the earlier mark”), which consists of the following:



3. The earlier mark was filed on 16 June 2016 and became registered on 17 February 2017. The earlier mark is registered in respect of goods in classes 21, 24, and 25. For the purposes of the opposition, the opponent relies upon some of the goods, namely:

Class 25: Headwear; socks; boot warmers; boot socks; scarves; hats; gloves; tops; shirts; tee shirts; long sleeve tee shirts; fleeces.³

4. Given the respective filing dates, the opponent’s mark is an earlier mark, in accordance with section 6 of the Act. However, as it had not been registered for five years or more at the filing date of the application, it is not subject to the proof of use requirements specified within section 6A of the Act. Consequently, the opponent may rely upon all of the goods for which the earlier mark is registered without having to establish genuine use.

² Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing EUTM. As a result of the opponent’s EUTM number **15543747** being registered as at the end of the Implementation Period, a comparable UK trade mark was automatically created. The comparable UK mark is now recorded on the UK trade mark register, has the same legal status as if it had been applied for and registered under UK law, and the original EUTM filing date remains.

³ As a result of decision number BL O/148/22, issued on 21 February 2022, the opponent’s specification within class 25 (upon which it relies) has been limited. Therefore, the opponent cannot rely on some of the goods identified in its Form TM7 as the earlier mark is no longer registered for such goods. My decision will take into account only the goods of the earlier mark as they currently appear in the register.

5. In its notice of opposition, the opponent essentially argues that the respective goods are identical and that the marks are similar, giving rise to a likelihood of confusion.

6. The applicant filed a counterstatement denying the ground of opposition. The applicant denies that the marks are similar and neither admitted nor denied the opponent's claim that the goods are identical. However, it denies there would be a likelihood of confusion between the marks.

7. The opponent is professionally represented by Baron Warren Redfern, whereas the applicant is professionally represented by Fry Heath & Spence LLP. Both parties were given the option of an oral hearing, though neither asked to be heard on this matter. Evidence has been filed by the applicant in these proceedings. Only the applicant filed written submissions in lieu of an oral hearing. This decision is taken following a careful perusal of the papers.

8. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark case law.

Evidence and submissions

9. The applicant's evidence comprises the witness statement of Heather Donald dated 19 April 2022, together with Exhibits HD1 to HD4. Heather Donald is a Chartered Trade Mark Attorney at Fry Heath & Spence LLP. The purpose of their statement is to give evidence concerning the prevalence of the word "kids" in registered trade marks, as well as the use of the word "kids" in connection with clothing.

10. As stated above, the applicant filed written submissions in lieu of a hearing.

11. I have read all of the evidence and submissions and will return to them to the extent I consider necessary in the course of this decision.

Decision

Section 5(2)(b)

12. Sections 5(2)(b) and 5A of the Act read 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”.

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

Case law

13. I am guided by the following principles which 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 impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

14. In *Canon*, Case C-39/97, the Court of Justice of the European Union (“CJEU”) stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, [...] 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”.

15. 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.

16. In *Gérard Meric v Office for Harmonisation in the Internal Market ('Meric')*,⁴ the General Court stated that:

“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”.

17. The goods to be compared are those goods in class 25 outlined in paragraphs 1 and 3 of this decision.

18. The applicant's term “headgear” is simply an alternative way of expressing the opponent's term “headwear”. As a result, these goods are identical.

19. The opponent's terms “tops; shirts; tee shirts; long sleeve tee shirts; fleeces” are encompassed by the applicant's broader term “clothing” and, as such, I find that the respective goods are *Meric* identical.

20. The applicant's term “footwear” and the opponent's terms “socks, boot warmers, boot socks” overlap in nature method of use insofar as they are both worn on the foot. However, they differ in that footwear is typically worn as outerwear for the foot, whereas socks are worn directly on the foot. The intended purpose differs, as footwear

⁴ Case T-133/05

usually has a robust protective sole that protects your feet from the ground and prevents your feet from getting dirty or wet, whereas socks or boot warmer are worn for comfort, or for warmth. The trade channels may overlap as undertakings that provide footwear often provide socks; furthermore, they will be sold in the same outlets. For example, many sport shoe brands will also produce sports socks. Users will also be the same. The competing goods are complementary as, for many types of footwear, such as trainers or hiking boots, socks are considered essential, and consumers may reasonably believe that the same undertaking would offer both. However, the goods are not competitive as, although they are both worn on the foot, a sock cannot be worn as a replacement for footwear. Overall, I am of the opinion that the respective goods are similar to a high degree.

The average consumer and the nature of the purchasing act

21. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

22. 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.”

23. I find that the average consumer of the goods at issue is likely to be a member of the general public. The cost of the purchase is likely to vary, from an inexpensive pair

of socks to a more expensive shirt or high-performance, outdoor fleece, but, overall, they will be relatively inexpensive. On average, consumers are likely to purchase these goods rather frequently. I find that the purchasing process is likely to be fairly casual, however, consideration will be given to the materials used, the fit, the aesthetic appearance and the durability of the goods. Taking the above factors into account, I find that consumers will demonstrate an average level of attention in respect of these goods. The goods are likely to be obtained by self-selection from the shelves of a retail outlet, online or through a catalogue equivalent. Overall, I am of the view that visual considerations would dominate the purchasing process. However, I do not discount aural considerations entirely as it is possible that the purchasing of these kinds of goods would involve discussions with sales assistants.⁵

Distinctive character of the earlier mark

24. The distinctive character of a trade mark can be measured only, first, by reference to the goods or services in respect of which registration is sought and, second, by reference to the way it is perceived by the relevant public. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for

⁵ *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03, paragraph 50

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)."

25. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. Dictionary words which do not allude to the goods and services will be somewhere in between. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion, the more distinctive the earlier mark, the greater the likelihood of confusion.

26. Further, although the distinctiveness of a mark can be enhanced by virtue of the use that has been made of it, the opponent has not filed any evidence of use (nor was it required to do so). Consequently, I have only the inherent position to consider.

27. The earlier mark is figurative and comprises the word "kids" and gardening tool devices. The word "kids" is dictionary defined as being an informal noun for a child.⁶ I also note that the applicant has adduced evidence which suggests that the word "kids" is used within the fashion industry in the UK to refer to clothing for children.⁷ This supports, rather than contradicts, my own impression of its use as a term in this industry. In my view, the average consumer would perceive the word element of the earlier mark as a descriptive reference to a characteristic of the clothing products offered under the earlier mark; it serves to inform the average consumer that the clothing is for children. However, the word is presented in multiple colours. Positioned before and after the word are stylised representations of gardening tools. The devices

⁶ Exhibit HD4 (Cambridge English Dictionary)

⁷ Exhibit HD3

are presented in the same vibrant colour scheme as the word. The gardening tools do not describe or allude to any of the goods for which the earlier mark is registered. Overall, I consider that the earlier mark possesses a low degree of inherent distinctive character. I should add that this is attributable to the mark as a whole and its particular graphical representation, rather than the word “kids” alone.

Comparison of the marks

28. It is clear from *Sabel BV v. Puma AG*⁸ 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 in *Bimbo SA v OHIM*, Case C-591/12P, that:

“34. [...] 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.”

29. It would therefore be wrong to artificially 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.

30. The respective trade marks are shown below:

⁸ Case C-251/95, paragraph 23

Earlier mark	Contested mark
	

Overall impressions

31. The earlier mark comprises the word “kids” presented in blue, orange and green, in a large font at the centre of the mark. Before and after the word are gardening tool devices. These gardening tools are in the same colour scheme as the word element. The word, the devices and the colour scheme all dominate in roughly equal measure. However, the word element will have slightly more impact as consumers’ eyes are naturally drawn to elements of marks that can be read.⁹

32. The contested mark contains the words “KIDS”, which is presented in black, capital letters at the top of the mark. Underneath the word “KIDS” are the words “El Corte Inglés” also in black, but in a smaller, highly stylised font. Given its size and positioning within the mark, as well as the fact it is an English word which will be readily understood, the word “KIDS” plays a greater role in the overall impression. However, the words “El Corte Inglés” also have an impact and contribute to the overall impression.

Visual comparison

33. The competing marks are similar as they both contain the word “kids” which is the dominant and co-dominant element of both marks. However, the word “kids”, although present within both marks, is presented differently. In the earlier mark, it is presented in blue, orange and green, at the centre of the mark. Conversely, in the contested

⁹ *MigrosGenossenschafts-Bund v EUIPO*, T-68/17

mark, it is presented in black, capital letters at the top of the mark. The competing marks also differ as the earlier marks contain garden tools placed either side of the word “kids”. These pictorial device elements are not reproduced in the contested mark. Moreover, the contested mark includes the words “El Corte Inglés” at the bottom of the mark, in a highly stylised black font. These words have no counterparts in the earlier mark. Taking into account the overall impressions, I find that the competing marks are visually similar to a medium degree at best.

Aural comparison

34. The earlier mark comprises a single syllable i.e. “KIDS”, as consumers will make no attempt to articulate the garden tool devices. Although the additional words in the contested mark are smaller and less familiar to the average consumer, in my view, they are far from negligible and will be pronounced. Therefore, the contested mark encompasses six syllables “KIDS/EL/COUR/TAY/EN/GLES”. The first syllable in the competing marks is, therefore, identical; however, the additional syllables within the contested mark are a point of significant difference. As a result, I find that the marks are aurally similar to a low degree.

Conceptual comparison

35. As noted above, both marks contain the word “kids”. This word has a clear meaning which will be readily understood by the average consumer. In both marks it will be perceived as a descriptive reference to the goods, i.e. children’s clothing. The bright colour scheme used in the earlier mark adds a playful and youthful perception of the mark which reinforces the concept of the word “kids”. The garden tool devices in the earlier mark would be perceived as such and, therefore, provide a concept which has no counterpoint in the earlier mark. Within the contested mark, the highly stylised words “El Corte Inglés” would be perceived as invented or non-English words. Either way, consumers will not attribute a meaning to these words. Therefore, they are conceptually neutral. There is a reasonable amount of conceptual overlap as a result of the shared word “kids”; overall, I find that the competing marks are conceptually similar to at least a medium degree.

Likelihood of confusion

36. Whether there is a likelihood of confusion must be assessed globally, taking into account a number of factors. One such factor is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods, and vice versa. It is also necessary for me to keep in mind the distinctive character of the opponent's trade mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be aware of the fact 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 that they have retained in their mind.

37. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods and services down to the responsible undertakings being the same or related.

38. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis K.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context 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).”

39. These examples are not exhaustive but provide helpful focus.

40. I have found that the respective goods are either identical or highly similar and that the average consumer of the goods will be the general public, who will pay an average level of attention. I have found that the purchasing process will be largely visual, however, I have not discounted aural considerations. The word “kids” dominates, or co-dominates, the overall impressions of the competing marks. I have found that the earlier mark and the contested mark are visually and conceptually similar to a medium degree at best, and aurally similar to a low degree. I have also found that the earlier mark possesses a low level of inherent distinctive character.

41. I acknowledge that both marks contain the word “kids”. However, the presentation of the word in each of the respective marks is noticeably different. In the earlier mark the word is presented in vivid colours, (blue, orange and green) that link the components of the earlier mark together. In my view, this is a relatively unique colour combination that would not be protected by fair and normal use of a mark registered

in black and white. The earlier mark also contains garden tool devices which share the same colours that are found in the word element of the mark. In contrast, the word “kids” in the contested mark exists in black. Furthermore, the contested mark contains the additional, highly distinctive, and stylised words “El Corte Inglés”, also in black font. In my opinion, the differences would not be overlooked and are of heightened importance given that I have found the purchasing process to be predominantly visual in nature.¹⁰ Aurally, the number of syllables differ in the earlier mark compared to the opposed mark and, although the first syllable is identical, the following syllables in the contested mark create a difference in length and enough variance for the consumer to aurally distinguish between the marks. The marks share a level of conceptual overlap, but that exists in a descriptive word, consequently, this is not a distinctive similarity. It is my view that, despite the similarity between the marks created by the commonality of the word “kids”, it is unlikely that the competing marks will be mistaken or misremembered for one another; despite the common element presenting as the dominant, or co-dominant element within the respective marks, it is not the distinctive element of either mark. Rather, the aforementioned differences are likely to be sufficient to enable consumers to differentiate between them. I remind myself of *Nicoventures Holdings Ltd v The London Vape Company Ltd*¹¹ where it was held that “[...] having regard to the low degree of distinctiveness about the features these two marks have in common, even taking into account imperfect recollection the differences in the two marks will take on a greater significance for the average consumer than they might otherwise.” I consider that to be the case here. In my judgement, taking all the above factors into account, the differences between the competing trade marks are likely to enable consumers, paying an average level of attention, to avoid mistaking the marks for one another, even when factoring in the principles of imperfect recollection and interdependency. As a result, I find that there is no likelihood of direct confusion, even in relation to identical goods.

42. That leaves indirect confusion to be considered. I bear in mind that a finding of indirect confusion should not be made merely because the two marks share a common

¹⁰ *Quelle AG v OHIM*, Case T-88/05

¹¹ [2017] EWHC 3393

element. In this connection, it is not sufficient that a mark merely calls to mind another mark: this is mere association not indirect confusion.¹²

43. As explained above, consumers will recognise the common word “kids”, which is a dominant but not distinctive element of both trade marks. However, in my view, the commonality of this word will still be seen as merely coincidental. Consumers will recognise the shared word in the competing marks, but they will also identify the aforementioned differences. Consequently, I do not believe that consumers will assume that the applicant and the opponent are economically linked undertakings on the basis of the competing trade marks; I am unconvinced that consumers would assume a commercial association or licensing arrangement between the parties, or sponsorship on the part of the opponent, merely because of the shared word “kids”. It is my view that consumers will recognise the visual differences between the marks. These differences between the competing marks are not conducive to any logical brand extensions, as there is no logical reason why an undertaking would remove all the elements that make the earlier mark distinctive overall, such as, the colourful garden tool devices, and replace them with additional words that appear completely unrelated to the earlier mark. Furthermore, by removing the stylisation and vibrant colour scheme (that links the word and device elements together and conveys a playful and youthful concept that would appeal to children), only to replace it with a plain black font in a different style, would appear to remove the very essence of the earlier mark that would lead consumers to recognise its origin. The common usage of the word “kids” is likely to be viewed as coincidental as it is descriptive of a characteristic of the goods i.e. consumers would perceive it as informing them that the goods offered are for children, rather than an indicator that the marks emanate from related undertakings. In my opinion, this would be the same even on goods that are identical. Therefore, I find that there is no likelihood of indirect confusion.

Conclusion

44. The opposition under section 5(2)(b) of the Act has failed. Subject to any appeal, the application will proceed to registration in the UK.

¹² *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

Costs

45. The applicant has been successful and is, therefore, entitled to a contribution towards its costs based upon the scale published in Annex A of Tribunal Practice Notice 2 of 2016. Applying this guidance, I award the applicant the following as a contribution toward costs:

Considering the opponent's statement and preparing a counterstatement	£200
Preparing evidence	£500
Preparing written submissions	£300
Total	£1,000

46. Accordingly, I hereby order Smart Garden Products Limited to pay El Corte Inglés, S.A. the sum of **£1,000**. This sum is to be paid within twenty-one days of the expiry of the appeal period, or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 21 day of October 2022

Sarah Wallace
For the Registrar