o/0027/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003765467

BY HOLMPATRICK LTD

TO REGISTER THE TRADE MARK:

IN CLASS 9

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 437399

BY NICOLAS WILFER

BACKGROUND AND PLEADINGS

1. On 14 March 2022, Nicolas Wilfer ("the applicant") applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 29 July 2022. The applicant seeks registration for the following goods:

Class 9 Sound effect pedals for musical instruments; Electronic sound pickups for stringed musical instruments.[1]

2. The application was opposed by Holmpatrick Ltd ("the opponent") on 9 November 2022. The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opponent relies upon the following trade mark:

SOUNDLAB

Comparable UK trade mark (EU) registration no. UK00900211862[2]
Filing date 1 April 1996.
Registration date 1 August 2000.
Relying upon all of the goods for which the earlier mark is registered, namely:[3]

Class 9 Apparatus for the reproduction, transmission, mixing, amplification and reception of sound, disco equipment, none of them being for laboratory or studio purposes.

[1] The applicant's mark was originally registered for the above goods and the additional terms "*Electronic apparatus for sound conditioning, namely, amplifiers, pre-amplifiers, tuners, mixers, equalizers; Loudspeakers".* However, these terms were removed following the filing of a Form TM21b dated 12 March 2024. In an official letter dated 15 March 2024, the Registry asked for the opponent to confirm in writing, by 2 April 2024, whether this amendment to the specification would allow the opposition to be withdrawn. However, no response was received by the Registry, which confirmed on 19 April 2024 that the opposition would proceed.
[2] Following the end of the transition period of the UK's withdrawal from the EU, all EU trade marks ("EUTM") registered before 1 January 2021 were recorded as comparable trade marks in the UK trade mark register (and as a consequence, have the same legal status as if they had been applied for and registered under UK law). A 'comparable trade mark (EU)' retains the same filing date, priority date (if applicable) and registration date of the EUTM from which it derives.
[3] Whilst the TM7 states that they are only relying upon some of their goods, they list all of their goods in the question 1 box.

3. The opponent claims that there is a likelihood of confusion because the marks and goods are similar.

4. The applicant filed a counterstatement denying the claims made and put the opponent to proof of use.

5. The opponent is unrepresented and the applicant is represented by Dolleymores. Only the opponent filed evidence. Neither party requested a hearing but the applicant filed written submissions during the evidence rounds and in lieu of a hearing. This decision is taken following a careful perusal of the papers.

6. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

EVIDENCE

7. The opponent's evidence consists of the witness statement of Paul Ledwith dated 1 November 2023. Mr Ledwith is the Group Legal Counsel for the opponent, a position which he has held since 2013. Mr Ledwith's statement is accompanied by 4 exhibits.

8. I have taken all of the evidence and submissions into consideration in reaching my decision and will refer to them where necessary below.

DECISION

Section 5(2)(b)

9. Section 5(2)(b) reads as follows:

> "5(2) A trade mark shall not be registered if because –

(a)…

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

10. The opponent's mark qualifies as earlier mark in accordance with section 6(1)(a) of the Act as its filing date is earlier than the filing date of the applicants' mark. As the opponent's mark has completed its registration process more than five years before the filing date of the mark in issue, it is subject to proof of use pursuant to section 6A of the Act.

Proof of use

11. I will begin by assessing whether there has been genuine use of the earlier mark. The relevant statutory provisions are as follows:

12. Section 6A of the Act states:

"(1) This section applies where

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes –

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the

purposes of this section as if it were registered only in respect of those goods or services."

13. Pursuant to section 6A of the Act, the relevant period for assessing whether there has been genuine use of the earlier mark is the five years ending on the filing date of the applicants' mark, i.e. 15 March 2017 to 14 March 2022. By virtue of paragraph 7 of Part 1, Schedule 2A of the Act, use within the EU is relevant for the part of the relevant period which falls prior to IP Completion Day (31 December 2020). After that date, only use in the UK is relevant.

14. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

"105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp* v *Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'*[2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at[36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the

characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

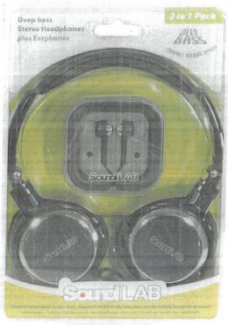
(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32]."

Evidence of use

15. I note the following from the opponent's evidence:

a) **Exhibit 1** contains a table showing the "full list" of SOUNDLAB branded products which is 28 pages long and contains item codes. The first 40 goods are highlighted in yellow which are speakers, earpieces, earphones and headphones. I also note that other goods listed in the table include loudspeakers, microphones, adapters and amplifiers. Within the table it shows what stock of the goods the opponent has, which ranges from 0 to over 7,000, and some of the goods have an amazon "ASIN" number. The table is undated, but it contains some dates within it which is the "last date of receipt". However, Mr Ledwith does not clarify what this means.

b) **Exhibit 2** contains a “sample of the artworks showing the Soundlab brand”. Mr Ledwith states that as the opponent has over 700 products, that it “would be a disproportionate use of the tribunal’s time to go through every product”, and therefore this exhibit only contains the following:



c) **Exhibit 3** contains a sample of sales table for the goods which were highlighted in yellow in **exhibit 1** from 1 January 2020 until 31 October 2023. I have also cross referenced the item codes from the sales table with the item codes contained within the product list to confirm that it shows the sales of these goods. The table is 140 pages long, and the "Soundlab" mark is clearly used within the table. The price of these goods varies between £1.19 and £330. Mr Ledwith states that the sample sales amount to £326,609.11.

d) **Exhibit 4** contains 4 invoices dated between 11 October 2023 and 30 November 2023, which falls after the relevant period. I note that the invoices are from "Electrovision" which has an address in Merseyside (UK), and that Mr Ledwith confirms that Electrovision is a part of the opponent's group.

Assessment of genuine use and fair specification

16. As far as the form of the mark is concerned, I am satisfied that the mark has been used as registered on the product list and sample of sales table. For the sake of completeness, the evidence above shows "SoundLAB" presented in a stylised blue typeface. However, the stylisation is very minimal, and I consider that the use of the "LAB" element presented in all upper-case does not alter the distinctive character of the mark.[4] Therefore it is acceptable variant use.

17. As I have found the variant mark used in the evidence to be acceptable, I will now consider whether the evidence shows that the earlier mark has been genuinely used.

[4] *Dreamersclub Ltd v KTS Group Ltd*, BL O/091/19

An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.[5] As indicated in the case law cited above, use does not need to be quantitively significant in order to be genuine. The assessment must take into account a number of factors in order to ascertain whether there has been real commercial exploitation of the mark which can be regarded as "warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark".

18. In *Awareness Limited v Plymouth City Council,* Case BL O/236/13, Mr Daniel Alexander Q.C. as the Appointed Person stated that:

> "22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public."

19. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd,* Case BL 0/404/13*,* Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

> "21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with

[5] *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

> [24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not *'show'* (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use."

20. The case law summarised in the passage from *easygroup* quoted above makes it clear that real commercial exploitation of the trade mark must be shown. Even in a case where the use is not sham, i.e. it is not use engineered solely to preserve the trade mark registration, the use must be more than trivial if it is to be considered genuine. An example of this can be seen in *Memory Opticians Ltd's Application*, BL

O/528/15, where the Appointed Person, Professor Ruth Annand, upheld the decision to revoke the protection of the mark STRADA on the grounds that it had not been put to genuine use within the requisite 5-year period. There had in fact been sales of goods bearing the mark, but these were very low in volume (circa 40 pairs of spectacles per year) and all the sales were local, from 3 branches of an optician. There was no advertising of the goods under the mark, and the evidence indicated that they were only displayed in-store on occasion. The mark was said to have been applied to the goods via a sticker applied to the arms of a dummy lens. This level of use was held to be insufficient to create or maintain a market under the mark. Consequently, it was not genuine use.

21. Where proof of use is required, it is typical to see evidence such as turnover figures, numbers of units sold and invoices showing the sale of goods to customers, whether retail or wholesale. In this case, I have only been provided with a sample of sales made from some of the opponent's goods, and the invoice evidence to support this is dated after the relevant period.

22. It is not necessarily fatal to the assertion of genuine use that there is little, or no such evidence, if other material filed by the opponent is sufficient to show that there has been a real attempt to exploit the mark in the sector. However, there is very little evidence of other activity in this case.

23. I have not been provided with a breakdown of sales for the different types of goods that the opponent sells. Whilst the opponent has provided some amazon ASIN numbers for some of its goods in its product list, as noted by the applicant, there is no supporting evidence provided to show that these goods were for sale on Amazon during the relevant period. I also note that the opponent has provided a "sample of the artworks", which I consider to be the opponent's product packaging. However, all of this is undated and therefore I am unable to determine when this packaging was used. The applicant also notes that there is no evidence to show this product packaging used within the marketplace in the relevant territory. Furthermore, whilst the product list and sample of sales tables shows that the opponent sold "SOUNDLAB" speakers, earpieces, earphones and headphones, the applicant notes that there are no details provided of the seller or the purchaser of the goods. There is no evidence (narrative

or exhibited) to confirm where and who these sales were made to. The sales table does show that they were made in pounds (£), and whilst they are dated after the relevant period, the invoices shows that Electrovision is based in the UK (Merseyside). This could therefore explain why the sales were made in pounds. However, I do not have any evidence of where the customers of these sales were based, I do not have any evidence to show if these sales were all made to one customer or if these sales were geographically spread (whether in the UK, EU or worldwide). Lastly, I bear in mind that I have not been provided with any advertising figures or advertising examples. Therefore, taking the evidence as a whole, my view is that it does not establish that there has been genuine use of the opponent's mark for any goods.

24. However, for the sake of completeness, I will proceed with the rest of the decision as if the opponent had established genuine use for the full breadth of their specification.

Section 5(2)(b) - case law

25. In making this decision, I bear in mind the following principles 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

26. The competing goods are as follows:

Opponent's goods	**Applicant's goods**
Class 9 Apparatus for the reproduction, transmission, mixing, amplification and reception of sound, disco equipment, none of them being for laboratory or studio purposes.	Class 9 Sound effect pedals for musical instruments; Electronic sound pickups for stringed musical instruments.

27. In *Gérard Meric v OHIM*, Case T- 133/05, the General Court ("GC") 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."

28. Before I conduct my goods comparison, I note that the opponent's specification contains the limitation "*none of them being for laboratory or studio purposes*". I note that restrictions should be drafted with sufficient clarity and precision to enable the Registrar and third parties to identify what is and is not covered by the specification (See *IP Translator,* C-307/10), and the way in which the proposed limitation is worded is insufficiently clear or precise. I also consider that limiting the goods, so that they are not to be used within a laboratory or studio, is artificial. The fact that a party only intends for its goods to be used in places other than a laboratory or studio, such as a

club, for example, does not alter the nature, function or purpose of the goods themselves (see *Croom's Application* [2005] RPC 2). Regardless of where the goods are used, they are still fundamentally "apparatus for the reproduction, transmission, mixing, amplification and reception of sound". On the basis that the limitation does not identify a proper sub-category of goods, it will not be taken into account in my comparison.[6]

29. The applicant's above goods falls within the broader category of "apparatus for the reproduction, transmission, mixing, amplification and reception of sound" in the opponent's specification. The goods are identical on the principle outlined in *Meric.*

30. For the sake of completeness, even if I took the opponent's limitation into account, this would not affect my *Meric* finding on the basis that the applicant's goods would be used in places other than a laboratory or studio, such as in a live music setting.

The average consumer and the nature of the purchasing act

31. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J (as he then was) 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."

[6] See Tribunal Practice Notice 1/2024: Restricting specifications of applications and registrations subject to Tribunal proceedings.

32. The average consumer for the goods will be members of the general public and music professionals. The cost of purchase is likely to vary, but it is not likely to be at the very highest end of the scale. The frequency of the purchase is also likely to vary, although it is unlikely to be particularly regular. Even where the cost of the purchase is lower, various factors will be taken into consideration such as suitability for the user's particular needs, ease of use and reliability. Consequently, I consider that a medium degree of attention will be paid during the purchasing process.

33. The goods are likely to be purchased from musical instrument and accessory stores and their online equivalents. Alternatively, the goods may be purchased following perusal of advertisements or inspection of a catalogue. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount that there may also be an aural component to the purchase through advice sought from a sales assistant or representative.

Comparison of the trade marks

34. 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."

35. 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.

36. The respective trade marks are shown below:

Opponent's trade mark	Applicant's trade mark
SOUNDLAB	Thorn SOUNDLABS

37. The opponent's mark consists of the word "SOUNDLAB". There are no other elements to contribute to the overall impression which lies in the word itself.

38. The applicant's mark consists of the words "Thorn" and "SOUNDLABS". I note that the word "Thorn" is presented at the top of the mark, in the biggest typeface, and is stylised. The letter "T" has an elongated top line, which has jagged edges, which creates the illusion of an electricity bolt. The remaining letters (horn), are all connected in a lower-case, hand-written typeface. The word "SOUNDLABS" is presented below it, in a much smaller, capitalised typeface. The word "SOUNDLABS" is likely to be seen by the average consumer as being composed of two words; "SOUND" and "LABS". The word "SOUND" is highly allusive of the applicant's goods which produce and amplify sound. The word "LABS" will be seen by the average consumer as the shortening of the ordinary dictionary word "laboratories", which is a place equipped for experimental study and testing. Therefore, as a whole, I find that the word "SOUNDLABS" will most likely be seen as allusive of where the applicant's class 9 goods come from (originating from sound laboratories, i.e. undertakings which experiment with sound). I agree with the applicant that the word "Thorn" (which is neither allusive or descriptive of the goods) is the dominant and distinctive element of the mark, which plays a greater role in the overall impression, with the allusive and smaller word "SOUNDLABS" playing a lesser role.

39. Visually, the opponent's word mark, "SOUNDLAB", wholly appears in the applicant's mark. This acts as a visual point of similarity. However, I note that this word is plural in the applicant's mark (with the letter S at the end), underneath the word "Thorn", presented in a stylised typeface (to which the letter "T" is the most heavily stylised, with its top line creating an illusion of an electricity bolt). These act as visual points of difference. I also bear in mind that the word "Thorn" appears at the beginning of the applicant's mark, a position to which the average consumer pays more attention.[7] I therefore find the marks are visually similar to a medium degree.

40. Aurally, the opponent's mark will likely be pronounced as SOUND-LAB. The word "THORN" will be given its ordinary dictionary pronunciation. Therefore, as a whole, the mark will likely be pronounced as THORN SOUND-LABS. Consequently, the beginning of the marks differ aurally. However, as they overlap in the "SOUND" syllable, and the "LAB" element, I find the marks are aurally similar to a medium degree.

41. Conceptually, I note that neither party made any submissions on the meaning of the word "SOUNDLAB" in the opponent's mark. I therefore consider that the word "SOUNDLAB" will likely be seen by the average consumer as being composed of two words "SOUND" and "LAB". The word "SOUND" is an ordinary dictionary word and I consider that the word "LAB", as noted above, will be seen as the shortening of the dictionary word "laboratory". Therefore, as a whole, the mark will evoke a "sound laboratory", which would be understood by the average consumer as an undertaking which experiments with sound.

42. The applicant's mark consists of the ordinary dictionary word "Thorn" (a sharp point most likely found on the stem of a plant). I note that the letter "T" is highly stylised, with the top line creating an illusion of an electricity bolt, which I consider would slightly add to the concept of the mark. The word "Thorn" is followed by the word "SOUNDLABS" which, as noted above, will be seen by the average consumer as being composed of the ordinary dictionary word "SOUND" and the word "LABS", which will be recognised as the shortening of the word "laboratories". I therefore consider that, as a whole, the

[7] *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

mark will be understood to evoke the meaning of “sound laboratories”, i.e. undertakings which experiment with sound, called “Thorn”.

43. On the basis that both marks overlap in the meaning of “sound” and “laboratory”/laboratories”, I find the marks to be conceptually similar to a medium degree.

Distinctive character of the earlier trade mark

44. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

> “22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C108/97 and C-109/97 Windsurfing Chiemsee v Huber and Attenberger [1999] ECR 1-2779, paragraph 49).
>
> 23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promotion of the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see Windsurfing Chiemsee, paragraph 51).”

45. 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, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

46. I will begin by assessing the inherent distinctive character of the opponent's mark. As noted above, the word "SOUNDLAB" will likely be seen by the average consumer as being composed of the ordinary dictionary word "SOUND" and the word "LAB" (shortening of laboratory). Therefore, as a whole, the consumer will understand the mark as meaning a "sound laboratory", which I find is highly allusive of where the opponent's class 9 goods originate from i.e. an undertaking which experiments with sound. Therefore, I consider that the opponent's mark is inherently distinctive to a low degree.

47. I will now assess whether the evidence filed by the opponent is sufficient to demonstrate enhanced distinctiveness. The relevant market for assessing this is the UK market.

48. I have only been provided with a sample of sales made from some of the opponent's goods, which amounts to £326,609.11. I note that 4 invoices have been filed to support this figure, however, they are dated after the relevant date. The sample of sales evidence does not show where the sales were made to, and therefore I am unable to determine whether the sales pertain to the UK. I have also not been provided with the opponent's overall turnover figures, nor have I been provided with evidence of the opponent's market share, advertising figures or examples of adverting. Moreover, the evidence of packaging provided is undated. Therefore, taking all of the above into account, I do not consider the evidence sufficient to establish enhanced distinctiveness of the opponent's mark at the relevant date of 14 March 2022.

Likelihood of confusion

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

the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. It is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to 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 he has retained in his mind.

50. The following factors must be considered to determine if a likelihood of confusion can be established:

- I have found the marks to be visually similar to a medium degree.
- I have found the marks to be aurally similar to a medium degree.
- I have found the marks to be conceptually similar to a medium degree.
- I have found the opponent's earlier mark to be inherently distinctive to a low degree.
- I have identified the average consumer as the general public and music professionals, who will select the goods primarily by visual means, although I do not discount an aural component.
- I have concluded that a medium degree of attention will be paid during the purchasing process.
- The parties' goods are identical.

51. Taking all of the factors listed in paragraph 50 into account, even bearing in mind the principle of imperfect recollection, I am satisfied that the parties' marks are unlikely to be mistakenly recalled as each other. I do not consider that the average consumer paying a medium degree of attention during the purchasing process will overlook the "Thorn" element in the applicant's mark. This is on the basis that the word "Thorn" is the dominant and distinctive element of the mark, which consequently plays a greater role in the overall impression, and it is placed at the beginning of the applicant's mark,

a position which tends to make more of an impact than the ends. I therefore do not consider there to be a likelihood of direct confusion.

52. It now falls to me to consider the likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C., (as he was then) sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

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

53. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

54. Mr Purvis KC in *L.A Sugar Limited* above sets out that there are three main categories of indirect confusion and that indirect confusion 'tends' to fall in one of them. The opponent has not provided any submissions as to what category this case would fall within. However, for the sake of completeness, I will go through each category.

55. Firstly, where the common element is so strikingly distinctive that the average consumer would assume that no-one else, but the brand owner, would be using it. In this case, the opponent's mark as a whole is inherently distinctive to a low degree. This is because the word "SOUNDLAB" consists of the ordinary dictionary word "SOUND" and the word "LAB", which would be recognised as a shortening of the word "laboratory". Therefore, as a whole, the mark will be understood by the average consumer as a "sound laboratory", which is highly allusive of where the opponent's class 9 "apparatus for the reproduction, transmission, mixing, amplification and reception of sound, disco equipment" originates from (i.e. an undertaking which experiments with sound). Consequently, I do not consider that the word "SOUNDLAB" is so strikingly distinctive that the average consumer would think that no-one else but the opponent would use it. It is more likely to be viewed as a coincidence, especially as the marks are being used on class 9 goods which are used to produce and amplify sound. On this basis, I find that the first category is not applicable.

56. Secondly, where the later mark simply adds a non-distinctive element to the earlier mark. For this category to be satisfied, the opponent's mark as a whole, that being

"SOUNDLAB", would need to be reproduced, with an addition of a non-distinctive element. I bear in mind that imperfect recollection can still occur in indirect confusion, and that the "SOUNDLABS" element at the end of the applicant's mark could be imperfectly recalled as "SOUNDLAB", or vice versa. However, as noted above, the addition of the word "Thorn" plays a greater role in the overall impression of the applicant's mark, and it is neither allusive or descriptive of the applicant's goods. It is, therefore, not a non-distinctive addition and it is also not a word which is frequently used to indicate sub-brands such as 'LITE' or 'EXPRESS'. Consequently, the second category cannot be applicable.

57. Lastly, where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension. In this case, I still bear in mind that "SOUNDLAB" and "SOUNDLABS" could be imperfectly recalled as each other. However, I do not consider that the addition of the word "Thorn" to the beginning of the applicant's mark is logical or consistent with a brand extension. I also do not consider that the removal of the word "Thorn" would be logical or consistent with a brand extension, especially as it the dominant and distinctive part of the mark which plays a greater role in the overall impression.[8] I therefore do not consider that the third category is applicable.

58. I bear in mind that the examples above set out by Mr Purvis Q.C. are not exhaustive. However, I do not consider that there are any other logical examples of how the applicant's mark could be indirectly confused with the opponent's and the opponent has not suggested any.

59. I consider that having noticed that the trade marks are different, I see no reason why the average consumer would assume that they come from the same or economically linked undertakings. I find there is no likelihood of indirect confusion, even when the marks are used on identical goods.

[8] See Colloseum Holdings AG v Levi Strauss & Co., Case C-12/12, regarding "wrong way round confusion", referring to Comic Enterprises. In that case Kitchin LJ explained that "right way round" or "wrong way round" confusion may be a consequence of nothing more meaningful than the order in which the consumer happened to come across the mark and the sign. He explain further that in both instances the consumer thinks that the goods in issue come from the same undertaking or economically linked undertakings, and they may be equally damaging to the distinctiveness and functions of the mark.

CONCLUSION

60. The opposition is unsuccessful, and the application may proceed to registration.

COSTS

61. The applicant has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the applicant the sum of **£1,050** as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Considering the Notice of opposition and preparing a counterstatement	£200
Considering the opponent's evidence	£500
Preparing and filing written submissions and submissions in lieu of a hearing	£350
Total	**£1,050**

62. I therefore order Holmpatrick Ltd to pay Nicolas Wilfer the sum of £1,050. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 14th day of January 2025

L FAYTER

For the Registrar