BL O/0054/25

TRADE MARKS ACT 1994

IN THE MATTER OF
TRADE MARK APPLICATON NO. 3884350
BY FORUS S.A. TO REGISTER AS A TRADE MARK:

IN CLASSES 18, 25 AND 35.

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NO. OP000442104
BY FFI GLOBAL S.R.L.

BACKGROUND AND PLEADINGS

1. On 02 March 2023, Forus S.A. ("the applicant") applied to register the trade mark displayed on the cover page of this decision, under number 3884350 ("the application"). It was accepted and published in the Trade Marks Journal on 21 April 2023 in respect of the following goods and services:

Class 18: Leather shoulder bags; wallets; purses; bags; sports bags; mountaineering bags; handbags; backpacks; rucksacks; umbrellas.

Class 25: Coats; shoes; headgear; bandanas [neckerchiefs]; boas [scarves]; boots; knickers; socks; footwear; shirts; T-shirts; sports shirts; waistcoats; jackets; belts [garments]; skirts; caps; gloves [articles of clothing]; pullovers [articles of clothing]; tights [leggings]; stockings; trousers; pantyhose; slippers; parkas; pyjamas; beachwear; sandals; bras; underwear; bathing costumes [swimwear]; dresses.

Class 35: Administration of consumer loyalty programmes; assistance in the management of commercial or industrial undertakings; assistance in business management; professional business consultancy; product demonstration; marketing; presentation of products in any media for retail sale; promotion of products and services through sponsorship of sporting events; sales promotion for others; administrative processing of purchase orders; retail services connected with the sale of footwear; retail services connected with the sale of clothing; retail and wholesale services connected with the sale of fitness and sporting goods, sporting goods and equipment; retail services connected with the sale of handbags; online retail

services connected with the sale of clothing; online retail services connected with the sale of handbags; online retail services connected with the sale of sporting goods; online retail services connected with the sale of footwear.

2. On 21 July 2023, the application was opposed by FFI GLOBAL S.R.L. ("the opponent"). The opposition is brought under section 5(2)(b) of the Trade Marks Act 1994 ("the Act"), is directed against some of the goods specified in the application as shown below, and is reliant upon the following word only mark:

Free Soul

Comparable UK trade mark (EU) registration no. UK00900285023.[1]
Filing date: 02 July 1996
Registration date: 14 April 2000
Relying on the following goods:

Class 25: Clothing, footwear, headgear.

Opposed goods and services

3. The opponent seeks only to oppose the following goods and services:

Class 18: Leather shoulder bags; wallets; purses; bags; sports bags; mountaineering bags; handbags; backpacks; rucksacks; umbrellas.

Class 25: Coats; shoes; headgear; bandanas [neckerchiefs]; boas [scarves]; boots; knickers; socks; footwear; shirts; T-shirts;

[1] 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.

sports shirts; waistcoats; jackets; belts [garments]; skirts; caps; gloves [articles of clothing]; pullovers [articles of clothing]; tights [leggings]; stockings; trousers; pantyhose; slippers; parkas; pyjamas; beachwear; sandals; bras; underwear; bathing costumes [swimwear]; dresses.

Class 35: Retail services connected with the sale of footwear; retail services connected with the sale of clothing; retail and wholesale services connected with the sale of fitness and sporting goods, sporting goods and equipment; retail services connected with the sale of handbags; online retail services connected with the sale of clothing; online retail services connected with the sale of handbags; online retail services connected with the sale of sporting goods; online retail services connected with the sale of footwear.

4. By virtue of its earlier filing date, the above registration constitutes an earlier mark within the meaning of section 6 of the Act. As the mark had completed its registration process more than five years before the filing date of the contested mark, it is subject to the proof of use provisions contained in section 6A of the Act.

5. In its notice of opposition, the opponent submits that the marks at issue are highly similar, stating that the applicant's mark would be perceived as 'BSOUL' by consumers, which is highly similar to the opponent's mark 'FREE SOUL'. They go on to argue that both marks coincide in the distinctive element 'SOUL', which constitutes four out of five letters in the applicant's mark. This identity between the 'SOUL' elements of each mark renders the marks visually, aurally and conceptually similar to a high degree in the opinion of the opponent. Furthermore, they submit that there are aural similarities between 'FREE' and 'B' at the beginning of the respective marks. Additionally, the opponent states that the contested goods in class 18 are similar to the goods in class 25 of the opponent's mark, as the goods in class 18 are complementary to the class 25

goods. Further, the contested goods in class 25 are identical to the goods in class 25 of the opponent's mark, as all of the goods are forms of clothing. The opponent's mark covers "*clothing*" at large in class 25 and therefore the applicant's goods are identical to and are wholly encompassed by the opponent's mark. Finally, the contested services in class 35 are similar to the class 25 goods covered by the opponent's mark. It is well-established in case law that retail services relating to the sale of goods are similar to the goods themselves.

6. The applicant filed a counterstatement denying that the marks are similar. In particular, the applicant denies that their mark would be perceived by consumers as "BSOUL" and that both marks coincide in the element "SOUL". They go on to argue that the applicant's mark consists of the word elements "BS" and "UL" separated by a figurative lotus flower device, and, as a result, the differences are sufficient to distinguish the marks overall. The applicant acknowledges that the contested goods and services are identical and/or similar to varying degrees to the goods covered by the opponent's mark. The applicant also chose to put the opponent to proof of use in respect of its earlier mark.

7. The opponent is represented by Barker Brettell LLP and the applicant is represented by Marks & Clerk LLP. Only the opponent filed evidence, but neither party requested a hearing. Only the applicant filed written submissions in lieu. I make this decision having taken full account of all the papers, referring to them as necessary.

RELEVANCE OF EU LAW

8. 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

9. The opponent's evidence consists of the witness statement of Deborah Scalcon dated 27 December 2023 and is accompanied by 2 exhibits (DS01 – DS02). Ms. Scalcon is the CEO of FFI Global S.R.L. The purpose of the opponent's evidence is to demonstrate that the earlier mark has been put to genuine use for the goods on which the opponent relies.

DECISION

Proof of use

10. The applicant has requested proof of use in these proceedings in respect of the opponent's earlier mark. I will begin by assessing whether and to what extent the evidence supports the opponent's statement that it has made genuine use of the mark in relation to the goods relied upon. The relevant period for this purpose is the five-year period ending with the date of the application in issue, namely 03 March 2018 to 02 March 2023. As the earlier mark subject to proof of use is a comparable mark, use within the EU (including the UK) is relevant for the period ending with IP Completion Day, i.e., 03 March 2018 to 31 December 2020. From 01 January 2021 onwards, however, the relevant territory is the **UK only**.

11. The relevant statutory provisions are set out in Section 6A of the Act, which 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."

12. Section 100 is also relevant, which reads:

> "If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it."

13. Consequently, the onus is upon the opponent to prove that genuine use of the earlier mark was made within the relevant territory in the relevant period, and in respect of the relevant goods as registered.

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]."

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

1. Exhibit DS01 consists of a number of invoices and purchase orders made out to two apparently connected companies ('TJX UK' and 'TJX EUROPE BUYING LIMITED'). The "FFI" invoices shown in this exhibit demonstrate orders from 2020, 2021 and 2022. There are no

invoices shown for 2018, 2019 or 2023. The total amount invoiced (shown in Euros) is €62,503.76 with €20,037 in 2020, €14,616 in 2021, and €27,850.76 in 2022. The same invoices also demonstrate that a total of 6536 units had been sold throughout this period, with 1917 in 2020, 1506 in 2021, and 3113 in 2022. I also note that the invoice appearing on the page numbered 19 shows a consignment address in Germany. Whilst the evidence of use may show use of the mark in the EU up until 01 January 2021, this particular invoice is dated 27 September 2021 and is therefore considered to show use outside of the relevant territory. As a result, the total amount of sales in 2021 would be reduced to €9816 with total of 1106 units shipped to the UK. Finally, there appears to be no information present in the invoices or purchase orders that shows use of the mark in relation to footwear or headgear.

2. Exhibit DS02 consists of a number of screenshots from the opponent's website 'freesoulworld.com' using the internet archive 'wayback machine'. The screenshots, whilst showing use of the mark on the opponent's website during the relevant period, fail to show if any goods were actually available for sale on said website i.e., there are no examples of product listings shown in the evidence. The exhibit merely demonstrates what appears to be the home page of the opponent's website over the years.

Conclusions from the evidence on genuine use

16. 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. [2]

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

17. 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".

17. In *Awareness Limited v Plymouth City Council*, Case BL O/236/13, Mr Daniel Alexander Q.C. (as he then was) 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."

18. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL 0/404/13, Mr Geoffrey Hobbs Q.C. (as he then was) 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 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."

19. 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.

20. Where proof of use is required, it is typical to see evidence such as turnover figures. Whilst I have been provided with invoices showing sales figures, from which I have calculated totals, there are no formal turnover figures provided and I am unsure if the invoices shown demonstrate the only sales made in the relevant period or just a "snapshot". Additionally, the invoices only demonstrate invoices addressed to two third-party companies that appear to be connected. Turnover figures are considered information which should have been readily available and relatively easy to provide. Notwithstanding this, the sales figures shown above are fairly small in scale, especially when considering the size of the clothing industry in the UK. The applicant, in their submissions, has provided information from 'Statista.com' that shows the revenue of the UK apparel market was estimated to be over £60 billion in 2022 alone. I note this information however I cannot take it into consideration as it has been filed as an annexe to the applicant's submissions in lieu of a hearing and not as formal evidence *per se.* However, in any event, it is a notorious fact that the UK clothing market is worth billions of pounds every year.

21. It is not necessarily fatal to the assertion of genuine use that there is limited evidence of sales, 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.

22. I have been provided with screenshots of the opponent's website, however, as stated previously, they appear to merely show the home page with no indication as to whether any products were actually branded with the opponent's mark, or even if any of the relevant products were for sale from the website. The opponent has also not provided any advertising figures nor any examples of advertising material or campaigns. Additionally there is no evidence to demonstrate whether the mark had been exposed to a wide ranging area of the UK.

23. I accept that there has been some commercial activity under the mark, however, taking the evidence as a whole into account, I consider that it fails to show real commercial exploitation of the opponent's mark to create or maintain a share of the EU or the UK market for the opponent's goods. The consequence of my finding on use is that UK00900285023 may not be relied upon in these proceedings. As there is no other basis for the opposition, the opponent's claim under section 5(2)(b) must fail.

24. However, if I am wrong in my finding above, I will now go on to consider the likelihood of confusion in any event.

Section 5(2)(b): legislation and case law

25. The opposition is based upon section 5(2)(b) of the Act which reads 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"

26. Section 5A of the Act states as follows:

> "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."

27. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc,* Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV,* Case C-425/98, *Matratzen Concord GmbH v OHIM,* Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM,* Case C-591/12P.

The principles:

(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

28. Section 60A of the Act provides:

> "(1) For the purpose of this Act goods and services-
>
> (a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.
>
> (b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.
>
> (2) In subsection (1), the "Nice Classification" means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1979."

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

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

30. 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.

31. For the purposes of considering the issue of similarity of goods and services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Albingia SA v Axis Bank Limited,* BL O/253/18, a decision of the Appointed Person, Professor Phillip Johnson, at paragraph 42).

32. In *Gérard Meric v Office for Harmonisation in the Internal Market*, 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 for Lernsysterne 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."

33. The goods to be compared are:

The opponent's goods	The applicant's goods
Class 25: Clothing, footwear, headgear.	**Class 18:** Leather shoulder bags; wallets; purses; bags; sports bags; mountaineering bags; handbags; backpacks; rucksacks; umbrellas. **Class 25:** Coats; shoes; headgear; bandanas [neckerchiefs]; boas [scarves]; boots; knickers; socks; footwear; shirts; T-shirts; sports shirts; waistcoats; jackets; belts [garments]; skirts; caps; gloves [articles of clothing]; pullovers [articles of clothing]; tights [leggings]; stockings; trousers; pantyhose; slippers; parkas; pyjamas; beachwear; sandals; bras; underwear; bathing costumes [swimwear]; dresses. **Class 35:** Retail services connected with the sale of footwear; retail services connected with the sale of clothing; retail and wholesale services connected with the sale of fitness and sporting goods, sporting goods and equipment; retail services connected with the sale of handbags; online retail services connected with the sale of clothing; online retail services connected with the sale of handbags; online retail services connected with the sale of sporting goods; online retail services connected with the sale of footwear.

34. In its notice of opposition, the opponent contends that the goods in class 18 of the application are similar to its goods in class 25 due to them being complementary. They argue that the goods in class 25 of the application are identical to its goods due to the wide terms encompassing all of the applied for goods. Finally, they submit that it is well established in case law that retail services relating to the sale of goods are similar to the goods themselves.

35. In their submissions, the applicant accepts that in class 18 "*leather shoulder bags; wallets; purses; handbags"* are similar to a medium degree to the opponent's *"clothing"* in class 25 as they are perceived as clothing accessories and therefore complementary to items of clothing as per *Gitana SA v OHIM*, Case T-569/11, paragraph 45. However, they deny that *"bags; sports bags; mountaineering bags; backpacks; rucksacks"* are similar to the opponent's goods. They state that it is accepted case law that "*backpacks*" and "*travel bags*" are not considered clothing accessories and are therefore not similar to class 25 clothing goods (*Gitana SA v OHIM*, Case T-569/11). Additionally, they deny that "*umbrellas"* are similar to the opponent's class 25 clothing goods as they differ in nature and intended purpose, there is no overlap in trade channels and that there is no competition or complementarity. The applicant referred to *Ugo Bensoussan v LULU's FASHION LOUNGE, LLC* ,Case BL 0/0170/23, paragraph 24. The applicant does accept that the clothing, footwear and headgear items in its class 25 specification are identical to the opponent's class 25 goods. The applicant concedes that the following services are similar to a medium degree to that of the opponent's class 25 goods owing to the complementarity between the goods and services:

Retail services connected with the sale of footwear; retail services connected with the sale of clothing; online retail services connected with the sale of clothing; online retail services connected with the sale of footwear"

However, the applicant denies that the following services in class 35 are similar to the opponent's goods:

"retail and wholesale services connected with the sale of fitness and sporting goods, sporting goods and equipment; retail services connected with the sale of handbags; online retail services connected with the sale of handbags; online retail services connected with the sale of sporting goods".

This is because the services differ to the opponent's goods in their nature, intended purpose and they do not overlap in trade channels. Further, they are not in competition or complementary.

36. I take on board these concessions by the applicant and will go on to consider the remaining goods where similarity is not admitted.

Class 18

Leather shoulder bags; bags; handbags; wallets; purses;

37. I note that the applicant has conceded that the above goods are similar to the opponent's goods to a medium degree; in which case, that is the finding I make.

Sports bags; mountaineering bags; backpacks; rucksacks;

38. In *El Corte Ingles SA v OHIM*, Case T-443/05 the GC found that *Clothing, footwear and headgear* in class 25 were similar to the clothing accessories included in *Leather and imitations of leather, and goods made of those materials and not included in other classes*. However, I note that in a later case, *Asos plc v OHIM*, Case T-647/11, the GC found that, for example, sports bags and briefcases could not be considered clothing accessories and were not

similar to class 25 goods. The principle to be applied was summarised in *Gitana SA v OHIM*, Case T-569/11:

> "Moreover, in respect of the relationship between the 'goods in leather and imitations of leather' in Class 18 covered by the trade mark sought and the goods in Class 25 covered by the earlier mark, it is apparent also from settled case-law that the 'goods in leather and imitations of leather' include clothing accessories such as 'bags or wallets' made from that raw material and which, as such, contribute, with clothing and other clothing goods, to the external image ('look') of the consumer concerned, that is to say coordination of its various components at the design stage or when they are purchased. Furthermore, the fact that those goods are often sold in the same specialist sales outlets is likely to facilitate the perception by the relevant consumer of the close connections between them and support the impression that the same undertaking is responsible for the production of those goods. It follows that some consumers may perceive a close connection between clothing, footwear and headgear in Class 25 and certain 'goods made of these materials [leather and imitations of leather] and not included in other classes' in Class 18 which are clothing accessories. Consequently, clothing, shoes and headgear in Class 25 bear more than a slight degree of similarity to a category of 'goods made of these materials [leather and imitations of leather] and not included in other classes' in Class 18 consisting of clothing accessories made of those materials (see, to that effect, *PiraÑAM diseño original Juan Bolaños*, paragraph 42 above, paragraphs 49 to 51; exē, paragraph 42 above, paragraph 32; and *GIORDANO*, paragraph 42 above, paragraphs 25 to 27)."

39. As can be seen from the above case law, goods such as backpacks are not considered clothing accessories and therefore are not found to be similar to

class 25 clothing goods. I believe this applies to all of the above goods and therefore consider these goods to be dissimilar to the opponent's specification.

Umbrellas

40. I consider the above goods do not overlap in nature or use with the opponent's goods. There is no overlap in user or trade channels other than they might be sold within the proximity of clothing items. I do not believe there is any competition or complementarity. I therefore find these goods to be dissimilar to the opponent's specification.

Class 25

Coats; shoes; headgear; bandanas [neckerchiefs]; boas [scarves]; boots; knickers; socks; footwear; shirts; T-shirts; sports shirts; waistcoats; jackets; belts [garments]; skirts; caps; gloves [articles of clothing]; pullovers [articles of clothing]; tights [leggings]; stockings; trousers; pantyhose; slippers; parkas; pyjamas; beachwear; sandals; bras; underwear; bathing costumes [swimwear]; dresses.

41. I note that the applicant has conceded that the above goods are identical to the opponent's goods; in which case, that is the finding I make.

Class 35

Retail services connected with the sale of footwear; retail services connected with the sale of clothing; online retail services connected with the sale of clothing; online retail services connected with the sale of footwear

42. I note that the applicant has conceded that the above goods are similar to the opponent's goods to a medium degree; in which case, that is the finding I make.

retail services connected with the sale of handbags; online retail services connected with the sale of handbags

43. I do not overlook that in *Oakley* [3] the goods covered by the earlier mark, found to be complementary, were identical to those to which the applicant's services related, but I also note the following points from that case:

> • at paragraph 49, "the fact that the retail services are provided at the same sales points as the goods is a relevant criterion for the purposes of the examination of the similarity between the services and goods concerned"
>
> • at paragraph 50, "manufacturers of the goods in question often have their own sales outlets for their goods or resort to distribution agreements which authorise the provider of the retail services to use the same mark as that affixed to the goods sold".

44. In the MissBoo case [4], Geoffrey Hobbs Q.C (as he then was) as the Appointed Person commented that "the criteria for determining whether, when and to what degree services are 'similar' to goods are not clear cut." Mr Hobbs reviewed the law concerning goods as against retail services and, on the basis of the European courts' judgments in *Sanco SA v OHIM* [5] and *Assembled Investments (Proprietary) Ltd v. OHIM* [6], upheld on appeal in *Waterford Wedgewood Plc v. Assembled Investments (Proprietary) Ltd* [7], his conclusions included that:

> i) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;
>
> ii) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer's point of view, they are unlikely to be offered by one and the same undertaking;

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[3] *Oakley, Inc v OHIM*, Case T-116/06
[4] *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14
[5] C-411/13P
[6] Case T-105/05,
[7] Case C-398/07P

iii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent's goods and then to compare the opponent's goods with the retail services covered by the applicant's trade mark;

iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

45. In this context, I note the following extracts from Mr Hobbs' appeal decision in MissBoo:

"3. Both as between marks and as between goods and services, the evaluation of 'similarity' is a means to an end. It serves as a way of enabling the decision taker to gauge whether there is 'similarity' of a kind and to a degree which is liable to give rise to perceptions of relatedness in the mind of the average consumer of the goods or services concerned. This calls for a realistic appraisal of the net effect of the similarities and differences between the marks and the goods or services in issue, giving the similarities and differences as much or as little significance as the relevant average consumer (who is taken to be reasonably well-informed and reasonably observant and circumspect) would have attached to them at the relevant point in time.

4. […] The relatedness or otherwise of the trading activities involved in the comparison is ultimately a matter of consumer perception.

25. In evaluating whether and, if so, to what degree retail services across the spectrum covered by the Listed Services were 'similar' to 'handbags' in Class 18 and 'shoes for women' in Class 25, it was necessary, in keeping with the principle of proportionality, to consider the greater or lesser likelihood that a single economic undertaking would naturally be regarded as responsible for providing not only goods of that kind, but

also retail services of the kind in question. The degree to which retail services within the spectrum were found on evaluation to be 'similar' to such goods would be a co-variable with the degree of 'similarity' between the signs in the overall assessment of the existence or otherwise of a likelihood of confusion."

46. It seems clear, therefore, that as part of the overall assessment of 'similarity' it is necessary to consider whether there is 'complementarity' between the goods and services in issue – i.e. whether the goods and services in issue are closely connected in the sense that one is indispensable or important for the use of the other in such a way that consumers may think that the same undertaking is responsible for manufacturing those goods or providing those services. I bear in mind the principle of proportionality and I note too that the applicant's services above do not relate to goods that are identical to the limited goods specified by the opponent. I also note that 'complementarity' does not always or necessarily equal 'similarity'. However, taking into account all of the relevant case law, I find that there is between a low and medium degree of similarity between the opponent's goods in Class 25 and the applicant's *retail services connected with the sale of handbags; online retail services connected with the sale of handbags*. Such similarity is based on complementarity, shared trade channels and shared users.

retail and wholesale services connected with the sale of fitness and sporting goods, sporting goods and equipment; online retail services connected with the sale of sporting goods"

47. In contrast with the above, I find that the retail (online retail) and wholesale of fitness and sporting goods and equipment are dissimilar to the opponent's class 25 goods. Whilst the users of the goods and services may be the same, these particular goods that are to be retailed are not so closely connected in the sense that one is indispensable or important for the use of the other in such a way that consumers may think that the same undertaking is responsible for manufacturing those goods or providing those services. As a result, I do not believe there to be a complementary relationship, nor is there any competition.

48. As some degree of similarity between goods and services is necessary to engage the test for likelihood of confusion, my findings above mean that the opposition aimed against those goods and services I have found to be dissimilar will fail.[8]

The average consumer and the nature of the purchasing act

49. 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 (see *Lloyd Schuhfabrik Meyer,* Case C-342/97).

50. 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."

51. I have no submissions from the opponent relating to the average consumer and nature of the purchasing act. The applicant, in their submissions, state that the relevant consumer in this instance is a member of the general public who wishes to purchase clothing with an average level of attention. Further, as class

[8] See *eSure Insurance v Direct Line Insurance,* [2008] ETMR 77 CA and *Waterford Wedgwood PLC v OHIM* - C-398/07 P

18 and class 25 goods such as clothing, footwear, headgear, clothing accessories and bags are sold visually, the nature of the purchasing act would primarily be just that; I agree. The goods at issue are ordinary consumer goods that will be selected by members of the general public at large. The goods will likely be sold through a range of retailers and their online equivalents. In physical retailers, the goods at issue will be displayed on shelves or racks, where they will be viewed and self-selected by the consumer. A similar process will apply to online sales, where the consumer will select the goods having viewed an image displayed on a webpage. The selection of the goods at issue will, therefore, be primarily visual. That being said, I do not discount aural considerations in the form of advice sought from sales assistants or word of mouth recommendations. The goods will be selected relatively frequently and will vary in cost. Regardless of the price of the goods, the average consumer will still give consideration to various factors such as size, current fashion trends, materials used, suitability and durability. The services will be selected after inspection of premises, websites or, for example, online searches. The choice of services will be influenced by factors such as the range of goods on offer, knowledge of staff and potentially factors such as the ethical practices of the retailer. These are relatively ordinary considerations and, as a result, I find that the average consumer will select the goods and services at issue whilst paying a medium degree of attention.

Comparison of trade marks

52. 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 judgement 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".

53. 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 trade marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the trade marks.

54. The trade marks to be compared are as follows:

Earlier trade mark	Contested trade mark
Free Soul	

55. The opponent contends that the applicant's mark would be perceived as 'BSOUL' by consumers, which is highly similar to 'FREE SOUL'. Additionally, they argue that both marks coincide in the distinctive element 'SOUL', which constitutes four out of five letters in the applicant's mark. This identity between the 'SOUL' elements of each mark renders the marks visually, aurally and conceptually similar to a high degree. Furthermore, they submit that there are aural similarities between 'FREE' and 'B' at the beginning of the respective marks.

56. The applicant, on the other hand, submits that the differences between the signs is extremely pronounced, with the opponent's mark consisting of two distinct words and being eight characters in length, registered in black. Whereas the applicant's mark consists of the letters 'BS' and 'UL' separated by

a graphical depiction of lotus flower in pink. The applicant also denies that its mark would be viewed as the word 'BSOUL' because the lotus separating the letters 'BS' and 'UL' is in a different lighter colour which makes the letters 'BS UL' more pronounced when reading the mark, as well as the device element sitting lower that the letters. Additionally, they argue that the average consumer when seeing the device element, would not assume that it was a substitute for an 'O' when there is no indication or suggestion of the lotus creating an 'O'. Next, the applicant acknowledges that whilst the letter 'B' and the word 'Free' may rhyme, the similarities must be considered in the context of their position in the marks as a whole, adding that it is the word 'FREE' and the letters 'BS' that should be compared as the average consumer would consider the applicant's mark to break down into 'BS' and 'UL' and the opponent's mark to breakdown into 'FREE' and 'SOUL'. The word 'FREE' and the letters 'BS' share little to no phonetic similarities. Further, when comparing the second elements of the marks, the word 'SOUL' and the letters 'UL' share little to no phonetic similarities. The applicant's final submission relating to the phonetic similarity of the marks is that the earlier mark would be pronounced 'FREE SOUL' whereas the Applicant's Mark would be pronounced using the letters 'B,S,U,L'. As regards conceptual similarity, the applicant argues that there is none. The phrase 'FREE SOUL' brings to mind a person living without being bound by societal expectations or conventions or someone who lives without constraints. The letters 'BS UL' do not have semantic content. Additionally, whilst the applicant expressly denies that the mark would be perceived as 'BSOUL' by the consumer, in any event there are no conceptual similarities as this would be perceived as 'be soul' meaning to be spiritual or have emotional or intellectual energy or intensity, which is distinct from the meaning of 'FREE SOUL', a person living without the bindings of societal expectations.

Overall Impression

57. The opponent's mark consists of the two words 'Free Soul'. There are no other elements in the mark to contribute to its overall impression, which lies in the words themselves.

58. The applicant's mark contains the four letters B,S,U,L where the BS and UL are separated by a stylised depiction of a pink lotus flower. Given the overall presentation, in my opinion the average consumer is likely to see the lotus flower device as a replacement for the letter "O", resulting in them reading the mark as 'BSOUL'. It is my view that the overall impression of the applicant's mark lies in the unit formed by the stylisation of the 'O'/figurative lotus flower. However, the device, in my view, makes a roughly equal contribution in the overall impression due to its size and prominence in the mark as whole.

Visual Comparison

59. The opponent's mark consists of two words, both consisting of four letters. The applicant's mark contains four letters, with three of those being the same as those present in the opponent's mark (S,U,L). Additionally, the applicant's mark contains a stylised device representing a lotus flower in the colour pink, as well as the letter 'B' at the beginning of the mark which is not reproduced at all in the opponent's mark. As stated above, it is my view that the device element is used in replacement of the letter 'O' but is immediately noticeable in the mark. Further, the applicant's mark gives the impression of one word 'BSOUL' which gives a different visual impression to that of the opponent's two-word mark. Accounting for all of the visual differences the marks are, in my opinion, visually similar to a low degree.

Aural Comparison

60. Aurally, the opponent's mark will be articulated as two syllables and will be pronounced in accordance with their ordinary dictionary definitions. The applicant contends that each of the letters 'B,S,U, L' in its mark will be pronounced individually, however I do not agree. In my view the average consumer will articulate the applicant's mark as two syllables, pronouncing the letter 'B' first followed by the word 'SOUL'. This is as a result of them perceiving the lotus flower as a letter 'O'. The figurative element in the mark will not be articulated. As acknowledged by the applicant, the letter 'B' and the word 'Free' rhyme. Whilst they are not pronounced identically, they are considered to sound

similar. Consequently, I find the marks to be aurally similar to between a medium and high degree.

Conceptual Comparison

61. Conceptually, I agree with the applicant that the opponent's mark 'Free Soul' brings to mind a person living without being bound by societal expectations or conventions or someone who lives without constraints. The applicant's mark on the other hand does not convey the same concept. Whilst both marks would be perceived as sharing a reference to 'SOUL', I again agree with the applicant that its mark would be perceived as 'be soul' meaning to be spiritual or to be in touch with one's emotional or moral nature or identity. Alternatively, if the consumer does not perceive the sign as 'be soul' then the mark does not convey a specific concept other than something relating to 'soul'. As a result, I find that the marks are conceptually similar to a low degree, owing to the shared reference to 'soul'.

Distinctive character of the opponent's mark

62. 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 *WindsurfingChiemsee 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 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)."

63. 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 distinctive character of a mark can be enhanced by virtue of the use that has been made of it. The opponent has not claimed that its mark has acquired an enhanced degree of distinctiveness and did not file any evidence to that effect. As such, I have only the inherent position to consider.

64. The earlier mark consists of the plain words 'Free Soul' without any additional stylisation or figurative elements. As such, the inherent distinctive character rests solely in the words themselves. The opponent's mark consists of two readily understood dictionary words that combine to create a readily understood phrase. The phrase is not descriptive of the goods concerned nor is it considered to be related to them. As a result, I find that the opponent's mark possesses a medium degree of distinctive character.

Likelihood of confusion

65. 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 and services down to the responsible undertakings being the same or related.

66. 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 (see *Sabel*, C-251/95, para 22). 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 services and vice versa (see *Canon*, C-39/97, para 17). It is necessary for me to keep in mind the distinctive character of the earlier marks, 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.

67. Whilst conducting a global assessment of the likelihood of confusion I must be aware of the fact that not all aspects of the respective marks will necessarily have the same impact. For example, the importance of the respective visual, aural and conceptual aspects will be dependent on factors such as the way the goods at issue are marketed, and in which type of store/platform they are made available.

68. Throughout the course of this decision, I have determined that:

- The respective goods and services range from being dissimilar to identical.

- The average consumers are members of the general public at large who will demonstrate a medium level of attention during the purchasing process.

- The purchasing process for the goods and services will be primarily visual in nature, though aural considerations have not been excluded.

- The opponent's mark possesses a medium degree of inherent distinctive character.

- The marks at issue are visually similar to a low degree. The marks are aurally similar to between a medium and high degree. The marks are conceptually similar to a low degree.

69. In respect of the aural similarities potentially reaching a high degree, I remind myself of the case of *The Royal Academy Of Arts v Errea Sport S.P.A.* BL O/010/16, wherein Mr Iain Purvis QC (as he then was), as the Appointed Person, rejected the appellant's submission that there was bound to be a likelihood of confusion where one mark consisted of letters and the other consisted of the same letters in (heavily) stylised form. He said:

> "In essence [the appellant's attorney's] argument was that there was bound to be a likelihood of confusion in this case because of the aural 'identity' between the marks (if one tried to ask for goods using an aural version of the earlier mark, one would ask for 'RA' goods, just as one would ask for the applicant's goods). This argument seems to me to fly in the face of the necessary 'global' assessment, bearing in mind the visual, conceptual and aural similarities, which the tribunal must carry out. Particularly in the case of an earlier mark which is a heavily stylised device mark, taking the aural similarities alone tends to ignore the real substance and distinctive character of the mark and is likely to lead to an erroneous result."

70. Further, I also remind myself that, as above, I have found that the visual component will play the greater role in the selection process for the goods and services at issue. On this point, I refer to the case of In *New Look Limited v OHIM,* joined cases T-117/03 to T-119/03 and T-171/03, the General Court stated that:

> "49. However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (*BUDMEN*, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumer choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs."

And

> "50..... Generally in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly the visual aspect plays a greater role in the global assessment of the likelihood of confusion."

71. Taking all of the above into account, and even bearing in mind the principle of imperfect recollection, I consider that the differences between the marks are such that the consumers would be able to accurately recall and sufficiently remember which mark was which. I appreciate that the marks may share a reference to 'soul' (albeit the applicant's mark does not actually include the word *per se*), however, the differences created by the letter 'B', the addition of the stylised lotus flower, as well as the fact the mark would be perceived as a single

unit rather than two separate words, will not go unnoticed. Therefore, despite some overlap created by the commonality of the reference to ‘soul’, in my view, this will be outweighed by the other differences. Consequently, it is unlikely that the competing marks will be mistaken or misremembered for one another. Rather, the aforementioned differences are likely to be sufficient to enable consumers to differentiate between them. In my judgement, taking all the above factors into account, the differences between the competing trade marks are likely to enable consumers paying a medium level of attention, to avoid mistaking the marks for one another, notwithstanding the principles of imperfect recollection and interdependency. As a result, I find that there is no likelihood of direct confusion, even in relation to goods that are identical.

72. That leaves indirect confusion to be considered. In *L.A. Sugar Limited v By Back Beat Inc,* Case BL O/375/10, Mr Iain Purvis QC, (as he then was) sitting 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)."

73. These three categories are not exhaustive; rather, they were intended to be illustrative of the general approach, as has been confirmed by the Court of Appeal in *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors.* [9] I recognise that a finding of indirect confusion should not be made merely because the competing marks share a common element. In this connection, it is not sufficient that a mark merely calls to mind another mark: this is mere association not indirect confusion.

74. Furthermore, in *Liverpool Gin* Arnold LJ referred to the comments of James Mellor Q.C. (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.

[9] *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207

75. Consumers, having recognised the differences between the marks, would not then assume that they are economically linked undertakings. I do not consider it logical that an undertaking would replace the word first word in their mark with a single letter, the letter 'B' in replacement of the word 'Free' in this case; this is more than simply removing a non-distinctive element. Whilst I appreciate that the *L.A. Sugar* categories (referred to above) are not exhaustive, I do not see any other plausible basis on which to conclude that consumers would see the competing marks as deriving from economically linked undertakings. Instead, in my opinion, the shared reference to 'soul' will be seen as merely coincidental. Consequently, and bearing in mind the comments of Arnold LJ and Mr Mellor Q.C (as he then was) in the preceding paragraph, I do not consider there to be a likelihood of indirect confusion.

Conclusion

76. The opposition has failed in its entirety. Therefore, subject to any successful appeal, the application may proceed to registration for all of the goods and services contained within the specification.

Costs

77. As the applicant has been successful, it is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice ("TPN") 1/2023. [10] In the circumstances, I award the applicant the sum of £1350. The sum is calculated as follows:

Considering the notice of opposition and preparing the counterstatement	£350
Considering the opponent's evidence	£600
Preparing written submissions in lieu	£350

[10] As the proceedings were commenced after 01 February 2023

Total	£1300

78. I therefore order **FFI GLOBAL S.R.L.** to pay **Forus S.A.** the sum of £1300. 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 21st day of January 2025

Oliver Rose'Meyer
For the Registrar