

O/0059/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3947282
IN THE NAME OF CRAIG ROBINSON
TO REGISTER THE FOLLOWING TRADE MARK:

Grimm Prints

IN CLASS 25

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 443939
BY GRIMM AND CO. LIMITED

Background and pleadings

1. Craig Robinson (“the applicant”) applied to register the trade mark **Grimm Prints** in the UK on 30 August 2023, under number 3947282 (“the applicant’s mark”). It was accepted and published in the Trade Marks Journal on 1 September 2023 in respect of the following goods:

Class 25

Clothing; Jackets [clothing]; Ready-to-wear clothing; Linen clothing; Headbands for clothing; Headbands [clothing]; Clothes; Aprons [clothing]; Maternity clothing; Jerseys [clothing]; Shorts [clothing]; Denims [clothing]; Parts of clothing, footwear and headgear; Embroidered clothing; Hoods [clothing]; Windproof clothing; Wristbands [clothing]; Belts for clothing; Belts [clothing]; Casual clothing; Jackets being sports clothing; Clothing for leisure wear; Ready-made clothing; Bottoms [clothing]; Latex clothing; Playsuits [clothing]; Woven clothing; Infant clothing; Clothing for sports; Sports clothing; Leisure clothing; Athletic clothing; Ties [clothing]; Clothing for children; Clothing for infants; Clothing for babies; Tops [clothing]; Pockets for clothing; Beach clothing; Triathlon clothing; Men's clothing; Dance clothing

2. Grimm & Co. Limited (“the opponent”) oppose the trade mark on the basis of section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). This is on the basis of its UK trade mark number 3351962, **GRIMM & CO** (“the opponent’s mark”). The opponent’s mark was filed on 8 November 2018 and became registered on 22 March 2019. It stands registered for a range of goods and services in 12 classes. For the purposes of the opposition, the opponent only relies on some of its goods, namely:

Class 25: T-shirts; Costumes for use in children's dress up play

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

4. The opponent argues that the respective goods are identical or similar and that the marks are highly similar. On this basis, it submits that there is a likelihood of confusion.

5. The applicant filed a counterstatement denying the ground of opposition.

6. The opponent is professionally represented by Haseltine Lake Kempner LLP, whereas the applicant is not professionally represented. Neither party filed evidence. No hearing was requested and only the opponent filed written submissions in lieu. These will not be summarised but will be referred to as and where appropriate during this decision. This decision is taken following careful consideration of all the papers before me.

7. 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.

Section 5(2)(b)

8. Section 5(2)(b) of the Act is 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”.

9. Section 5A states: [...] “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.”

10. I am guided by the following principles which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-*

Goldwyn-Mayer Inc, Case C-39/97, Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V. Case C-342/97, Marca Mode CV v Adidas AG & Adidas Benelux BV, Case C-425/98, Matratzen Concord GmbH v OHIM, Case C-3/03, Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH, Case C-120/04, Shaker di L. Laudato & C. Sas v OHIM, Case C-334/05P and Bimbo SA v OHIM, Case C-591/12P.

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

11. 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.

12. In *Canon*, Case C-39/97, the Court of Justice of the European Union (“CJEU”) stated, at paragraph 23 of its judgment, that when considering whether goods are similar, all the relevant factors relating to the goods should be taken into account. The CJEU stated that those factors include their nature, intended purpose, method of use and whether they are in competition with each other or are complementary.

13. 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.

14. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court (“GC”) stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking.”

15. In *Gérard Meric v OHIM*, the GC confirmed that even if goods are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

“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.”

16. The goods to be compared are shown in the table below:

The opponent's goods	The applicant's goods
<p><i>Class 25: T-shirts; Costumes for use in children's dress up play.</i></p>	<p><i>Class 25: Clothing; Jackets [clothing]; Ready-to-wear clothing; Linen clothing; Headbands for clothing; Headbands [clothing]; Clothes; Aprons [clothing]; Maternity clothing; Jerseys [clothing]; Shorts [clothing]; Denims [clothing]; Parts of clothing, footwear and headgear; Embroidered clothing; Hoods [clothing]; Windproof clothing; Wristbands [clothing]; Belts for clothing; Belts [clothing]; Casual clothing; Jackets being sports clothing; Clothing for leisure wear; Ready-made clothing; Bottoms [clothing]; Latex clothing; Playsuits [clothing]; Woven clothing; Infant clothing; Clothing for sports; Sports clothing; Leisure clothing; Athletic clothing; Ties [clothing]; Clothing for children; Clothing for infants; Clothing for babies; Tops [clothing]; Pockets for clothing; Beach clothing; Triathlon clothing; Men's clothing; Dance clothing.</i></p>

17. In the amended counterstatement and defence filed on 16 November 2023, the applicant argues that costumes for use in children's dress-up play is not a 'service' that he provides, nor can he see that this is a 'service' that the opponent provides. The applicant also highlights that he is unable to find evidence of the applicant selling t-shirts on their webpage. However, the opponent is not required to show evidence of use of its mark (for reasons set out in paragraph 3 of this decision). As such, the

opponent's mark is entitled to protection against a likelihood of confusion with the applicant's mark based upon its 'notional' use in respect of the full range of goods relied upon (see *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41, paragraph 22). Moreover, when assessing the likelihood of confusion in the context of registering a new trade mark (such as the applicant's mark), it is necessary to consider all the circumstances in which the mark might be used if it were registered (see *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06, paragraph 66). Therefore, even though the applicant has suggested the ways in which the mark will not be used, my assessment must take into account only the applicant's specification as applied for. Any differences between the actual goods provided by the parties are not relevant unless those differences are apparent from the applied-for and registered marks.

18. The opponent contends that the following goods are identical to the opponent's goods on the basis that all of these goods include the opponent's goods in Class 25, namely "t-shirts" and/or "costumes for use in children's dress-up play":

Clothing; Ready-to-wear clothing; Linen clothing; Clothes; Maternity clothing; Jerseys [clothing]; Embroidered clothing; Casual clothing; Clothing for leisure wear; Ready-made clothing; Latex clothing; Woven clothing; Infant clothing; Clothing for sports; Sports clothing; Leisure clothing; Athletic clothing; Clothing for children; Clothing for infants; Clothing for babies; Tops [clothing]; Beach clothing; Triathlon clothing; Men's clothing; Dance clothing

19. I agree that the applicant's goods above encompass "t-shirts". I am of the view therefore that these goods are identical under the principles set out in *Meric*.

20. I am of the view that "jerseys [clothing]" are included within this group on the basis that the Cambridge Dictionary defines a 'jersey' as "a piece of wool or cotton clothing that is worn on the upper part of the body and has sleeves but no opening at the front". This implies that it can be interpreted in the same way as a "t-shirt" and therefore is also identical as per the principles set out in *Meric*. However, if I am wrong in this analysis, I have also considered "jerseys [clothing]" with other types of clothing (see paragraph 25).

21. The remaining goods to be compared are:

Jackets [clothing]; Headbands for clothing; Headbands [clothing]; Aprons [clothing]; Shorts [clothing]; Denims [clothing]; Parts of clothing, footwear and headgear; Hoods [clothing]; Windproof clothing; Wristbands [clothing]; Belts for clothing; Belts [clothing]; Jackets being sports clothing; Bottoms [clothing]; Playsuits [clothing]; Ties [clothing]; Pockets for clothing

22. The opponent argues that these goods are highly similar on the basis that a) they belong to a homogeneous sector of products on the market, b) their purpose is the same, c) they are sold in the same retail outlets, d) they are manufactured and produced by the same entities, and e) they are in competition with each other and/or complementary with the opponent's goods.

23. For the purposes of considering the issue of similarity of goods, 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 *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38). I have therefore assessed the applicant's remaining goods by dividing them into the groups as per below.

Headbands for clothing; headbands [clothing]; wristbands [clothing]; belts for clothing; belts [clothing]; ties [clothing]

24. These goods are clothing accessories. They are used in the same way as "t-shirts" in that they are items to be worn on the body. The end users will be the public at large. The applicant's goods have a similar nature as the opponent's goods, albeit not identical. They are sold through the same trade channels such as clothing outlets and shops, online, and in catalogues. These types of clothing accessories are also typically found near the opponent's goods within these trade channels. These items are likely to be bought to aesthetically complement the opponent's goods, and consumers are likely to believe that responsibility for both lies with the same undertakings, so there is an element of complementarity too. I therefore find there to be a high degree of similarity between these goods and the opponent's goods.

Jackets [clothing]; jerseys [clothing]; shorts [clothing]; denims [clothing]; windproof clothing; jackets being sports clothing; bottoms [clothing]; playsuits [clothing]; hoods.

25. These are items of other types of clothing, other than “t-shirts” or “costumes for use in children’s dress-up play”. I have included hoods amongst these goods as a finished item of clothing rather than as a constituent part of a piece of clothing, as in my experience, it is possible to buy hoods akin to a balaclava to be worn on the head (other than the type of hood attached to a jacket). Whilst I have included “jerseys [clothing]” in the category of identical goods above (paragraph 20), I have also included “jerseys [clothing]” in this category in the event that the finding of “jerseys [clothing]” being identical to “t-shirts” is incorrect, given that “jerseys [clothing]” may instead be interpreted as a type of jumper.

26. “Jackets [clothing]”, “shorts [clothing]”, “playsuits [clothing]”, and “bottoms [clothing]” could reasonably include those which constitute “costumes for use in children’s dress-up play” (for example, a military-style soldier jacket), and thus these terms could be seen as identical to the opponent’s goods on the principle outlined in *Meric*. However, in the event that I am wrong in this finding, I will assess them as types of clothing other than “t-shirts” or “costumes for use in children’s dress-up play”.

27. These goods have a shared use with “t-shirts”, namely, to be worn or cover the body. The end users will be the same, i.e., the public at large. They have the same (or a highly similar) physical nature as the opponent’s goods. They will be sold through the same trade channels such as clothing retailers, online, and in catalogues. They will be sold alongside t-shirts within these trade channels. They are bought to aesthetically complement the opponent’s “t-shirts”, and consumers are likely to believe that responsibility for both lies with the same undertakings. As such, there is a degree of complementarity. I therefore find that there is a high degree of similarity between these goods and the opponent’s goods.

Parts of clothing, footwear, and headgear; pockets for clothing

28. These goods form constituent parts of the finished products. In *Les Éditions Albert René v OHIM*, Case T-336/03, the GC found that:

“61... The mere fact that a particular good is used as a part, element or component of another does not suffice in itself to show that the finished goods containing those components are similar since, in particular, their nature,

intended purpose and the customers for those goods may be completely different.”

29. The opponent accepts that these goods are not the finished articles but argues that they might ‘easily coincide in end consumers’ and can be manufactured by the same undertakings.

30. “Pockets” and “parts of clothing, footwear, and headgear” are used to manufacture finished items clothing, footwear and headgear. As such, they have a different purpose to the opponent’s “t-shirts”, which are worn to cover the body. Users of the goods overlap in that they may be purchased by both tradespeople and the public at large, such as people who make their own clothing or customise their clothes. The physical nature of the respective goods overlaps since they may be made from the same materials. They could be sold directly to trade, or to the public such as within haberdashery shops. They may be manufactured by the same undertakings. Parts of clothing in particular are of importance to finished articles of clothing such as “t-shirts”, and consumers may think that responsibility for them lies with the same undertakings, resulting in a degree of complementarity. It is therefore considered that the goods have a low to medium level of similarity with the opponent’s goods.

Aprons [clothing]

31. The nature and purpose of aprons overlaps with “t-shirts”, as they are both items of clothing worn on the body, and are likely made from similar materials. However, their purpose and nature are not precisely the same given that the primary function of aprons is protect other items of clothing. Users of both goods will overlap. There may be differences in trade channels, given that aprons are typically sold in homeware stores rather than through clothing stores. They are not complementary with the opponent’s goods in the sense outlined in case law, nor are they in competition with them. I find that they therefore have a low to medium level of similarity with the opponent’s goods.

Average consumer and the purchasing act

32. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion,

it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

33. 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.”

34. The average consumer for the goods will be members of the general public, as well as trade customers too. The cost of purchase is likely to vary, and the goods will be purchased on a reasonably frequent basis. Several factors may influence the average consumer when purchasing the goods, such as, inter alia, the type of material, the quality, and the aesthetic appearance. I therefore consider that that the average consumer will pay a medium level of attention when selecting the goods.

35. The goods are likely to be self-selected from shelves within retail outlets, via online retailers, or in catalogues. In *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03, the GC stated that:

“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.”

36. Visual considerations are therefore likely to be the primary factor when purchasing the goods. However, I do not discount the role that aural selection may play when purchasing, such as through word-of-mouth recommendations or when placing telephone orders.

Comparison of marks

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

38. It would be wrong, therefore, to dissect the trade marks artificially, 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.

39. The respective trade marks are shown below:

Earlier trade mark	Contested trade mark
GRIMM & CO	Grimm Prints

40. The opponent’s mark is a plain word mark, written all in uppercase. In *LA Superquimica v European Union Intellectual Property Office (EUIPO)*, Case T-

24/17, the GC held at [39] that such marks protected the word or words contained in the mark in whatever case, colour or typeface. The word 'GRIMM' may be perceived as a surname, as an invented word or as a misspelling of the dictionary-defined word 'grim'. The ampersand and additional word '& CO' is defined by Cambridge Dictionary as "and Company". It would therefore be perceived as a non-distinctive reference to the type of undertaking producing the goods by the average consumer. Consequently, the overall impression of the mark is therefore dominated by the word 'GRIMM', whereas '& CO' plays a much lesser role.

41. The applicant's mark is a plan word mark, written in title case. The word 'Grimm' in this mark will also be perceived as a surname, as an invented word or as a misspelling of the dictionary-defined word 'grim'. The word 'Prints' will be perceived as a descriptive reference to a print design on an item of clothing. The word 'Grimm' therefore dominates the overall impression of the mark, whilst the word 'Prints' plays a much lesser role.

Visual comparison

42. Visually, the marks share the first word 'Grimm'. In the opponent's mark, 'Grimm' is presented in upper case whereas it is presented in lower case in the applicant's mark. However, it is noted that the difference in capitalisation is not significant on the basis that word-only marks protect the word itself rather than the case used. The marks' additional components ('& CO' and 'Prints') differ from each other. However, taking into account the overall impressions, particularly the dominant role that the shared word 'Grimm' plays in both marks, I am of the view that the marks are visually similar to between a medium and high degree.

Aural comparison

43. Aurally, the marks are similar because of the shared first word 'Grimm'. They differ in their remaining components. The '& Co' in the opponent's mark has two syllables (the ampersand being articulated as the word 'AND'), whereas the word 'Prints' in the applicant's mark has just one syllable. In my view, as the shared word 'Grimm' is the dominant element within the marks' overall impressions, the marks are aurally similar to between a medium and high degree.

Conceptual comparison

44. The opponent argues that the marks have no real meaning, and therefore there are no conceptual differences between them which consumers can use to differentiate the two marks.
45. It is considered that the average consumer may recognise the marks' dominant element ('Grimm') as a surname, given the popularity of, inter alia, the Brothers Grimm. In the opponent's mark, the construction of 'GRIMM & CO' implies the partnership between an individual named 'Grimm' and others. The applicant's mark, 'Grimm Prints', could also be viewed as relating to an individual with the surname 'Grimm', coupled with the non-distinctive element 'Prints'. If perceived in this way, then the marks both convey the concept of an individual with the surname 'Grimm'. Although the marks differ in their non-distinctive elements ('& CO' and 'Prints'), the shared element 'Grimm'/'GRIMM' results in the marks having between a medium and high degree of conceptual similarity.
46. However, there may be a significant proportion of average consumers who may not recognise the surname and instead view 'Grimm' as an invented word. If perceived in this way, 'Grimm' will not convey any meaning and therefore this part of the competing marks will be conceptually neutral. Whilst the additional elements '& CO' and 'Prints' contribute less to the marks' overall impressions, the marks are conceptually different overall as they are composed of the neutral word 'Grimm' along with additional (differing) components.
47. It is also possible that they may recognise the dictionary-defined word 'Grim' and perceive it as a deliberate misspelling. If perceived in this way, then it is considered that 'Grimm' will convey the meaning of the dictionary word 'grim', which is a point of conceptual similarity between the marks. When the whole marks including their additional elements ('& CO' and 'Prints') are taken into consideration, then it is considered that there is a medium to high level of similarity between them.

Distinctive character of the earlier trade mark

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

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

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

49. Registered trade marks possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. Although the distinctiveness of a mark can be enhanced by virtue of the use made of it, the opponent has not filed any evidence. Therefore, I have only the inherent position to consider.

50. As previously outlined, the opponent’s mark consists of the words ‘GRIMM & CO’. The distinctive character of the mark predominantly lies in ‘GRIMM’. It is considered that the addition of ‘& CO’ will be understood as a non-distinctive element and is therefore given less weight when assessing the inherent distinctiveness of the mark as per the guidance set out above in *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97. As previously discussed, the word ‘GRIMM’ may be understood in different ways. If it is perceived as a surname or a misspelling of the dictionary-defined word ‘grim’, then the earlier mark as a whole will have a medium

level of distinctiveness. If it is perceived as an invented word, then the earlier mark as a whole will have a high level of distinctiveness.

Global assessment – conclusions on likelihood of confusion

51. 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 set formula for establishing a likelihood of confusion between marks; it is a global assessment where a number of factors need to be borne in mind.

52. One such factor is the interdependency principle, i.e. a lesser degree of similarity between the competing marks may be offset by a greater degree of similarity between the respective goods, and vice versa. As mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be mindful that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

53. In the counterstatement, I note that the applicant has only commented on the parties' use of the marks, and not directly commented on the similarity of the two marks or the likelihood of confusion between them. The opponent contends that there is a high degree of similarity between the two marks, that the goods are either identical or similar, and therefore a risk of direct and/or indirect confusion exists.

54. Earlier in this decision I have found that the goods have differing levels of similarity, with some goods being identical, some goods having a high degree of similarity, whereas a few have a low to medium level of similarity between them. The average consumer will consist of members of the general public and trade customers. It is considered that they will pay a medium degree of attention when selecting the goods through primarily visual means, although I do not discount aural considerations entirely. I have also found the marks to be visually and aurally similar to between a medium and high degree, and either conceptually similar to

between a medium and high degree of dissimilarity, depending on how the word 'GRIMM' is perceived. The earlier mark has either a medium or high level of inherent distinctive character, depending on how the word 'GRIMM' is perceived.

55. The dominant element in both marks is 'GRIMM'/'Grimm', given that the additional elements within the marks ('& CO' and 'Prints') are non-distinctive. Although the additional elements within each mark contribute less to the overall impressions of the marks, they are not negligible. It is unlikely that the average consumer, paying a medium level of attention, would completely overlook them. These differences are therefore likely to be sufficient to prevent the average consumer from mistaking one for the other. I consider this to be the case whether the word 'GRIMM' is seen as an invented word (notwithstanding it being highly distinctive) or as a surname/misspelling of the word 'grim' (irrespective of the shared conceptual meaning). I therefore find that there is no likelihood of direct confusion, even in respect of identical goods.

56. This leaves indirect confusion to be considered. In *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

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

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).
- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).
- (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)."

57. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ approved Mr Purvis's formulation but added:

"13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/219/16) at [16] 'a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion'. Mr Mellor went on to say that, if there is no likelihood of direct confusion, 'one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion'. I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion."

58. It is not sufficient that a mark merely calls to mind another mark (as per *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17). This is mere association not indirect confusion. A finding of indirect confusion should not be made merely due to a shared element within marks. As per *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10 (set out above), indirect confusion should be identified in cases where the average consumer is likely to notice the differences between the competing marks but assume an economic link between the two undertakings based on their similarities.

59. If the average consumer perceives 'Grimm' within the marks as an invented word, then it is considered that, as a highly distinctive word, the average consumer may assume that no-one other than the opponent is using it in a trade mark, as per the first category of examples set out in *LA Sugar* above. Alternatively, if the average consumer views 'Grimm' as a surname or misspelling of the word 'grim' then it is considered that the medium level of distinctiveness held by the earlier mark is enough to cause indirect confusion, notwithstanding the differences between the marks. This is on the basis that the additional element "& CO" is a non-distinctive reference to it being a company, and "Prints" is a descriptive reference to the goods. It is considered that these differences are consistent with a sub-brand or brand extension, with the applicant's mark (Grimm Prints) being seen as a sub-brand/brand extension of the house mark (GRIMM & CO) indicating the part of the brand which deals with printed clothing. On that basis, consumers will assume that there is an economic connection between the users of the marks. Therefore I find that there is a likelihood of indirect confusion, even in relation to goods which are only similar to a low to medium degree.

Final Remarks

60. The opposition under section 5(2)(b) has been successful in its entirety. Subject to any successful appeal, the application will be refused registration.

Costs

61. The opponent has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances I award the opponent the sum of £750 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Preparing a statement and considering the other side's statement: £250

Preparing submissions-in-lieu: £400

Official fees: £100

62. I therefore order Craig Robinson to pay Grimm & Co. Limited the sum of £750. The above sum should be paid within twenty-one days of the expiry of the appeal period

or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 22nd day of January 2025

K SERRAVALLE

For the Registrar