O/0135/24

TRADE MARKS ACT 1994

IN THE MATTER OF
TRADE MARK APPLICATION NO. 3776357
IN THE NAME OF WOW STUDIO LIMITED
TO REGISTER AS A TRADE MARK

IN CLASSES 32 AND 33

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 600002488
BY WOW HYDRATE LIMITED

BACKGROUND AND PLEADINGS

1. On 11 April 2022, WOW STUDIO LIMITED ("the applicant") applied to register the trade mark shown on the cover page of this decision in the United Kingdom, claiming priority from EUTM No. 018676384, which has a priority date of 22 February 2022. The application was accepted and published for opposition purposes on 27 May 2022, in respect of the following goods[1]:

Class 32: *Beer.*

Class 33: *Wine; Alcoholic beverages, except beer; Liquor.*

2. The application is opposed by WOW Hydrate Limited ("the opponent") under the fast-track procedure. The opposition was filed on 27 July 2022 and is based upon Section of the Trade Marks Act 1994 ("the Act"). The opposition is directed against all of the goods in classes 32 and 33 of the application. The opponent relies upon the following marks:

WOW ENERGY

UK trade mark registration number 3574904
Filing date: 5 January 2021
Registration date: 9 July 2021
Registered in Classes 5, 32 and 35
Relying on all goods in class 32 only.
("The '904 mark"); and

WOW

UK trade mark registration number 3574928
Filing date: 5 January 2021
Registration date: 2 July 2021
Registered in Classes 5, 32 and 35

[1] I note that the application as originally filed was in respect of goods and services in classes 3, 14, 16, 21, 25, 28, 32, 33 and 35. On 5 October 2022, the applicant filed form TM12 to request that the application be divided, and accordingly, in the official letter of 18 October 2022, the Registry confirmed that the application had been divided and was proceeding under UK3776357 in classes 32 and 33 and under UK3840118 for the remaining classes.

Relying on all goods in class 32 only.
("The '928 mark"); and

WOWHYDRATE

WOWHYDRATE

(Series of 2)
UK trade mark registration number 3439915
Filing date: 28 October 2019
Registration date: 7 February 2020
Registered in Classes 5, 32 and 35
Relying on all goods in class 32 only.
("The '915 mark").

3. Each of the marks relied upon by the opponent qualifies as an earlier mark under section 6(1) of the Act. As none of the marks had completed the registration procedure more than five years before the application date for the contested mark, they are not subject to the use provisions contained in section 6A of the Act.

4. The opponent submits that the dominant portion of each of the respective marks is the word WOW, and that the respective goods all relate to beverages. Therefore, it submits that a likelihood of confusion exists, including a likelihood of association.

5. The applicant filed a counterstatement denying the claims. It requests that the opposition be dismissed in its entirety and an award of costs made in the applicant's favour.

6. Rule 6 of the Trade Marks (Fast Track Opposition)(Amendment) Rules 2013, S.I. 2013 No. 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

"(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit."

7. The net effect of these changes is to require parties to seek leave in order to file evidence in fast track oppositions. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken.

8. In an official letter dated 14 July 2023, in accordance with Tribunal Practice Notice 2/2013, the parties were allowed until 28 July 2023 to seek leave to file evidence and/or request a hearing and until 14 August 2023 to provide written submissions.

9. Both parties filed written submissions which will be referred to as and where appropriate during this decision. Neither party sought leave to file evidence or to request a hearing, therefore this decision is taken following careful consideration of the papers.

10. In these proceedings, the opponent is represented by Panoramix Limited and the applicant is represented by Beck Greener LLP.[2]

DECISION

11. 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.

[2] TM33 appointing Beck Greener LLP as representatives to the applicant, replacing previous representatives Lane IP Limited, was received on 31 July 2023.

My approach

12. On its form TM7F, the opponent submits that the dominant portion of both the ‘904 mark and the ‘915 mark is the word “WOW”, with the subsequent words “ENERGY” and “HYDRATE”, respectively, being of lesser significance. Given the non-distinctive nature of the words ENERGY and HYDRATE in relation to the goods at issue, all being liquid drinks, and the fact that neither word is present in the applicant’s mark, in my view, it is the ‘928 mark “WOW” which represents the opponent’s best case. While I note that in its written submissions, the opponent only makes a comparison between its ‘904 mark “WOW ENERGY” and the applicant’s mark, it has not said that it no longer wishes to rely on the other two marks. I also note that the class 32 specifications relied upon are identical for all three earlier marks.

13. I do not consider that assessing either the opponent’s ‘904 mark or its ‘915 mark would improve the opponent’s position. I will therefore proceed by making my comparisons in relation to the earlier ‘928 mark only, which from this point forward I will refer to as “the opponent’s mark”. I will return to consider the position in respect of the remaining earlier marks should I consider it necessary to do so.

Section 5(2)(b)

14. Section 5(2)(b) is relied on and reads as follows:

> “5(2) A trade mark shall not be registered if because -
>
> (a) …
>
> (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,
>
> there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

15. 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."

16. 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 Office for Harmonisation in the Internal Market (Trade Marks and Designs) ("OHIM")*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other

components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a greater 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 to mind the earlier mark, 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

17. Pursuant to section 60A of the Act, goods and services are not to be automatically regarded as being similar to each other on the ground that they appear in the same class, nor automatically regarded as dissimilar from each other on the ground that they appear in different classes.

18. The opposed goods are "*Beer*" in class 32 and "*Wine; Alcoholic beverages, except beer; Liquor"* in class 33.

19. The opponent is relying on the following goods in class 32:

Water; mineral water; aerated water; non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages; vitamin-enriched water and water based drinks; protein enriched water and water based drinks; beverages containing proteins; beverages containing vitamins; isotonic water; isotonic drinks; sports drinks; sports drinks containing electrolytes; sports drinks containing vitamins; sports drinks containing proteins; isotonic sports drinks; whey beverages; energy drinks; protein and vitamin enriched water and water based drinks; protein enriched sports beverages.

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

> "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".[3]

21. In *Canon*, Case C-39/97, the Court of Justice of the European Union ("CJEU") stated that:

> "In assessing the similarity of the goods or services concerned, … all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended

[3] Paragraph 29

purpose and their method of use and whether they are in competition with each other or are complementary".[4]

22. Additionally, the factors for assessing similarity between goods and services identified in *British Sugar Plc v James Robertson & Sons Limited* ("*Treat*") [1996] R.P.C. 281 include an assessment of users and the channels of trade of the respective goods or services.

23. 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 OHIM*, Case T-325/06, the 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".[5]

24. While making my comparison, I bear in mind the comments of Floyd J. (as he then was) in *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch):

> "… Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise. … Nevertheless the principle should not be taken too far. ... Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."[6]

25. In its written submissions, the applicant submits that wine, liquor and other alcoholic drinks in class 33 are not generally consumed for the purpose of quenching thirst, as submitted by the opponent, but "to be sipped and savoured ..., as well as for

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[4] Paragraph 23
[5] Paragraph 82.
[6] Paragraph 12.

the relaxing and mildly intoxicating effect of the alcohol that such drinks contain".[7] It makes similar submissions in regard to beer, and although it accepts that there are low and alcohol-free beers, it submits that "these are not common". I also note the applicant's various references to earlier decisions issued by the Tribunal, as well as the judgement of the GC in *Wesergold Getrankeindustrie GmbH & bCo KG v EUIPO*, case T-278/10, where the GC held that 'spirits, particularly whisky' was not similar to non-alcoholic beverages.[8] However, whilst I have considered the impact of these decisions, I am not bound by the findings, and I draw my own conclusions as rationalised below.

The contested goods in class 32

26. The applicant's goods in class 32 are "*beer*". The opponent's class 32 specification includes the broad term "*non-alcoholic drinks".* As such, the opponent's wider term could feasibly include non-alcoholic beers, rendering the goods identical as per the principles outlined in *Meric*. In case I am wrong in this finding, I will consider, in the alternative, the similarity between the goods. I disagree with the applicant that non-alcoholic versions of beer are uncommon. In my view, the goods at issue overlap in intended purpose in as much that the purpose of both is as a liquid refreshment. The goods share the same method of use, i.e. oral consumption, and they share the same channels of trade where they are likely to be positioned in close proximity, although not necessarily side by side. Although I do not consider them to be complementary, the respective goods may be targeted towards the same end user. There is an element of competition between the goods, with the consumer making an informed choice between alcoholic beer or an alternative alcohol-free beer. I do not consider it unreasonable that the average consumer would expect the same or economically linked undertakings to produce beers that are both non-alcoholic as well as beers that contain alcoholic content. Taking all of the above into account, I consider the applicant's "*beer"* to be similar to at least a medium degree to the opponent's "*non-alcoholic drinks".*

[7] Points 6 of the applicant's written submissions dated 14 August 2023.
[8] Points 8 -9.

<u>The contested goods in class 33</u>

Wine.

27. The opponent's "*non-alcoholic drinks"* in class 32 could include non-alcoholic wines. While the competing goods are in different classes, for the same (alternative) reasons given above in relation to beer and non-alcoholic drinks, I consider the applicant's "*wine"* in class 33 to be similar to the opponent's "*non-alcoholic drinks"* in class 32 to at least a medium degree.

Alcoholic beverages, except beer.

28. The applicant's broad term "*Alcoholic beverages, except beer"* could include wine, and so again, as previously considered, I find it to be similar to at least a medium degree to the opponent's "*non-alcoholic drinks"* in class 32.

Liquor.

29. I consider that the average UK consumer would interpret the term "liquor" as being alcoholic drinks such as whisky, vodka, gin or other strong spirits. I note that the *Wesergold* judgement referenced by the applicant was issued in 2010, and since that time, in my view, there has been a marked increase in the availability of non-alcoholic spirits, as well as beers and wines. I am aware of several producers who now offer 0% alcohol alternatives to spirits, particularly in the field of gin and vodka. I agree with the applicant's submissions that, for the reasons given in *Wesergold*, some non-alcoholic beverages, such as the opponent's various types of water, juices and energy drinks, are not in competition with "liquor" and are likely to be positioned in a different area in supermarkets, and are not complementary within the meaning of the case law. However, the opponent's broad term "*non-alcoholic drinks"* in class 32 could include alcohol-free liquor such as gin and vodka, and I consider that these would be situated in close proximity to the alcoholic versions of those goods in retail outlets. I again consider there to be an element of competition between such goods, and it would not be unreasonable for the average consumer to expect undertakings to offer both alcoholic and non-alcoholic versions of those goods. In view of the overlap in trade channels, as well as the shared purpose and method of use, I consider "*Liquor"* to be similar to the opponent's "*non-alcoholic drinks"* in class 32 to at least a medium degree.

The average consumer and the nature of the purchasing act

30. The average consumer is a legal construct, deemed to be reasonably well informed and reasonably circumspect: see *Hearst Holdings Inc & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), paragraph 60. 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, at [26].

31. The goods at issue are both alcoholic and non-alcoholic beverages. Insofar as the alcoholic drinks are concerned, the average consumer will be the adult (over 18) member of the general public, and will include connoisseurs alongside ‘pleasure drinkers’ whose knowledge will be more rudimentary, both of whom may purchase the goods for consumption at home or in a social setting such as a bar or restaurant.

32. The goods are sold through a range of channels including wholesale outlets and retail outlets such as supermarkets and off-licences, as well as through specialist suppliers and online. In bricks and mortar stores, the goods will be sold on shelves where they will be viewed and self-selected by the consumer. A similar process will apply to websites, where the consumer will select the goods having viewed an image displayed on a webpage. The goods will also be sold in restaurants, bars and public houses, where they are likely to be displayed behind the counter or listed on a drinks menu. Considered overall, the selection process is predominantly visual, although I do not discount aural considerations, particularly in bars and restaurants, where the goods may also be selected and requested verbally. I bear in mind the comments of the GC in *Simonds Farsons Cisk plc v OHIM*, Case T-3/04, who said:

> "58. In that respect, as OHIM quite rightly observes, it must be noted that, even if bars and restaurants are not negligible distribution channels for the applicant’s goods, the bottles are generally displayed on shelves behind the counter in such a way that consumers are also able to inspect them visually. That is why, even if it is possible that the goods in question may also be sold by ordering them orally, that method cannot be regarded as their usual marketing channel.

In addition, even though consumers can order a beverage without having examined those shelves in advance they are, in any event, in a position to make a visual inspection of the bottle which is served to them."

33. The value of the goods in common, which are not considered to be an everyday purchase, but are likely to be purchased on a semi-regular basis by the general public, will vary in price, and will include expensive vintage wines which may give rise to an elevated degree of attention being paid, but are generally considered to be relatively inexpensive. In my view, neither alcoholic drinks nor their non-alcoholic counterparts are highly considered purchases. Overall, I consider that the average consumer will pay a medium level of attention during the selection process, basing their selection on the type of beverage and personal taste, as well as the cost of the product and the occasion for which it is being purchased.

Comparison of marks

34. 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 in *Bimbo SA v OHIM* Case C-591/12P, 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."[9]

35. The respective trade marks are shown below:

[9] Paragraph 34

Opponent’s trade mark	Applicant’s trade mark
WOW	world of women

36. In view of the aforementioned case law, although it would be wrong to artificially dissect the trade marks, it is necessary for me 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.

37. The opponent submits that the average consumer’s attention would be drawn to the large, dominant representation of the word WOW in the applicant’s mark and that little, if any weight would be placed on the words “world of women”.[10] The applicant submits that it is the words “WORLD OF WOMEN” which attracts the eye and dominates the mark, which arises from the low distinctive character of the word “WOW” and the high degree of stylisation in the applicant’s mark.[11]

Overall impression

38. The opponent’s mark consists of the word “WOW”, presented in capital letters in a standard typeface, without any other elements to contribute to the overall impression. The overall impression conveyed by the mark therefore lies in the word itself.

39. The applicant’s mark consists of the words “world of women”, with the letter “w” of the first and third words presented in a stylised white typeface, with the remaining

[10] See paragraph 2 of the opponent’s written submissions filed on 14 August 2023.
[11] Paragraph 17 of the applicant’s written submissions dated 14 August 2023.

letters presented in a standard white typeface. The words are positioned centrally across the letters “W O W”. The “WOW” element is presented in large, stylised block letters, which are each infilled in a different colour, being purple, red and blue, respectively. I accept the opponent’s submissions that the words “world of women” are set in a much smaller white ‘language’ (font). To my mind, it is the words “world of women” in the white typeface which stand out from the larger coloured letters and it is the words, not the letters, to which the eye is drawn. While the “WOW” element would not go unnoticed, given that it also represents the first letters of the words “world of women”, in my view, a significant proportion of consumers would perceive the “WOW” element as an acronym of the three word combination. This is reinforced by the stylisation of the letter “w” in the words “world” and “women” which is similarly presented in the acronym. Considered overall, it is the words “world of women” which make the greatest contribution to the overall impression of the mark, with the stylised “WOW” element making a lesser, but still significant, contribution.

Visual comparison

40. The opponent’s mark consists of the word “WOW”, while the applicant’s mark comprises the words “world of women” in conjunction with the “WOW” element, as previously described. Although the “WOW” element cannot be ignored, considering the competing marks as a whole, I find there to be a low degree of visual similarity between them.

Aural comparison

41. The opponent’s mark would be pronounced in its entirety as one syllable “WOW”. I consider it unlikely that a significant proportion of consumers would articulate the “WOW” element of the applicant’s mark, instead voicing it as four syllables, WORLD-OF-WHIM-IN”. To those consumers, the marks are aurally dissimilar.

42. In cases where the consumer also voices the “WOW” element of the applicant’s mark, it would be articulated as a whole as five syllables, and could be voiced as either “WOW-WORLD-OF-WHIM-IN”, or alternately, “WORLD-OF-WHIM-IN-WOW”. In *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, the GC noted that the

beginning of words tend to have more visual and aural impact than the ends, although I acknowledge that this is not always the case. Meanwhile, in *dm-drogerie markt GmbH & Co. KG v OHIM,* Case T-304/10, the GC noted that in the case of word signs which are relatively short, the differences between marks of different lengths will be more easily grasped by the average consumer.[12] In the case before me, given the brevity of the opponent's mark compared to the much longer applicant's mark, in whichever position the "WOW" element of the applicant's is pronounced, I consider it to be aurally similar to the opponent's mark to a low degree.

Conceptual comparison

43. For a conceptual message to be relevant, it must be capable of immediate grasp by the average consumer - Case C-361/04 P *Ruiz-Picasso and others v OHIM* [2006][13].

44. The word "WOW" is an ordinary, dictionary defined word which would be recognised by the average consumer as an exclamation expressing surprise or admiration. This would be the message conveyed by the opponent's earlier mark. As mentioned earlier in this decision, I consider that a significant proportion of consumers would see the "WOW" element of the applicant's mark as merely being an acronym for the dominant element "world of women". In *Whyte and Mackay Ltd v Origin Wine UK Ltd*[14] Arnold J. (as he was then) considered the impact of the CJEU's judgment in *Bimbo,* Case C-591/12P, on the court's earlier judgment in *Medion v Thomson* in relation to components of composite marks which play an independent, distinctive role. However, given the overall presentation of the mark, I consider it unlikely that consumers would perceive the "WOW" element as being either distinctive or independent from the words "world of women", the three letter combination purely representing the initials of those words. As such, I find the marks before me conceptually dissimilar.

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[12] At [42].
[13] Paragraph 56.
[14] *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch).

Distinctive character of the earlier marks

45. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. The factors I must take into account in assessing the level of distinctive character were set out by the CJEU in *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97:

> "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)."

46. Registered trade marks possess varying degrees of inherent distinctive character, being lower where they are allusive or suggestive of a characteristic of the goods and/or services, ranging up to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it. The opponent has not claimed that its mark has enhanced distinctiveness and no evidence has been filed. Therefore, I only have the inherent characteristics of the mark to consider.

47. The applicant submits that the opponent's mark has a "vanishingly small" degree of distinctive character, if any at all. It has expressed surprise that the earlier mark was not refused registration under section 3 of the Act "as being a descriptive, laudatory and wholly descriptive sign for the goods in question".[15] However, as

[15] See point 15 of the applicant's written submissions.

accepted by the applicant, as it is a registered trade mark, it must be regarded as having at least a minimum level of distinctive character: *Formula One Licensing BV v OHIM,* Case C-196/11P.[16]

48. The earlier mark consists of the dictionary defined word "WOW", which I consider consumers would perceive as alluding to the impressive nature of the goods. While the mark does not describe the goods at hand, given the laudatory quality of the word "WOW", I consider it to be at the lower end of the range of distinctive character, although not of the very lowest degree.

Likelihood of confusion

49. There is no simple formula for determining whether there is a likelihood of confusion. It is clear that I must make a global assessment of the competing factors (*Sabel* at [22]), keeping in mind the interdependency between them i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa (*Canon* at [17]). I must consider the various factors from the perspective of the average consumer, bearing in mind 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 he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

50. There are two types of possible confusion: direct, where the average consumer mistakes one mark for the other, or indirect, where the average consumer recognises that the marks are different, but assumes that the goods and/or services are the responsibility of the same or connected undertakings. The distinction between these was explained by Mr Iain Purvis Q.C. (as he then was), sitting as the Appointed Person, in *L.A. Sugar Limited v Back Beat Inc*, Case BL-O/375/10. He said:

> "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

[16] At [41-44].

– 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)."

51. The above are examples only which are intended to be illustrative of the general approach. These examples are not exhaustive but provide helpful focus.

52. Earlier in this decision, I found the competing goods to be either identical or in the alternative, similar to at least a medium degree, with the average consumer paying a medium level of attention during the selection of those goods, which would be selected by predominantly visual means, although I did not discount aural considerations. I

found the competing trade marks to be visually similar to a low degree and aurally dissimilar, although in the alternative I found them aurally similar to a low degree where the “WOW” element of the applicant’s mark was also voiced. I considered that to a significant proportion of consumers, the “WOW” component of the applicant’s mark would not play an independent, distinctive role within the mark, and as such, I found the competing marks to be conceptually dissimilar. I considered the earlier mark to be at the lower end of the spectrum of inherent distinctive character, but not of the very lowest degree.

53. I bear in mind the decision of the CJEU in *L’Oréal SA v OHIM*, Case C-235/05 P, in which the court confirmed that weak distinctive character of the earlier trade mark does not automatically preclude a likelihood of confusion.

54. While allowing that the average consumer is unlikely to see the marks side-by-side and will therefore be reliant on the imperfect picture of them they have kept in their mind, I consider it unlikely that they would mistake one mark for the other. In my view, the average consumer will notice and recall the visual, aural and conceptual differences between the marks. I do not consider there is any likelihood of direct confusion as the differences between the marks are too great for confusion to arise.

55. Taking into account the previously outlined guidance of Mr Iain Purvis Q.C. (as he then was), in *L.A. Sugar*, I will now consider whether there might be a likelihood of indirect confusion. In *Duebros Limited v Heirler Cenovis GmbH,* BL O/547/17, Mr James Mellor Q.C. (as he then was), as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

56. In *Liverpool Gin Distillery Ltd and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207, Lord Justice Arnold referred to the comments of James Mellor QC (as he then was) sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said (at [16]) that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion".

Lord Justice Arnold added that there must be "a proper basis" for concluding that there is a likelihood of indirect confusion when there is no likelihood of direct confusion.

57. I acknowledge that the categories listed by Mr Iain Purvis Q.C. (as he then was) are not exhaustive. I have made a multi-factorial assessment of the various considerations in play, however, I do not see anything which would lead the average consumer into believing that one mark is a sub-brand or brand extension of the other, or assume that there is an economic connection between the undertakings. Even where the consumer recognises that the initials of the "world of women" form the acronym "WOW" in the applicant's mark, which brings to mind the opponent's mark, given the laudatory connotations and the low degree of inherent distinctive character of the earlier mark, the average consumer is likely to put it down to coincidence and would not assume that no-one other than the brand owner would be using it in a trade mark. I therefore find no likelihood of indirect confusion.

58. The opposition fails under section 5(2)(b) of the Act.[17]

CONCLUSION

59. The applicant has been successful. Subject to any successful appeal, the application by WOW STUDIO LIMITED may proceed to registration.

COSTS

60. The applicant has been successful, and is therefore entitled to a contribution towards its costs. Awards of costs in fast track opposition proceedings are governed by Tribunal Practice Notice ("TPN") 2/2015. Applying the guidance in that TPN, I award the applicant the sum of £500, which is calculated as follows:

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[17] Earlier in the decision, I said that I would return to consider the position in respect of the remaining earlier marks should I consider it necessary to do so. In view of my findings in relation to the '928 mark, given the descriptive/non-distinctive nature of the additional elements in relation to the '904 mark and the '915 mark, I do not consider that either mark would have represented a stronger case for the opponent. I therefore consider that the final outcome in relation to a likelihood of confusion against the applicant's mark would not have been any different to my findings in relation to the '928 mark.

Considering a notice of opposition and preparing a counterstatement:	£200
Preparing written submissions:	£300
Total:	**£500**

61. I therefore order WOW Hydrate Limited to pay WOW STUDIO LIMITED the sum of £500. 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 21st day of February 2024

Suzanne Hitchings
For the Registrar,
the Comptroller-General