

**O/0136/25**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3867688  
BY TUTU INTERNATIONAL CO., LIMITED**

**IN RESPECT OF THE TRADE MARK:**

***TuTu***

**IN CLASS 9**

**AND**

**IN THE MATTER OF THE OPPOSITION THERETO  
UNDER NO. 441810  
BY TUTUS DATA AB**

## BACKGROUND AND PLEADINGS

1. On 13 January 2023, TUTU INTERNATIONAL CO., LIMITED (“the applicant”) applied to register the trade mark shown on the cover page of this decision (“the contested mark”) in the UK. The application was published for opposition purposes on 7 April 2023, and registration is sought for goods in Class 9.<sup>1</sup>

2. On 7 July 2023, the application was opposed by Tutus Data AB (“the opponent”) based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against all the goods in the application. The opponent relies upon two earlier comparable United Kingdom Trade Marks (“UKTM”)<sup>2</sup> for its opposition:

i) UKTM 913810346 (“the First Earlier Mark”)

TUTUS

Filing date: 10 March 2015

Registration date: 2 July 2015

Registered in Classes 9, 38 and 42

For the purpose of these proceedings the opponent relies on all the goods and services in Classes 9 and 42.<sup>3</sup>

ii) UKTM 917880854 (“the Second Earlier Mark”)



Filing date: 27 March 2018

Registration date: 14 July 2018

Registered in Classes 9, 38 and 42

For the purpose of these proceedings the opponent relies on all the goods and services in Classes 9 and 42.<sup>4</sup>

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<sup>1</sup> See goods and services comparison.

<sup>2</sup> Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing registered EUTM or International Registration designating the EU. As a result, the opponent’s mark was converted into a comparable UK trade mark. Comparable UK marks are now recorded in the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and the original filing dates remain the same. See also Tribunal Practice Notice (“TPN”) 2/2020 End of Transition Period – impact on tribunal proceedings.

<sup>3</sup> See ‘Annex’ at the end of this decision.

<sup>4</sup> See goods and services comparison.

3. The opponent claims that the marks are highly similar and that the goods and services covered by the marks are either identical or highly similar, resulting in a likelihood of confusion on the part of the public, which includes a likelihood of association.

4. The applicant filed a counterstatement denying the grounds of opposition and putting the opponent to proof of use in respect of the First Earlier Mark.

5. The trade marks upon which the opponent relies qualify as earlier trade marks under section 6 of the Act by virtue of their earlier filing dates. However, only the First Earlier Mark had completed its registration process more than 5 years before the filing date of the contested application and is therefore subject to the proof of use conditions, as per section 6A of the Act. As the Second Earlier Mark had not completed its registration process more than 5 years before the application date of the mark in issue, it is not subject to proof of use pursuant to Section 6A of the Act. The opponent can therefore rely upon all the goods and services identified in respect of its second mark.

6. The applicant is represented by Trademarkit LLP; the opponent is represented by Haseltine Lake Kempner LLP. Only the opponent filed evidence. No hearing was requested and only the opponent chose to file written submissions in lieu of a hearing. This decision is taken following a careful review of the papers.

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.

## **EVIDENCE**

8. The opponent filed evidence in the form of the witness statement of Jen Bohlin, dated 31 January 2023, which is accompanied by 7 exhibits (JB1 – JB7). Jen Bohlin is the Chief Executive Officer at the opponent's company. The evidence has been

adduced to prove the use that has been made of the First Earlier Mark. I shall refer to the evidence to the extent that I consider necessary.

## **PRELIMINARY ISSUES**

9. The applicant has raised points in its counterstatement which I intend to address before going any further into the merits of this opposition. This is because, it is necessary to explain why, as a matter of law, these points will have no bearing on the outcome of this opposition.

- Goods comparison and the target market

10. In its counterstatement, the applicant states the following:

“[...] it is submitted that the Opponent is only involved in IT security and data encryption services provided mostly in Sweden, and that the Opponent has no genuine intention to use the mark in the UK.”

11. Differences between the goods and services currently provided by the parties, such as particular characteristics of the goods and services, are irrelevant, except to the extent that those differences are apparent from each party's specification. Furthermore, since the opponent's Second Earlier Mark is not subject to proof of use, it is entitled to protection in the UK in relation to all the goods and services for which it is registered. It is the goods and services relied upon by the opponent and the goods applied for by the applicant that I will be comparing later in this decision. The assessment I must make between the goods and services is a notional and objective assessment, rather than a subjective one.

12. Furthermore, marketing strategies, including the targeting of specific consumers, are temporary and may change over time.<sup>5</sup> As such, it is not appropriate to take that factor into account in my assessment. However, I will make an assessment, later in

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<sup>5</sup> *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P

this decision, as to who the average consumer could be for the goods and services at issue.

## **MY APPROACH**

13. The opponent relies on two earlier marks, however only one (i.e. the First Earlier Mark), is subject to proof of use. Both earlier marks are registered in respect of the same goods and services, and the same goods and services are relied upon by the opponent. The First Earlier Mark is a word-only mark consisting of the word 'TUTUS', whilst the Second Earlier Mark is a composite mark comprising the word 'TUTUS' and a figurative element.

14. Further to the above, I will conduct my assessment on the basis of the Second Earlier Mark (not subject to proof of use) in the first instance, returning to the First Earlier Mark (subject to proof of use) only if it is necessary to do so. For ease of reference, going forward, I will refer to the opponent's Second Earlier Mark as, simply, "the opponent's mark".

## **DECISION**

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

15. Section 5(2)(b) of the Act is as follows:

"(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."

16. I am guided by the following principles, gleaned from the decisions of the Court of Justice of the European Union (“CJEU”) 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 BV* (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-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):

(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 and services**

17. Where the goods or services in the specification of one party are included in a broader term from the other party's specification, those goods or services are considered to be identical: See *Gérard Meric v OHIM*, Case T-133/05 at [29].

18. In *Canon*, Case C-39/97, the CJEU stated that:

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

purpose and their method of use and whether they are in competition with each other or are complementary”.

19. 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 the users and the channels of trade of the respective goods or services.

20. 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 General Court (“GC”) stated that “complementary” means:

“82. ...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”.

21. For the purposes of considering the issue of similarity of goods or 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 *Separode Trade Mark* (BL O/399/10), Mr Geoffrey Hobbs QC (as he then was), sitting as the Appointed Person, and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

22. The goods and services to be compared are shown in the following table:

The opponent’s goods and services	The applicant’s goods
Class 9 Data processing equipment and computers; computer peripherals; computer programs (downloadable software); recorded	Class 9 Computers; notebook computers; computer monitors; interactive touch screen terminals; tablet computers; television

<p>computer programs; stored computer programs; computer games (software); computer systems; electronic publications, namely, electronically readable technical and user manuals for computer systems.</p> <p>Class 42 Design and development of computer hardware and computer software; computer programming; maintenance and updating of computer software; computer system analysis, namely, monitoring the computer systems of others for technical purposes and providing back-up computer software and facilities; rental of computer hardware and software; providing on-line non-downloadable software; security services relating to computerised data.</p>	<p>apparatus; electronic advertising displays; video screens; mobile power supply [rechargeable batteries]; cabinets for loudspeakers; portable outdoor power supplies.</p>
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Computers; notebook computers; tablet computers

23. The above contested goods have direct equivalents in the opponent's specification (*computers*) and are therefore identical in line with the principle set out in *Meric*.

Computer monitors

24. The above goods are a type of *computer peripheral* which when connected to a computer, will display signals sent by the computer in a visual format, enabling users to interact with the computer. The opponent's earlier mark includes *computer*

*peripherals* in Class 9. Therefore, the goods are considered identical in line with the principle set out in *Meric*.

#### Interactive touch screen terminals

25. Generally speaking, an interactive touch screen terminal is essentially a type of specialised computer that allows users to enter and access information or complete transactions without assistance, for example. Accordingly, I find there to be a clear overlap between the above goods and the opponent's *computers* in Class 9. Therefore, I find that they are identical in line with the principle set out in *Meric*. However, if I am wrong in my analysis, then I find that the respective goods are similar to a high degree, on the basis that the goods are likely to share a similar purpose and can coincide in producers, channels of trade and end users.

#### Television apparatus

26. In general, the term *television apparatus* is not only used to describe a television set, but also the accessories forming part of the set, and the antennas, both external and internal, etc. Nowadays, most television sets (TV's), such as smart TV's, contain software, which enable them to be connected to the internet, to operate and to carry out software updates, etc. Consequently, I find that there is a degree of similarity between the above contested goods and the opponent's *computer programs (downloadable software)*, *recorded computer programs* and *stored computer programs*. Whilst I bear in mind that components of goods, such as software are not necessarily similar to the contested goods themselves,<sup>6</sup> I find there to be complementarity between them, since the opponent's goods are likely to be essential to the function of the contested goods. Such a relationship will lead consumers to believing that the goods are provided by the same undertaking. Furthermore, the goods can coincide in producers and end users. However, I acknowledge that the method of use and nature of the goods at issue are different. Overall, I find the goods are similar to a medium degree.

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<sup>6</sup> *Les Éditions Albert René v OHIM*, Case T-336/03 [paragraph 61]

### Electronic advertising displays

27. As with *television apparatus* the contested *electronic advertising displays* will likely contain software in order to operate, for example, to program the advertising displays to change, throughout a specific period, etc. As such, I find that software will likely play an important role in the function of the contested goods. Consequently, I find that there is a degree of similarity between the contested goods and the opponent's *computer programs (downloadable software)*, *recorded computer programs* and *stored computer programs*, since the opponent's goods are likely to play a key role in the function of the contested goods to the point that consumers will believe that the goods are the responsibility of the same undertaking. I therefore find them to be complementary. Whilst I acknowledge that the method of use and nature of the goods at issue differ, the goods can coincide in producers and end users. Accordingly, I find that the competing goods are similar to a medium degree.

### Video screens

28. Broadly speaking, a *video screen* is the part of a terminal or monitor upon which information is displayed, such as a computer monitor. The opponent's earlier mark includes *computer peripherals* being output devices which when connected to a computer, for example, will display signals sent by the computer in a visual format. Therefore, I find that the goods at issue are identical in line with the principle set out in *Meric*. However, if I am wrong in my analysis, then I find that the respective goods are similar to at least a medium degree, on the basis that the goods are likely to share a similar purpose and can coincide in producers, channels of trade and end users.

### Mobile power supply [rechargeable batteries]; portable outdoor power supplies

29. In general, a mobile/portable power supply is a temporary power supply that provides power support to various devices, such as computers and laptops, etc. Mobile and portable outdoor power supplies tend to be compact, lightweight devices designed to provide power for charging and operating electronic devices, when, for example, the user is on the move. I find that there is a degree of similarity between the contested goods and the opponent's *computers*, contained in Class 9 of the

opponent's earlier mark. The goods at issue may share the same user and may also overlap in trade channels, as they may be available via the same retailers, and they may be produced by the same undertakings. Therefore, I find that the competing goods are similar to a low degree.

### Cabinets for loudspeakers

30. A loudspeaker cabinet is an enclosure, generally box-shaped, in which a loudspeaker (often shortened to speaker), and associated electronic hardware are mounted. The main purpose of a speaker cabinet is to provide a controlled acoustical enclosure for the speaker to operate efficiently, and to provide a physical structure to hold the speaker in place, for example, whilst positioning them optimally for the listener. Speakers are output devices that can, for example, be connected to the outside of a computer, either physically or wirelessly, in order to produce sound. The opponent's goods in Class 9 contain *computer peripherals* which is a broad term describing devices that connect to a computer. Such peripherals include monitors, webcams and speakers, etc. Accordingly, I find that the contested goods and the opponent's *computer peripherals*, which include speakers, are similar to a degree, on the basis that they share a complementary relationship in that a speaker is important and/or indispensable for a speaker/loudspeaker cabinet, and therefore it is likely that the average consumer will believe that one undertaking is responsible for both. Furthermore, there is also likely to be an overlap in users, producers and trade channels. As such, I find that the competing goods are similar to a low degree.

### **The average consumer and the nature of the purchasing act**

31. 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).

32. 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.”

33. The average consumer of the goods at issue is likely to include members of the general public as well as business and professional users. The goods will mainly be available via retailers, being both general retailers and more specialist ones, and their online or catalogue equivalents. At the retailers’ physical premises, the goods will be displayed on shelves and in cabinets, being self-selected by the consumer. A similar process will apply when the goods are selected online or via catalogues, in that a consumer will select them after seeing an image, on, for example, a webpage or in a catalogue. In my view, while the visual component will play a significant role in the selection process of the goods, I do not discount an aural component playing a part as the selection process may involve some discussion with sales persons. Given the goods at issue, the price and frequency of purchase will vary depending on their nature and type. In this regard, when selecting the goods at issue, the average consumer is likely to pay at least a medium degree of attention.



### **Comparison of the marks**

34. It is clear from *Sabel BV v. Puma AG* that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo SA v OHIM*, that:

“34. [...] it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

35. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the trade marks.

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

The opponent's mark	The applicant's mark
	

37. With regard to the similarity of the marks, in its counterstatement the applicant submits:

“The contested mark consists of two separate verbal elements “Tu” and “Tu” conjoined, and this is made clear by virtue of the repeated upper-case letter “T”. The contested mark appears in stylized script and would be likely to be pronounced “too-too”. Conceptually, the contested mark represents a common term referring to a ballet costume. The Opponent’s earlier marks consist of (i) the word mark TUTU [sic] in standard upper-case letters, and (ii) a figurative mark consisting of a blue square device above the word TUTUS in bold upper-case letters. The additional letter “S” at the end of TUTUS serves to distinguish

this word from the word TuTu. The additional letter “S” creates a different overall impression both visually and aurally.”

38. In its written submissions in lieu,<sup>7</sup> the opponent submits the following:

“The Opponent submits that the Applicant’s Mark “TUTU” is clearly and obviously highly similar to the Opponent’s earlier marks “TUTUS” (together, the Earlier Marks). The Applicant’s mark is wholly subsumed within the Opponent’s Earlier Marks, and it is only the addition of the final letter “S” as an indication of the plural form, in the marks the subject of the Opponent’s Earlier Registrations which differentiates them. The respective marks have a nearly identical visual, aural and conceptual impression from the perspective of the relevant consumers, who are at minimum reasonably observant and circumspect and, in the case of the Goods at issue in the Opposition, are likely to pay only an average level of attention in selecting them.”

#### Overall impression

39. The applicant’s mark comprises of the word ‘TuTu’ depicted in a fairly standard black upper and lowercase slanted typeface. The overall impression resides in this single element as the way the word is presented makes a relatively minor contribution to the overall impression of the mark. Accordingly, I find that the mark is dominated by the word itself, while the stylisation plays a secondary role.

40. The opponent’s mark consists of the word ‘TUTUS’ presented in a standard black uppercase typeface. Positioned above this word is a figurative device element, featuring a thick white squiggly line placed upon a blue square background. The white line is placed centrally on the square, running from the top to the bottom. As a whole, the device gives the illusion of two blue shapes capable of interlocking.

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<sup>7</sup> Dated 21 May 2024.

### Visual comparison

41. Visually, the competing marks identically share the same letters in the same order, with the exception of the fifth letter 'S' present in the opponent's mark, which has no counterpart in the applicant's mark, i.e. 'TUTUS / TuTu'. I do not consider the distinction in letter case between the earlier mark and the contested mark to be a point of significant difference between them. The device element present in the opponent's mark is not replicated in the applicant's mark. Accordingly, weighing up the similarities with the differences, I find the competing marks to be visually similar to a medium degree.

### Aural comparison

42. The opponent's mark consists of two syllables 'TU-TUS', pronounced as 'TOO-TOOS'. The applicant's mark consists of two syllables 'Tu-Tu', pronounced as 'TOO-TOO'. The device element in the opponent's mark will not be articulated. Overall, I find that the competing marks are aurally similar to a very high degree.

### Conceptual comparison

43. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] E.C.R.-I-643; [2006] E.T.M.R 29. The assessment must, therefore, be made from the point of view of the average consumer.

44. In my view the words 'TUTUS' and 'TuTu' in the respective marks will be immediately recognisable words for the average consumer, namely, as reference to a short, layered skirt worn by female ballet dancers ('TUTU' being the singular form and 'TUTUS' being the plural form). As such, the competing marks convey the same concept. The fact that one is the singular form of the word and the other is the plural form, does not detract from that concept.

45. As for the figurative device element present in the opponent's mark, this will merely be understood as representing a particular design, but will have no clear relationship

with the word 'TUTUS', on the basis that the device does not serve to emphasise or obscure elements of the word, nor does it convey a particular distinct concept. Therefore, the device element will not convey any message to the consumer. Accordingly, I consider the marks to be conceptually identical.

### **Distinctive character of the opponent's mark**

46. The distinctive character of a trade mark can be measured only, first, by reference to the goods or services in respect of which registration is sought and, second, by reference to the way it is perceived by the relevant public. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, 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).”

47. 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.

48. Although the distinctiveness of a mark can be enhanced by virtue of the use that has been made of it, the opponent has not filed any evidence of use in relation to the Second Earlier Mark. Consequently, I have only the inherent position to consider

49. The earlier mark is a composite mark, comprising the word 'TUTUS' along with a figurative device. Whilst this word 'TUTUS' will likely be understood as a reference to a type of skirt worn by female ballet dancers ('TUTUS' being the plural form), it has no obvious connection with the goods or services for which the opponent's mark is registered. With regards to the device element, whilst it cannot be overlooked, I do not find it particularly striking, nor does it have any obvious meaning in respect of the goods and services at issue. Accordingly, as a whole, I find the mark to be inherently distinctive to a medium degree.

### **Likelihood of confusion**

50. Making an assessment of the likelihood of confusion is a matter of considering the relevant factors from the viewpoint of the average consumer of the goods at issue and determining whether they are likely to be confused. When doing this, I am required to bear in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely on the imperfect picture of them that they have in their mind. This means that the global assessment emulates what happens in the mind of the average consumer on encountering the later mark with an imperfect recollection of the earlier mark. The courts have not said what weight should be attached to each of the factors or provided a formula that can be applied to any set of circumstances. However, I am required to take account of the interdependency principle, i.e. that a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods or vice versa.

51. There are two types of confusion: direct and indirect. In *L.A. Sugar Limited v Back Beat Inc*, 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 recognised 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).”

52. In *Liverpool Gin Distillery Limited & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ commented that:

“12. This is a helpful explanation of the concept of indirect confusion, which has frequently been cited subsequently, but as Mr Purvis made clear it was not intended to be an exhaustive definition.

13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/291/16) at [16] ‘a finding of 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.”

53. Earlier in the decision I found that:

- The marks are visually similar to a medium degree, aurally similar to a very high degree and conceptually identical;
- I have found the parties’ goods to range between identical and similar to a low degree;
- The earlier mark has a medium degree of inherent distinctive character for the goods and services at issue.
- The average consumer would include members of the general public as well as business and professional users, who will source the goods by both visual and

aural means. Given the nature of the goods, I would expect the average consumer to pay at least a medium degree of attention.

54. Taking all the factors into account and bearing in mind the imperfect recollection of the average consumer, it is my view that there is a likelihood of the marks being mistaken one for the other, where the goods are identical or similar to any degree. The applicant's word 'TuTu' is near identical to the word element 'TUTUS' present in the opponent's mark, and I am of the view that the average consumer may easily not recall whether there is a device, or whether the word 'TUTUS' is in the plural, even when they are paying a higher degree of attention. Accordingly, taking all these factors into account, I find that there is a likelihood of direct confusion.

55. For completeness, if the average consumer recognises the differences between the marks, I do not consider it likely that they will assume that the marks belong to the same or economically connected undertakings. In my view, the common element ('TUTU') is not so strikingly distinctive that the average consumer would assume that no-one else, but the opponent would use it in trade, and I do not see that the differences between the marks could be considered as logical brand extensions. The average consumer would merely put the presence of the common elements in both marks down to coincidence rather than economic connection.

## **CONCLUSION**

56. As the opposition based on the Second Earlier Mark has been wholly successful, I do not need to consider the position in respect of the First Earlier Mark.

57. Accordingly, as the opposition under section 5(2)(b) succeeds in full, the applicant's mark is hereby, subject to any successful appeal of my decision, refused registration for all of the goods applied for.

## **COSTS**

58. As the opponent has succeeded, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice ("TPN") 1/2023. I

appreciate that the evidence filed by the opponent was not particularly relevant to the decision I have made. Ordinarily, this would result in either a lower costs award in respect of the evidence rounds or, in some circumstances, no costs award whatsoever. However, the decision to not assess the evidence was due to the approach that I decided to take rather than because the evidence was of no assistance. As a result, I am of the view that it is still appropriate to grant the opponent costs for the filing of its evidence.

59. In the circumstances, I award the opponent the sum of £800 as a contribution towards its costs. The sum is calculated as follows:

Official fees:	£100
Preparing a notice of opposition and considering the counterstatement:	£200
Filing evidence:	£250
Written submissions in lieu :	£250
<b>Total:</b>	<b>£800</b>

60. I therefore order TUTU INTERNATIONAL CO., LIMITED to pay Tutus Data AB the sum of £800. The above sum should 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 14<sup>th</sup> day of February 2025**

**Sam Congreve**  
**For the Registrar**

## **Annex**

### **First Earlier Mark - UK00913810346**

Class 9 Data processing equipment and computers; computer peripherals; computer programs (downloadable software); recorded computer programs; stored computer programs; computer games (software); computer systems; electronic publications, namely, electronically readable technical and user manuals for computer systems.

Class 42 Design and development of computer hardware and computer software; computer programming; maintenance and updating of computer software; computer system analysis, namely, monitoring the computer systems of others for technical purposes and providing back-up computer software and facilities; rental of computer hardware and software; providing on-line non-downloadable software; security services relating to computerised data.