BL O/0193/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003897582

IN THE NAME OF STACKD GYM WEAR LTD

TO REGISTER THE FOLLOWING TRADE MARK:

STACKD

IN CLASSES 25, 35

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. OP000442392

BY

HOLD GROUP LIMITED

Background and pleadings

1. On 5 April 2023, STACKD GYM WEAR LTD ("***the Applicant***") applied to register the trade mark shown on the cover page of this decision in the UK under number UK00003897582 ("***the Contested Mark***"). It was accepted and details of the application were published for opposition purposes in the Trade Marks Journal on 5 May 2023. Registration is sought for the following goods and services:

    Class 25: Clothing; footwear; headgear.

    Class 35: Retail services relating to clothing, footwear, and headgear; Online retail store services in relation to clothing, footwear, and headgear; Wholesale services in relation to clothing, footwear, and headgear.

2. On 7 August 2023, Hold Group Limited ("***the Opponent***") opposed the application under Section 5(2)(b) of the Trade Marks Act 1994 ("***the Act***").[1] The Opponent relies upon the following trade mark registration ("***the Earlier Mark***"):

UK Registration no. UK00003816234 (series of two marks)

Mark 1	**THE STACK**
Mark 2	**STACK**

Filing date: 3 August 2022

Date of registration: 17 March 2023

Goods and services relied upon:

Class 25: Clothing; footwear; headgear.

Class 35: Retail services in relation to the sale of clothing, clothing accessories, fashion accessories, tops, sweatshirts, T-shirts, hoodies, scarves, footwear, headgear, hats, caps, baseball caps.

[1] I note that the opposition was also originally brought on the basis of section 5(3) and 5(4)(a) of the Act. However, as no evidence was filed by the opponent, these grounds of opposition were withdrawn in accordance with Rule 20(3) of the Trade Marks Rules 2008.

3. By virtue of its earlier filing date of 3 August 2022, the registration set out above constitutes an earlier mark within the meaning of section 6 of the Act. As the Earlier Mark had not completed its registration process more than five years before the filing date of the application in issue, it is not subject to the use conditions under section 6A of the Act. The Opponent can, therefore, rely upon all of the goods and services it has identified without having to demonstrate use.

4. In its statement of grounds, the Opponent submits that the Contested Mark is substantially identical or highly similar to the Earlier Mark and that the Applicant's goods and services are identical or substantially identical to the goods and services covered by their earlier right, giving rise to a likelihood of confusion under section 5(2)(b) of the Act, including a likelihood of association, and requests an award of costs in their favour.

5. The Applicant subsequently filed a counterstatement denying the grounds of opposition and asking for the opposition to be dismissed. More specifically, the Applicant submits that the 'D' as the end of the word is obvious and is pronounced substantially differentiating the Contested mark from the Earlier Mark. The Applicant also denies the similarity between the competing goods and that there exists a likelihood of confusion including a likelihood of association.

6. The Applicant is represented by Panoramix Limited. The Opponent is represented by Murgitroyd & Company.

Relevance of EU law

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 and submissions

8. The Applicant filed evidence and the Opponent filed evidence in reply. Neither party requested a hearing, however both parties filed submissions in lieu of a hearing. The Applicant filed evidence in the form of a witness statement from

Michael Daniel Godley, a director of Stackd Gym Wear Ltd, signed and dated 19 March 2024, and Exhibits MDG01 – MDG05. The Opponent filed evidence in reply in the form of a witness statement from Neill Aidan Winch, a director of Hold Group Limited, signed and dated 15 May 2024. I will not summarise the evidence and submissions here, but I will refer to them as and where appropriate during this decision. This decision is taken following a careful perusal of the papers.

Preliminary matters

Use of the Contested Mark prior to trade mark filing

9. In his witness statement, Mr Godley submitted that the Contested Mark has been used on social media (i.e., Instagram) since 26 March 2023. I find the reason for this submission from the Applicant to be unclear. In the eventuality the Applicant intends to argue prior unregistered use of the Contested Mark, I note that the date of the Contested Mark's alleged use (26 March 2023) still falls after the Opponent's mark filing date (3 August 2022). Therefore, the Opponent's mark constitutes an earlier mark within the meaning of section 6 of the Act.

No actual confusion in the market

10. In his witness statement Mr Godley submitted that:

> "*Carrying out Google searches for 'stack', 'the stack', 'stack clothing' or 'the stack clothing' does not bring up the Company website. Carrying out a Google search for 'stackd' or 'stackd clothing' does not bring up the Opponent's webpage.*
>
> *[…] the Company has never had any instances where consumers have thought my Company was in any was related to the Opponent*".

11. I acknowledge the Applicant's comments and evidence, however, I must clarify that the absence of actual confusion will not have any bearing on whether there exists a likelihood of confusion between the Applicant's mark and the Opponent's Mark. Whilst evidence of actual confusion may be persuasive where it exists, the absence of confusion in the marketplace is rarely significant.[2] This is because the absence of confusion may be attributable to the Earlier Mark having only been used to a

[2] *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283.

limited extent, in relation to only some of the goods or services for which it is registered, or in such a way that there has been no possibility of the one being mistaken for the other.[3] The provisions of the Act are not merely a reflection of what may be happening in the market. Even where there is no confusion in practice, it remains possible for there to be a finding of a likelihood of confusion.[4]

Parties operate in different market sectors

12. Mr Godley also submitted that "*the Opponent appears to provide leisure and social community hubs in the UK […]*" and that "*the Company and Opponent do not provide the same goods and services*". It appears to me the Applicant intends to bring forward the argument that the competing goods and services are dissimilar as the parties operate in different market sectors. I am reminded of the findings of Dr. Brian Whitehead in *City Storage Systems LLC v Kenmark Kitchen Limited,*[5] where, sitting as the Appointed Person, he stated (my emphasis):

> "18. The authors of Kerly state at 11-055: "It is the goods or services covered by the specifications of the marks at issue that must be considered when making this assessment, and not the goods or services actually marketed under those marks", referring to *Present-Service Ullrich GmbH & Co KG v OHIM* (T-66/11) [2013] E.T.M.R. 29. In that case, the General Court said at 45:
>
> > "Secondly, the applicant's claim that it operates in a completely different commercial sector from the intervener is also irrelevant. In order to assess the similarity of the goods or services at issue for the purposes of art.8(1)(b) of Regulation 207/2009, the group of goods or services protected by the marks at issue must be taken into account, and not the goods or services actually marketed under those marks".

13. It follows that in my assessment I must look at the similarity of the goods and services solely on the basis of those registered and it is impermissible for me to take into account the goods and services actually provided by the parties. I, thus, disregard this submission by the Applicant.

[3] *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220.
[4] *Compass Publishing BV v Compass Logistics Ltd* ([2004] RPC 41).
[5] Decision BL O/0065/24.

No proof of genuine use required

14. I notice that Mr Godley submitted, in his witness statement, that he is "*not aware of the existence of any use of the Earlier Mark on clothing, footwear, and headgear, or in relation to retail, online retail or wholesale services for clothing, footwear, and headgear, against which a direct comparison may be made*". Mr Godley provided printouts of the Opponent's website to show that the Opponent does not provide the goods and services in object.[6] Whilst I acknowledge the Applicant's submission, I note that, as stated above in this decision, the Earlier Mark has not been registered for more than five years, therefore the Opponent is entitled to rely upon all of the goods and services identified for the purposes of this opposition without provide evidence of genuine use.

State of the Register argument

15. Mr Godley provided, in his witness statement, an extract from the UK IPO register containing a list of registered third-party 'STACK' marks or marks containing 'STACK'.[7] The Applicant did not submit any evidence that such trade marks have genuinely been used. Whilst I acknowledge these comments, I find that the existence of some registered third-party marks consisting of or containing the word "STACK" does not provide much assistance in relation to the assessment of similarity between the marks at hand. In accordance with the comments of the General Court ("GC") in *Zero Industry Srl v OHIM*,[8] the presence on the UK register of marks containing the same or shared elements is not evidence of how many of such trade marks are in fact used in the market, nor does it clarify whether consumers have or have not been confused by the presence of such marks. The decision I am required to make is based on a notional assessment of the likelihood of confusion; whether there has already been confusion in the marketplace or not is irrelevant to my assessment.

Approach

16. The Opponent's Earlier Mark consists of a series of two marks (as set out above in this decision). Earlier Mark 2 represents the Opponent's strongest case. For the

[6] Exhibit MDG04.
[7] Exhibit MDG05.
[8] Case T-400/06.

purposes of this opposition, if the Opponent cannot succeed on the basis of its Earlier Mark 2, it is clearly in no better position based upon the other Earlier Mark 1 of the series (due to the additional verbal element 'THE' which introduces an obvious further point of difference between this earlier mark and the Contested Mark (at least visually and aurally)). I proceed accordingly.

DECISION

Section 5(2)(b)

17. Section 5(2)(b) of the Act is 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."

18. Section 5A reads:

> "5A 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."

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

(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; Page 8 of 20

(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

20. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union ("CJEU") in *Canon,* Case C-39/97, the court stated at paragraph 23 that:

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

21. Guidance on this issue has come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

    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.

22. The General Court ("GC") confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, that, even if goods (or services) 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 fur 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".

23. For the purposes of considering the issue of similarity of goods and services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

24. The goods and services for comparison are as follows:

Opponent's goods and services	Applicant's goods and services
Class 25	**Class 25**
Clothing; footwear; headgear.	Clothing; footwear; headgear.
Class 35	**Class 35**
Retail services in relation to the sale of clothing, clothing accessories, fashion accessories, tops, sweatshirts, T-shirts, hoodies, scarves, footwear, headgear, hats, caps, baseball caps.	Retail services relating to clothing, footwear, and headgear; Online retail store services in relation to clothing, footwear, and headgear; Wholesale services in relation to clothing, footwear, and headgear.

Class 25

- "*Clothing; footwear; headgear*"

25. The Applicant's goods above are identically reproduced in the Opponent's specification.

Class 35

- "*Retail services relating to clothing, footwear, and headgear; Online retail store services in relation to clothing, footwear, and headgear; Wholesale services in relation to clothing, footwear, and headgear*"

26. The Applicant's services above essentially consist of retail of clothing, footwear, and headgear. Accordingly, the Applicant's services fall within the Opponent's wider category of "*Retail services in relation to the sale of clothing, […] footwear, headgear, […]*". Thus, they are identical in line with the principle outlined in *Meric*.

Average consumer and the purchasing act

27. It is necessary for me to determine who the average consumer is for the goods and services in question; I must then determine the manner in which the goods and services are likely to be selected by the average consumer in the course of trade.

28. 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 and services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97.* 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:

> "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."

29. The average consumer for the goods in class 25 (i.e., clothing, footwear, and headgear) will be members of the general public. The cost of purchase for these goods is likely to vary but not to be excessively high, and the goods will be purchased relatively frequently. However, various factors are still likely to be taken into consideration during the purchasing process, such as materials used, cut, size, aesthetic appearance, wearability, durability, and suitability for purpose. The average consumer for the goods in class 35 (retail of clothing) is also likely to be the general public. The services will range in price but, overall, they are likely to be fairly inexpensive. The goods purchased under the services are of the kind that consumers would purchase fairly regularly (i.e. clothing), consequently the services will be utilised quite regularly. I find that the selection process is likely to be more casual than careful. However, when selecting the services, the general public will still consider factors such as the range of goods on offer, as well as the quality and speed of the service. Thus, for the goods and services it is my view that, overall, the general public will demonstrate a medium degree of attention during the purchasing process.

30. I consider the purchase of the goods and services to be mainly visual with the goods and services likely being purchased following an inspection of shopfronts, obtained by self-selection from the shelves in retail outlets, selected from online catalogues (i.e., pictures of items on websites); however, I do not discount aural considerations will play their part, particularly when advice is sought from sales representatives or for word of mouth recommendations.

Comparison of marks

31. 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 Court of Justice of the European Union 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."

32. 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.

33. The respective trade marks are shown below:

Earlier trade mark	Contested trade mark
STACK	**STACKD**

Overall impression

34. The overall impression of each mark resides in the single word of which each is composed.

Visual similarity

35. The Earlier Mark is composed of five letters and the Contested Mark is six letters long. The first five letters of the Applicant's Mark are identical in sequence to the Opponent's Mark. The marks only differ in the Contested Mark's last additional letter 'D'. UK consumers read from left to right.

36. In the instant case, the visual difference created by the additional letter 'D' in the Applicant's mark are tempered by the fact that all the other letters composing the two marks are identical.

37. The respective marks are in standard characters and all in capital letters.

38. In *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, the GC noted that the beginnings of words tend to have more visual and aural impact than the ends and I find that to be the case here. The court stated:

> "81. It is clear that visually the similarities between the word marks MUNDICOLOR and the mark applied for, MUNDICOR, are very pronounced. As was pointed out by the Board of Appeal, the only visual difference between the signs is in the additional letters 'lo' which characterise the earlier marks and which are, however, preceded in those marks by six letters placed in the same position as in the mark MUNDICOR and followed by the letter 'r', which is also the final letter of the mark applied for. Given that, as the Opposition Division and the Board of Appeal rightly held, *the consumer normally attaches more importance to the first part of words*, the presence of the same root 'mundico' in the opposing signs gives rise to a strong visual similarity, which is, moreover, reinforced by the presence of the letter 'r' at the end of the two signs. Given those similarities, the applicant's argument based on the difference in length of the opposing signs is insufficient to dispel the existence of a strong visual similarity.
>
> 82. As regards aural characteristics, it should be noted first that all eight letters of the mark MUNDICOR are included in the MUNDICOLOR marks.
>
> 83. Second, the first two syllables of the opposing signs forming the prefix 'mundi' are the same. In that respect, *it should again be emphasised that the attention of the consumer is usually directed to the beginning of the word*. Those features make the sound very similar.[9]

39. Overall, I consider that there is a high degree of visual similarity between the marks.

[9] For similar case law on this principle see, *inter alia*, *Sport Eybl & Sports Experts v OHIM* (Case T-179/11) and *Gappol v EUIPO* (Case T-411/15).

Aural similarity

40. The respective marks both comprise of one-syllable words.

41. In its submissions in lieu,[10] the Applicant submits that the 'D' at the end of the Contested Mark "*is obvious and is pronounced, which substantially differentiates the mark, both visually and orally, from the Registered Mark*". The Opponent contends that the Applicant's mark "*consists of the Opponent's mark with a letter tacked on the end, for no obvious purpose, and which has no effect on the aural impact of the mark applied for. […] In an aural comparison the marks share the common first five out of six letters in the same order. The consonant tacked on the end does not add to the sound of 'STACK' or make any aural impact. It would not be stressed or sounded*".[11]

42. It is my view that the relevant consumer, when confronted with the Contested Mark 'STACKD' will voice it as "stacked", notwithstanding the absence of the letter 'e' before the final 'D'. Therefore, the respective marks are read similarly in their first part "stack-" (this being the whole Earlier Mark) with the addition of an "-ed" sound at the end of the Contested Mark.

43. Therefore, I find that the marks are aurally highly similar.

Conceptual similarity

44. The Applicant contends that 'STACKD' is the misspelling of "stacked" and provided dictionary references showing "stacked" is a slang word meaning "having a voluptuous figure" or "being "well-rounded". The Applicant also argues that the misspelling 'STACKD' "*gives it a further conceptual distinction from the Opponent's marks since the incorrect misspelling creates an impression of edginess and youth which is absent from the Opponent's Marks and which serves to further emphasise the slang meaning of the Contested Mark as "voluptuous" or 'well-rounded'*".[12]

45. The Opponent submitted dictionary references showing that the primary definition of "STACK" is "a pile of things arranged one on top of another". The Opponent also pointed out that the definitions submitted by the Applicant for "stacked" are taken

[10] Dated 18 June 2024.
[11] Submissions in lieu dated 25 June 2024.
[12] Submissions in lieu dated 18 June 2024, [5] and [9] – [10].

from a US dictionary rather than a British dictionary and that the Cambridge dictionary defines "STACKED" as a "US slang term" that "is considered offensive by many women". The Opponent finally contended that "STACKED" is merely the adjectival form of "STACK".[13]

46. According to their submissions, the parties agree that "STACK" means "a pile of things". Turning to the meaning of "STACKD", I find that the relevant consumers, when reading the mark, are likely to fill in the gaps (i.e., the missing "e") and understand it as "stacked".

47. Regarding the Applicant's argument for the meaning of "stacked", it is settled case law[14] that for a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. I do not believe that the UK relevant consumer will immediately understand the Applicant's mark as conveying the concept of a US slang word meaning *"voluptuous" or 'well-rounded'*". Differently, it is my view that the relevant consumer is more likely to understand "stacked" as the adjectival form of "stack" as submitted by the Opponent.

48. Therefore, the competing marks both refer to the same concept of something being arrange in a (ordered) pile. Thus, I find there is a high conceptual similarity between the marks.

Distinctive character of the earlier trade mark

49. The distinctive character of a trade mark can be appraised only, first, by reference to the goods and services 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. In *Lloyd Schuhfabrik*, 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

[13] Submissions in lieu dated 25 June 2024, [19] – [21].
[14] 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.

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)."

50. Registered trade marks possess varying degrees of inherent distinctive character. These range from the very low, such as those which are suggestive or allusive of the services, to those with high inherent distinctive character, such as invented words.

51. Although the distinctiveness of a mark may be enhanced as a result of it having been used in the market, the Opponent has filed no evidence of use of its mark. Accordingly, I have only the inherent position to consider.

52. The Earlier Mark is the English dictionary word "STACK" indicating "a pile of things arranged one on top of another" (noun).[15] Therefore, the Earlier Mark is an arbitrary dictionary word that is neither descriptive nor allusive to the goods and services at hand. However, taking into consideration that the goods in object are clothing (and that the services consist of the sale of clothing) and the fact that clothes can be arranged in a (ordered) pile, I find the Earlier Mark to have a medium degree of inherent distinctive character.

Likelihood of confusion

[15] https://dictionary.cambridge.org/dictionary/english/stack.

53. There is no simple formula for determining whether there is a likelihood of confusion. The factors considered above have a degree of interdependency (*Canon* at [17]). I must make a global assessment of the competing factors (*Sabel* at [22]), considering the various factors from the perspective of the average consumer and deciding whether the average consumer is likely to be confused. In making my assessment, I must keep 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]).

54. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. The concept of indirect confusion was explained by Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10 as follows:

> "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)."

55. I have found the respective goods and services to be identical. The consumer is likely to pay a medium level of attention in their selection. The distinctiveness of the Earlier Mark is medium. The visual, aural, and conceptual similarity is high. The purchase of the contested goods and services is considered to be mainly visual but the potential for aural use is borne in mind.

56. The Contested Mark fully contains the Earlier Mark. The relevant English consumers read from left to right and will attribute more importance to the initial string of letters ('STACK') which is identical in both marks and forms an English dictionary word that consumers will easily understand. The marks exclusively differ in the Contested Mark's last letter 'D'. Weighing all of these factors, and bearing in mind the effects of imperfect recollection, I find that the average consumer is likely to mistake the Earlier Mark for the Contested Mark. Thus, there is a likelihood of direct confusion.

Conclusion

57. The opposition under section 5(2)(b) succeeds and the application, subject to any appeal, will be refused for all goods and services.

Costs

58. The Opponent has been successful and is entitled to an award of costs. The relevant scale is contained in Tribunal Practice Notice ("TPN") 1/2023. Bearing that scale in mind, I reduce the award for the official fee from £200 to £100. This is because the grounds under sections 5(3) and 5(4)(a) were subsequently

withdrawn, due to lack of evidence, limiting the opposition to exclusively section 5(2) of the Act. It follows that I award costs to the Opponent as follows:

Official fee	£100
Preparing the notice of opposition and considering the counterstatement	£250
Preparing evidence and considering and commenting on the other side's evidence	£600
Submissions in lieu of a hearing	£350
Total:	**£1,300**

59. I order STACKD GYM WEAR LTD to pay Hold Group Limited the sum of **£1,300**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 4th day of March 2025

Andrea Rossi

For the Registrar