O/0250/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3826382

BY CARMEN BYRNE

TO REGISTER:

Only JDM

AS A TRADE MARK IN CLASS 25

AND

IN THE MATTER OF THE OPPOSITION THERETO

UNDER NO. 439349 BY

AKTIESELSKABET AF 21. NOVEMBER 2001

BACKGROUND AND PLEADINGS

1. On 5 September 2022, Carmen Byrne ("the applicant") applied to register **Only JDM** as a trade mark in the United Kingdom in respect of the following goods:

> *Class 25*
>
> *Clothing; Clothes; Wristbands [clothing]; Tops [clothing]; Knitted clothing; Oilskins [clothing]; Motorcyclists' clothing; Hoods [clothing]; Leisure clothing; Infant clothing; Children's clothing; Childrens' clothing; Sports clothing; Leather clothing; Gloves [clothing]; Waterproof clothing; Plush clothing; Girls' clothing; Swaddling clothes; Layettes [clothing]; Jackets [clothing]; Kerchiefs [clothing]; Chaps (clothing); Maternity clothing; Thermal clothing; Belts [clothing]; Muffs [clothing]; Capes (clothing); Motorists' clothing; Boas [clothing]; Slips [clothing]; Veils [clothing]; Wraps [clothing]; Athletic clothing; Triathlon clothing; Windproof clothing; Silk clothing; Work clothes; Woolen clothing; Ladies' clothing; Latex clothing; Knitwear [clothing]; Cloth bibs; Cyclists' clothing; Playsuits [clothing]; Slipovers [clothing]; Jerseys [clothing]; Weatherproof clothing; Casual clothing; Denims [clothing]; Combinations [clothing]; Furs [clothing]; Shorts [clothing]; Collars [clothing]; Babies' clothing; Ties [clothing]; Outer clothing; Cashmere clothing; Bandeaux [clothing]; Women's clothing; Bodies [clothing]; Embroidered clothing.*

2. On 24 February 2023, the application was opposed by Aktieselskabet af 21. November 2001 ("the opponent"). The opposition was originally based on sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act") and concerns all the goods in respect of which registration is sought. However, in its written submissions dated 24 June 2023, the opponent said that it wished to proceed with the section 5(2)(b) claim only.

3. The opponent is relying on the following marks:

a) UKTM No. 900638833 ("the 833 mark")

ONLY

Filing date: 25 September 1997

Registration date: 7 January 2000

Relying on the following goods:

Class 25
Clothing, headgear.

b) UKTM No. 912158283 ("the 283 mark")

ONLY & SONS

Filing date: 20 September 2013
Registration date: 11 April 2014

Relying on the following goods:

Class 25
Clothing, headgear.

4. The opponent claims that the contested mark is highly similar to the earlier marks, submitting that the "JDM" element would be seen as a subsidiary part of the mark or as indicating a sub-brand of the ONLY family. The opponent argues that this family includes the earlier marks, but also the brands KIDS ONLY, ONLY MATERNITY, ONLY LIFE, ONLY PLAY and ONLY CARMAKONA. It also claims that the earlier mark enjoys an enhanced degree of distinctive character as a result of a significant number of sales made in the EU. As a result, there is a likelihood of confusion on the part of the public.

5. The applicant filed a defence and counterstatement denying that the marks are similar and that there is a likelihood of confusion under section 5(2)(b). She did not put the opponent to proof of use and so the opponent may rely on all the goods listed in paragraph 3 above.

REPRESENTATION

6. In these proceedings, the opponent has been represented by Browne Jacobson LLP and the applicant represents herself.

EVIDENCE AND SUBMISSIONS

7. The opponent's evidence comes from Faye Elizabeth McConnell, a Senior Associate in the firm Browne Jacobson LLP, the opponent's legal representatives. Her witness statement is dated 24 July 2023 and is a vehicle for exhibiting website screenshots showing use of the earlier marks for goods on sale on the websites of retailers Next, ASOS and New Look. The opponent filed written submissions with the same date.

8. The applicant filed a statement on 22 September 2023. This was in the form of an email with an attached exhibit containing website screenshots. On 26 October 2023, the Registry wrote to the applicant to inform her that the documents were not in the correct evidential format and that, should she wish the evidence to be considered, it should be refiled with a witness statement and the appropriate form requesting an extension to the deadline for filing evidence. As no response was received, the Registry wrote to the applicant again on 4 December 2023, giving a preliminary view to admit the filing of 25 September as submissions only. On 15 December 2023, the applicant sent a witness statement to the Registry. However, this was not accompanied by the required form and so the Registry wrote to the applicant on 22 January 2024 requesting the filing of a form TM9R and amended witness statement on or before 29 January 2024. No form was filed and so the email of 22 September was admitted as submissions.

9. Neither party requested a hearing, but the opponent filed written submissions in lieu on 21 June 2024. I have taken this decision following a careful consideration of the papers.

RELEVANCE OF EU LAW

10. 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.

DECISION

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

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

12. In considering this opposition, 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. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant, but someone who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them they have kept in their 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 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; and

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

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

Contested goods	Earlier goods
Class 25 *Clothing; Clothes; Wristbands [clothing]; Tops [clothing]; Knitted clothing; Oilskins [clothing]; Motorcyclists' clothing; Hoods [clothing]; Leisure clothing; Infant clothing; Children's clothing; Childrens' clothing; Sports clothing; Leather clothing; Gloves [clothing]; Waterproof clothing; Plush clothing; Girls' clothing; Swaddling clothes; Layettes [clothing]; Jackets [clothing]; Kerchiefs [clothing]; Chaps (clothing); Maternity clothing; Thermal clothing; Belts [clothing]; Muffs [clothing]; Capes (clothing); Motorists' clothing; Boas [clothing]; Slips [clothing]; Veils [clothing]; Wraps [clothing]; Athletic clothing; Triathlon clothing; Windproof clothing; Silk clothing; Work clothes; Woolen clothing; Ladies' clothing; Latex clothing; Knitwear [clothing]; Cloth bibs; Cyclists' clothing; Playsuits [clothing]; Slipovers [clothing] Jerseys [clothing]; Weatherproof clothing; Casual clothing; Denims [clothing]; Combinations [clothing]; Furs [clothing]; Shorts [clothing]; Collars [clothing]; Babies' clothing; Ties [clothing]; Outer clothing; Cashmere clothing; Bandeaux [clothing];*	*Class 25* *Clothing; Headgear.*

Contested goods	Earlier goods
Women's clothing; Bodies [clothing]; Embroidered clothing.	

14. *Clothing* appears in the specifications of both parties' marks, and *Clothes* in the applicant's specification is synonymous with this term.

15. Where goods in the specification of one party are included in a broader term from the other party's specification, those goods are considered to be identical: see *Gérard Meric v OHIM*, Case T-133/05, paragraph 29. The applicant's *Hoods [clothing]* is included in the opponent's broader *Headgear* and the applicant's remaining terms are included in the opponent's broader *Clothing*.

16. Consequently, I find that all the contested goods are identical to the earlier goods.

Average consumer and the purchasing process

17. The average consumer is 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 purposes 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: see *Lloyd Schuhfabrik*, paragraph 26.

18. The average consumer of the goods at issue is a member of the general public. The consumer will buy them from a clothing retailer or a department store, either visiting a physical shop or ordering from the internet or a printed catalogue. This means that the mark will be seen and so the visual element will be the most significant: see *New Look Limited v OHIM*, Joined cases T-117/03 to T-119/03 and T-171/03, paragraph 50. However, I do not discount the aural element, as the consumer may in some cases be assisted by a member of staff. The price varies, but in many cases these goods will be frequent purchases. The consumer will pay attention to the size, the materials, the style and colours to ensure they buy a garment that fits them and achieves the effect they desire. In my view, the average consumer of these goods will be paying a medium degree of attention.

Comparison of marks

19. It is clear from *SABEL* (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* that:

> "34. … it is necessary to ascertain in each individual case, the overall impression made on the target public by the sign for which the 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."

20. Artificial dissection of the marks would therefore be wrong, although it is necessary for me 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 marks.

21. The respective marks are shown below:

Contested mark	**Earlier marks**
ONLY JDM	The 833 mark: ONLY The 283 mark: ONLY & SONS

22. The applicant has not denied that the contested mark is similar to the earlier marks, merely that they are visually or phonetically identical.

23. All the marks under consideration are word marks. In *LA Superquimica v European Union Intellectual Property Office*, Case T-24/17, the General Court ("GC") held that such plain word marks protected the word or words contained in the mark, irrespective of form, colour or typeface.

24. The 833 mark is a single word ("ONLY"). There are no other elements to contribute to the overall impression of the mark which lies in the word itself.

25. The 283 mark contains two words ("ONLY" and "SONS"), separated by an ampersand. This average consumer is accustomed to seeing this formulation in the names of businesses. It will therefore perceive the word "ONLY" as a surname, and it makes the greater contribution to the overall impression of the mark. The letters "& SONS" make a lesser contribution.

26. The contested mark also begins with the word "ONLY". This is followed by three letters "JDM", which will be perceived as a set of initials. In the context of the goods at issue, these initials have no meaning. The applicant submits that it is "JDM" that is the dominant element in the contested mark. In my view, "ONLY" is a word that the average consumer would understand to denote a single thing or a few things. This would be likely to lead the average consumer to assume that it qualifies the word that comes directly before or after it. On this basis, I find that it is "JDM" that makes the greater contribution to the overall impression of the contested mark, with a smaller role being played by "ONLY".

Comparison with the 833 mark

27. The contested mark consists of two words, made up of four and three characters respectively. The first of these words is the sole element of the 833 mark. The beginnings of marks tend to have more visual and aural impact than the ends: see *El Corte Inglés SA v OHIM*, Joined cases T-183/02 and T-184/02, paragraphs 81-83. Consequently, I find that the marks are visually highly similar.

28. The word "ONLY" would be given its ordinary pronunciation and the abbreviation would be spoken as the letters "JAY-DEE-EM". The 833 mark would therefore have two syllables, with the contested mark having five. The first two syllables of those five

are phonetically identical to the 833 mark. I find that the marks are phonetically similar to a medium to high degree.

29. The opponent submits that the marks are conceptually highly similar. The concept of the earlier mark is of a single thing or a few things. I consider that it may, to some extent, be laudatory, suggesting that these are the only goods that the consumer needs. I have already found that the initials "JDM" would have no meaning in the context of the goods at issue. The message conveyed by the contested mark is that the goods just come from a company called JDM. I find that the marks are conceptually similar to a medium degree.

Comparison with the 283 mark

30. The 283 mark consists of two four-letter words, separated by an ampersand. At nine letters, plus two spaces, it is longer than the contested mark, which has seven letters and a space. Both marks begin with the same four-letter word: "ONLY". I found that this word made the greater contribution to the overall impression of the earlier mark. Consequently, I find that the marks are visually similar to a medium to high degree.

31. Phonetically, the 283 mark has four syllables, one fewer than the contested mark. The first two of those are identical to the first two of the contested mark. I find that the marks are phonetically similar to a medium to high degree.

32. The element "& SONS" in the 283 mark would be perceived by the average consumer as a reference to a family business. As I have already said, I consider that this would mean that the word "ONLY" would be understood to refer to a surname. The contested mark would have the meaning set out in paragraph 29 above. Consequently, I find that the marks are conceptually dissimilar.

Distinctive character of the earlier mark

33. Distinctive character is a measure of how strongly a mark distinguishes the goods or services of one undertaking from those of others. The factors that I must take into account in assessing the level of distinctive character were set out by the CJEU in *Lloyd Schuhfabrik Meyer*:

> "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)."

34. Registered trade marks possess varying degrees of inherent distinctive character from low, because they are suggestive of, or allude to, a characteristic of the goods or services, to high, for example, where the mark consists of invented words which have no allusive qualities. The distinctiveness of the mark can be enhanced by the use that has been made of it.

35. The word "ONLY" is a common word in the English language. I consider that it is to some extent laudatory, as it could be perceived as alluding to the fact that the goods are unique and that there are no other brands or clothing like it, i.e. it is the "only" brand consumers need to be aware of. Consequently, I find that the 833 has a low to medium degree of inherent distinctive character. Turning to the 283 mark, I recall that I found that this would be perceived to be a surname in the context of the mark as a whole. "ONLY" is not a common surname, and so I find that the inherent distinctive character of this mark is slightly higher than medium.

36. The opponent claims that the earlier marks enjoy an enhanced degree of distinctive character. This claim has not been denied by the applicant. The need for pleadings to be fully particularised was emphasised by Professor Phillip Johnson, sitting as the Appointed Person, in *SkyClub Trade Mark*, BL O/044/21, paragraphs 23-28. He quoted Lord Hoffmann's statement in *Barclays Bank Plc v Boulter* [1999] 1 WLR 1919 at [1923]:

> "The purpose of the pleadings is to define the issues and give the other party fair notice of the case which he has to meet."[1]

37. Tribunal Practice Notice ("TPN") No. 4/2000 contains the following guidance on the content of counterstatements:

> "19. A defence should comment on the facts set out in the statement of case and should state which of the grounds are admitted or denied and those which the applicant is unable to admit or deny but which he requires the opponent to prove.
>
> 20. The counter-statement should set out the reasons for denying a particular allegation and if necessary the facts on which they will rely in their defence. For example, if the party filing the counter-statement wishes to refer to prior registrations in support of their application then, as above, full details of those registrations should be provided."

38. In *SkyClub*, Professor Johnson explained that, while it would be possible to file an adequately particularised notice of opposition by completing the boxes on Form TM7, the same could not be said for the defence and Form TM8. Consequently, it would be wrong for me to proceed as if the claim that the distinctive character of the mark has been enhanced is denied. That said, I do consider that I may make an assessment of the degree of such enhancement.

39. The opponent's evidence consists of a collection of website screenshots obtained via the Internet Archive Wayback Machine from the websites of ASOS, Next and New Look. The 833 mark is shown in six of these, dated from 3 April 2016 to 20 August 2022. All these screenshots feature women's clothing. The 283 mark also appears on six screenshots, dating from 26 August 2016 to 24 July 2023, showing men's clothing. It is noted that the last of these is after the filing date of the contested mark. In addition, there are two screenshots from the New Look website dated 20 August 2022 and 11 December 2022 showing use of the brand "ONLY PLAY" for sportswear. The second of these is after the relevant date.

[1] Quoted by the Appointed Person at paragraph 26 of his decision.

40. There is no information on sales figures, amounts spent on marketing, or examples of marketing. However, I remind myself that the applicant has not denied the opponent's claim to enhanced distinctiveness of the mark and, for the reasons given above, I am proceeding on the basis that it has been enhanced to some degree. Having considered the evidence before me, I am reluctant to conclude that this degree is anything other than slight. Consequently, I find that the distinctive character of the 833 mark has been enhanced to a medium degree, while the distinctive character of the 283 mark has been enhanced to a medium to high degree.

Conclusions on likelihood of confusion

41. 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.

42. The applicant claims that the contested mark is used to identify a group of designs, and not as a brand or as a *"dominant print"* on clothing. However, I must bear in mind that any assessment is to be made on the basis of notional fair use of the mark. This is because it is necessary to consider all the circumstances in which the contested mark might be used if it were registered: see *O2 Holdings Limited & Anor v Hutchison 3G UK Limited*, Case C-533/06, paragraph 66. This means that I need to consider its use for all the goods listed in the specification.

43. The applicant also argued in its counterstatement that it had been using the contested mark for 26 months and there had been no instances of actual confusion. In

Maier & Anor v ASOS & Anor [2015] EWCA Civ 220, Kitchin LJ (as he then was) said that:

> "80. … the likelihood of confusion must be assessed globally taking into account all relevant factors and having regard to the matters set out in *Specsavers* at paragraph [52] and repeated above. If the mark and the sign have both been used and there has been actual confusion between them, this may be powerful evidence that their similarity is such that there exists a likelihood of confusion. But conversely, the absence of actual confusion despite side by side use may be powerful evidence that they are not sufficiently similar to give rise to a likelihood of confusion. This may not always be so, however. The reason for the absence of confusion may be that the mark has only been used to a limited extent or 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 taken for the other. So there may, in truth, have been limited opportunity for real confusion to occur."

44. I should therefore not read anything into the mere fact that the opponent did not contact the applicant about the contested mark prior to its filing of the notice of threatened opposition (Form TM7a).

45. The applicant also submits that since 7 January 2000, there have been 71 trade marks beginning with the word "ONLY" that have been registered for goods in Class 25. This argument does not help the applicant, for the reasons explained by the GC in *Zero Industry Srl v OHIM*, Case T-400/06:

> "73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word 'zero', it should be pointed out that the Opposition Division found, in that regard, that '… there are no indications as to how many of such trade marks are effectively used in the market'. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue

contain the word ‘zero’ is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T-135/04 *GfK v OHIM – BUS (Online Bus)* [2005] ECR II-4865, paragraph 68, and Case T-29/04 *Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH)* [2005] ECR II-5309, paragraph 71).”

46. The findings that feed into my assessment of the likelihood of confusion are as follows:

a) the parties’ goods are identical;

b) the average consumer is a member of the general public paying a medium degree of attention during what is largely a visual purchasing process;

c) the contested mark is visually and phonetically highly similar to the 833 mark and conceptually similar to the 833 mark to a medium degree;

d) the contested mark is visually and aurally similar to the 283 mark to a medium to high degree and conceptually dissimilar to it;

e) the 833 mark has a low to medium degree of inherent distinctive character which has been enhanced to a medium degree; and

f) the 283 mark has a slightly higher than medium degree of inherent distinctive character which has been enhanced to a degree between medium and high.

47. There are two types of confusion that may occur. Direct confusion is where the average consumer mistakes one mark for the other, while indirect confusion is where the average consumer recognises that the marks are different, but assumes that the later mark also identifies the goods or services of the owner of the earlier mark, or that the two undertakings are related: see *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10, paragraph 16. It is my view that the differences between the marks are such that the average consumer will notice that the contested mark contains an element “JDM” that is absent from the earlier marks, even taking into account the imperfect recollection of the marks. I find there is no likelihood of direct confusion.

48. In paragraph 17 of *LA Sugar*, Mr Iain Purvis QC, sitting as the Appointed Person, gave the following examples of scenarios in which indirect confusion might occur:

> "(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 different elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)."

49. In *Liverpool Gin Distillery Limited & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ commented on this passage, saying 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."

50. One "proper basis" might be that the contested mark is seen as another member of a family of marks. The opponent claims that the earlier marks are part of a family of

"ONLY" marks. The CJEU held in *Il Ponte Finanziaria SpA v OHIM*, Case C-234/06, that:

> "62. While it is true that, in the case of opposition to an application for registration of a Community trade mark based on the existence of only one earlier trade mark that is not yet subject to an obligation of use, the assessment of the likelihood of confusion is to be carried out by comparing the two marks as they were registered, the same does not apply where the opposition is based on the existence of several trade marks possessing common characteristics which made it possible for them to be regarded as part of a 'family' or 'series' of marks.
>
> 63. The risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94 (see *Alcon v OHIM*, paragraph 55, and, to that effect, *Canon*, paragraph 29). Where there is a 'family' or 'series' of trade marks, the likelihood of confusion results more specifically from the possibility that the consumer may be mistaken as to the provenance or origin of goods or services covered by the trade mark applied for or considers erroneously that that trade mark is part of that family or series of marks.
>
> 64. As the Advocate General stated at paragraph 101 of her Opinion, no consumer can be expected, in the absence of use of a sufficient number of trade marks capable of constituting a family or a series, to detect a common element in such a family or series and/or to associate with that family or series another trade mark containing the same common element. Accordingly, in order for there to be a likelihood that the public may be mistaken as to whether the trade mark applied for belongs to a 'family' or 'series', the earlier trade marks which are part of that 'family' or 'series' must be present on the market.
>
> 65. Thus, contrary to what the appellant maintains, the Court of First Instance did not require proof of use as such of the earlier trade marks but

only of use of a sufficient number of them as to be capable of constituting a family or series of trade marks and therefore of demonstrating that such a family or series exists for the purposes of the assessment of the likelihood of confusion.

66. It follows that, having found that there was no such use, the Court of First Instance was properly able to conclude that the Board of Appeal was entitled to disregard the arguments by which the appellant claimed the protection that could be due to 'marks in a series'."

51. The opponent submits that the applicant has not denied that it is the proprietor of a series of marks containing the common element "ONLY" and including the earlier marks and the signs KIDS ONLY, ONLY MATERNITY, ONLY LIFE, ONLY PLAY and ONLY CARMAKONA, and that all these other signs are used by the opponent on its website. I can find no denial in the applicant's counterstatement, and therefore will proceed on the basis that it accepts that the opponent is the proprietor of such a family. However, the existence of family of marks does not in itself mean that there is a likelihood of confusion. The average consumer still needs to assume that the contested mark is part of the family. In paragraph 64 of *Il Ponte Finanziaria*, the CJEU said that in order for there to be a likelihood of confusion the earlier trade marks must be present on the market. The opponent has adduced screenshots showing use of the earlier marks and ONLY PLAY, and has said that the other signs are used on its website. However, there is nothing to tell me that these marks were used before the relevant date or, if they were, the extent to which they were used. Consequently, I will proceed on the basis that the ONLY, ONLY & SONS and ONLY PLAY marks were on the market at the time that the application for the contested mark was filed.

52. All the marks contain the common element "ONLY". The evidence shows that "ONLY & SONS" is used for menswear and "ONLY PLAY" for sportswear. The additional elements, therefore, allude to the type of clothing sold under those marks. In contrast, I have found that "JDM" in the contested mark has no meaning, and that it was the element that made the greater contribution to the overall impression of the contested mark. Consequently, I do not find that the contested mark follows the same pattern shown in the marks in the opponent's family, and so I find it unlikely that the average consumer would assume that it belongs to that family. I do not consider that

the opponent has shown me that it is likely that any mark that begins with the word "ONLY" would be perceived as coming from the opponent.

53. Neither do I find that the contested mark would be consistent with a sub-brand or brand extension, given the lack of meaning of "JDM" and my finding that the 833 mark has only a medium degree of distinctive character. I see no other reason why indirect confusion would arise. I find no likelihood of indirect confusion.

54. The opposition fails under section 5(2)(b) of the Act.

CONCLUSION

55. The opposition is unsuccessful, and the application may proceed to registration.

COSTS

56. The applicant has been successful and would ordinarily be entitled to a contribution towards its costs. As the applicant is a litigant in person, the Tribunal wrote to her on 24 May 2024, inviting her to file a costs proforma recording the amount of time spent on particular activities undertaken during the course of the proceedings. The letter stated that, if a completed proforma were not returned, costs, other than official fees arising from the action (excluding extensions of time), may not be awarded.

57. The applicant did not file a completed costs proforma and did not incur any official fees during the course of the proceedings. Therefore, I make no award of costs.

Dated this 18th day of March 2025

Clare Boucher
For the Registrar,
Comptroller-General