o/0270/24

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003775743

BY ICED LONDON LTD

TO REGISTER THE TRADE MARK:

Iced London

ICED
LONDON

(SERIES OF 2)

IN CLASSES 9, 14, 25 AND 35

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 436471

BY ICE IP S.A.

BACKGROUND AND PLEADINGS

1. On 8 April 2022, Iced London Ltd ("the applicant") applied to register the series of two trade marks shown on the cover page of this decision in the UK. The application was published for opposition purposes on 24 June 2022 and registration is sought for the goods set out in the Annex to this decision.

2. On 26 September 2022, the application was partially opposed by ICE IP S.A. ("the opponent") based section 5(2)(b) of the Trade Marks Act 1994 ("the Act") and is directed against the following goods and services of the applicant:

Class 14 Jewellery; Watches.

Class 35 Retail services in relation to jewellery.

3. Under section 5(2)(b) the opponent relies upon the following trade marks:

ICE

Comparable trade mark (IR) UK registration no. UK0081128035[1]
Filing date 10 July 2012; Registration date 30 July 2013.
("The First Earlier Mark")

ICE

Comparable UK trade mark (EU) registration no. UK00911572435
Filing date 14 February 2013; Registration date 12 July 2013.
("The Second Earlier Mark")

[1] Following the end of the transition period of the UK's withdrawal from the EU, all international (EU) trade mark designations registered before 1 January 2021 were recorded as comparable trade marks in the UK trade mark register (and as a consequence, have the same legal status as if they had been applied for and registered under UK law). A 'comparable trade mark (IR)' retains the same designation date (filing date), priority date (if applicable) and registration date of the international (EU) trade mark designation.

ICE

Comparable UK trade mark (EU) registration no.UK00918113387[2]
Filing date 23 August 2019.
Registration date 8 January 2020.
("The Third Earlier Mark")

4. The opponent claims that there is a likelihood of confusion because of the identity/similarity of the goods, and the similarity of the marks.

5. The applicant filed a counterstatement denying the claims made and putting the opponent's Second Earlier Mark to proof of use for ornaments (jewellery), charms, medals, medallions, insignias and amulets, rings, earrings, bracelets and brooches, chains and necklaces, pearls (jewellery), figurines of precious metal, cuff-links, tie-pins, hat-pins, Ornaments (Hat -) of precious metal, shoe ornaments of precious metal, novelty key rings.

6. However, in the opponent's "further submissions" dated 6 July 2023, the opponent confirmed that they were not filing proof of use evidence for these goods. Consequently, in an official letter dated 4 August 2023, the Registry confirmed that applying Rule 20(3)(b) of the Trade Mark Rules 2008, the opponent could no longer rely upon these goods during these proceedings (and therefore the opposition is withdrawn in relation to those goods). Consequently, the goods that the opponent relies upon are contained in the annex to this decision.

7. The opponent is represented by Baron Warren Redfern and the applicant is unrepresented. A hearing was neither requested nor considered necessary, however, the opponent filed submissions in lieu of a hearing. I have taken all of the submissions into consideration in reaching my decision and will refer to it where necessary below.

[2] Following the end of the transition period of the UK's withdrawal from the EU, all EU trade marks ("EUTM") registered before 1 January 2021 were recorded as comparable trade marks in the UK trade mark register (and as a consequence, have the same legal status as if they had been applied for and registered under UK law). A 'comparable trade mark (EU)' retains the same filing date, priority date (if applicable) and registration date of the EUTM from which it derives.

8. 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

Section 5(2)(b)

9. Section 5(2)(b) reads as follows:

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

10. Section 5A states:

> "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."

11. The First and Second Earlier Marks had completed their registration process more than five years before the relevant date (the filing date of the applicant's marks). Accordingly, the use provisions at section 6A of the Act do apply. The applicant only

requested proof of use on some of the opponents Second Earlier Marks goods, and as highlighted above, the opponent did not provide evidence of use of these. On this basis, the class 14 goods listed at paragraph 5 of this decision cannot be relied upon. Therefore, the opponent can only rely on its remaining goods in its Second Earlier Marks specification, and all of the goods within its First Earlier Marks specification, without demonstrating that the marks have been used.

12. The Third Earlier Mark had not completed their registration process more than five years before the relevant date. Accordingly, the use provisions do not apply, and the opponent may rely on all of its class 14 goods without demonstrating it has used the mark.

Section 5(2)(b) - case law

13. In making this decision, I bear in mind the following principles 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;

(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

14. The competing goods and services are as follows:

Opponent's goods	Applicant's goods and services
The First Earlier Mark Class 14 Watches, watch straps, watch chains, watch casings, caskets and cases for clock- and watch-making, clocks, alarm clocks, stopwatches, chronographs, ornaments (jewellery), charms, medals, medallions, insignias and amulets, rings, earrings, bracelets and brooches, chains and necklaces, pearls (jewellery), figurines of precious metal, cuff-links, tie-pins, hat-pins, hat ornaments, ornaments for footwear; Novelty key rings **The Second Earlier Mark** Class 14 Watches, watch straps, watch chains, watch casings, caskets and cases for clock- and watch-making, clocks, alarm clocks, stopwatches, chronographs. **The Third Earlier Mark** Class 14 Watches, watch straps, watch chains, watch casings, caskets and cases for clock- and watch-making, clocks, alarm	Class 14 Jewellery; Watches. Class 35 Retail services in relation to jewellery.

clocks, stopwatches, chronographs, ornaments (jewellery), charms, medals, medallions, insignias and amulets, rings, earrings, bracelets and brooches, chains and necklaces, pearls (jewellery), figurines of precious metal, cuff-links, tie-pins, hat-pins, Ornaments (Hat -) of precious metal, Shoe ornaments of precious metal; Novelty key rings.	

15. 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 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."

16. 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

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

> "29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark."

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

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

19. The applicant's counterstatement acknowledges some overlap in the goods and services offered by both parties*, "however, the differences in style, target market, and price points set our products apart. (The opponent) primarily sells watches and lower priced jewellery from aluminium, gold plating, or acetate, targeting European customers. In contrast, (The applicant) offers high-end jewelery made from precious metals, lab diamonds and natural diamonds, catering to a younger American audience*

interested in the hip-hop scene. These distinctions make it unlikely that consumers would confuse the two brands".

20. The applicant's above submissions regarding how the goods are used in practice is not relevant to my assessment. I have to carry out a notional assessment based upon the specifications before me, and all the circumstances in which the mark applied for might be used if it were registered.[3]

Class 14

21. The term "watches" in the applicant's specification appears identically in all three of the opponent's specifications.

22. The terms "ornaments (jewellery)", "charms", "earrings", "bracelets and brooches", "chains and necklaces" and "pearls (jewellery)" in the opponent's First and Third Earlier Mark's specifications falls within the broader category of "jewellery" in the applicant's specification. The goods are identical on the principle outlined in Meric.

Class 35

23. *In Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the General Court ("GC") held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

24. In *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services v goods. He stated (at paragraph 9 of his judgment):

> "9. The position with regard to the question of conflict between use of BOO! for handbags in Class 18 and shoes for women in Class 25 and use of MissBoo

[3] *O2 Holdings Limited & Anor v Hutchison 3G UK Limited*, Case C-533/06, paragraph 66.

for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent's earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are 'similar' to goods are not clear cut.

25. However, on the basis of the European courts' judgments in *Sanco SA v OHIM*[4], and *Assembled Investments (Proprietary) Ltd v. OHIM* Case T-105/05[5], upheld on appeal in *Waterford Wedgewood Plc v. Assembled Investments (Proprietary) Ltd,* Case C-398/07P, Mr Hobbs concluded:

(i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer's point of view, they are unlikely to be offered by one and the same undertaking;

ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent's goods and then to compare the opponent's goods with the retail services covered by the applicant's trade mark;

iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;

[4] Case C-411/13P
[5] paragraphs [30] to [35] of the judgment

iv) The General Court's findings in Oakley did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

26. I consider the applicant's class 35 services "retail services in relation to jewellery" are similar to the opponent's "ornaments (jewellery), charms, earrings, bracelets and brooches, chains and necklaces, pearls (jewellery)" goods in its First and Third Earlier Marks specifications. As highlighted in *Oakley* above, the GC held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree. In this case, the applicant's retail jewellery services relate to the sale of the opponent's class 14 jewellery goods. Applying the guidance from *Oakley*, I find that the opponent's jewellery goods and the applicant's retail services in relation to jewellery are similar to a medium degree.

The average consumer and the nature of the purchasing act

27. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then determine the manner in which the goods and services are likely to be selected by the average consumer. 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."

28. The average consumer for the goods and services are likely to be members of the public. The goods and services are likely to vary in cost and frequency of purchase, for example, costume jewellery will be lower in cost and purchased frequently, whereas jewellery made from precious metals such as gold and platinum is likely to be an infrequent purchase with the price of these goods relatively high. Regardless, the average consumer will take various factors into consideration such as the aesthetics, cost, quality, materials used, location and the suitability of the goods and services for the user's needs. Therefore, the level of attention paid during the purchasing process will be medium.

29. The goods are likely to be obtained by self-selection from the shelves of a retail outlet, jewellers or online equivalents, and the services are likely to be purchased following perusal of signage on premises frontage. I also consider that the goods and services may be purchased following perusal of advertisements. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount that there may also be an aural component to the purchase through advice sought from a sales assistant or representative.

Comparison of the trade marks

30. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) 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 the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated, at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

> "… it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall

impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion."

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

32. The respective trade marks are shown below:

Opponent's trade marks	Applicant's Trade Mark
ICE	**Iced London** ICED **LONDON** **(SERIES OF 2)**

Overall impression

33. The opponent's First, Second and Third Earlier word marks all consist of the three-letter word 'ICE'. There are no other elements to contribute to the overall impression which lies in the word itself.

34. The applicant's trade mark is a series of two marks consisting of the words 'Iced London' and 'ICED LONDON'. In the second mark in the series, 'LONDON' is presented in bold. For reasons I will come to discuss in the conceptual comparison,

the word ‘ICED’ plays a greater role in the overall impression of the marks, with the word ‘LONDON’ playing a lesser role.

Visual comparisons

35. The applicant’s counterstatement acknowledges there is an “undeniable” visual similarity with the opponent’s marks. I consider that this is on the basis that the marks coincide in the letters I, C and E which appear at the beginning of the marks, a position that is generally considered to have more impact.[6] The difference in letter case is not significant, since the registration of word-only marks (such as the contested mark) provides protection for the words themselves, irrespective of whether they are presented in upper, lower or title case. These, therefore, act as visual points of similarity. However, the letters “ICE” are followed by the letter D in the applicant’s marks. The word “LONDON” is also contained at the end of the applicant’s marks, which is presented in bold in the second mark of the series. These act as visual points of difference. Therefore, taking all of the above into account, I consider that the marks are visually similar to the opponent’s marks between a low to medium degree.

Aural Similarities

36. Aurally, I consider the opponent’s First, Second and Third Earlier Marks will likely be pronounced as ICE. The applicant marks will likely be pronounced as ICED LUN-DON. Therefore, because the beginnings of both marks overlap in the pronunciation of “ICE”, I consider the marks to be aurally similar to a medium degree.

Conceptual comparison

37. I note that in its counterstatement, the applicant states that ’ICED’ is a “reference to the expression “iced out”, initially made popular by US hip-hop and rap recording artists, which means wearing a large amount of jewellery which contains diamonds or other gemstones. The term has been used by numerous artists including Tupac Shakur, Drake and J. Cole to name a few and continues to be used to date”.

[6] *4 El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

38. The opponent also states that ICED is "indeed a popular term used in Hip-Hop culture to mean filled with diamonds, but this is simply because diamonds are referred to as "ice". This reinforces the argument that there will always be a very high degree of conceptual similarity in the eyes of the average consumer between ICE and ICED".

39. I therefore consider that both parties agree that ICED is a popular term, one which would be known to the average consumer as referring to jewellery that is filled with diamonds, in the context of the parties' goods and services. On this basis, the term ICE will also be seen as a reference to diamonds.

40. However, I also consider that there will be a proportion of consumers who would not know the popular terminology of ICED and ICE as referring to diamonds and diamond jewellery. For these consumers, the words will be assigned their ordinary dictionary meanings (frozen water, or something that has been cooled by the means of ice).

41. The applicant's marks end in the word LONDON, which, when taken in the context of the applicant's goods and services, is likely to be perceived by the consumer as the location where the jewellery is produced and where the company is based selling these goods.

42. Therefore, taking the above into account, if the consumer sees the words ICE and ICED as denoting the concept diamonds/diamond jewellery, or as denoting their ordinary dictionary meanings, the parties' marks are conceptually similar to between a medium and high degree.

Distinctive character of the earlier trade mark

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

> "22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an

overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C108/97 and C-109/97 Windsurfing Chiemsee v Huber and Attenberger [1999] ECR 1-2779, 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 promotion of 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)."

44. 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 and services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

45. As the opponent has not filed any evidence of use to show that the distinctiveness of its mark has been enhanced through use, I only have the inherent position to consider.

46. As highlighted above, the opponent's trade mark consists of the ordinary dictionary word 'ICE'. As noted above, the word "ICE" when taken in the context of the goods, would likely be seen as a reference to diamonds. On this basis, the marks are highly allusive of the opponent's goods. On this basis the First, Second and Third Earlier Marks are inherently distinctive to a low degree.

47. However, as highlighted in paragraph 39 above, there would be a proportion of consumers who would assign 'ICE' its ordinary dictionary meaning (frozen water), which is neither allusive nor descriptive of the goods. For those consumers, I consider that the First, Second and Third Earlier marks are inherently distinctive to a medium degree.

Likelihood of confusion

48. In assessing the likelihood of confusion, I must adopt the global approach advocated by case-law and take into account that marks are rarely recalled perfectly, the consumer relying instead upon the imperfect recollection of them that they have kept in mind.[7] I must also consider the average consumer of the goods and services, the nature of the selection process and bear in mind that a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa.[8]

49. Making an assessment as to the likelihood of confusion is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused. The global assessment is supposed to emulate what happens in the mind of the average consumer on encountering the later mark with an imperfect recollection of the earlier mark in mind. It is not a process of analysis or reasoning, but an impression or instinctive reaction.[9] The relative weight of the factors is not laid down by law but is a matter of judgement for the tribunal on the particular facts of each case.[10]

50. Confusion can be direct, which is a simple matter of the consumer mistaking one mark for another, or indirect, which is where the consumer notices that the marks are

[7] *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*, Case C-342/97, paragraph 27
[8] *Canon Kabushiki Kaisha v. Metro-Goldwyn-Maye*r Inc, Case C-39/97, paragraph 17
[9] *Duebros Limited v Heirler Cenovis* GmbH, BL O/547/17, paragraph 81
[10] See paragraph 33 of the Appointed Person's decision in Case No. O/049/17, (*Rochester Trade Mark*)

different, but the later mark and the earlier mark share common elements that lead the consumer to conclude that it is another brand of the owner of the earlier mark.[11]

51. Earlier in this decision, I found that:

(i) The applicant's goods in class 14 are identical to the opponent's class 14 goods and similar to a medium degree to the applicant's class 35 services.

(ii) The average consumer would likely be members of the public, paying a medium degree of attention to the purchasing process. The purchasing process will be predominantly visual although aural considerations also apply.

(iii) All of the marks are visually similar to between a low and medium degree.

(iv) All of the marks are aurally similar to a medium degree.

(v) All of the marks are conceptually similar to between a medium and high degree.

(vi) I have found the opponent's First, Second and Third Earlier Marks to be inherently distinctive to a low degree, or a medium degree, depending on the meaning assigned to them by the average consumer.

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

53. Therefore, taking all of the above into account, bearing in mind that the average consumer rarely has the chance to make direct comparisons between trade marks and, instead, must rely upon the imperfect picture of them retained in its mind, I consider that the marks are likely to be mistakenly recalled or misremembered as each other.

[11] See *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, paragraphs 16 to 17 wherein Mr Iain Purvis QC, sitting as the Appointed Person, dealt with the distinction between direct and indirect confusion.

54. Both marks begin with the letters I, C and E and as noted above, the beginning of the marks tend to make more of an impact than the ends. Therefore, the inclusion of the additional letter “D” at the end of the applicant’s first word in its mark would be easily overlooked by the average consumer. The applicant’s mark ends with the word LONDON, which as noted above, plays a lesser role in the overall impression of the mark, because when taken in the context of the goods and services, it denotes the location of where the jewellery is produced and where the company is based selling the jewellery goods. It would, therefore, also be easily overlooked by the average consumer. Furthermore, and as noted above, the marks are also conceptually similar to between a medium and high degree. This is on the basis that the word ICE and ICED in the opponent’s and applicant’s marks will be seen by the average consumer as referring to either diamonds and diamond jewellery, or to frozen water and something that has been cooled by the means of ice. Consequently, there is no significant conceptual hook in order to differentiate the marks. In my view, this results in a likelihood of direct confusion.

CONCLUSION

55. The opposition is successful. Subject to appeal, the application will be refused in respect of the following goods and services:

Class 14 Jewellery; Watches.

Class 35 Retail services in relation to jewellery.

56. The opposition was not directed against the following goods and services for which the application can proceed to registration:

Class 9 Sunglasses.

Class 25 Clothing; Headgear.

Class 35 Retail services in relation to clothing.

COSTS

57. The opponent has been successful and is entitled to a contribution towards its costs. In the circumstances, I award the opponent the sum of £700, based on the scale set out in Tribunal Practice Notice 1/2023, as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Official fee	£100
Filing a Notice of Opposition and considering the applicant's counterstatement	£250
Preparing written submissions in lieu	£350
Total	**£700**

58. I therefore order **Iced London Ltd** to pay **ICE IP S.A.** the sum of £700. This sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 27th day of March 2024

J BYRNE
For the Registrar

ANNEX

The applicant's specification

Class 9
Sunglasses

Class 14
Jewellery; Watches

Class 25
Clothing; Headgear

Class 35
Retail services in relation to jewellery; Retail services in relation to clothing.

The opponent's relied upon goods

The First Earlier Mark

Class 14
Watches, watch straps, watch chains, watch casings, caskets and cases for clock- and watch-making, clocks, alarm clocks, stopwatches, chronographs, ornaments (jewellery), charms, medals, medallions, insignias and amulets, rings, earrings, bracelets and brooches, chains and necklaces, pearls (jewellery), figurines of precious metal, cuff-links, tie-pins, hat-pins, hat ornaments, ornaments for footwear; Novelty key rings

The Second Earlier Mark

Class 14
Watches, watch straps, watch chains, watch casings, caskets and cases for clock- and watch-making, clocks, alarm clocks, stopwatches, chronographs.

The Third Earlier Mark

Class 14

Watches, watch straps, watch chains, watch casings, caskets and cases for clock- and watch-making, clocks, alarm clocks, stopwatches, chronographs, ornaments (jewellery), charms, medals, medallions, insignias and amulets, rings, earrings, bracelets and brooches, chains and necklaces, pearls (jewellery), figurines of precious metal, cuff-links, tie-pins, hat-pins, Ornaments (Hat -) of precious metal, Shoe ornaments of precious metal; Novelty key rings.