

O/0313/24

TRADE MARKS ACT 1994

**IN THE MATTER OF
TRADE MARK APPLICATION NO. 3779237
IN THE NAME OF ALBERT ADOLPHE
TO REGISTER AS A TRADE MARK**

Pushers Only

IN CLASSES 25 AND 41

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 435873
BY EMBRACER GROUP AB**

BACKGROUND AND PLEADINGS

1. On 20 April 2022, Albert Adolphe (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the United Kingdom. The application was accepted and published for opposition purposes on 27 May 2022, in respect of the following goods and services:

Class 25: *Clothing, footwear and headwear.*

Class 41: *Education; providing of training; entertainment; on-line entertainment; sporting and cultural activities; lottery services; electronic games services provided by means of the Internet; the provision of on-line electronic publications and podcast.*

2. The application is opposed by Embracer Group AB (“the opponent”). The opposition was filed on 26 August 2022 and is based upon Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against all of the goods and services in the application. The opponent relies upon the following comparable mark:

PUSHER

UK trade mark registration number 902885184

Filing date: 8 October 2002

Registration date: 15 July 2004

Registered in Class 9

Relying on all goods, namely:

Electrical equipment for recording, transmission or reproduction of sound or images; electronic games adapted for use exclusively with a television receiver; data carriers, in particular CD-ROMs, diskettes, magnetic tapes and digital memory components with computer programs as a component part of data carriers, computer software, in particular for games.

3. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing registered EUTM or International Trade Mark designating the EU. As a result, the opponent's mark was converted into a comparable UK trade mark. Comparable UK marks are now recorded in the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and the original filing dates remain the same.¹

4. The opponent's mark qualifies as an earlier mark under section 6(1) of the Act. As the earlier mark was registered more than 5 years before the application date of the applicant's mark, it is, in principle, subject to the provisions on use under Section 6A of the Act. The opponent made a statement of use in relation to all of the goods relied upon.

5. The opponent submits that the respective marks are similar and that the contested goods and services are complementary to, and therefore similar to, those covered by the registration. On account of the similarities, the opponent submits that there exists a likelihood of confusion on the part of the public, which includes a likelihood of association.

6. The applicant filed a counterstatement denying the claims. Although the applicant could have required the opponent to provide proof of use of the earlier mark under section 6A of the Act, it did not do so.² As a result, the opponent is able to rely on all the goods for which it made a statement of use on the notice of opposition (form TM7), without having to provide evidence that it has used its mark in relation to any of those goods.

7. The applicant filed written submissions during the evidence rounds; the opponent filed written submissions in lieu of a hearing. The written submissions will be referred to as and where appropriate during this decision. Neither party elected to file evidence

¹ See also Tribunal Practice Notice ("TPN") 2/2020 End of Transition Period – impact on tribunal proceedings.

² As per question 7 of the amended form TM8 dated 26 January 2023, where the applicant has ticked 'No' in answer to the question: 'Do you want the opponent to provide "proof of use"?'.

and neither party requested a hearing, therefore this decision is taken following careful consideration of the papers.

8. In these proceedings, the opponent is represented by Haseltine Lake Kempner LLP and the applicant is unrepresented.

DECISION

9. 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.

Section 5(2)(b)

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

“5(2) A trade mark shall not be registered if because -

(a) ...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

11. Section 5A states:

“Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the

trade mark is applied for, the application is to be refused in relation to those goods and services only.”

12. I am guided by the following principles which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (“OHIM”)*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

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

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

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

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings to mind the earlier mark, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public 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

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

14. The goods and services to be compared are:

Opponent's goods	Applicant's goods and services
<p><u>Class 9</u></p> <p><i>Electrical equipment for recording, transmission or reproduction of sound or images; electronic games adapted for use exclusively with a television receiver; data carriers, in particular CD-ROMs, diskettes, magnetic tapes and digital memory components with computer programs as a component part of data carriers, computer software, in particular for games.</i></p>	<p><u>Class 25</u></p> <p><i>Clothing, footwear and headwear.</i></p> <p><u>Class 41</u></p> <p><i>Education; providing of training; entertainment; on-line entertainment; sporting and cultural activities; lottery services; electronic games services provided by means of the Internet; the provision of on-line electronic publications and podcast.</i></p>

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

“In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM - Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.³

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

“In assessing the similarity of the goods or services concerned, ... all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.⁴

³ Paragraph 29

⁴ Paragraph 23

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

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 OHIM*, Case T-325/06, the GC stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.⁵

19. For the purposes of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where appropriate. In *Separode Trade Mark*, BL O-399-10, Mr Geoffrey Hobbs QC (as he then was), sitting as the Appointed Person, said:

“The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”⁶

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

⁵ Paragraph 82

⁶ Paragraph 5

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise. ... Nevertheless the principle should not be taken too far. ... Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."⁷

21. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

"In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase."

The contested goods in class 25

Clothing, footwear and headwear.

22. I note the written submissions of the opponent in which it submits that the contested goods in class 25 are similar to the goods covered by the opponent's mark insofar as they are complementary. The applicant's goods are clearly different in physical nature, purpose and method of use to the opponent's goods in class 9, such as "*electronic games adapted for use exclusively with a television receiver*". The goods are not in competition and I do not consider them to be complementary in a trade mark sense. As outlined in *Boston Scientific*, the goods at issue are not indispensable or important for the use of the other, and the average consumer of the applicant's "*Clothing, footwear and headwear*" would not normally expect it to be provided by the same undertaking as for any of the opponent's goods in class 9. I acknowledge that, as the opponent submits, it is possible to find video game merchandise in the form of clothing, footwear and headgear, and under these specific conditions, there will be an overlap in users and in trade channels. However, I

⁷ Paragraph 12

consider any purported link between the opponent's "*electronic games adapted for use exclusively with a television receiver*" in class 9 and the applicant's "*Clothing, footwear and headwear*" in class 25 to be contrived. Under ordinary circumstances, the goods are unlikely to share channels of trade, and even where this is the case, such as in the likes of department stores, they will not be positioned in close proximity. Therefore, any overlap in relation to specific merchandise and channels of trade is considered tenuous and insufficient for a finding of similarity between the goods at hand. I therefore find the opposing goods to be dissimilar. However, if I am wrong in this, and there is any similarity, it will be at a very low level based on the overlap in users and trade channels of particular merchandise, as identified above.

The contested services in class 41

Entertainment; on-line entertainment; electronic games services provided by means of the Internet.

23. The opponent submits that the applicant's "*entertainment; on-line entertainment; electronic games services provided by means of the Internet*" in class 41 are highly similar to the opponent's "*electronic games adapted for use exclusively with a television receiver; data carriers, in particular CD-ROMs, diskettes, magnetic tapes and digital memory components with computer programs as a component part of data carriers, computer software, in particular for games*" in Class 9.⁸ I am mindful of the guidance given in *Avnet* to confine services to the core of the possible meanings attributable to the broad term. While the term "entertainment" is suitably broad, I consider electronic games to be used for entertainment purposes and as such there is likely to be an overlap in users of the applicant's above listed services with the likes of the opponent's "*electronic games adapted for use exclusively with a television receiver*" as well as games-specific software or CD-ROMs. The physical nature and method of use of the services are not the same as for the goods, and neither do I consider the respective goods and services to be complementary, or to share trade channels. However, there will be an element of competition between them, with the

⁸ I acknowledge that the opponent's use of "*in particular*" is merely indicative of an example of the kind of goods, but that it does not limit the preceding goods as being only for games purposes.

consumer either choosing to purchase the opponent's goods in their physical form, or alternatively electing to access the applicant's entertainment services, including electronic games services, over the internet. It would not be unreasonable to expect manufacturers of games software or of physical games adapted for use with a television receiver to also offer an online version of the same game. Overall, I consider the goods and services at issue to be similar to a medium degree.

The provision of on-line electronic publications and podcast.

24. I disagree with the opponent's submissions that its "*Electrical equipment for recording, transmission or reproduction of sound or images*" in class 9 are the physical embodiment of the applicant's above services. In *Commercy AG v OHIM* Case T-316/07, the Board of Appeal ("BOA") found that just because goods are used by an undertaking in order to provide its services, the respective goods and services are targeted at different consumers, and as such, there can be no complementary connection between them.⁹ As per *Commercy*, although the opponent's "*Electrical equipment for recording, transmission or reproduction of sound or images*" may support the applicant's services in "*the provision of on-line electronic publications and podcast*", they are different in nature, method of use, intended purpose and channels of trade, and they are not in competition. Overall, I consider the respective goods and services to be dissimilar.

Education; providing of training; sporting and cultural activities; lottery services.

25. The opponent submits that the applicant's above services are similar to the class 9 goods as they will be provided via computer programmes and software as covered by the earlier registration. The respective goods and services are clearly different in nature, purpose and method of use, and are not in competition. For the same reasons as given above in paragraph 24, as per *Commercy*, the opponent's goods and the applicant's services are targeted at different consumers, therefore there is no complementary relationship between them. While there may be an overlap in end users, overall, I consider the opponent's "*Electrical equipment for recording,*

⁹ At [49-62].

transmission or reproduction of sound or images; electronic games adapted for use exclusively with a television receiver; data carriers, in particular CD-ROMs, diskettes, magnetic tapes and digital memory components with computer programs as a component part of data carriers, computer software, in particular for games” to be dissimilar to the applicant’s “Education; providing of training; sporting and cultural activities; lottery services”.

26. Under section 5(2)(b), a degree of similarity between the goods and services is essential for there to be a finding of likelihood of confusion: see paragraph 49 of *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA. In relation to the goods and services which I have found to be dissimilar, as there can be no likelihood of confusion under section 5(2)(b), I will take no further account of such services, with the opposition failing to that extent.

The average consumer and the nature of the purchasing act

27. The average consumer is a legal construct, deemed to be reasonably well informed and reasonably circumspect: see *Hearst Holdings Inc & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), paragraph 60. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97, at [26].

28. Earlier in this decision, I considered that the opponent’s “*electronic games adapted for use exclusively with a television receiver*” and its games-related CD-ROMs/computer software would be used for entertainment purposes and as such there would be an overlap between the goods with the applicant’s broad terms “*Entertainment*” and “*on-line entertainment*” services, as well as its “*electronic games services provided by means of the Internet*”. As such, I consider that the average consumer for the goods and services in common will most likely be the general public with an interest in gaming as a form of entertainment.

29. The physical goods may be sold through a range of channels, such as through high street retail outlets, including games specialists, and via online sales, while the

services are most likely to be selected via the internet. The purchasing process for both will be predominantly visual, with consumers seeking information from written reviews and recommendations, particularly online. However, I do not discount aural considerations, where consumers would receive verbal advice and recommendations from sales representatives, as well as from fellow gamers.

30. Purchases of electronic games, be that as a physical game or through a games service provided by means of the Internet, are likely to be made relatively frequently, where the consumer will pay a medium degree of attention to the genre of games they wish to play and the features and player options available.

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 CJEU stated in *Bimbo SA v OHIM* Case C-591/12P, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”¹⁰

32. 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.

¹⁰ Paragraph 34

33. The opponent's mark consists of the single word "**PUSHER**", presented in a standard typeface in capital letters, with no other elements to contribute to the overall impression.

34. The applicant's mark consists of two words "**Pushers Only**", presented in a standard typeface in title case. Neither word dominates, and there are no other elements to contribute to the overall impression.

35. The overall impression of each mark therefore rests in the word or combination of words that make up the respective marks. I note that the registration of a word mark gives protection irrespective of capitalisation (see *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17). In *dm-drogerie markt GmbH & Co. KG v OHIM*, Case T-304/10, the GC noted that in the case of word signs which are relatively short, the differences between marks of different lengths will be more easily grasped by the average consumer.¹¹ Meanwhile, in *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, the GC noted that the beginning of words tend to have more visual and aural impact than the ends, although I acknowledge that this is not always the case.

36. The opponent's mark consists of one word compared to the two words which make up the applicant's mark, which contributes to a visual disparity between the marks. The marks share in common the word "PUSHER", albeit that the word is pluralised in the applicant's mark. The word in common is positioned at the start of the contested mark. Considering both the position of the word in common, as well as the length of the respective marks, I consider the marks to be visually similar to a medium degree.

37. Aurally, the marks will be pronounced in the ordinary way, with the opponent's mark being articulated as two syllables, and the applicant's mark as four syllables. Given that the marks coincide aurally by way of the first two syllables, the sibilant "S" sound at the end of the second syllable of the applicant's mark notwithstanding, overall, I consider there to be a medium degree of aural similarity between the marks.

¹¹ At [42].

38. With regard to conceptual comparison, in *Luciano Sandrone v European Union Intellectual Property Office (EUIPO)*, Case T-268/18, the GC held:

“... In that regard, it must be borne in mind that the purpose of the conceptual comparison is to compare the ‘concepts’ that the signs at issue convey. The term ‘concept’ means, according to the definition given, for example, by the Larousse dictionary, a ‘general and abstract idea used to denote a specific or abstract thought which enables a person to associate with that thought the various perceptions which that person has of it and to organise knowledge about it.’”¹²

39. In its written submissions in lieu, the opponent submits that conceptually, the word “pusher” is identical in both marks and conveys the same meaning in English of “a person or thing that pushes”. Further, that while the mark of the application also includes the additional word “only”, as an adverb it merely serves to qualify the noun “Pushers”.¹³

40. The opponent’s mark comprises the everyday word “PUSHER”, which I would expect a significant proportion of consumers to recognise as a dictionary defined word in the United Kingdom. However, there are various meanings attributed to the word, with the definition given by the opponent being only one of several possible meanings. As such, it could be construed differently by different consumers, including, for example, as an informal reference to someone who sells illegal drugs. That being said, I agree that in the applicant’s mark, the word “Only” qualifies the word “Pushers”, which together conveys the message that the brand is directed exclusively (“only”) to pushers (whatever it may be that is being “pushed”). I also consider that the “PUSHER” element would be perceived identically in each of the marks, albeit that in the opponent’s mark it is in the singular and in the applicant’s mark it is in the plural. Overall, I find the marks to be conceptually similar to at least a medium degree.

¹² Paragraph 8.

¹³ At point 34.2 of the submissions dated 20 September 2023.

Distinctive character of the earlier marks

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

“23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

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

43. The earlier mark is made up of the ordinary, dictionary defined word “PUSHER”. I do not consider the mark to be descriptive or allusive of the goods at issue, but neither is it unusual as an invented word would be. Overall, I consider the mark to be inherently distinctive to a medium degree.

Likelihood of confusion

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

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

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – 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).”

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

47. Earlier in this decision, I found the contested goods in class 25 to be dissimilar to the opponent’s goods, with an alternative finding that they were similar to only a very low level, while I found a medium degree of similarity between some of the contested services in class 41 and the earlier goods relied upon. I considered that the average consumer of the overlapping goods and services would pay a medium degree of attention during the purchasing process, selecting the goods and services by predominantly visual means, although I did not discount aural considerations. I found the competing marks to be visually and aurally similar to a medium degree, and conceptually similar to at least a medium degree; I considered that the earlier mark possessed a medium degree of inherent distinctive character.

48. I acknowledge the applicant’s submissions that the parties’ brands operate in different industries, catering to distinct target markets.¹⁴ However, I must make my assessment based on how the goods and services might fairly be used now or in the

¹⁴ At page 2 of 3 of the applicant’s written submissions dated 11 July 2023.

future. In *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P, the CJEU stated that:

“59. As regards the fact that the particular circumstances in which the goods in question were marketed were not taken into account, the Court of First Instance was fully entitled to hold that, since these may vary in time and depending on the wishes of the proprietors of the opposing marks, it is inappropriate to take those circumstances into account in the prospective analysis of the likelihood of confusion between those marks.”

49. I have weighed up each of the competing factors in my decision, not least the differences as well as the similarities between the competing marks, including the degree of visual, aural, and conceptual similarity between them, as identified above, and the medium degree of similarity between the overlapping goods and services. Despite the medium level of attention paid by the average consumer to the purchasing process of the goods and services, bearing in mind the principle of imperfect recollection, I consider the differences between the marks to be sufficient to avoid them being mistakenly recalled as each other. When considered overall, I do not consider the commonalities to be sufficient to give rise to a likelihood of direct confusion.

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

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

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

52. I bear in mind the various factors in my decision and the principle of interdependency between them. I note the common element within the competing marks and that the additional letter "S" and qualifying word "ONLY" to the word "PUSHER" leads to a conceptual similarity between the marks as a whole. I have taken into account the previously outlined guidance of Mr Iain Purvis Q.C. (as he then was), in *L.A. Sugar*. I do not consider the common element to be so strikingly distinctive that the average consumer would assume that only the brand owner would be using it in a trade mark. However, as per paragraph 17(c) of that decision, I consider it reasonable that a significant proportion of the average consumer would perceive the sign "PUSHERS ONLY" as logical and consistent with a brand extension or a sub-brand of the owner of the earlier mark, or that they would assume that there is an economic connection between the undertakings. By way of example, the "PUSHERS ONLY" mark could be perceived as a sub-brand which is specifically directed towards members of a subscription type service of the universally accessible "PUSHER" brand. Consequently, I consider there to be a likelihood of indirect confusion between the marks in relation to those goods and services which were identified as being similar to a medium degree (but not the contested goods in class 25 with the alternative finding of similarity at a very low level).

53. As I have found a likelihood of confusion between the applicant's mark and the earlier mark, the opposition under section 5(2)(b) succeeds in respect of the following services only in class 41:

Entertainment; on-line entertainment; electronic games services provided by means of the Internet.

54. The opposition fails in respect of the remaining goods and services.

CONCLUSION

55. The applicant has been partially successful. Subject to any successful appeal, the application by Albert Adolphe may proceed to registration in respect of the following goods and services only:

Class 25

Clothing, footwear and headwear.

Class 41

Education; providing of training; sporting and cultural activities; lottery services; the provision of on-line electronic publications and podcast.

COSTS

56. Both parties have enjoyed a share of success, with the greater part going to the applicant, who would normally be entitled to a contribution towards its costs. However, as the applicant is not professionally represented, such costs would be based on £19 per hour, reflecting the necessary tasks in the process.

57. In the letter dated 24 August 2023, the Registry informed the applicant that if it intended to make a request for an award of costs, it was required to complete and return the provided form by 21 September 2023, else costs may not be awarded. The pro-forma was not returned. I take this to mean that the applicant has not made an application for costs. Consequently, I direct that each side should bear its own costs.

Dated this 9th day of April 2024

Suzanne Hitchings
For the Registrar,
the Comptroller-General