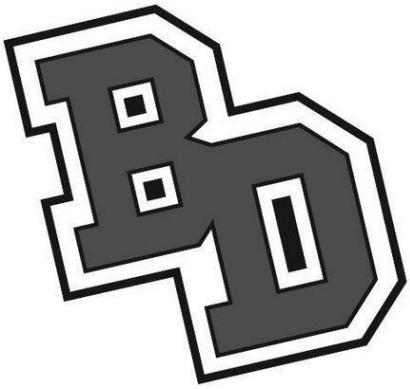
O/0352/24

TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL REGISTRATION NO. WO0000001651612 IN THE NAME OF BACK DOOR S.R.L. FOR THE FOLLOWING MARK:



IN CLASS 25

AND

IN THE MATTER OF THE OPPOSITION THERETO UNDER NO. 436257 BY G. & G. S.R.L.

BACKGROUND AND PLEADINGS

1. BACK DOOR S.R.L. ("the holder") is the holder of the International Registration shown on the cover page of this decision ("the IR"). The IR was registered on 15 February 2022 and, with effect from the same date, the holder designated the UK as a territory in which it seeks to protect the IR under the terms of the Protocol of the Madrid Agreement. The IR was accepted and published in the Trade Marks Journal for opposition purposes on 15 July 2022. The holder seeks protection for the following goods:

   Class 25: Shoes; basketball sneakers; gymnastic shoes; sportswear.

2. On 15 September 2022, the IR was opposed by G. & G. S.r.l. ("the opponent"). The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 ("the Act") and is reliant upon the following marks:

   BD BAGGIES
   UK registration no. 915115926[1]
   Filing date 16 February 2016; registration date 8 July 2016
   Relying on some goods, namely:

   Class 25: Clothing; Outerwear; Sportswear; Knitwear; Underwear; Nightwear; Beachwear; Ties; Hosiery; Scarves; Gloves; Belts; Pocket squares; Footwear; Headwear.

   ("the opponent's first mark"); and

[1] The opponent's first mark is a comparable mark based on earlier EUTM. On 1 January 2021, in accordance with Article 54 of the Withdrawal Agreement between the UK and the European Union, the UK IPO created comparable UK trade marks for all right holders with existing EUTMs and IRs designating the EU.

UK registration no. 3600218[2]
Filing date 24 February 2021; registration date 23 July 2021
Relying on some goods, namely:

Class 25: Clothing; Outerwear; Hosiery; Underwear; Bathing suits; Nightwear; Footwear; Headgear; Waist belts; Shawls and stoles; Cravats; Foulards [clothing articles]; Kerchiefs [clothing]; Gloves [clothing]; Neckwear; Sportswear; Training shoes; Headgear for use in sports.

("the opponent's second mark").

3. The opponent claims that the marks at issue are similar to each other and that the goods at issue are identical or highly similar. As a result, the opponent claims that there exists a likelihood of confusion on the part of the relevant purchasing public.

4. In relying on its first mark, the opponent confirmed that the registration process of the same was completed more than five years prior to the designation date of the IR. In doing so, the opponent has provided a statement of use that it has used the mark in respect of "clothing" only. The consequence of the opponent's statement of use is that while it sought to rely on additional goods in class 25, it may now only be permitted to rely on its first mark in respect of "clothing" only. In its counterstatement, aside from denying the claims against it, the holder requested that the opponent provide proof of use of its first mark in respect of the "clothing" goods for which this statement of use was given.

[2] By virtue of the opponent's second mark being filed pursuant to Article 59 of the Withdrawal Agreement between the UK and the European Union, it is deemed to have the same filing date as the opponent's identical EUTM, being 7 December 2020.

5. The opponent is represented by Bromhead Johnson LLP and the holder is represented by Armstrong Teasdale Limited. Only the opponent filed evidence and, in doing so, also filed written submissions. No hearing was requested and only the holder filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

6. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

EVIDENCE

7. The opponent's evidence came in the form of the witness statement of Cristina Calori dated 22 June 2023. Ms Calori is the Managing Director of the opponent, a position she has held since 24 June 1988. Ms Calori's statement is accompanied by eight exhibits, being those labelled CC1 to CC8.

8. I do not intend to summarise the opponents' evidence or the parties' submissions in full here. However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

MY APPROACH

9. In its written submissions in lieu, the holder sets out that it does not accept that the opponent has provided evidence that entitles it to rely on the full scope of protection of the goods subject to the proof of use request, being "clothing". However, the holder does make some concessions as to the opponent's proof of use. It goes on to discuss the fact that the opponent's evidence only points to sales of one item of clothing, being button down casual shirts. While the holder does not seek to have

the opponent's position limited to this specific category of goods,[3] it does contend that the term should be limited to "clothing, namely button-down shirts".

10. While I have not conducted a proof of use assessment, my initial view is that the holder's submissions are reflective of what the opponent's evidence actually shows, i.e. use of button-down shirts. As a result, a proof of use assessment of the opponent's first mark will only serve to limit the specification relied upon and, plainly, take away any degree of identity between the goods in the opponent's first mark and the IR and would only serve to reduce any level of similarity between them. In considering the goods in the opponent's second mark (which are not subject to proof of use) and bearing in mind its dominant elements (more on this below), I do not consider that the reliance upon the opponent's first mark offers any real advantage to the opponent. As a result, I do not consider it necessary to proceed to consider the opponent's first mark as a basis for the present opposition. Instead, I will proceed to consider this decision as though it is only reliant upon the opponent's second mark. For the avoidance of doubt, I will refer to the opponent's second mark going forward as, simply, the opponent's mark.

DECISION

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

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

> "(2) A trade mark shall not be registered if because-
>
> (a) […]

[3] In doing so, I note that the holder makes reference to the established cased law in respect of the forming of fair specifications in Tribunal proceedings, being *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch)

(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 or association with the earlier trade mark."

12. Section 5A of the Act states as follows:

"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."

13. The opponent's mark qualifies as an "earlier trade mark" for the purposes of this decision since it was applied for at an earlier date than the designation date for the IR.[4] The opponent's mark did not complete its registration process more than five years prior to the designation date of the IR meaning that it is not subject to proof of use pursuant to section 6A of the Act. This means that the opponent can rely upon all of the goods for which its mark is protected.

14. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V*. Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v Office for Harmonization 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:

[4] See Section 6(1)(a) of the Act.

(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

15. The competing goods are as follows:

The opponent's goods	The holder's goods
Class 25 Clothing; Outerwear; Hosiery; Underwear; Bathing suits; Nightwear; Footwear; Headgear; Waist belts; Shawls and stoles; Cravats; Foulards [clothing articles]; Kerchiefs [clothing]; Gloves [clothing]; Neckwear; Sportswear; Training shoes; Headgear for use in sports.	Class 25 Shoes; basketball sneakers; gymnastic shoes; sportswear.

16. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court 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 fur Lernsysteme

v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark."

17. The term of "sportwear" appears in both parties' specifications and it is, therefore, self-evidently identical.

18. The holder's goods of "shoes", "basketball sneakers" and "gymnastic shoes" are different types of footwear. "Footwear" is a term that is present in the opponent's specification meaning that it encompasses all of the holder's goods. As a result, these goods are identical under the principle outlined in *Meric*.

The average consumer and the nature of the purchasing act

19. As the case law set out above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then decide the manner in which these goods are likely to be selected by the average consumer in the course of trade. 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. (as he then was) 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."

20. The goods at issue are ordinary consumer goods that will be selected by members of the general public at large. The goods will likely be sold through a range of retailers and their online or catalogue equivalents. In physical retailers, the goods

at issue will be displayed on shelves or racks, where they will be viewed and self-selected by the consumer. A similar process will apply to online and catalogue sales, where the consumer will select the goods having viewed an image displayed on a webpage or in a catalogue. The selection of the goods at issue will, therefore, be primarily visual. That being said, I do not discount aural considerations in the form of advice sought from sales assistants or word of mouth recommendations.

21. The goods will be selected relatively frequently and will vary in cost quite considerably. I say this because some footwear goods (such as flip flops, for example) can be relatively low cost but can also extend to cover rather expensive shoes (such as formal leather shoes, for example). Regardless of the price of the goods, the average consumer will still give consideration to various factors such as current fashion trends, materials used, suitability and durability. These are relatively ordinary considerations and, as a result, I find that the average consumer will select the goods at issue whilst paying a medium degree of attention.

Comparison of the marks

22. It is clear from *Sabel 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.

23. The Court of Justice of the European Union ("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."

24. 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.

25. The respective trade marks are shown below:

The opponent's mark	The IR
	

26. I have submissions from both parties in respect of the comparison of the marks. I do not intend to repeat those here but will, where necessary, make reference to specific submissions below. For the avoidance of doubt, however, I confirm that I have taken the parties' submissions into account in making the following comparisons.

Overall Impression

The opponent's mark

27. The opponent's mark is a figurative mark that consists of the letters 'BD'. Between these letters is a full-stop element. Below these letters is the word 'BAGGIES'. Both of the verbal elements are presented in a standard black typeface. I note that the letters 'B' and 'S' in 'BAGGIES' are larger than the other letters in that word but I

consider that this will be overlooked. At the top of the mark sits a coat hanger device and, at the bottom, is a horizontal line. Both of these elements are in black. In respect of the overall impression of this mark, I am of the view that, for reasons I will come to discuss further below, it is the letters 'BD' that play the greater role, with 'BAGGIES' playing a slightly lesser role. I consider that the coat hanger device will play a lesser role than both of the verbal elements with the full-stop between 'B' and 'D' and the underline at the bottom both playing negligible roles due to their banal nature.

The IR

28. The IR is a figurative mark that consists of the letters 'BD' in a fairly standard typeface. I note that the letters are joined and are both surrounded by a singular border element. The letters are displayed at a slight angle and I note that the letter 'B' is placed higher than the letter 'D'. The holder submits that the IR is a highly stylised 'unit mark' that will be perceived by the consumer to be the initials of a sports term (whether real or imagined) or of a sportswear manufacturer and/or shoe maker. I will discuss the latter point when considering the concept of the IR below. However, as for the former claim that the IR is a highly stylised mark, I do not agree. I accept that it possesses some stylisation, however, I consider this to be fairly standard and in no way significant enough to suggest that the IR is highly stylised. In terms of the overall impression, clearly, the IR will be dominated by the letters 'BD' with the stylisation of the same playing a much lesser role.

<u>Visual Comparison</u>

29. The holder submits that the only similarity between the marks is the inclusion of the letter combination 'BD'. I agree that this is the only point of visual similarity between the marks. The marks differ in the presence of the word 'BAGGIES' and the coat hanger device in the opponent's mark (which have no counterpart in the IR). Further, the stylisation of both marks, while not considerable, is different. Even where the points of difference lie in lesser elements, they are still points of visual difference. Taking all of this into account and bearing in mind the overall

impressions of the marks, I consider that they are visually similar to no more than a medium degree.

Aural Comparison

30. The letters 'BD' in the opponent's mark will be articulated as individual letters. 'BAGGIES' will be pronounced in the ordinary way. As a result, the opponent's mark consists of four syllables. The only aural element of the IR is the letters 'BD' which will be pronounced in the same way as they are in the opponent's mark. This means that the entire aural element of the IR is identical to the first two syllables of the opponent's mark. The marks differ in the last two syllables of the opponent's mark, which have no counterpart in the IR. Given that the points of aural identity sit at the beginning of the opponent's mark, being where consumers tend to focus,[5] I find that the marks are aurally similar to between a medium and high degree.

Conceptual Comparison

31. The holder submits that 'BD' in the opponent's mark may be perceived to be an abbreviation for 'button down'. While this argument is noted, such an abbreviation is not something that I am aware of as being commonly used by UK consumers. On this point, I note that I have nothing before me to suggest that a significant proportion of average consumers would see 'BD' in this way. As a result, I consider that 'BD' will be understood as a two-letter combination which carries no concept other than perhaps to be perceived as the initials of someone or something. As for the word 'BAGGIES', I am of the view that this is likely to be understood as a reference to something that is baggy, such as loose-fitting clothing. As a result, I consider that 'BAGGIES' will be viewed as being allusive to clothing goods. On this point, I will say that while I am not particularly aware of 'BAGGIES' being commonly used as a term for loose fitting or baggy clothing, I consider that this meaning will be reinforced by the presence of the coat hanger device. As a whole, the concept

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

of the opponent's mark will be viewed as a combination of an unknown 'BD' element together with the understanding that the mark alludes to baggy clothing.

32. As for the IR, I have set out above that the holder submits that it will be readily perceived as the initials of a sports term or the initials of the sportswear manufacturer and/or shoemaker. I appreciate that the letters 'BD' are presented in such a way that they appear to be similar to the stylings used on American high school letterman jackets.[6] That being said, I have nothing to suggest that average consumers in the UK would be as readily aware of this and without such, I am not willing to find that they would be. On this point, I do not consider that it is a fact that is so notoriously known to the point that I would be entitled to take judicial notice of the same.[7] As such, I consider that the concept of the IR will be the same as 'BD' in the opponent's mark, being a two-letter combination which carries no concept other than perhaps to be perceived as the initials of someone or something.

33. In comparing the marks, despite perhaps being perceived as the initials of someone or something, the unknown nature of 'BD' is such that it can only be conceptually neutral. As for the addition of 'BAGGIES', this is a point of difference meaning that the marks, as wholes, are conceptually dissimilar.

Distinctive character of the opponent's mark

34. 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

[6] Which, as far as I am aware are worn by American student-athletes and are emblazoned with the initials of the team they play for.
[7] For guidance on Hearing Officers taking judicial notice, see the case of *Chorkee Ltd v Cherokee Inc.,* Case BL O/048/08.

undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

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

35. Registered trade marks possess varying degrees of inherent distinctive character, perhaps lower where a mark may be suggestive or allusive of a characteristic of the goods or services for which it is registered, 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. In the present case, the opponent's evidence speaks solely to use of its mark on shirts. The problem with this is that the terms upon which my goods comparison was based cannot be said to cover shirts. As a result, I do not consider that the evidence filed is of any real assistance when it comes to the enhanced distinctive character in respect of the *actual* goods at issue. In light of this, I will only consider the inherent position.

36. When considering the concept of the mark, I found that the letters 'BD' carry no concept other than perhaps to be perceived as the initials of someone or something. While not descriptive or allusive to the goods at issue, use of such an element as the basis for a trade mark is not remarkable. As such, I consider that it carries no more than a medium degree of inherent distinctive character. While I

have found that this is the dominant element of the mark, it is not the sole element. My assessment here must, therefore, be based on the mark as a whole. Having said that, I bear in mind what I have said about the additional elements (being the word 'BAGGIES' and the coat hanger device) when considering the concept of the opponent's mark, i.e. that they are allusive to loose fitted clothing. While these elements will not be ignored, I do not consider that they contribute to the distinctiveness of the mark to the point that it would take the inherent position beyond that which is created by the letters 'BD'. As a result, I consider that the opponent's mark possesses no more than a medium degree of inherent distinctive character.

Likelihood of confusion

37. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle 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. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact 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 that he has retained in his or her mind.

38. The goods at issue are identical. I have found the average consumer for the goods to be members of the general public at large. The selection process will be primarily visual, though I do not discount an aural component playing a role. I have concluded that during the selection of the goods at issue, the level of attention paid

by the average consumer will be medium. In respect of the marks comparison, I have found them to be visually similar to no more than a medium degree, aurally similar to between a medium and high degree and conceptually dissimilar (though I remind myself that the 'BD' elements of the marks are conceptually neutral). I have found that the opponent's mark is inherently distinctive to no more than a medium degree.

39. Taking all of the above into account and even bearing in mind the principle of imperfect recollection, I do not consider that these marks will be inaccurately recalled or misremembered for one another. While they share the dominant element of 'BD', I consider that the points of difference between the marks are sufficient to enable the average consumer to recall which mark was which. Consequently, I do not consider that there is a likelihood of direct confusion between these marks, even bearing in mind that the goods at issue are identical.

40. I turn now to consider indirect confusion. In doing so, I remind myself of the case of *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, wherein Mr Iain Purvis Q.C., as the Appointed Person, explained that:

> "16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually 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)".

41. Further, I note the case of *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, wherein Arnold LJ referred to the comments of James Mellor Q.C. (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at paragraph 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". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

42. When confronted with the parties' marks, I am of the view that it is the shared 'BD' element that would be viewed as the indicator of origin for both marks. I appreciate that this element is not highly distinctive, however, I do not consider that its shared use would be coincidental as it neither alludes to nor describes the goods at issue. As a result, I am of the view that the identity of this element forms the basis for a

finding that the consumer would believe that the marks at issue are from the same or economically linked undertakings. I make this finding primarily on the basis that the additional element of 'BAGGIES' would be viewed as a logical indicator that the 'BD' brand has created a sub-brand that deals with loose-fitted clothing. For example, in a scenario where the average consumer views the opponent's mark on sportswear and then views the IR on footwear, the consumer will believe that the shared 'BD' element was the primary indicator of the undertaking responsible for the goods and that the addition of the word' BAGGIES' was simply one that was used to indicate that the sportswear goods under that branding were loose-fitting clothing goods. In light of the comments of Mr Purvis Q.C. in *L.A. Sugar* (cited above), this is plainly a circumstance where indirect confusion would exist. As for the differences in stylisation between the marks, I am of the view that this would be chalked up to alternative marks being used by the same or economically linked undertakings. Lastly, I remind myself that the marks are conceptually dissimilar and that the shared element between them is conceptually neutral. Neither of these factors take away from the finding that consumers would believe the marks to originate from the same or economically linked undertakings. Consequently, even bearing in mind the comments of Arnold LJ and Mr Mellor Q.C. in the preceding paragraph, I consider that there exists a likelihood of indirect confusion between the marks.

CONCLUSION

43. The opposition has succeeded in its entirety. Therefore, subject to any successful appeal, the IR is refused protection in the UK in respect of all goods.

COSTS

44. As the opponent has succeeded in full, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. I appreciate that the evidence filed by the opponent was not particularly relevant to the decision I have made. Ordinarily, this would result in either a lower costs award in respect of the evidence rounds or, in some circumstances, no costs award

whatsoever. However, the decision to not assess the evidence in full was due to the approach that I decided to take rather than because the evidence was of no assistance. As a result, I am of the view that it is still appropriate to grant the opponent costs for the filing of its evidence.

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

Preparing a notice of opposition and considering the counterstatement:	£200
Filing evidence and submissions:	£500
Official fees:	£100
Total:	**£800**

46. I hereby order BACK DOOR S.R.L. to pay G. & G. S.r.l. the sum of £800. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 16th day of April 2024

A COOPER
For the Registrar