O/0451/25

TRADE MARKS ACT 1994

IN THE MATTER OF THE DESIGNATION OF INTERNATIONAL REGISTRATION NO. WO0000001734532 BY NEUE WELT BRANDS GMBH FOR PROTECTION IN THE UNITED KINGDOM OF THE FOLLOWING TRADE MARK:

IN CLASSES 9, 28 AND 41

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NO. 444950 BY COULTER VENTURES, LLC

BACKGROUND AND PLEADINGS

1. International trade mark 1734532 ("the IR") consists of the sign shown on the cover page of this decision. The IR is registered with effect from 28 April 2023 and the holder is Neue Welt Brands GmbH. 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 to the Madrid Agreement. I note that the mark also claims a priority date of 20 January 2023 from Trade Mark no. 18825446. The holder seeks protection for the following goods and services:

Mobile apps (class 9)

Sports equipment (class 28)

Education, entertainment and sport services; live performance services; organisation of sporting events; conducting of sports events; arranging and conducting of sporting events; conducting of live sports events; providing sporting events; event management services being arranging and conducting of sporting events; arranging and conducting of sports events; organising of sporting activities and of sporting competitions (class 41)

2. The request to protect the IR was published on 29 September 2023. On 28 December 2023, Coulter Ventures, LLC ("the opponent") opposed the protection of the IR in the UK, in part, under section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The scope of the opposition extends to the goods applied for in class 28 only. For the purpose of the opposition, the opponent relies upon the following trade mark and all goods for which it is registered, as laid out below:

United Kingdom Trade Mark ("UKTM") 3418971:

OSO

Filing date: 5 August 2019
Registration date: 25 October 2019

Barbells; barbell collars and rubber plugs therefor; safety blocks for barbells (class 28)

3. By virtue of raising an objection under section 5(2)(b), the opponent contends that the parties' respective marks are similar and that the competing goods are identical or similar, giving rise to a likelihood of confusion on the part of the average consumer.

4. In its counterstatement, the holder denies that the parties' marks are similar, submitting instead that there are "clear differences" between them. As for the parties' specifications, the holder puts the opponent to proof of its claim that the respective goods are identical or similar, noting that ""barbells" and other goods for use with barbells" represent "a very specialist and niche category of products."

5. The holder is represented by Marks & Clerk LLP and the opponent by Bird & Bird LLP. Neither party filed evidence during the course of the proceedings and neither requested a hearing, though both elected instead to file written submissions in lieu. This decision is taken following a careful perusal of the papers.

DECISION

Relevance of EU law

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.

Section 5(2)(b) grounds

7. Section 5(2)(b) of the Act 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."

8. Section 5A of the Act reads as follows:

"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."

9. By virtue of the marks' respective filing and priority dates, the opponent's trade mark clearly qualifies as an earlier mark pursuant to section 6 of the Act. As the opponent's mark had not completed its registration process more than 5 years before the priority date at issue it is not subject to the proof of use provisions laid out in section 6A of the Act. Consequently, the opponent is able to rely upon its mark and all goods for which it is registered without providing evidence of use.

Section 5(2)(b) – case law

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

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

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

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

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

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

11. The competing goods are laid out at paragraphs 1 and 2 to this decision.

12. In addition to cases of *literal* identity, the General Court ("GC") set out a further provision as to when goods can be considered identical in *Gérard Meric v Office for Harmonisation in the Internal Market*[1]. It stated:

> "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".

13. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

[1] Case T-133/05

(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.

14. In *Kurt Hesse v OHIM*[2], the Court of Justice of the European Union ("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)*[3], 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."

Sports equipment

15. Whilst I have noted the holder's comments regarding the 'niche' nature of the opponent's goods, the term applied for is broad in nature, such that I find it likely to be encompassing of the opponent's goods which may naturally be described as "sports equipment". The holder contends that ""barbells" and goods for use in relation to such goods are aimed at fitness or exercise with very specific purposes rather than for use in sports (for example, "barbell collars and rubber plugs therefor" are for the purpose of

[2] Case C-50/15 P
[3] Case T-325/06

retaining a weighted plate on a barbell rather than for the purpose of undertaking a sporting or athletic activity), and there is some room for distinguishing the goods on this basis". In my view, there is not a great distinction here. *Sports equipment* is a wide-reaching term which could include, for example, equipment which is used for weight-lifting which, to my knowledge, would directly include equipment such as barbells, for example. With that in mind, I find the parties' goods are identical.

16. In the alternative, if the goods relied upon by the opponent would not naturally fall within the remit of the holder's "sports equipment", I find there is at least a high degree of similarity. Even if the opponent's goods are more concerned with "fitness or exercise", as the holder contends, I find they are nonetheless likely to be used for a similar purpose to *sports equipment*. The goods are likely to be selected by the same consumers and reach the market through the same channels of trade. Given the broad nature of the holder's *sports equipment*, in some circumstances there may be some elements of physical similarity between the goods. Though not necessarily indispensable in all cases, it would not seem unreasonable for the average consumer to expect that the same entity would provide both parties' goods. Given the closeness in the goods' purpose, there may also be some instances whereby the goods occupy competitive roles.

The average consumer and the nature of the purchasing act

17. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which the goods 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.”

18. The average consumer of the goods at issue is likely to predominantly comprise members of the general public, though it seems reasonable to assume that the goods will also be purchased on a professional basis; to equip a fitness suite or with the intention to train clients, for example. As the goods are likely to be selected from the pages of a catalogue or an online resource, the marks’ visual impression is consequently likely to carry the greatest weight, though I do not discount the relevance of the marks’ aural impact, particularly as word-of-mouth recommendations may be offered by colleagues or peers, for example. To my knowledge, the cost associated with the goods is unlikely to be particularly high and the purchase will not be made with any real degree of frequency. Nevertheless, the average consumer is likely to be alive to considerations such as quality and compatibility when approaching their purchase. Weighing all factors, I find the average consumer is likely to apply at least a medium degree of attention during the selection process, slightly higher than medium for a professional consumer.

Comparison of trade marks

19. 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 *Bimbo SA v OHIM*[4], 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

[4] Case C-591/12P

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

20. 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.

21. For ease, the parties' trade marks are displayed in the table below:

Opponent's trade mark	Holder's trade mark
OSO	

22. The opponent's mark comprises a single word of three letters (O-S-O). In the absence of any additional components, the mark's overall impression therefore resides solely in the word itself.

23. The holder's mark is figurative, with its comprising components positioned in a vertical column. I find the mark's overall impression to reside in the device as a whole.

24. I refer below to the parties' comments on the marks' visual impressions, beginning with the opponent:

"Visually, the Contested Mark visibly contains the letters O S O. The middle letter S is stylized and reads as the word OSO which is identical to the Earlier Mark. Even if consumers read the contested mark as OSSO, which is not conceded, the

Contested Mark remains highly similar to the Earlier Mark and the middle S is likely to go unnoticed by the relevant consumer. The Contested Mark and the Earlier Mark therefore coincide and are identical. The stylization adopted in the Contested Mark is minimal and does not detract from the clear overall impression of the mark, which is the word OSO. In any event, as the Earlier Mark is a word mark, it affords the Opponent with protection for the word OSO regardless of the stylisation adopted."

25. The holder contends as follows:

"15. Visually, there are clear differences between the marks. The Applicant's figurative mark has a striking and memorable appearance. As mentioned in our Notice of Defence and Counterstatement, we submit that the presentation of the figurative elements of the Applicant's mark in vertical form is such that consumers may view this representation of a spring with bolts at either end. Particularly in the context of the class 28 goods in question, the image of a spring may naturally come to mind when consumers view the Applicant's mark given that muscles and tendons behave like a spring in the body during sporting / athletic activities.

16. While we submit the above is the most likely specific visual impression conveyed by the mark, the graphic appearance of the mark is so unusual and striking that it is also possible consumers may perceive the mark as a purely abstract figurative mark consisting of two rectangles connected by a sinuous line, all with a right-hand tile. Due to the strong stylization of the Applicant's mark, consumers may in fact have no reason to examine the design and the geometric shapes to consider whether they may be letters, numbers or form an overall image, particularly as the average consumer will not break down a mark into its individual elements (rather they will consider the overall impression of the mark as a whole).

17. On the basis of the above we submit the marks are visually dissimilar."

26. To my mind, the degree of visual similarity between the parties' marks will rely in part on the consumer's interpretation of the holder's mark. In trying to determine the most

likely interpretation, having kept in mind that the average consumer will naturally be inclined to look for identifiable elements within a mark, I find it likely that at least a significant proportion of consumers will interpret the mark as a stylised or italicized series of letters (O-S-S-O) presented in a vertical orientation. Where that is the case, I find there is some visual coincidence between the marks insofar as the marks each comprise a combination of letters 'O' and 'S' with an 'O' positioned at both the beginning and end of the respective word. Keeping in mind the differences in the marks' presentation, and having regard to what fair and notional use of the opponent's word mark would likely extend to, where the holder's mark is recognized as a series of letters, namely O-S-S-O, I find the marks' visual similarity is of at least a medium degree.

27. I accept, however, that there may be some consumers who will not identify the holder's mark as the word O-S-S-O, or indeed a word at all. Instead, the consumer may interpret the mark as simply a figurative combination of lines and shapes. Whilst this may give rise to a finding of a lower degree of visual similarity between the marks, given that the 'shapes' in the holder's mark are (at least) dimensionally evocative of the letters O-S-S-O, I do not consider it will be reduced to any meaningful extent. In the scenario that the holder's mark is not perceived as a word, I find the marks' visual similarity is between a low and medium degree.

28. For completeness, I have considered the holder's other propositions concerning the possible interpretation(s) of its mark. It submits, for example, that its mark may be perceived as "depicting either four numbers ("0550") or a combination of letters and numbers ("O55O")". I find this an unlikely interpretation. In my view, the consumer will be more inclined to identify letters within the marks than numbers and I find the curves applied to the mark's central digits more consistent with the letter 'S' than the number '5'. In relation to the holder's comments regarding its mark being viewed as a spring, even when considered in the context of the relevant goods, I find this a highly unlikely perception. Even if some consumers do perceive the mark in either of these ways, they are unlikely to constitute a significant proportion of the average consumer. I therefore do not intend to discuss either of these interpretations any further.

29. Finally, I have also considered the opponent's submission in which it contends that the holder's mark will be viewed as the word 'OSO' (above). I find the central element(s)

in the holder's mark will be viewed as two distinct 'S' letters (or shapes resembling the same), rather than a single letter. It would seem highly unusual, to my mind, for the consumer to view a shape or unit of that length as a single letter (S), rather than two joined together (SS).

30. Aurally, the opponent's mark will likely be articulated in two syllables; either OSS-OH or OH-SO. Where the holder's mark is identified as a four-letter word I find it likely to be articulated also in two syllables; either OSS-OH or OH-SO. For the average consumer who identifies the mark in this way, the aural similarity is either of a high degree or the marks are aurally identical. Where the consumer views the holder's mark as a figurative combination of shapes, I find it highly unlikely that it will attempt to verbalise it at all. In such circumstances, the aural position is neutral, i.e. one mark will be aurally articulated and the other will not.

31. From a conceptual perspective, the holder contends that:

> "29. Conceptually, whatever theoretical verbal reading of the Applicant's mark is reached, neither mark has a clear conceptual meaning and a comparison based on verbal elements is therefore not possible.
>
> 30. However, we submit the Applicant's mark would be viewed by consumers as a figurative representation of a spring and this concept is completely absent from the Opponent's mark and the marks must be considered conceptually different."

32. The opponent, in turn, submits:

> "22. Conceptually, both the Contested Mark and the Earlier Mark do not have any meaning in relation to the respective goods. Therefore, a conceptual comparison is not possible."

33. The conceptual position must be considered from the perspective of the average consumer. To my mind, the opponent's mark 'OSO' is likely to be perceived as an invented word, absent of any conceptual indication. The holder's mark, where identified

as a figurative expression of the word 'OSSO', is also likely to be viewed as an invented word and, consequently, it is unlikely to convey any conceptual meaning to the average consumer. On that basis, there is no conceptual comparison to be undertaken.

34. I make much the same finding in circumstances whereby the average consumer perceives the holder's mark as a figurative combination of lines and shapes. The mark remains unlikely to convey anything conceptual and, consequently, there is no conceptual comparison to be made.

Distinctive character of the earlier trade mark

35. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*,[5] 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 C-108/97 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 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

[5] Case C-342/97

industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)."

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

37. In the absence of evidence showing the use made of the earlier mark, I have only the inherent position to consider. I have already found that OSO is likely to be perceived by the average consumer as an invented word which does not convey any specific meaning. I do not, therefore, consider the mark descriptive or allusive in any regard when considered against the relied upon goods. That being said, the word itself is fairly short and not particularly elaborate. Weighing those findings, I find the earlier mark enjoys a fairly high degree of inherent distinctiveness.

Likelihood of confusion

38. In determining whether there is a likelihood of confusion, 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 vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark, as the more distinctive it is, the greater the likelihood of confusion. Conversely, the less distinctive it is, the lower the likelihood of confusion.

39. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods down to the responsible undertakings being the same or related.

40. I take note of the comments made by Mr Iain Purvis Q.C., as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*[6], where he 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."
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> 17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:
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> (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).
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> (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)".

[6] Case BL O/375/10

41. To make the assessment, I must adopt the global approach advocated by the case law whilst taking account of my earlier conclusions. I also bear 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.

42. Throughout my decision, I have found the marks are visually similar to either an at least medium or between a low and medium degree, they are aurally similar to either an identical or highly similar degree or the position is neutral and, with neither mark (and neither interpretation of the holder's mark) likely to convey any meaningful concept, there is no conceptual comparison to be made. The average consumer is likely to apply at least a medium degree of attention to its selection of the relevant goods (slightly higher for a professional consumer), with the marks' visual impression carrying the greater weight, though I do not overlook the relevance of the marks' aural impression. I have found that the parties' goods are identical (or at least highly similar). The earlier mark enjoys a fairly high degree of inherent distinctiveness.

43. I turn first to a likelihood of direct confusion. I begin by approaching the likelihood from the perspective of the average consumer who will perceive the holder's mark as a series of letters, specifically O-S-S-O. In these circumstances, notwithstanding the vertical positioning and italicising applied to the holder's mark, in my view the words OSO and OSSO would be imperfectly recollected by the average consumer. Neither offers the consumer a tangible concept which it can recall (on repeat purchase, for example) and each is likely to be remembered as a relatively short word comprising letters O and S, with an O positioned at both the beginning and end. As a consequence, particularly in respect of identical or highly similar goods and with regard to the effects of the interdependency principle, I find this will lead to direct confusion on the part of the average consumer, whereby it erroneously concludes that it is encountering the same "OSO" or "OSSO" mark.

44. In the alternative, if there is found to be sufficient difference between the marks to overcome a likelihood of direct confusion, I turn briefly to consider a likelihood of indirect confusion. What is most likely to be identified as a difference between the parties' marks is the adopted stylisation in the holder's mark (or a lack thereof in the opponent's mark).

Whilst this may enable the average consumer to identify that the later mark is not the same as the earlier mark (or vice versa), I maintain the view that the consumer will nonetheless misremember the marks' OSO/OSSO element, particularly on account of the lack of conceptual insight from either word. That being so, even if the consumer readily acknowledges that the marks are not the same, it would be minded to conclude, for example, that the later mark is an aesthetically revised version of the original mark. In other words, where direct confusion is not engaged, by virtue of the misremembering of words OSO and OSSO, I find the marks will be indirectly confused.

45. Where the holder's mark is perceived as simply a figurative device of various shapes or lines, I see no reason why the average consumer would confuse the marks directly or indirectly. If the consumer does not perceive any letter or word elements within the holder's mark, it will make no association between this and the opponent's mark. The marks will instead be viewed as two distinct marks derived from unrelated undertakings.

46. The conclusions I have reached throughout the course of my decision have led me to two different findings; one a likelihood of both direct and indirect confusion and the other no confusion at all, determined by the way in which the average consumer will perceive the holder's mark. In that respect, I keep in mind *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation*[7], in which Kitchin LJ considered the characteristics of the average consumer. Although this was an infringement case, the principles apply equally under section 5(2):

> "34 ….. This court considered the characteristics of the average consumer at some length in *Interflora Inc v Marks and Spencer plc* [2015] EWCA Civ 1403, [2014] FSR 10 from [107] to [130]. The following general points emerge further to those set out above:
>
> > i) the average consumer is a hypothetical person or, as he has been called, a legal construct; he is a person who has been created to strike the right balance between the various competing interests including, on the one hand, the need to protect consumers and, on the other hand, the promotion

[7] [2016] EWCA Civ 41

of free trade in an openly competitive market, and also to provide a standard, defined in EU law, which national courts may then apply;

ii) the average consumer is not a statistical test; the national court must exercise its own judgment in accordance with the principle of proportionality and the principles explained by the Court of Justice to determine the perceptions of the average consumer in any given case in the light of all the circumstances; the test provides the court with a perspective from which to assess the particular question it has to decide;

iii) in a case involving ordinary goods and services, the court may be able to put itself in the position of the average consumer without requiring evidence from consumers, still less expert evidence or a consumer survey. In such a case, the judge can make up his or her own mind about the particular issue he or she has to decide in the absence of evidence and using his or her own common sense and experience of the world. A judge may nevertheless decide that it is necessary to have recourse to an expert's opinion or a survey for the purpose of assisting the court to come to a conclusion as to whether there is a likelihood of deception;

iv) the issue of a trade mark's distinctiveness is intimately tied to the scope of the protection to which it is entitled. So, in assessing an allegation of infringement under Article 5(1)(b) of the Directive arising from the use of a similar sign, the court must take into account the distinctiveness of the trade mark, and there will be a greater likelihood of confusion where the trade mark has a highly distinctive character either per se or as a result of the use which has been made of it. It follows that the court must necessarily have regard to the impact of the accused sign on the proportion of consumers to whom the trade mark is particularly distinctive;

v) if, having regard to the perceptions and expectations of the average consumer, the court concludes that a significant proportion of the relevant public is likely to be confused such as to warrant the intervention of the court then it may properly find infringement."

47. In *Soulcycle Inc v Matalan Ltd*[8], Mann J. approved the approach of the Hearing Officer at first instance in considering the reactions of average consumers who did, and did not, recognise the word SOUL within the mark SOULUXE. The judge said:

> "27. I do not consider that the Hearing Officer made an error of principle in this respect. In considering the question of the effect of the mark within the class, by reference to proportions who did not share the same view, he was following the same line as that pursued by Arnold J at first instance in *Interflora Inc v Marks and Spencer plc* [2013] EWHC 1291 (Ch). Arnold J considered at some length whether there was a "single meaning rule" in trade mark law under which the court had to identify one, and one only, perception amongst the relevant class of average consumer, and judge confusion accordingly. At paragraph 213 he found there is no such rule and then set out his reasoning over the following paragraphs. Paragraph 224 set out important parts of his conclusion; the references to Lewison LJ is to that judge's judgment in an earlier case.
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> > "224 … Thirdly, Lewison LJ expressly accepts that a trade mark is distinctive if a significant proportion of the relevant public identify goods as originating from a particular undertaking because of the mark. Thus he accepts that there is no single meaning rule in the context of validity. As I have said, that is logically inconsistent with a single meaning rule when one comes to infringement. Fourthly, the reason why it is not necessarily sufficient for a finding of infringement that "some" consumers may be confused is that, as noted above, confusion on the part of the ill-informed or unobservant must be discounted. That is a rule about the standard to be applied, not a rule requiring the determination of a single meaning. If a significant proportion of the relevant class of consumers is confused, then it is likely that confusion extends beyond those who are ill-informed or unobservant. Fifthly, Lewison LJ does not refer to many of the authorities discussed above, no doubt because they were not cited. Nor does he discuss the nature of the test for the assessment of likelihood of confusion laid down by the Court of Justice. The legislative

[8] [2017] EWHC 496 (Ch)

criterion is that "there exists a likelihood of confusion on the part of the public". As noted above, the Court of Justice has held that "the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion". This is not a binary question: is the average consumer confused or is the average consumer not confused? Rather, it requires an assessment of whether it is likely that there is, or will be, confusion, applying the standard of perspicacity of the average consumer. It is clear from the case law that this does not mean likely in the sense of more probable than not. Rather, it means sufficiently likely to warrant the court's intervention. The fact that many consumers of whom the average consumer is representative would not be confused does not mean that the question whether there is a likelihood of confusion is to be answered in the negative if a significant number would be confused." (my emphasis)

28. That justifies a consideration of confusion in relation to a proportion of the class of average consumer by reference to perceptions, in the manner in which the Hearing Officer went about the matter. It also justifies applying the same technique (where appropriate on the facts) to validity and infringement proceedings alike."

48. Having carefully considered my earlier findings against the case law reproduced above, I am satisfied that a significant proportion of consumers will perceive the holder's mark as a representation of the word OSSO and, consequently, will either directly or indirectly confuse the parties' respective trade marks.

Conclusion

49. The opposition succeeds. Subject to any successful appeal against this decision, the application will be refused in respect of:

Sports equipment (class 28)

50. The application may proceed to registration in respect of all goods and services which were not opposed, namely:

Mobile apps (class 9)

Education, entertainment and sport services; live performance services; organisation of sporting events; conducting of sports events; arranging and conducting of sporting events; conducting of live sports events; providing sporting events; event management services being arranging and conducting of sporting events; arranging and conducting of sports events; organising of sporting activities and of sporting competitions (class 41)

Costs

51. As the opponent has succeeded, it is entitled to a contribution toward its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice ("TPN") 1/2023. In accordance with that TPN, I award the costs to the opponent as follows:

Preparing a Notice of Opposition and considering the applicant's counterstatement:	£250
Preparing written submissions in lieu of a hearing:	£250
Official fees:	£100
Total:	**£600**

52. I hereby order Neue Welt Brands GmbH to pay Coulter Ventures, LLC the sum of £600. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 22nd day of May 2025

Laura Stephens
For the Registrar