O/0592/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NUMBER UK00003988468

BY LOOP KINETICS LTD

TO REGISTER THE FOLLOWING TRADE MARK:

Loop Kinetics

IN CLASS 25

AND

AN OPPOSITION THERETO UNDER NUMBER OP000445872

BY FLO MAGAZACILIK VE PAZARLAMA ANONIM SIRKETI

BACKGROUND AND PLEADINGS

1. On 06 December 2023, Loop Kinetics Ltd ("the applicant") applied to register in the UK the trade mark shown on the cover page of this decision ("the contested mark"). The application was accepted and published for opposition purposes on 22 December 2023 and registration is sought for the following goods:

   Class 25: Clothing; Knitwear [clothing]; Jackets [clothing];Ready-to-wear clothing; Woolen clothing; Garments for protecting clothing; Clothes; Gloves as clothing; Gloves [clothing]; Jerseys [clothing];Shorts [clothing];Knitted clothing; Embroidered clothing; Windproof clothing; Wristbands [clothing];Casual clothing; Rainproof clothing; Waterproof clothing; Jackets being sports clothing; Jackets (Stuff -) [clothing];Stuff jackets [clothing]; Clothing for leisure wear; Ready-made clothing; Bottoms [clothing]; Trunks being clothing; Playsuits [clothing]; Woven clothing; Infant clothing; Clothing for sports; Sports clothing; Leisure clothing; Athletic clothing; Clothing for children; Bodies [clothing];Tops [clothing];Weatherproof clothing; Clothing for cycling; Water-resistant clothing; Fabric belts [clothing];Pockets for clothing; Handwarmers [clothing]; Clothing for skiing; Triathlon clothing; Thermal clothing; Men's clothing; Dance clothing.

2. On 15 February 2024, Flo Magazacilik Ve Pazarlama Anonim Sirketi ("the opponent") opposed the application in full under section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opponent relies upon the following mark:[1]

   UK trade mark number: UK00003676502

[1] The opponent initially relied on three earlier marks, however two were subject to proof of use, as no evidence was provided reliance on those two earlier marks was struck out.

Filing date: 22 January 2020[2]

Registration date: 28 January 2022

Relying upon the following goods:

Class 18: Leather and imitations of leather; animal skins and hides; luggage and carrying bags; umbrellas and parasols; walking sticks; whips, harness and saddlery; collars, leashes and clothing for animals.

Class 25: Clothing, footwear, headwear.

Class 28: Games, toys and playthings; video game apparatus; gymnastic and sporting articles; decorations for Christmas trees.

3. Given the filing date, the opponent's mark is an earlier mark, in accordance with section 6 of the Act. However, as it had not been registered for five years or more at the filing date of the application, it is not subject to the proof of use requirements specified within section 6A of the Act. As a consequence, the opponent may rely upon all of the services for which the earlier mark is registered without having to establish genuine use.

4. Under section 5(2)(b), the opponent claims that there is a likelihood of confusion on the basis that the marks are similar and the goods are identical or similar.

5. The applicant filed a defence and counterstatement denying a likelihood of confusion on the basis of a lack of similarity between the marks. The applicant also submits that the goods are different in their construction, features and target market.

[2] On 1 January 2021, the UK left the EU after the expiry of the transition period. Under Article 59 of the Withdrawal Agreement between the UK and EU, applications for EUTMs made before the end of the transition period that had received a filing date can form the basis of a UK application with the same filing date as the corresponding EUTM, provided they were filed within 9 months of the end of the transition period. The applicant's EUTM number 18186387 was filed at the EUIPO on 22/01/2020, whereas its UK application was filed on 03 August 2021. Accordingly, the UK application was given the same filing date as its EUTM.

6. The opponent is represented by Stobbs; the applicant is unrepresented. Neither party filed evidence. Neither party requested a hearing nor did they file written submissions in lieu. This decision is therefore taken following a careful perusal of the papers.

DECISION

Legislation

7. Sections 5(2)(b) and 5A of the Act state:

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

Section 5(2)(b) - case law

8. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying

assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

9. 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.

   (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; Page 8 of 20

(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

10. All relevant factors relating to the goods should be taken into account, which include, inter alia:[3]

    • the physical nature;

    • their intended purpose;

[3] See *Canon*, Case C-39/97, paragraph 23; and *British Sugar PLC v James Robertson & Sons Ltd.,* [1996] R.P.C. 281 – the "*Treat*" case.

• their method of use / uses;

• who the users of the goods are;

• the trade channels through which the goods reach the market;

• in the case of self-serve consumer items, where in practice they are found or likely to be found in shops and in particular whether they are, or are likely to be, found on the same or different shelves; and

• whether they are in competition with each other (taking into account how those in trade classify goods, for instance whether market research companies put them in the same or different sectors)

or

• whether they are complementary to each other. Complementary signifying that "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".[4] Noting that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity.[5]

11. When interpreting the terms in a specification, I bear in mind that it is necessary to focus on the core of what is being described and that 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 and 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.[6]

[4] *Boston Scientific Ltd v OHIM*, Case T-325/06, paragraph 82, see also *Sandra Amalia Mary Elliot v LRC Holdings Limited,* BL O/255/13
[5] *Kurt Hesse v OHIM*, Case C-50/15 P, se also *Sanco SA v OHIM*, Case T-249/11
[6] *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), paragraphs 11 - 12

12. Furthermore, I bear in mind the approach in *Sky v Skykick,*[7] where Lord Justice Arnold set out the correct approach to interpreting broad and/or vague terms.

> "365. […] The correct approach, as a matter of principle, in considering a specification of services which is defined by terms which are not clear or precise, is to confine the terms used to the substance or core of their possible meanings: see, for example, *Reed Executive plc v Reed Business Information Ltd* [2004] EWCA Civ 159; [2004] RPC 40, at para 43. So too, if a specification of goods is defined by terms which are ambiguous, then it should be confined to those goods which are clearly covered. These principles are consistent with first, the requirement that the specifications of goods and services must be clear and precise so that others know what they can and cannot do; and secondly, general fairness because any ambiguity is the responsibility of the owner of the mark. If despite this, the words used are still unclear so that they cannot be interpreted, then it is permissible to disregard them. But, in my opinion, that will rarely be the case."

13. In *Gérard Meric v Office for Harmonisation in the Internal Market ('Meric'),*[8] the General Court held that goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application and vice versa.

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

The opponent's goods	**The applicant's goods**
Class 18: Leather and imitations of leather; animal skins and hides; luggage and carrying bags; umbrellas and parasols; walking sticks; whips, harness and saddlery; collars, leashes and clothing for animals.	Class 25: Clothing; Knitwear [clothing]; Jackets [clothing];Ready-to-wear clothing; Woolen clothing; Garments for protecting clothing; Clothes; Gloves as clothing; Gloves [clothing]; Jerseys

[7] [2020] EWHC 990, (Ch),
[8] Case T-133/05, paragraph 29.

Class 25: Clothing, footwear, headwear. Class 28: Games, toys and playthings; video game apparatus; gymnastic and sporting articles; decorations for Christmas trees.	[clothing];Shorts [clothing];Knitted clothing; Embroidered clothing; Windproof clothing; Wristbands [clothing];Casual clothing; Rainproof clothing; Waterproof clothing; Jackets being sports clothing; Jackets (Stuff -) [clothing];Stuff jackets [clothing]; Clothing for leisure wear; Ready-made clothing; Bottoms [clothing]; Trunks being clothing; Playsuits [clothing]; Woven clothing; Infant clothing; Clothing for sports; Sports clothing; Leisure clothing; Athletic clothing; Clothing for children; Bodies [clothing];Tops [clothing];Weatherproof clothing; Clothing for cycling; Water-resistant clothing; Fabric belts [clothing];Pockets for clothing; Handwarmers [clothing]; Clothing for skiing; Triathlon clothing; Thermal clothing; Men's clothing; Dance clothing.

15. I note that the applicant claims the marks operate in different industries; the applicant submits that it offers clothing goods containing wearable/smart/e-Textile technology integration whilst the opponent provides conventional sportswear.[9] However, as the registered mark is less than five years old at the date of application of the contested mark, I must assess the similarity of the goods based on notional use of the specification registered or applied for, rather than how the goods are actually being used on the market in practice.

[9] Applicant's counterstatement, page 2.

"Clothing; Knitwear [clothing]; Jackets [clothing]; Ready-to-wear clothing; Woolen clothing; Garments for protecting clothing; Clothes; Gloves as clothing; Gloves [clothing]; Jerseys [clothing]; Shorts [clothing]; Knitted clothing; Embroidered clothing; Windproof clothing; Wristbands [clothing]; Casual clothing; Rainproof clothing; Waterproof clothing; Jackets being sports clothing; Jackets (Stuff -) [clothing]; Stuff jackets [clothing]; Clothing for leisure wear; Ready-made clothing; Bottoms [clothing]; Trunks being clothing; Playsuits [clothing]; Woven clothing; Infant clothing; Clothing for sports; Sports clothing; Leisure clothing; Athletic clothing; Clothing for children; Bodies [clothing];Tops [clothing];Weatherproof clothing; Clothing for cycling; Water-resistant clothing; Fabric belts [clothing]; Handwarmers [clothing]; Clothing for skiing; Triathlon clothing; Thermal clothing; Men's clothing; Dance clothing."

16. The applicant's above goods are all types of clothing and therefore fall within the opponent's broader term "Clothing, footwear, headwear". They are therefore identical on the principle outlined in *Meric.*

Pockets for clothing

17. Unlike the rest of the applicant's specification, pockets are not finished articles of clothing instead, they are components of such articles, and I keep in mind that one good being a component of another is not alone sufficient for a finding of similarity.[10] I acknowledge that there will be a distinction in both use and users. Clothing is selected by consumers for its 'ready-to-wear' attributes, whereas its components are primarily selected to fulfil a role in the manufacturing or creation of clothing. In my experience, the average consumer for clothing, at large, is the general public, whereas the average consumer for clothing components is likely to be a smaller demographic made up of those with the intention of making clothes, either for personal use or on a professional level. When it comes to the goods' physical nature, whilst the finished articles are likely to differ, there is likely to be a degree of similarity in the material used to necessitate compatibility between the components and the finished article. However, I do not consider the trade channels will overlap as parts of clothing are likely to be purchased through craft or wholesale

[10] *Les Editions Albert Rene v OHIM,* Case T-336/03

suppliers for use in the manufacture of clothing; they are less likely to be sold by fashion retailers. Further, given their different states, the goods are unlikely to be competitive. On balance, I find the goods are similar to a low degree.

The average consumer and the purchasing act

18. It is necessary for me to determine who the average consumer is for the goods in question; I must then determine the manner in which the goods are likely to be selected by the average consumer in the course of trade.

19. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. 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 in question: *Lloyd Schuhfabrik Meyer, Case C-342/97.* 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:

> "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 average consumer of the clothing goods is likely to be the general public with the goods self-selected from the shelves of traditional high street retail outlets or their online equivalents, or in the case of pockets for clothing, those with the intention of making clothes, either for personal use or on a professional level, such as a business or clothing manufacturer. The goods may vary in price, but none are likely to be prohibitively expensive and will be purchased reasonably frequently. However, various factors are still likely to be taken into consideration during the

purchasing process, such as materials used, cut, aesthetic appearance and durability. Given the process of selection, the marks' visual impact is likely to play the greater role[11], though I do not discount the opportunity for aural recommendations made by salespeople, for example. Weighing all factors, I find that both groups of average consumers will apply a medium (average) level of attention to the purchase.

Comparison of marks

21. It is clear from *Sabel* 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 Court of Justice of the European Union ("CJEU") states at paragraph 34 of its judgment in *Bimbo*, 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 relevant 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."

22. It would be wrong, therefore, to dissect the trade marks artificially, although it is necessary to take into account the distinctive and dominant components of the trade 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.

23. The marks to be compared are as follows:

[11] *New Look Limited v OHIM*, Joined cases T-117/03 to T-119/03 and T-171/03, paragraph 50

The opponent's earlier mark	The applicant's contested mark
	**Loop Kinetics**

24. The opponent's mark consists of the word "kinetix" in fairly standard text with a large figurative element in black and orange sat above which will be perceived as representing the letter X. Consumers attention is usually drawn to words that can be read such as the word "kinetix", however, given the size and positioning of the figurative letter X, I find that the word element and the figurative element dominate the mark in roughly equal measure.

25. The applicant's mark is a word only mark that consists of two words "Loop" and "Kinetics". The overall impression of the mark lies in the combination of these elements in equal measure.

Visually

26. The marks coincide in the highly similar words "kinetix" and "Kinetics", however, they differ in the additional elements found within the competing marks. The opponent's mark has a large figurative element that will be recognised as the letter X in orange and black which is sat above the word "kinetix". This is not replicated within the applicant's mark. Equally, the applicant's mark has the word "Loop" at the beginning of its mark which is absent from the opponent's mark. Consequently, there is, at best, a medium degree of visual similarity.

Aurally

27. Despite the differences in spelling, the highly similar words "kinetix" and "Kinetics" will be pronounced in the same way, i.e. "KIN-ET-ICS". As for the figurative element within the opponent's mark, although this will be perceived as the letter X, given how stylised this figurative element is, it is unlikely to be articulated by consumers. Consequently, the opponent's mark will have three syllables only, in contrast, the

applicant's mark contains the additional syllable "LOOP" at the beginning of its mark, resulting in the marks having different beginnings. Therefore, the marks are similar to at least a medium degree.

Conceptually

28. The word "kinetix" will be seen as a misspelling of "Kinetics". Therefore, the words will be perceived in line with the dictionary definition for Kinetics, i.e. the branch of mechanics, including both dynamics and kinematics, concerned with the study of motion or forces. However, the marks differ in the presence of the additional elements within the marks that are not found within the respective marks. The figurative letter X within the opponent's mark will be seen as such whilst in contrast, "Loop" will be understood in line with its dictionary definition as a shape produced by a curve that bends round and crosses itself. Nevertheless, the marks overlap in the concept arising from the highly similar words kinetix/Kinetics. Overall, due to the presence of the highly similar words, I find that the marks are conceptually similar to a medium degree.

Distinctive character of the earlier mark

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

> "22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases 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)."

30. 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 allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

31. The opponent has not filed any evidence to support that its mark's distinctive character has been enhanced through use. Consequently, I have only the inherent position to consider.

32. As discussed above, the earlier mark consists of the word "kinetix" along with a figurative letter X. As aforementioned the word "kinetix" will be identified as a misspelling of the word "kinetics" and will therefore be understood according to its dictionary definition, i.e. a branch of mechanics concerned with the study of motion or forces. As for the figurative element, this will be understood as the letter X. Therefore, the earlier mark contains a common, although highly figurative, letter and a dictionary defined word which are not descriptive or allusive of the goods for which the earlier mark is registered. Therefore, overall, the earlier mark possesses a medium level of inherent distinctive character.

Likelihood of confusion

33. 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 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 vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade 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 mind.

34. I have found:

- The goods to be either identical or similar to between a low and medium degree.
- The average consumer of the goods will be either the general public, or in the case of pockets for clothing, those with the intention of making clothes, either for personal use or on a professional level such as a business or clothing manufacturer; regardless, both groups of consumers will pay a medium (average) level of attention during the purchasing process.
- The purchasing process will be predominantly visual, however, I have not discounted aural considerations.
- The competing marks are visually similar to, at best, a medium degree, aurally similar to at least a medium degree and conceptually similar to a medium degree.
- The earlier mark to be inherently distinctive to a medium degree, with no evidence of enhanced distinctiveness before me.

35. Whilst the competing marks both contain the highly similar words "kinetix/Kinetics, they also contain further additional elements which are not found within the others mark. In the opponent's mark, this is a large figurative letter X in orange and black

which sits above the word “kinetix” and in my view would not go unnoticed by the average consumer given its size and position within the mark. In contrast, the applicant’s mark includes the word “Loop” at its beginning, a position where it is commonly recognised that consumers will focus most attention.[12] Therefore, these differences would prevent the marks from being mistaken for one another through imperfect recollection, even on identical goods. Therefore, I do not consider there to be a likelihood of direct confusion.

36. For the sake of completeness, I will also consider indirect confusion. Indirect confusion was described in the following terms by Iain Purvis QC (as he then was), sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*:[13]

> “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 recognised 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.

[12] *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02
[13] BL O/375/10

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)."

37. These three categories are not exhaustive; rather, they were intended to be illustrative of the general approach, as has been confirmed by the Court of Appeal. I recognise that a finding of indirect confusion should not be made merely because the competing marks share a common element. In this connection, it is not sufficient that a mark merely calls to mind another mark: this is mere association not indirect confusion.[14]

38. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ 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". 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.

39. As referred to in the above case law, indirect confusion exists where the differences between the marks are noticed, and those differences point to the existence of an economic relationship between the marks at issue.

[14] *Duebros Limited v Heirler Cenovis GmbH,* Case BL O/547/17

40. Having recognised the differences between the marks, I consider it unlikely that the average consumer will conclude that they originate from the same or economically linked undertakings. In my view, whilst the highly similar words "kinetix/kinetics" may be misremembered for one another, with "kinetix" being perceived as a misspelling of the word "kinetics". The word "kinetics" (nor its misspelling) is not so strikingly distinctive in relation to the goods that consumers will believe that only the applicant will be using them in a trade mark. Instead, the use of the highly similar elements "kinetix/kinetics" will be seen as merely coincidental, particularly when the marks are viewed as a whole. Equally, I do not consider this to be a case where the later mark has simply bolted on a non-distinctive element that would be identified as a sub brand or brand extension. Indeed, removing the figurative element (which I have found above co-dominates the overall impression of the opponent's mark in roughly equal measure) and replacing it with the word "Loop", fails to make logical sense as a sub brand or brand extension. Rather these differences between the marks will deter consumers from believing that they derive from the same undertaking. Consequently, overall, I do not consider there to be a likelihood of indirect confusion, even for identical goods.

CONCLUSION

41. The opposition under section 5(2)(b) of the Act has failed. Therefore, subject to any successful appeal against my decision, the application will proceed to registration.

COSTS

42. As the applicant has been successful, it is therefore, entitled to a contribution towards its costs. As the applicant is unrepresented, it was invited by the Tribunal on 12 September 2024 to indicate whether it intended to make a request for an award of costs in the event that it was successful, and if so, it was requested to

complete a costs proforma including accurate estimates of the number of hours spent on a range of given activities relating to defending the proceedings. The deadline for providing the costs proforma was 10 October 2024. However, the applicant failed to file a completed cost proforma with the Tribunal. Consequently, no award for costs will be made.

Dated this 30th day of June 2025

Sarah Wallace
For the Registrar