

O/0610/23

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION
NO. 3736716 BY
ABIGAIL HITCHEN
TO REGISTER AS A TRADE MARK:**

Toto The Pom

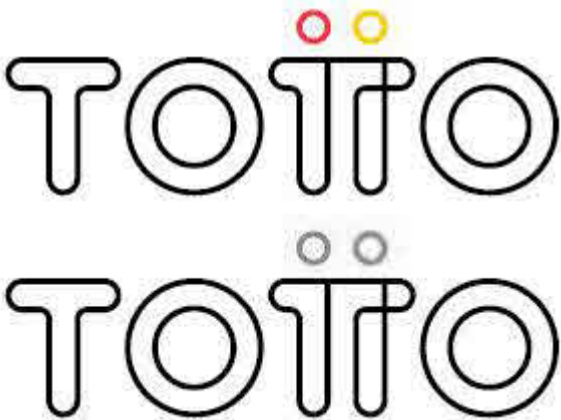
**IN CLASSES:
3, 8, 9, 12, 15, 16, 18, 20, 21, 25, 28, 30, 31, 35, 41 & 43**

AND

**OPPOSITION THERETO
UNDER NO. 433599
BY ESSENTIAL EXPORT, LIMITADA**

Background & Pleadings

1. Abigail Hitchen (“**the applicant**”) applied to register the mark shown on the front page of this decision in the United Kingdom. The application was filed on 24 December 2021 and was published on 18 February 2022. For the purposes of this opposition the relevant goods in the specification are shown in paragraph 19 of this decision.
2. ESSENTIAL EXPORT, LIMITADA (“**the opponent**”) filed an opposition on 18 May 2022 against the application on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent is the proprietor of the following series of marks:

Trade Mark no.	UK00003694923
Series of Two Marks	
Goods & Services Relied Upon	Classes 9, 16, 18, 20, 21, 25, 35
Relevant Dates	Filing date: 15 September 2021
	Date of entry in register: 17 December 2021
Priority details	Priority date: 10 September 2021 Priority country: European Union Intellectual Property Office (EUIPO) TM from which priority claimed: 018555967

3. For ease of reference, I will refer to the series of the earlier marks as the ‘earlier mark’, unless it becomes necessary to differentiate between the marks which comprise the series.

4. Under Section 6(1) of the Act, the opponent's trade mark clearly qualifies as an earlier trade mark. Further, as protection of the opponent's earlier mark was conferred less than five years before the application date of the contested mark, proof of use is not relevant in these proceedings as per Section 6A of the Act.
5. As shown in paragraph 19 of this decision, the opponent relies on only some goods and services for the purposes of this opposition proceedings.
6. The opponent in its notice of opposition claims that the contested mark is phonetically identical and visually highly similar to the earlier mark. It also asserts that the competing specifications contain identical or similar goods.
7. The applicant filed a defence and counterstatement, denying any similarity between the marks. She also admits that some goods and services are similar. I will address this later in this decision.
8. The opponent is represented by Vault LLP and the applicant is unrepresented. Neither party filed evidence. No hearing was requested and only the opponent filed written submissions in lieu. This decision is taken following a careful perusal of the papers.
9. Although the UK has left the EU, Section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

Decision

Section 5(2)(b)

10. Section 5(2)(b) of the Act is as follows:

“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”.

11. The principles considered in this opposition stem from the decisions of the European 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 BV* (Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market* (Trade Marks and Designs) (OHIM) (Case C-3/03), *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* (Case C-120/04), *Shaker di L. Laudato & C. Sas v OHIM* (Case C-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):

- 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 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 and Services

12. Section 60A of the Act provides:

“(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the “Nice Classification” means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975.”

13. When making the comparison, all relevant factors relating to the goods/services in the specifications should be taken into account. In *Canon Kabushiki Kaisha*, the Court of Justice of the European Union (“CJEU”) stated that:

“23. In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission

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

14. Guidance on this issue was also given by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited* (“*Treat*”) [1996] RPC 281. At [296], he identified the following relevant factors:

- “(a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found, or likely to be found, in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

15. The General Court (“GC”) confirmed in *Gérard Meric v OHIM*, Case T-133/05, paragraph 29, that, even if goods or services are not worded identically, they can still be considered identical if one term falls within the scope of another, or vice versa:

“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”.

16. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), paragraph 12, Floyd J (as he then was) gave the following guidance on construing the words used in specifications:

“[...] Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless, the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of ‘dessert sauce’ did not include jam, or because the ordinary and natural description of jam was not ‘a dessert sauce’. Each involved a straining of the relevant language, which is incorrect. 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.”

17. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU held that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods or services. The GC clarified the meaning of “complementary” goods or services in *Boston Scientific Ltd v OHIM*, Case T-325/06, at paragraph 82:

“[...] 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.”

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

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

19. The competing goods and services to be compared are shown in the following table:

Opponent's Goods and Services	Applicant's Goods
Class 9: Life-saving apparatus and instruments; Apparatus for recording sound and images; Apparatus for transmitting sound, data or images; Apparatus for reproducing sound; Apparatus for reproducing images; Downloadable software applications; Headphones; Magnetic recording media acoustic discs; Wireless headphones.	Class 9: E-books; Talking books; Audio books; Memo books [electronic]; Downloadable electronic books; Downloadable e-books; Electronic book readers; Digital book readers; Protective helmets for children; Musical cassettes; Music cassettes; Music software; Music recordings; Music headphones; Musical recordings; Music tapes; Downloadable music files; Portable music players; Juke boxes, musical; Downloadable digital music; Musical juke boxes.
Class 16: Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material, book covers, books; magazines; brochures; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; pencils; ballpoint pens; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); disposable training mats and pads and pads of paper or paperboard	Class 16: Books; Book wrappings; Log books; Appointment books; Recipe books; Cook books; Drawing books; Manuscript books; Score books; Birthday books; Autograph books; Copy books; Comic books; Sketch books; Commemorative books; Fiction books; Song books; Book covers; Cookery books; Children's books; Story books; Book bindings; Flip books; Gift books; Wedding books; Educational books; Book markers; Activity books; Sticker books; Agenda books; Printed books; Painting books; Scrap books; Writing books; Guide books;

for pets; Any kind of goods intended for sports purposes is expressly excluded.	Travel books; Fantasy books; Poster books; Music books; Book marks; Baby books; Exercise books; Colouring books; Coloring books; Picture books; Note books; Children's activity books; Pocket books [stationery]; Baby books [storybooks]; Travel guide books; Coffee table books; Wallpaper sample book; Pop-up books; Musical score books; Books for children; Book-cover paper; Graphic art books; Painting sets for children; Modeling clay for children.
Class 18: Umbrella rings; umbrella or parasol frames; harnesses; harness trimmings; umbrella poles; wallets; beach bags; travel bags; shopping bags; hand bags; tote bags; beach bags; school bags; baby carriers; wallets; pocket wallets; school satchels; leather goods; leather goods; key cases; baby slings; umbrella covers;; briefcases; document cases; backpacks; school backpacks; leather baby backpacks; imitation leather backpacks; coin purses; mesh purses; backpacks; lunch bags; school backpacks; school briefcases; school briefcases, sheet music holders, coin holders; parasols; card holders, wallets, handbags, travel trunks, leather goods, travel cases, tulas; fanny packs; pet collars; pet leashes, pet walking leashes; Pet harnesses, specialized leashes; muzzles; pet backpacks; pet carriers; pet carriers; pet carrier bags; pet clothing, pet coats, pet vests, pet jackets; pet scarves; pet paw pads; Except haversacks intended for practising sports and except goods intended for practising sports.	Class 18: Book bags; School book bags; Umbrellas for children; Reins for guiding children; Music bags; Music cases; Ruck sacks. Class 20: Furniture for children; Seats for children; Clothes hangers and clothes hooks; Clothes hangers, clothes stands [furniture] and clothes hooks; Clothes hangers; Clothes stands.
Class 20: Pet beds; Pet houses; Closet organizers [furniture parts]	Class 20: Furniture for children; Seats for children; Clothes hangers and clothes hooks; Clothes hangers, Clothes stands [furniture] and clothes hooks; Clothes hangers; Clothes stands.

Class 21: Lunch boxes; Thermos flasks; Bottles; Plastic bottles; Reusable bottles; Kitchen utensils; Household utensils; Kitchen containers; Household or culinary containers; Insulated household bags for food or beverages; Insulated bags for food or beverages; Insulated cooler bags for food or beverages; Insulated lunch bags of textile materials; Automatic dispensing feeders for pets; Portable drinking troughs for animals; Non-mechanized pet drinking troughs that are portable water and liquid dispensers; Portable animal feeders; Bowls; Animal feeders that activate the animals themselves; Cat litter trays; Food serving scoops for dogs and cats for household use; Scoops for collecting animal excrement	Class 21: Cookie [biscuit] cutters; Feeding cups for children.
Class 25: Clothing; Underwear; Outerwear; Casual jackets; Mask [article of clothing]; Footwear; Headgear; Caps; Gloves [clothing]; Foulards; Belts; Scarves; Windbreakers; Except Excluding beachwear, sports footwear and products intended for practising sports.	Class 25: Clothing for children; Clothing for men, women and children; Trousers for children; Swim wear for children; Clothing; Clothes; Wristbands [clothing]; Tops [clothing]; Knitted clothing; Hoods [clothing]; Leisure clothing; Infant clothing; Children's clothing; Sports clothing; Leather clothing; Gloves [clothing]; Girls' clothing; Maternity clothing; Muffs [clothing]; Capes (clothing); Children's clothing; Teddies; Teddies [undergarments]; Teddies [underclothing]; Hats; Beanie hats; Small hats; Baseball hats.
	Class 31: Animal biscuits; Dog biscuits; Biscuits (Dog -); Biscuits for animals; Biscuits for puppies; Biscuits for dogs; Savory biscuits for animals.
Class 35: Wholesale and retail product marketing services, through commercial establishments, internet sales of life-saving apparatus and instruments; wholesale and retail product marketing services, through commercial establishments, internet sales of sound	

and image recording apparatus, apparatus for the transmission of sound, data or images, apparatus for the reproduction of sound, apparatus for the reproduction of images, downloadable software applications, headphones, magnetic recording media, acoustic discs, mechanisms for prepaid devices; wholesale and retail merchandising services, through commercial establishments, internet sales of wireless headphones; wholesale and retail product marketing services, through commercial establishments, internet sales of paper and cardboard, printing products, writing and bookbinding articles, notebooks, books, magazines, brochures, photographs, stationery (articles of -), adhesives [glues] for stationery or household, artists' materials, brushes, pencils, pens, typewriters, office supplies (except furniture), educational and instructional materials, pencil cases, folders, stickers (stationery), stamping stamps, desk organizers, organizers [stationery]; wholesale and retail product marketing services, through commercial establishments, internet sales of mountaineering bags, beach bags, shopping net bags, shopping wheel bags, travel bags, leather bags, wraps and pouches for packing, shopping bags, hand bags, tote bags, beach bags, travel bags, school bags, baby carrier kangaroos; wholesale and retail product marketing services, through commercial establishments, internet sales of handbags, leather wallets, card wallets [leather goods], pocket wallets, school wallets, harness straps, leather or leatherboard cases, travel cases; wholesale and retail sales services, through commercial establishments, internet sales of baby slings, umbrella covers, suitcases, briefcases, document cases, document holders, backpacks,	
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school backpacks, leather baby carrier backpacks, imitation leather briefcases, coin purses, mesh purses; wholesale and retail sales services, through commercial establishments, internet sales of backpacks, lunch bags, hunting backpacks, backpacks with wheels, school backpacks, school bags, school briefcases, music cases, coin holders, umbrellas, umbrella stands; wholesale and retail merchandising services, through retail outlets, internet sales of animal collars, pet leashes, leather leashes [saddlery], harness leashes, animal harnesses, muzzles, animal backpacks, animal tulas, animal carrier bags; wholesale and retail marketing services, through commercial establishments, internet sales of animal clothing, animal coats, animal vests, animal jackets, animal jackets, animal scarves, animal leg protectors; wholesale and retail product marketing services, through commercial establishments, internet sales of pet beds, pet houses, closet organizers [furniture parts]; wholesale and retail product marketing services, through commercial establishments, internet sales of lunch boxes, lunch boxes, lunch boxes, thermoses, bottles, plastic bottles, reusable bottles, kitchen utensils, household utensils, kitchen containers, kitchen utensils, household or culinary containers; wholesale and retail marketing services, through commercial establishments, internet sales of insulated household bags for food or beverages, thermal bags for food or beverages; wholesale and retail product marketing services, through commercial establishments, internet sales of cooler bags for food and beverages, insulated bags of textile materials for lunch; wholesale and retail product marketing services, through commercial establishments, internet sales of	
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automatic dispensing feeders for pets, portable animal waterers, non-mechanized pet waterers that are portable water and liquid dispensers, portable animal feeders, bowls, animal feeders that activate the animals themselves; wholesale and retail product merchandising services, through retail outlets, internet sales of cat litter trays, dog and cat food scoops for household use, animal litter scoopers; wholesale and retail product marketing services, through commercial establishment, internet sales of clothing, underwear, outerwear, casual jackets, masks (clothing), footwear, headgear, hats, caps, gloves [clothing], scarves, belts, scarves, windbreakers	
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20. The opponent made lengthy submissions which I have considered and will not reproduce here.
21. The applicant, in her counterstatement, admits that there is similarity for part of the competing goods/services in the following terms:

“RE 5: I admit some of the good/services listed in our application are similar to those listed by the defendant however there is sufficient difference not only in the mark themselves but also in the likely ideas conveyed by the defendant and therefore can be no risk of confusion by the mark applied.”

She also asserts that “[t]he defendant does not offer goods or services in categories 9, 16, 21, 31 and so there can be no confusion on the part of the public or likelihood of association.” Although it is unclear which party the applicant is referring to as the “defendant”, this contention does not assist as it appears to be inaccurate. This is because the competing specifications contain a range of goods in Classes 9, 16, and 21. Although I note that registration of goods under Class 31 is sought by the applicant and the opponent does not rely on any equivalent Class of goods, I remind

myself that, as per Section 60A(1) of the Act, goods and services are not to be regarded as similar or dissimilar simply because they fall in the same or different Class. Furthermore, the applicant has not specified which competing terms are similar, nor has she put forward a blanket denial for any competing terms. Thus, it is deemed to have accepted the opponent's pleadings in full.¹ Therefore, I will only need to evaluate the identity or degree of similarity between the competing goods and services wherever the opponent has not pleaded this or I consider it necessary.

22. For the purpose of considering the issue of similarity of goods and services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way for the same reasons.²

Class 9

E-books; Talking books; Audio books; Memo books [electronic]; Downloadable electronic books; Downloadable e-books; Electronic book readers; Digital book readers; Portable music players; Juke boxes, musical; Musical juke boxes; Downloadable music files; Music software; Music headphones; Protective helmets for children

23. I agree with the opponent's submissions that the contested goods are all covered by the opponent's broad terms "*Apparatus for recording sound and images; Apparatus for transmitting sound, data or images; Apparatus for reproducing sound; Apparatus for reproducing images; Downloadable*

¹ Prof. Phillip Johnson, sitting as the Appointed Person, in *SKYCLUB*, BL O/044/21, at paragraph 24 states:

"The position in the Civil Procedure Rules (CPR) is clear; namely, a defendant must state which allegations are denied, which allegations a defendant is unable to admit or deny, and which allegations the defendant admits (CPR, 16.5(1)). Where a defendant fails to deal with an allegation it is taken to be admitted (CPR 16.5(5)). This is subject to the rule that where an allegation is not dealt with, but the defence sets out the nature of his case in relation to the issue to which that allegation is relevant, then the allegation must be proved by the Claimant (CPR 16.5(3)). Thus, the filing of a "blank" defence would lead to the whole of the Claimant's case being admitted."

² *Separode Trade Mark* BL O-399-10 and *BVBA Management, Training en Consultancy v BeneluxMerkenbureau* [2007] ETMR 35 at paragraphs 30 to 38.

software applications; Apparatus for reproducing sound; Downloadable software applications; Headphones; Wireless headphones; Life-saving apparatus and instruments". Thus, they will be identical pursuant to *Meric*.

Musical cassettes; Music cassettes; Music tapes; Music recordings; Musical recordings

24. Although the opponent claims identity for the contested terms, I do not consider them identical as there are no broad terms in the competing specification that could cover the competing goods. That said, the contested goods are similar to the opponent's "*Apparatus for recording sound and images; Apparatus for transmitting sound, data or images; Apparatus for reproducing sound*" sharing the same purpose, users, and trade channels. There is a complementary relationship as they will be indispensable in the sense that the earlier goods are important for the use of the contested goods and vice versa, and the average consumer would, therefore, believe them to be from the same undertaking. Thus, I find them highly similar.

Class 16

Books; Book wrappings; Log books; Appointment books; Recipe books; Cook books; Drawing books; Manuscript books; Score books; Birthday books; Autograph books; Copy books; Comic books; Sketch books; Commemorative books; Fiction books; Song books; Book covers; Cookery books; Children's books; Story books; Book bindings; Flip books; Gift books; Wedding books; Educational books; Book markers; Activity books; Sticker books; Agenda books; Printed books; Painting books; Scrap books; Writing books; Guide books; Travel books; Fantasy books; Poster books; Music books; Book marks; Baby books; Exercise books; Colouring books; Coloring books; Picture books; Note books; Children's activity books; Pocket books [stationery]; Baby books [storybooks]; Travel guide books; Coffee table books; Wallpaper sample book; Pop-up books; Musical score

books; Books for children; Book-cover paper; Graphic art books; Painting sets for children; Modeling clay for children

25. I agree with the opponent's submissions that the contested goods are identical to the opponent's. The contested goods could be readily covered by the opponent's broad term "*books; bookbinding material, book covers; stationery; artists' materials*". Thus, I find them to be identical as per *Meric*.

Class 18

Book bags; School book bags; Ruck sacks; Music bags

26. The contested goods are ostensibly the same with the opponent's "*school bags; school satchels; backpacks; school backpacks; backpacks; school backpacks*" in Class 18. Thus, I find them to be identical.

Music cases

27. These are cases intended for carrying music sheets and/or instruments. The opponent submits that they are identical to its earlier goods in the same Class. However, there are no any earlier terms that could readily cover the contested goods. That said, I consider that the contested terms will share the same general nature and purpose with the opponent's "*school bags; school satchels; backpacks; school backpacks; backpacks; school backpacks*". There may be an overlap in trade channels and users. However, there is no complementarity. In relation to competition, I consider that the consumers may choose one or the other. I find the competing goods to be similar to a high degree.

Umbrellas for children

28. The opponent submits that the contested goods are similar to the earlier goods "*Umbrella rings; umbrella or parasol frames; umbrella poles; umbrella covers; parasols*". Although the contested items protect from rain, whereas the opponent's "*parasols*" in the same Class protect from the sun,

they share the same nature (materials), method of use, and trade channels. Additionally, while the contested goods are intended for children, they will be selected by adults, resulting in shared users. Therefore, I find that the respective goods are similar between a medium and high degree.

Reins for guiding children

29. The contested goods are a type of safety harness for children to wear when they go out with a caregiver. The opponent submits that the contested goods are similar to the earlier goods *“harnesses; harness trimmings; baby slings; leather baby backpacks; baby carriers”*. I note that the earlier term *“harnesses”* is a broad one and can include child safety harnesses. Against that background, I consider that the contested goods share the same nature with the earlier *“harnesses”* as they could be made from the same materials. They also share the same general purpose. The respective goods coincide in users, method of use, and trade channels as they will be sold in the same retail shops, potentially close to each other. Further, I consider there to be a degree of competition as a user may choose one over the other. However, there is no element of complementarity. Therefore, I find a high degree of similarity.

Class 20

Furniture for children; Clothes hangers and clothes hooks; Clothes hangers, Clothes stands [furniture] and clothes hooks; Clothes hangers; Clothes stands

30. The contested goods *“Clothes hangers and clothes hooks; Clothes hangers, [...] and clothes hooks; Clothes hangers”* are all used for hanging clothing. In its submissions, the opponent posits that the contested terms are similar to the opponent’s *“Closet organizers [furniture parts]”* in Class 20. I consider that the earlier terms cover types of clothes hangers. In this respect, the contested goods *“Clothes hangers and clothes hooks; Clothes hangers, [...] clothes hooks; Clothes hangers”* may share the same nature, purpose, users, and trade channels. While there may be competition

between the goods, they are not complementary. I find them to be highly similar.

31. As to the rest of the terms, namely “*Furniture for children; Clothes stands [furniture] [...]; Clothes stands*”, they are a step further away from the analysis in the previous paragraph. The competing goods will differ in purpose and nature as they will be made from different materials. However, I consider that there is an overlap in users and trade channels. They are not in competition and nor are they complementary. I find the goods to be similar to a medium degree.

Seats for children

32. The contested goods are seats specifically designed for children to protect them from injury. The closest comparable term from the earlier specification is “*Closet organizers [furniture parts]*” in the same Class. Although these contested goods differ in nature and serve different purposes, they may have the same users and trade channels, as they could both be sold in homeware stores, albeit not in close proximity. There is no degree of complementarity or competition between them. I find that they are similar to a low degree.

Class 21

Cookie [biscuit] cutters

33. I agree with the opponent’s submissions that the contested term will be covered by the broad earlier term “*kitchen utensils*”. Thus, I find the competing terms to be identical in accordance with the principle in *Meric*.

Feeding cups for children

34. The contested goods are feeding cups intended for children, potentially featuring non-spill properties. These are similar to the opponent’s “*Lunch boxes; Kitchen containers; Household or culinary containers*”. They may

share the same general nature (materials) but not purpose as the contested terms will be used in the course of feeding a child rather than for storing food, as with the earlier goods. Additionally, they will have the same users and trade channels. Nevertheless, I do not believe they compete or complement one another. I find them to be similar to a high degree.

Class 25

Clothing for children; Clothing for men, women and children; Trousers for children; Swim wear for children; Clothing; Clothes; Wristbands [clothing]; Tops [clothing]; Knitted clothing; Hoods [clothing]; Leisure clothing; Infant clothing; Children's clothing; Sports clothing; Leather clothing; Gloves [clothing]; Girls' clothing; Maternity clothing; Muffs [clothing]; Capes (clothing); Children's clothing; Teddies; Teddies [undergarments]; Teddies [underclothing]; Hats; Beanie hats; Small hats; Baseball hats

35. The contested terms are all items of clothing. I agree with the opponent's submissions that the contested goods are identical to the earlier goods in the same Class on the basis that the above goods will all be covered by the broad terms "*clothing; headgear*" in the opponent's specification. I find them identical as per *Meric*.

Class 31

Animal biscuits; Dog biscuits; Biscuits (Dog-); Biscuits for animals; Biscuits for puppies; Biscuits for dogs; Savory biscuits for animals

36. The contested terms are all pet food items. The opponent submits that the contested goods "are for pets and as such are complimentary to the various pet related products and retail and wholesale services relating to such goods, which are claimed in the earlier mark. The purchasers would be the same and the respective goods would be sold in the same undertaking. The goods are, therefore, confusingly similar." I disagree with the opponent's submissions that there is a complementary relationship with the earlier goods and services. I do not consider that the competing

goods will be provided by the same undertakings. That said, the contested goods share the same users (pet-owners) and trade channels as the opponent's "*Automatic dispensing feeders for pets; Portable animal feeders; Bowls; Animal feeders that activate the animals themselves; Food serving scoops for dogs and cats for household use*" in Class 21 goods, which may be sold in close proximity to each other. I find them to be similar to a low degree at best.

Average Consumer and the Purchasing Act

37. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purposes 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 and services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. In *Hearst Holdings & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), at paragraph 70, 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 word 'average' denotes that the person is typical. The term 'average' does not denote some form of numerical mean, mode or median."

38. The goods at issue cover a range of items which vary in cost, with various furniture goods being relatively expensive. The average consumer of the goods will be a member of the general public. The goods will be available for purchase in a variety of outlets, stores, including specialist ones, brochures, catalogues, and online. In retail premises, the goods will be displayed on shelves, where they will be viewed and self-selected by consumers. Therefore, visual considerations will dominate the selection of

the goods in question, particularly clothing goods in Class 25,³ but aural considerations will not be ignored in the assessment. The cost of the goods may vary, but in any case, and irrespective of the cost, the average consumer may examine the products to ensure that they are fit for purpose (e.g. correct type, quality, size, etc.). In this regard, the average consumer is likely to pay an average degree of attention when selecting the goods at issue.

Comparison of Trade Marks

39. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated 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.”

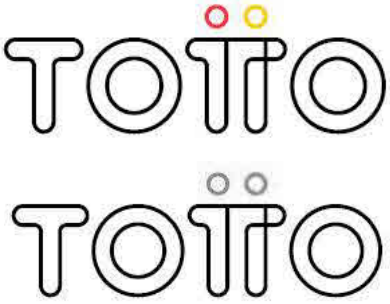
40. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant

³ The General Court highlighted this in *New Look Ltd v OHIM* Cases T-117/03 to T-119/03 and T-171/03, at paragraph 50:

“Generally, in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly, the visual aspect plays a greater role in the global assessment of the likelihood of confusion.”

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.

41. The marks to be compared are:

The Earlier Mark	Applicant's Mark
	Toto The Pom

Overall Impression

42. The contested mark is a word only mark in title case and a standard typeface. Registration of a word mark protects the words in the mark.⁴ The overall impression of the mark lies in the words themselves.
43. The earlier mark consists of both verbal and figurative elements. The verbal element is “TOTTO”, which appears slightly stylised with a rounded typeface and black outline. Also, the ‘T’ letters appear to be joined together. In addition, two relatively small circular devices are positioned above the double “T” letters. In the first mark in the series, the circular devices are in red and yellow colours, while in the second mark, they are in grey. It is my view that the circular devices, together with the conjoined ‘T’ letters, create an abstract representation of two human figures. That said, I consider that the dominant element is the word “TOTTO” by virtue of its prominent size. Thus, the word element plays the greatest role in the overall impression, whereas the device elements play a lesser role.

⁴ See *LA Superquímica v EUIPO*, T-24/17, para 39; and *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17, paragraph 16.

Visual Comparison

44. The earlier mark is five letters long whereas the contested mark is ten. Bearing in mind, as a rule of thumb, that the beginnings of words tend to have more impact than the ends,⁵ the first word element in the contested mark contains all but the letter 'T' of the earlier mark, namely "TOT-O". However, the presence/absence of the word elements "The Pom" in the contested mark and the device elements in the earlier mark are points of visual difference. Taking into account the above and the overall impressions of the marks, I find that they are visually similar to a low degree.

Aural Comparison

45. The earlier mark will be pronounced as "TOT-OH" and the contested as "TOE-TOE-THUH-POM". Although the marks share a similar sound generated by the letters "TO", I note that their syllables are different. Thus, the articulation of the first two syllables will be slightly different between the marks. I also note that there are no phonetic counterparts of the "-THUH-POM" in the earlier mark. Also, the average consumer will not attempt to articulate the figurative elements of the earlier mark. I find that the competing marks are aurally similar to a low degree.

Conceptual Comparison

46. The opponent submits that:

"If consumers were to recognise "pom" as being a reference to a dog, they would merely view the mark as meaning "Toto the dog". [...] Furthermore, the element "THE POM" is essentially being used as a descriptor in relation to the main part of the mark "

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

47. The applicant asserts that “‘TOTO THE POM’ will clearly evoke thoughts of a dog as the word POM is a breed of dog. TOTTO does not convey ideas of a Dog.”
48. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.⁶
49. No immediate perceptible meaning can be attributed to the verbal element “TOTTO” in the earlier mark. I consider that the average consumer will see it as a name or an invented word with no identifiable concept. Further, it is my view that the average consumer could extract the notion of two abstract human figures from the circular devices that sit above the letters “TT”, with no such counterpart existing in the contested mark.
50. Regarding the contested mark, similarly here, the first word element “Toto” can be perceived as a name or an invented word. As to the word “Pom”, the Oxford English Dictionary defines it as a colloquial term for a Pomeranian dog.⁷ Even if the applicant is correct that this will evoke the concept of the said dog breed, in the absence of evidence and despite the former dictionary reference, I am unwilling to conclude that the entirety of the consumers in the UK will be aware of this colloquial meaning.⁸ Therefore, when viewed as a whole, those consumers who are familiar with the term may interpret the mark as a Pomeranian dog named Toto, and those who are not may see it as a second name or invented word with no particular meaning. In the context of the applicant’s Class 31 goods, I note that the word “Pom” may have an allusive significance in relation to the pet food items.
51. I note the presence/absence of the concepts emanating from the device elements and the additional words “The Pom” in the competing marks. Considering the above factors and overall impressions, the marks are

⁶ *Ruiz Picasso v OHIM* [2006] E.C.R.-I-643; [2006] E.T.M.R. 29.

⁷ See OED, <https://www.oed.com/view/Entry/147445>.

⁸ See *Chorkee Ltd v Cherokee Inc.*, Case BL O/048/08.

conceptually dissimilar, regardless of whether the term “Pom” is known or not.

Distinctive Character of the Earlier Trade Mark

52. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, paragraph 22 and 23, the CJEU stated that:

“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).

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).”

53. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

54. I have only the inherent distinctiveness of the earlier mark to consider. As described above in this decision, the earlier mark contains the slightly stylised verbal element “TOTTO” together with two circular devices. The earlier mark has no real suggestive or allusive significance in relation to the goods for which it is registered. The mark will be perceived by consumers as a name or an invented word, and I find that the level of inherent distinctiveness will be high.

Likelihood of Confusion

55. In assessing the likelihood of confusion, I must adopt the global approach set out in the case law to which I have already referred above in this decision. Such a global assessment is not a mechanical exercise. I must also have regard to the interdependency principle, that 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.⁹ It is essential to keep in mind the distinctive character of the opponent’s trade mark since the more distinctive the trade mark, the greater the likelihood of confusion. I must also keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon imperfect recollection.¹⁰
56. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. Indirect confusion is where the consumer notices the differences between the marks but concludes that the later mark is another brand of the owner of the earlier mark or a related undertaking. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Iain Purvis K.C., sitting as the Appointed Person, explained that:

⁹ See *Canon Kabushiki Kaisha*, paragraph 17.

¹⁰ See *Lloyd Schuhfabrik Meyer*, paragraph 27.

“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.

57. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, James Mellor K.C., sitting as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.
58. In *Liverpool Gin Distillery Ltd and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207, the Court of Appeal dismissed an appeal against a ruling of the High Court that trade marks for the words EAGLE RARE registered for whisky and bourbon whiskey were infringed by the launch of a bourbon whiskey under the sign "American Eagle". In his decision, Lord Justice Arnold stated that:

“13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/219/16) at [16] “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Mr Mellor went on to say that, if there is no likelihood of direct confusion, “one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion”. I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion.”

59. Earlier in this decision I have concluded that:

- the goods at issue range from identical to similar to a low degree;
- the average consumer is a member of the general public. The selection process is predominantly visual without discounting aural considerations. The average consumer may examine the products to ensure that they are fit for purpose. The level of attention paid will be average;
- the competing marks are visually and aurally similar to a low degree, and conceptually dissimilar;
- the earlier mark has a high degree of inherent distinctiveness.

60. Taking into account the above factors, I find that there is no likelihood of direct confusion for identical goods. Notwithstanding the concept of imperfect recollection, it is my view that the average consumer will recall that the earlier mark consists of the single verbal element “TOTTO” as opposed to the contested mark, “Toto The Pom”, which consists of three words. In this regard, and despite the high level of inherent distinctiveness of the earlier mark, I consider that the average consumer will not overlook the visual and aural differences and the conceptual dissimilarity between the competing marks during the purchasing process. In addition, in the case of those who are familiar with the term ‘Pom’ the contested mark will be perceived as a unit creating a phrase with a conceptual hook.

Consequently, it is unlikely for the average consumer to misrecall or misremember one mark for the other.

61. In terms of indirect confusion, I do not consider that the average consumer would put the common use of the common letters, “TOT-O”, as linking the two marks by way of the same or an economically linked undertaking. The differences between the marks do not lend themselves to a logical brand extension. In particular, the differences, especially the additional word elements “The Pom”, are such that the competing marks would not be perceived as variants or sub-brands of each other nor that the goods and services in question are from the same or economically linked undertakings. Notably, I find that the guidance given in *Duebros* applies to this case, namely that an average consumer may merely associate the shared letters in the marks but would not confuse them. Consequently, I find that there is no likelihood of indirect confusion.
62. This finding extends to the rest of the goods that I found to be similar at any degree.

Outcome

63. The opposition under Section 5(2)(b) of the Act is **unsuccessful in its entirety**. Therefore, subject to appeal, the application can proceed to registration.

Costs

64. The applicant has been successful and is entitled to a contribution towards her costs. The applicant was not professionally represented and had to submit a completed cost proforma to the Tribunal, outlining the number of hours spent on these proceedings. In an official letter to the parties, dated 14 February 2023, the Tribunal stated that “[...] If the pro-forma is not completed and returned, costs, other than official fees arising from the action (excluding extensions of time), may not be awarded.[...]” As the

applicant elected not to complete a costs pro-forma and as she has incurred no official fees in the defence of her application, I make no order as to costs.

65. The appeal period will run from the date of this decision.

Dated this 28th day of June 2023

Dr Stylianos Alexandridis

For the Registrar,

The Comptroller General