

O/0641/24

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003857114 BY

ST8 S.r.l. TO REGISTER THE FOLLOWING TRADE MARK:

ST8

IN CLASSES 3, 9, 14, 16, 18, 25, 28 and 41

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 440678 BY GR. SARANTIS ANONYMI VIOMICHANIKI & EMPORIKI

ETAIRIA KALLYNTIKON ENDYMATON OIKIAKON & PHARMAKEFTIKON

EIDON

Background and Pleadings

1. On 7 December 2022, ST8 S. r. l. ('the Applicant') applied to register the trade mark shown on the cover of this Decision, number UK00003857114. The application was published for opposition purposes in the Trade Marks Journal on 17 February 2023. Registration is sought for the following goods and services, the opposed terms shown in bold:

Class 3:

Soaps; essential oils; cosmetics; dentifrices; perfumes; aftershave lotions; Beauty balm creams; Body creams; Body gels; scented body spray; after sun lotions; Face creams; Skin cleansers; hand creams; shower gels; Body deodorants; shampoos; Hair conditioners; cosmetics authenticated by non-fungible tokens (NFTs).

Class 9:

Sunglasses; sports eyewear; motorcycle goggles; swim goggles; ski goggles; snow goggles; protective sports helmets; headphones; cases for smartphones; display screen filters; Protective cases for laptops; Protective cases for smartphones; Mobile phone screen protectors; smartwatches; Battery chargers for electronic cigarettes; downloadable digital files authenticated by non-fungible tokens (NFTs); sunglasses authenticated by non-fungible tokens (NFTs); cases for smartphones authenticated by nonfungible tokens (NFTs).

Class 14:

Precious metals and their alloys; Semi-precious stones; Jewellery; Precious stones; Chronometric instruments; Time instruments; clocks; clock cases; cuff links; tie pins; tie clips; jewellery authenticated by non-fungible tokens (NFTs); watches authenticated by non-fungible tokens (NFTs).

Class 16:

Paper and cardboard; printed matter; bookbinding material; photographs; Stationery; adhesives for stationery or household purposes; Artists' materials; instructional and teaching materials; Plastic materials for packaging; stickers;

decals; greeting cards; calendars; posters; photo albums; diaries; blank journal books; address books; Figurines made from paper; figurines authenticated by non-fungible tokens (NFTs).

Class 18:

*Leather and imitations of leather; animal skins and hides; Trunks and suitcases; umbrellas and parasols; walking sticks; **bags**; backpacks; sport bags; wallets; Handbags for ladies; umbrellas; **Cosmetic cases sold empty**; bags authenticated by non-fungible tokens (NFTs).*

Class 25:

Clothing; footwear; headgear; underwear; shorts; boxer shorts; briefs; Socks; sports socks; shirts; t-shirts; polo shirts; sweatshirts; suits; outer clothing; ties; belts; hats; beach clothes; gym suits; sports jerseys; sports jackets; sports clothing; sportswear; waterproof outer clothing; replica soccer shirts; articles of clothing authenticated by non-fungible tokens (NFTs); headgear authenticated by non-fungible tokens (NFTs); shoes authenticated by non-fungible tokens (NFTs).

Class 28:

Sports equipment; knee pads for athletic use; shoulder pads for athletic use; Leg guards for athletic use; Arm guards for sports use; Elbow guards [sports articles]; Wrist guards for athletic use; Protective padding for sports; Football gloves; Chest protectors for sports use; bags specially adapted for sports equipment; toys; articles of clothing for toys; board games; action skill games; handheld game consoles; Electronic games for the teaching of children; soccer balls; sports equipment authenticated by non-fungible tokens (NFTs).

Class 41:

Education; sporting and cultural activities; entertainment services; Providing sports news; Providing online newsletters in the fields of sports entertainment; Entertainment in the nature of soccer games; sports instruction services; entertainment services in the nature of organizing social entertainment events;

organization of electronic sports competitions; arranging and conducting of sports events; Esports services; sports coaching; Providing of sports facilities; sport camp services; sports education services; information services relating to sport; Organization of electronic sports competitions; production, post-production editing and presentation of digital contents (collectibles) in the nature of interactive media, video, photography, music, statistics, data, graphics, or visual effects, represented by non-fungible tokens (NFTs) via a blockchain network; entertainment services namely, publication of virtual entertainment items authenticated by non-fungible tokens (NFTs) via a blockchain network featuring footage, videos, data, statistics, records, images, art, visual effects, photography, graphics, and virtual experiences.

2. On 5 May 2023, GR. Sarantis Anonymi Viomichaniki & Emporiki Etairia Kallyntikon Endymaton Oikiakon & Pharmakeftikon Eidon. ('the Opponent') filed an opposition against the application based on section 5(2)(b) of the Trade Marks Act 1994 ('the Act'). The opposition is directed against part of the Applicant's specification: all goods in class 3 and some goods in class 18 (as shown in bold in the above table).
3. The Opponent relies on the following 4 earlier trade mark registrations:

i) UK00917717067¹



Filing date: 22 January 2018

Date of entry in register: 9 May 2018

Registered for the following goods, all of which are relied upon:

Class 3:

¹ The earlier mark is a comparable mark pursuant to Article 54 of the 'Agreement on the withdrawal of the United Kingdom of Great Britain and Northern Ireland from the European Union and the European Atomic Energy Community (2019/C 384 1/01)', also known as the 'Withdrawal Agreement', based on EUTM 017717067, which was registered prior to the withdrawal of the UK from the European Union.

Cosmetics; Perfumery and fragrances; Body cleaning and beauty care preparations; Scented body spray; Scented water; Perfumed toilet waters; Bay rums; Shampoos; Body washes; Shampoos for personal use; Dandruff shampoo; Shampoos for human hair; Bath foam; Bubble bath; Foaming bath gels; Shower and bath gel; Shower gels; Antiperspirants [toiletries]; Anti-perspirant deodorants; Personal deodorants; Body deodorants [perfumery]; Deodorants and antiperspirants; Deodorants for personal use [perfumery]; Deodorants, for personal use in the form of sticks; Roll-on deodorants [toiletries]; Shower and bath foam.

Class 8:

Razors; Disposable razors; Vibrating blade shavers; Safety razor blades.

ii) UK00917631201²



Filing date: 21 December 2017

Date of entry in register: 18 April 2018

Priority date: 1 December 2017³

Priority country: Greece

Registered for the following goods, all of which are relied upon:

² A comparable mark based on EUTM 017631201, registered prior to the withdrawal of the UK from the European Union.

³ The EUTM claims priority from the International registration 246534 which, in turn, can be relied upon in respect of the comparable UK mark.

Class 3:

Cosmetics; Perfumery; Body cleaning and beauty care preparations; Scented body spray; Scented water; Perfumed toilet waters; Bay rums; Shampoos; Body washes; Shampoos for personal use; Dandruff shampoo; Shampoos for human hair; Bath foam; Bubble bath; Shower and bath gel; Foaming bath gels; Shower gels; Antiperspirants [toiletries]; Anti-perspirant deodorants; Personal deodorants; Body deodorants [perfumery]; Deodorants and antiperspirants; Deodorants for personal use [perfumery]; Deodorants, for personal use in the form of sticks; Roll-on deodorants [toiletries]; Shower and bath foam.

Class 8:

Razors; Disposable razors; Vibrating blade shavers; Safety razor blades.

iii) UK917630872⁴



Filing date: 21 December 2017

Date of entry in register: 18 April 2018

Priority date: 1 December 2017⁵

Priority country: Greece

Registered for the following goods, all of which are relied upon:

⁴ A comparable mark based on EUTM 017630872, registered prior to the withdrawal of the UK from the European Union.

⁵ The EUTM claims priority from the International registration 246533 which, in turn, can be relied upon in respect of the comparable UK mark.

<p>Class 3:</p> <p><i>Cosmetics; Perfumery and fragrances; Body cleaning and beauty care preparations; Scented body spray; Scented water; Perfumed toilet waters; Bay rums; Shampoos; Body washes; Shampoos for personal use; Dandruff shampoo; Shampoos for human hair; Bath foam; Bubble bath; Foaming bath gels; Shower gels; Shower and bath foam; Antiperspirants [toiletries]; Anti-perspirant deodorants; Personal deodorants; Body deodorants [perfumery]; Deodorants and antiperspirants; Deodorants, for personal use in the form of sticks; Roll-on deodorants [toiletries]; Deodorants for personal use [perfumery]; Perfumery; Shower and bath gel.</i></p>
<p>Class 8:</p> <p><i>Vibrating blade shavers; Razors; Disposable razors; Safety razor blades.</i></p>

iv) UK00801482953⁶

STR8 GO FOR GREAT

Filing date: 2 July 2019

Date of entry in register: 21 January 2020

Registered for the following goods, all of which are relied upon:

<p>Class 3:</p> <p><i>Perfumes; cosmetics</i></p>

⁶ The earlier mark is a comparable mark pursuant to Article 54 of the 'Agreement on the withdrawal of the United Kingdom of Great Britain and Northern Ireland from the European Union and the European Atomic Energy Community (2019/C 384 1/01)', also known as the 'Withdrawal Agreement', based on IR 1482953, which was registered prior to the withdrawal of the UK from the European Union.

4. The Opponent claims that the parties' marks are similar and that the respective goods are identical/similar.
5. The Applicant filed a Defence and Counterstatement in which it denies the claim against it in its entirety.
6. The Opponent is represented by Page, White & Farrer Limited. The Applicant is represented by Brandit Ports UK Limited.
7. Only the Opponent filed evidence. A hearing was neither requested nor considered necessary. Only the Opponent filed written submissions in lieu of a hearing.
8. The Opponent's evidence comes from Mr James Philip Cornish, UK Trade Mark Attorney and Solicitor, of Bedford House, John Street, London. Mr Cornish's Witness Statement is dated 27 September 2023 and is accompanied by 8 exhibits: JPC1 – JPC8. The evidence focuses on the matter of the alleged similarity/identity of the parties' goods. I will not summarise the Opponent's evidence, but will refer to it, to the extent that it is relevant, in my decision.

RELEVANCE OF EU LAW

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

Section 5(2)(b)

11. 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.”

Earlier marks

12. In accordance with section 6 of the Act, all of the Opponent’s marks are earlier marks by virtue of their filing dates or priority dates, which fell before the filing date of the applied-for mark (7 December 2022).

Section 5(2)(b) case law

13. The following principles are derived from the decisions of the CJEU 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 C120/04; *Shake 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;

(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

14. 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.

15. The CJEU in *Canon*, Case C-39/97, stipulates that all relevant factors relating to the parties' goods and services must be taken into account:

"[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 are complementary".

16. Goods or services will be found to be in a competitive relationship only where one is substitutable for the other.⁷ In *Boston Scientific Ltd v OHIM*, Case T-325/06, the General Court described “complementary” in the following terms: “[...] 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”.⁸ In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods.

17. Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281⁹, identified the following factors for assessing similarity of the respective goods and services:

- (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.

⁷ *Lidl Stiftung & Co KG v EUIPO*, Case T-549/14.

⁸ Paragraph 82

⁹ *British Sugar Plc v James Robertson & Sons Ltd* [1996] R. P. C. 281, pp 296-297.

18. Goods (or services) may be grouped together for the purposes of assessment, as Geoffrey Hobbs QC (as he then was), sitting as the Appointed Person, said in *Separode Trade Mark* BL O-399-10:

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

19. In making an assessment between the competing goods and services, I bear in mind the decision of the General Court in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05:

“29. ... 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”.

20. In construing the terms used in the parties' specifications, I will follow the guidance of Floyd J. (as he then was) in *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch):

"... 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."

21. The Opponent has submitted that reliance on its two earlier marks 917717067 STR8 [stylised] and 801482953 STR8 GO FOR GREAT (earlier marks i) and iv)) amounts to its strongest case. I note that the specifications for the first three earlier registrations, essentially, cover the same goods anyway (although there are slight differences in the wording of some terms). I will therefore focus my decision on earlier marks i) and iv).

22. The goods to be compared are as follows:

<u>Opponent's marks:</u>	<u>Applicant's mark:</u>
<p data-bbox="252 1115 707 1149">Earlier mark i) UK00917717067</p> <p data-bbox="252 1227 810 1977">Class 3: Cosmetics; Perfumery and fragrances; Body cleaning and beauty care preparations; Scented body spray; Scented water; Perfumed toilet waters; Bay rums; Shampoos; Body washes; Shampoos for personal use; Dandruff shampoo; Shampoos for human hair; Bath foam; Bubble bath; Foaming bath gels; Shower and bath gel; Shower gels; Antiperspirants [toiletries]; Anti-perspirant deodorants; Personal deodorants; Body deodorants [perfumery]; Deodorants and</p>	<p data-bbox="833 1115 1378 1697">Class 3: Soaps; essential oils; cosmetics; dentifrices; perfumes; aftershave lotions; Beauty balm creams; Body creams; Body gels; scented body spray; after sun lotions; Face creams; Skin cleansers; hand creams; shower gels; Body deodorants; shampoos; Hair conditioners; cosmetics authenticated by non-fungible tokens (NFTs).</p> <p data-bbox="833 1776 1321 1865">Class 18: bags; Cosmetic cases sold empty</p>

<p><i>antiperspirants; Deodorants for personal use [perfumery]; Deodorants, for personal use in the form of sticks; Roll-on deodorants [toiletries]; Shower and bath foam.</i></p> <p>Class 8: <i>Razors; Disposable razors; Vibrating blade shavers; Safety razor blades.</i></p> <p>Earlier mark iv) UK00801482953</p> <p>Class 3: <i>Perfumes; cosmetics</i></p>	
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Class 3

23. I set out in the following table the goods that I find to be identical, either by virtue of being identically-worded or synonymous terms or according to the principle in *Meric*:

Opponent's marks:	Applicant's mark:
<i>cosmetics</i> (earlier marks i) and iv))	<i>Cosmetics;</i> <i>cosmetics authenticated by non-fungible tokens (NFTs).</i>
<i>perfumes</i> (earlier mark iv)) <i>Perfumery and fragrances</i> (earlier mark i))	<i>perfumes</i>
<i>Shampoos</i> (earlier mark i))	<i>shampoos</i>

<i>Scented body spray</i> (earlier mark i))	<i>scented body spray</i>
<i>Shower and bath gel</i> (earlier mark i))	<i>shower gels</i>
<i>Body deodorants [perfumery]</i> (earlier mark i))	<i>Body deodorants</i>
<i>Body cleaning [...] preparations</i> (earlier mark i))	<i>Soaps; dentifrices</i>
<i>[...] beauty care preparations</i> (earlier mark i))	<i>aftershave lotions; Beauty balm creams; Body creams; Body gels; Hair conditioners</i>
<i>fragrances</i> (earlier mark i))	<i>essential oils</i>

Class 18

24. I now compare the Applicant's terms *Cosmetic cases sold empty* to the Opponent's class 3 term *cosmetics* (earlier marks i) and iv)). The Opponent has submitted that the Applicant's goods are 'complementary ancillary goods in connection with cosmetics' and that both are 'sold by the same manufacturers'.¹⁰ In support of its submission, the Opponent has adduced evidence by way of screenshots of the website of various retailers of cosmetics.¹¹ I note the following:

- Nails INC, a cosmetics retailer, has product listings for make-up bags. I can see from the website header that the other goods sold on the site comprise various types of cosmetics for the nails; treatments; masks and makeup.

¹⁰ Opponent's written submissions, fifth unpaginated page, final unnumbered paragraph.

¹¹ Witness Statement of J. P. Cornish, [9]; Exhibit JPC6.

- MAC, a cosmetics retailer, has product listings for 'makeup bags'. The header of the webpage indicates that the other goods sold on the site are 'brush cases', 'travel cases' and 'MAC cosmetics'.
- Harrods, a retailer of various types of goods, has product listings for the cosmetics brand Bobbi Brown, under which cosmetics bags are sold as well as cosmetics and makeup brushes.
- Screenshots of webpages for Gucci and Prada goods include listings for both makeup items as well as cosmetics pouches/cases/bags indicating that both goods are sold under each name.
- Product listings for the brand Clarins, indicate that it sells both makeup items and 'wash bags'.

25. The parties' goods will have distinct purposes; cosmetics are intended to improve the appearance/condition of an aspect of the person, whereas cosmetics cases function as receptacles for items of cosmetics. Users will inevitably overlap. As borne out by the evidence noted above, trade channels will also overlap. Methods of use will differ; cosmetics will typically be applied to the person, whereas cosmetics cases will be used to house cosmetics products. The goods will also differ in terms of their physical nature; cosmetics will typically be in the form of 'consumable' substances including, *inter alia*, creams, gels, powders, whereas cosmetics cases are receptacles typically composed of a fabric or other flexible material. The respective goods are not in a competitive relationship, neither being substitutable for the other. I do, however, find complementarity. The Applicant's goods are useful for the Opponent's cosmetics, and I consider that the average consumer would likely presume both parties' goods to originate from the same undertaking. I find the respective goods to have a level of similarity above 'low' but below 'medium'.

26. I now consider the contested term *bags*. 'Bags' is a broad term encompassing bags for a wide range of purposes, including as receptacles for cosmetics. For the same

reasons provided above at [25], I find the parties goods to have a level of similarity above 'low' but below 'medium'.

Average consumer and the purchasing act

27. The average consumer is deemed to be reasonably well-informed and reasonably observant and circumspect. The word "average" denotes that the person is typical. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

28. The average consumer of the relevant goods will be predominantly the general public, with a smaller number of purchases made by professional consumers. The goods will be purchased from physical and online shops. The purchasing act will be primarily visual, the goods being self-selected from shelves/displays in physical shops, or 'clicked on' in the case of goods online. I recognise that there will also be an aural aspect to the purchasing process where the purchaser seeks advice from retail staff. In physical shops, I consider that the goods will typically be located in the 'beauty' or 'toiletries' sections. The goods are fairly frequent purchases, generally with a low price point. In my view, the average consumer will pay at least a medium level of attention when making their purchases. Factors considered during the purchasing process might include, *inter alia*: the ingredients (the class 3 goods); or the fabric/material (cosmetics cases; bags).


Comparison of the marks

29. 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.”

30. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account their distinctive and dominant components, and to give due weight to any other features which are not negligible and, therefore, contribute to the overall impressions created by the marks.

31. The marks to be compared are as follows:

Opponent's marks:	Applicant's mark:
i)  iv) STR8 GO FOR GREAT	ST8

Overall impression of the marks

32. The Opponent's mark i) comprises the 4 characters 'S, T, R, 8', rendered in a plain typeface, surrounded by a black border whose shape might be described as resembling a rear view mirror. I consider that both the text element and the border will contribute to the overall impression of the mark, with the 'STR8' element playing a much greater role due to the fact that, generally speaking, text elements 'speak louder' than figurative elements.

33. The Opponent's mark iv) is registered as a figurative mark and comprises the 'word' elements 'STR8 GO FOR GREAT', rendered in a plain typeface. In my view, both 'STR8' and 'GO FOR GREAT' will play some role within the overall impression

of the mark, albeit the 'STR8' element will likely dominate owing to its positioning and the somewhat laudatory nature of the words 'GO FOR GREAT'.

34. The Applicant's mark is a word mark¹² comprising the string of characters 'ST8', rendered in a plain typeface. All three characters play an equal role within the overall impression of the mark, owing to their uniform size and the fact that the mark is very short.

Visual comparison

35. I will first compare the Applicant's mark to the Opponent's mark i). Both marks include the characters 'S', 'T' and '8'. The only visual differences between the marks are:

- the presence of the 'R' between the characters 'T' and '8' in the Opponent's mark, which is absent from the Applicant's mark;
and
- the presence of the border around the text in the Opponent's mark, which is absent from the Applicant's mark.

I find the marks to have a high level of visual similarity.

36. I now compare the Applicant's mark to the Opponent's mark iv). Both marks include the characters 'S', 'T' and '8'. The points of visual difference are:

- the considerably greater length of the Opponent's mark;
- the presence of the words 'GO FOR GREAT' in the Opponent's mark, which are absent from the Applicant's mark;

¹² In *LA Superquimica v EUIPO*, Case T-24/17, at paragraph [39] it was held that:

'[...] it should be noted that a word mark is a mark consisting entirely of letters, words or groups of words, without any specific figurative element. The protection which results from registration of a word mark thus relates to the word mentioned in the application for registration and not the specific figurative or stylistic aspects which that mark might have. As a result, the font in which the word sign might be presented must not be taken into account. It follows that a word mark may be used in any form, in any colour or font type (see judgment of 28 June 2017, *Josel v EUIPO — Nationale-Nederlanden Nederland (NN)*, T-333/15, not published, EU:T:2017:444, paragraphs 37 and 38 and the case-law cited).'

- the presence of the 'R' character in the first 'word' element of the Opponent's mark, which is absent from the Applicant's mark.

I find the marks to have a very low level of visual similarity.

Aural comparison

37. I will first compare the Applicant's mark to the Opponent's mark i). The Opponent has submitted that the marks will be articulated as individual characters i.e. 'ESS-TEE-ARR-ATE' versus 'ESS-TEE-ATE'.¹³ I agree that a proportion of average consumers would articulate the marks in this way. I also consider that a significant proportion of average consumers would articulate the marks, respectively, as 'STRAIGHT' and 'STATE'. In the former instance, I consider the marks to have medium level of aural similarity. In the latter instance, I find the marks to have a high level of aural similarity.

38. I now compare the Applicant's mark to the Opponent's mark iv). The Opponent's mark will be articulated as either: 'ESS-TEE-ARR-ATE' followed by the words 'GO FOR GREAT', articulated in the usual way; or, 'STRAIGHT GO FOR GREAT'. Where the average consumer articulates the parties' marks as 'ESS TEE ARR ATE GO FOR GREAT' versus 'ESS-TEE-ATE', I find the marks to have no more than a medium level of aural similarity. Where the average consumer articulates the marks as 'STRAIGHT GO FOR GREAT' versus 'STATE', I also find no more than a medium level of aural similarity.

Conceptual comparison

39. I will first make my comparison against the earlier mark i). The Opponent has submitted that the parties' marks 'STR8' versus 'ST8' will be seen as 'inventive elements'.¹⁴ My view is that a significant proportion of average consumers will perceive the marks as deliberate playful misspellings of the words 'straight' and 'state'; for example, in the manner of 'text' speak. I find that the Opponent's mark

¹³ Opponent's written submissions, 9th unpaginated page, [15].

¹⁴ As above, [16].

will likely be understood as a reference to the word 'straight' meaning not bent. I consider that the Applicant's mark will be understood as a reference to the word 'State' denoting a geographical country or region or as a synonym for disposition or condition (e.g. a state of agitation). I find the parties' marks to be conceptually distinct. However, I am of the view that there will be another significant proportion of average consumers for whom the marks will be perceived merely as strings of characters, devoid of meaning. In this case, the marks will be conceptually neutral.

40. I now make my comparison against the earlier mark iv). The Opponent's mark will, in my view, be understood as the mere characters 'S-T-R-8' followed by words conveying the idea of 'aiming high' or the colloquial phrase 'go for it', for one proportion of average consumers. For the other proportion of average consumers, who perceive the 'STR8' element as a deliberate misspelling of the word 'straight', I find that the overall concept of the mark will be of 'doing one's best' or, perhaps, aiming 'straight for the top'. For both groups of consumers, my view is that the parties' marks will be conceptually distinct.

41. In the light of the foregoing, the Opponent's earlier mark i) represents its best case. The goods in respect of which earlier mark iv) is registered are also present in the specification for earlier mark i).

Distinctive character of the earlier mark i)

42. *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).”

43. Registered trade marks possess varying degrees of inherent distinctive character. Where a mark is suggestive or allusive of a characteristic of the goods or services, it tends to be low. Inherent distinctive character may range up to a high level for marks which consist of invented words with no allusive qualities.

44. I have found that the earlier mark i) will be perceived either as a mere string of characters or as a playful misspelling of the word ‘straight’. In the former instance, the mark will neither describe nor allude to the goods in respect of which it is registered. However, I bear in mind that the average consumer is accustomed to seeing marks in the form of mere strings of characters or initial and numerals which convey no particular meaning. For this group of consumers, I find the mark to have a medium level of inherent distinctive character. I now consider the proportion of average consumers for whom ‘STR8’ denotes the word ‘straight’. ‘Straight’ is a well-known English word which neither describes nor alludes the relevant goods. I consider that the distinctiveness derives, in part, from the playful spelling. For this latter group of average consumers, I find the mark to have a medium level of inherent distinctive character.

45. I now consider the matter of enhanced distinctive character. The Opponent’s evidence includes product listings for cosmetics, fragrances, deodorants and shower gels, sold online under its ‘STR8’ mark, from the UK websites ‘makeup.uk’, ‘Amazon.co.uk’ and ‘notino.co.uk’. This evidence is dated 9 September 2023,

which is after the filing date of the Applicant's mark.¹⁵ Mr Cornish has given narrative evidence that the Opponent is a multinational company which has been trading for over 55 years and that, at present, it had 2,300 employees, sold to 50 countries via 110,000 points of sale, with a turnover of about £385million in 2022.¹⁶ Two press articles, dated 28 June 2018 (published in Serbia), and dated 15 January 2019 (published in Greece) indicate that the Opponent company has a strong international presence, has 'operating subsidiaries' in 12 European countries, and exports to 'more than 40 countries worldwide'.¹⁷ While there may be an awareness of the Opponent's mark in the UK, I am unable to discern, from the evidence provided, how many employees, points of sale and the proportion of turnover are referable to the UK market. Material to demonstrate the Opponent's marketing and advertising efforts and expenditure for the mark in the UK would also have been useful, as well as information on the Opponent's position in the market. Based on the totality of evidence available to me, I am unable to make a finding that the earlier mark has a level of distinctiveness beyond the medium level of inherent distinctive character that I have found above.

Likelihood of confusion

46. Confusion can be direct or indirect. Mr Iain Purvis Q. C., (as he then was) as the Appointed Person, explained the difference in the decision of *L.A. Sugar Limited v By Back Beat Inc*¹⁸. Direct confusion occurs when one mark is mistaken for another. In *Lloyd Schuhfabrik*¹⁹, the CJEU recognised that the average consumer rarely encounters the two marks side by side but must rely on the imperfect picture of them that they have kept in mind. Direct confusion can therefore occur by imperfect recollection when the average consumer sees the later mark but mistakenly matches it to the imperfect image of the earlier mark in their 'mind's eye'. Indirect confusion occurs when the average consumer recognises that the competing marks are not the same in some respect, but the similarities between

¹⁵ Exhibits JCP3 and JCP4.

¹⁶ Witness Statement of J. P. Cornish, [6].

¹⁷

¹⁸ Case BL O/375/10 at [16].

¹⁹ *Lloyd Schuhfabrik Meyer and Co GmbH v Klijsen Handel BV* (C-34297) at [26].

them, combined with the goods/services at issue, leads them to conclude that the goods/services are the responsibility of the same or economically linked undertaking.

47. I must keep in mind that a global assessment is required taking into account all of the relevant factors, including the principles a) – k) set out above at [13]. When considering all relevant factors ‘in the round’, I must bear in mind that a greater degree of similarity between goods/services *may* be offset by a lesser degree of similarity between the marks, and vice versa.

48. In the light of my findings, I will make my assessment in respect of earlier mark i) UK00917717067:



49. I have found all of the opposed terms to have some level of similarity with the Opponent’s goods under earlier mark i); ranging from identical, for all class 3 goods; to ‘above low, below medium’ for the two class 18 terms. I have found the parties’ marks to have a high level of visual similarity, the only visual difference being the presence or absence of the character ‘R’. I have found that a significant proportion of average consumers will likely articulate the marks by pronouncing each individual character i.e. ‘ESS-TEE-ARR-ATE’ versus ‘ESS-TEE-ATE’, in which case, the marks will have a medium level of aural similarity. I nevertheless acknowledge that another group of consumers, significant in number, may articulate the marks as ‘straight’ versus ‘state’. Conceptually speaking, notwithstanding that a notable proportion of consumers might perceive the marks as playful deliberate misspellings of the words ‘straight’ and ‘state’, I have found that a significant proportion of average consumers will perceive both parties’ marks as mere strings of characters to which no meaning is readily ascribed. For this latter group of consumers, there will be no conceptual aspect for the mind to fix upon. Taking into account all of the circumstances of the case, it is my view that a significant proportion of average consumers may encounter either of the parties’ marks and, overlooking the difference in spelling (the presence or absence of the

sole character 'R') and the border around the earlier mark, may presume one party's mark to be that of the other. The text element of the earlier mark is not rendered in any particularly striking way and, given the absence, for a significant proportion of consumers, of any conceptual nexus between the marks, there is very little to distinguish the marks. I find that there is a likelihood of direct confusion between the marks. I find this to be so even though the average consumer will likely pay a medium level of attention during the purchasing act.

Conclusion

50. The opposition has succeeded in its entirety. Subject to a successful appeal, the application for UK00003857114 is refused in respect of all opposed goods and may proceed to registration only with respect to the unopposed terms.

Costs

51. The Opponent is the successful party and is entitled to a contribution to its costs based upon the scale published in Tribunal Practice Notice 1/2023, calculated as follows:

Official filing fee	£200
Preparation of statement	£250
Preparation of written submissions	£350
Preparation of evidence	£200
Total:	£1,000

I have awarded a sum below the minimum threshold for the preparation of evidence because a notable proportion of the material was unnecessary and much of the Witness Statement amounted to written submission rather than evidence.

52. I therefore order ST8 S.r.l. to pay to GR. Sarantis Anonymi Viomichaniki & Emporiki Etairia Kallyntikon Endymaton Oikiakon & Pharmakeftikon Eidon the sum of £1,000. 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 8th day of July 2024

N. R. Morris

For the Registrar,

the Comptroller-General