O/0780/25

TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL REGISTRATION NUMBER 1732321
BY BE KIND CO., LTD.
TO REGISTER THE FOLLOWING TRADE MARK:

IN CLASS 25

AND

AN OPPOSITION THERETO UNDER NUMBER 443045
BY PEDIGREE LICENSED PROPERTIES LIMITED

BACKGROUND AND PLEADINGS

1. Be Kind Co., Ltd. ("the holder") is the holder of the International Registration ("the IR") shown on the cover page of this decision ("the contested mark"). The holder designated the UK as a territory in which it seeks to protect the IR under the terms of the Protocol of the Madrid Agreement on 29 March 2023. The registration was published for opposition purposes on 16 June 2023 and registration is sought for the following goods in class 25:

   Class 25- Footwear for men and women; men's footwear; shoes; footwear; training shoes; canvas shoes; running shoes; running suits; sports jerseys; sports wear; athletic uniforms; round neck T-shirts; short-sleeved shirts; long-sleeved shirts; collared shirts; waist belts; uniforms; clothing.

2. On 15 September 2023, Pedigree Licensed Properties Limited ("the opponent") opposed the application in full under section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The Opponent relies upon the following trade mark ("the earlier mark"):

   UKTM no. 3603585
   Filing date 02 March 2021; registration date 16 July 2021.
   Relying on all goods in class 25, namely:

   Class 25 - Clothing; footwear; headgear; children's clothing; children's footwear; children's headgear; sports and activity clothing, footwear and headgear (other than helmets); boots; shoes; slippers; sandals; football boots; trainers; sports shoes; T-shirts; caps; ties; scarves; socks; waterproof clothing; braces; parts and fittings for all the aforesaid goods; none of the aforesaid goods relating to wrestling or self-defence or similar activities.

3. By virtue of its earlier filing date, the opponent's mark constitutes an earlier mark within the meaning of section 6 of the Act. As the earlier mark had not completed its registration process more than five years before the designation date of the IR it is not subject to proof of use pursuant to section 6A of the Act. The opponent can, therefore, rely upon all of the goods it has identified.

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

5. The holder filed a defence and counterstatement denying the grounds of the opposition and submitting as follows:

   "1. The Applicant denies every claim, submission and argument contained in the Notice of Opposition dated 15 September 2023.

   2. The Applicant denies every claim, submission and argument contained in the Grounds of Opposition dated 15 September 2023.

   3. Submissions and evidence in defence of the Opposition will be filed during the adversarial rounds at the appropriate point in the proceedings, once the Registrar sets the submissions and evidence deadlines.

   4. The Applicant asks the Registrar to dismiss the Opposition entirely and make an award of costs in its favour".

Preliminary Issues

6. On 10 January 2025, the holder made closing written submissions in respect of a Case Management Conference ("CMC") which was requested by the opponent on 19 November 2024. A CMC was requested by the opponent, as the holder had filed content which the opponent considered should have been removed and requested that the Registry direct this. This request was refused by the Registry, and subsequently a CMC was scheduled for 09 December 2024, however, on 06 December 2024, the opponent's representative wrote to the Registry with a request

to withdraw from the CMC, confirming that it no longer was challenging the Registry's decision. The CMC was subsequently vacated on 10 December 2025. The holder submits that due to the lateness of the request it had already prepared evidence and oral submissions for the CMC resulted in additional work, which was not initially budgeted for by the holder, and has resulted in higher-than-expected legal fees being incurred. I note that only authorities were filed ahead of the hearing. The holder has requested that if they are successful in their application, the Hearing Officer take the above into account when issuing their award of costs. The holder submits that approximately £1500 of additional legal fees were incurred by the holder due to the "unnecessary actions of the opponent" and therefore, an off-scale costs award in favour of the holder has been requested. I will deal with this matter at the outcome of my decision dependent upon my findings.

Representation

7. The opponent is represented by Ashfords LLP, and the holder is represented by Albright IP Limited. Neither party filed evidence. Only the holder filed submissions during the evidence rounds dated 13 November 2024. Neither party requested a hearing however both parties filed submissions in lieu, dated 09 January 2025 and 10 January 2025 respectively. This decision is taken following a careful consideration of the papers.

Relevance of EU LAW

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

DECISION

Section 5(2)(b)

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

> "5(2) A trade mark shall not be registered if because –
>
> […]
>
> (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,
>
> there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.
>
> 5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only."

Relevant Law

10. The following principles are gleaned from the decisions of the Court of Justice of the European Union ("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 C-120/04, *Shaker di L. Laudato & C. Sas v OHIM,* Case C-334/05P and *Bimbo SA v OHIM,* Case C-591/12P.

The principles

(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

11. The competing goods are shown in the table below:

Opponent's Goods	Holder's Goods
Class 25 - Clothing; footwear; headgear; children's clothing; children's footwear; children's headgear; sports and activity clothing, footwear and headgear (other than helmets); boots; shoes; slippers; sandals; football boots; trainers; sports shoes; T-shirts; caps; ties; scarves; socks; waterproof clothing; braces; parts and fittings for all the aforesaid goods; none of the aforesaid goods relating to wrestling or self-defence or similar activities.	Class 25 - Footwear for men and women; men's footwear; shoes; footwear; training shoes; canvas shoes; running shoes; running suits; sports jerseys; sports wear; athletic uniforms; round neck T-shirts; short-sleeved shirts; long-sleeved shirts; collared shirts; waist belts; uniforms; clothing.

12. The holder has not made any submissions regarding the similarity of the goods at issue. The opponent submits as follows:

> "12. The Applicant has applied to register the Applicant's Mark for goods which are identical to the goods covered by the Opponent's Trade Mark. Whilst this is denied by the Applicant, no submissions have been put forward to argue against the Opponent's assertion.
>
> 13. In any event, it is submitted that all of the class 25 goods covered by the Applicant's Mark are identical to the class 25 goods covered by the Opponent's Trade Mark. It is an established principle that where the list of goods/services of the earlier trade mark includes a general indication or a broad category that covers the goods/services of the contested mark in their entirety, the goods/services will be identical (17/01/2012, T522/10, Hell, EU:T:2012:9,§ 36)".

13. In comparing the respective specifications, all relevant factors should be considered, as per *Canon*, where the CJEU stated at paragraph 23 of its judgment:

> "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."

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

> (a) The respective uses of the respective goods or services;
>
> (b) The respective users of the respective goods or services;
>
> (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. In Gérard Meric v OHIM, Case T- 133/05, the General Court ("GC") stated that:

"29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut 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. Further, in *Kurt Hesse v OHIM*,[1] the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*,[2] GC stated that "complementary" means:

"…there is 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."

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

17. I bear in mind that it is permissible to group goods together for the purposes of assessment: *Separode Trade Mark*:[3]

> "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."

Class 25

Running suits; sports jerseys; sports wear; athletic uniforms; round neck T-shirts; short-sleeved shirts; long-sleeved shirts; collared shirts; uniforms; clothing.

18. All the aforementioned goods in the holder's specification are items of clothing which are self-evidently identical or fall within the broader categories of 'clothing' in the opponent's specification in Class 25. The goods are, therefore, either self-evidently identical or identical on the principles outlined in *Meric*.

Footwear for men and women; men's footwear; shoes; footwear; training shoes; canvas shoes; running shoes

19. All the aforementioned goods in the holder's specification are items of footwear which are self-evidently identical or fall within the broader categories of 'footwear' in the opponent's specification in Class 25. The goods are, therefore, either self-evidently identical or identical on the principles outlined in *Meric*.

Waist belts

20. I consider that the holder's above specification are items of clothing which fall within the broader category of 'clothing' in the opponent's specification in Class 25. The goods are, therefore, identical on the principles outlined in *Meric*. If I am wrong about that, and the goods are not considered to be items of clothing, I would

[3] BL O/399/10

consider them to be accessories to clothing. Belts are used to hold up garments, such as a pair of trousers or a skirt, and can also be worn for fashionable purposes. Therefore, the goods will overlap both in user and trade channels, although I accept that the purpose of the goods will differ. I consider that the goods are likely to be produced by the same undertakings and sold via the same retailers (and for larger retailers, are likely to be displayed in the same sections). Further, I consider that the goods are complementary, in that clothing is important and indispensable to the holder's goods, e.g. belts are used for holding up items of clothing. It is my view that as a result of the close association between these goods, the average consumer is likely to consider that one undertaking is responsible for both. I therefore find these goods similar to a medium degree.

The average consumer and the purchasing act

21. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited,* [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

> "60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The word "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

22. The average consumer for the goods is likely to be a member of the general public. The goods are unlikely to be particularly expensive purchases. They are not likely to be purchased every day, although they will be purchased reasonably frequently. Factors such as materials, aesthetics and comfort are likely to be taken into consideration. The goods are likely to be purchased by self-selection from the

shelves of a retail outlet, or an online equivalent. Consequently, visual considerations will dominate the selection process. However, I do not discount an aural component to the purchase given that advice may be sought from retail assistants and word-of-mouth recommendations may play a part. Consequently, I consider that the average consumer will pay an average degree of attention during the purchasing process.

Comparison of trade marks

23. It is clear form *Sabel* that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU states at paragraph 34 of its judgment in *Bimbo*, that:

> "…it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relevant weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion."

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

25. The marks to be compared are as follows:

The opponent's earlier mark	The Holder's contested mark
SHOOT	SHOOT FOR LOVE

26. The holder submits:

> "It is denied that the respective Trade Marks are visually similar, rather, they are dissimilar. The Application comprises a complex, striking and unmistakable composite logo, whereas the Earlier Mark is merely the word "SHOOT" in red and bold font. Contrary to what has been stated by the Opponent in its Statement of Grounds, the word "SHOOT" does not form a "visually important element" in the Application and similarity is not "self-evident" …The word is being used as part of a sentence, "SHOOT FOR LOVE", which will not be broken down into its constituent parts by an English-speaking consumer. It is submitted that the Opponent is artificially dissecting this sentence, with a view to placing undue weight and importance on the word "SHOOT". Clearly, the word "SHOOT" is no more or less important than the words "FOR LOVE" but is considerably less important than the relatively large heart device from a visual perspective."

27. The opponent submits as follows:

> "The differences between the two marks are not sufficient to outweigh the visual, aural and conceptual similarities produced by the common element 'SHOOT', which plays an independent distinctive role in both marks. The differences are not enough for an average consumer (applying an average degree of attention during the selection process) to counteract and outweigh

the similarities between the marks – especially the strong conceptual similarity/overall impression of the marks (nor the fact the goods in issue are identical), such as to rule out a likelihood of confusion. The word "SHOOT" is a distinctive element of the two marks in issue and will catch the attention of average consumers when encountering the Applicant's Mark. As a consequence, it is quite likely that relevant consumers will make a connection between the conflicting marks and assume that the goods in question come from the same undertaking or, as the case may be, from economically linked undertakings."

Overall impression

28. I note that the earlier mark is a figurative five-letter word, SHOOT, presented in red and written in a simple stylised font. Whilst the stylisation contributes to the mark, the overall impression lies in the word itself.

29. The contested mark is a figurative mark which comprises of a number of elements. At the top of the mark is a large red heart device. Inside the heart, to the upper left, there is a depiction of part of a globe. Adjacent to this, in the upper right of the heart, there is a football, and below this there are 7 lines forming the lower portion of the device which give the impression of the football moving. Underneath the heart, are the words SHOOT FOR LOVE in black, which are presented in a stacked formation, with SHOOT on top and FOR LOVE below. The word FOR is presented vertically underneath the letter S. I consider that the device and words both play equal roles in the overall impression of the mark.

Visual Comparison

30. The marks overlap visually to the extent that they each contain the same word SHOOT. The earlier word-only mark is presented in red, whereas the words in the contested mark are presented in a black, however, the device is presented in red. The font in both marks is unremarkable, meaning that any difference between them is not significant and is likely to go unnoticed. The marks differ insofar as the contested mark contains a pictorial element, which is not present in the earlier

mark, along with the words FOR LOVE. Weighing up the similarities and the differences I consider that the marks are visually similar to a low degree.

Aural Comparison

31. The opponent submits:

> "In word marks, or in marks containing a verbal element, the first part is generally the part that first catches the consumer's attention. They generally pay greater attention to the beginning than to the end and, therefore, the beginning will be remembered more clearly than the rest of the mark. This means that in general the beginning of a mark has a significant influence on the general impression made by the mark (see T-412/08, TRUBION/TriBion Harmonis at para 40, and T-109/07, Spa Therapy at para 30)."

32. The holder submits:

> "Aurally… it is denied that the Trade Marks are similar, rather, they are dissimilar. The word portion of each Trade Mark comprise common English dictionary words, the likes of which will be readily understood by English speaking consumers. The Earlier Mark will be pronounced "SHOOT", whereas the Application will be pronounced "SHOOT FOR LOVE". The word portion of the Earlier Mark contains a single syllable, 5 letter word. Conversely, the word portion of the Application contains a sentence made up of 3 syllables and 3 words, which in total comprise 12 letters. When spoken, there is no reason for an English-speaking consumer to place additional weight on the word "SHOOT" as pronounced in the Application. Aurally, the word portion of the Application will always be voiced as a whole: SHOOT-FOR-LOVE. With the Application always being spoken as a complete sentence, no greater weight or importance will be given to any one word within the Application."

33. Despite the contested mark being a figurative mark, the device will not play a part when the words are articulated. I note that both marks are made up of ordinary English dictionary words, and they will be pronounced in the normal way. I consider

that the contested mark will be said in full and will not be shortened. The point of aural overlap lies with the word SHOOT, as this is the same in both marks, and will be pronounced identically. The contested mark has two additional words, FOR LOVE, making the whole mark three syllables long, whereas the earlier mark has one syllable. The point of aural overlap lies in the beginning of the marks, as the first word of the contested mark and the entirety of the earlier mark are pronounced identically. Therefore, I consider the marks to be aurally similar to a medium degree.

Conceptual Comparison

34. The opponent submits as follows:

> "The Applicant's Mark clearly gives the conceptual meaning/overall impression of a mark that associates itself with football/soccer and the 'taking of a shot' in soccer, 'out of love' for the game of soccer (i.e. through the use of the image of a moving football and the use of the words "SHOOT" and "FOR LOVE"). Further, as the Applicant admits, the Opponent's Trade Mark also refers to football players taking a shot with a football towards a goal."

35. The holder submits:

> "It is denied that the Trade Marks are conceptually similar. The word element of the Earlier Mark, "SHOOT", has no specific meaning with respect to the goods on which the Opposition is based. The Opponent claims the word "SHOOT" is a word "…which is used to encourage an attacking player in soccer to kick a ball towards their opponent's goal, with intent of scoring a goal…". This is not denied by the Applicant. However, the Opponent has failed to consider the average consumer of the goods relied upon in the Opposition and their perception of the Earlier Mark in relation to these goods, and the goods being opposed. With the exception of football boots, the word "SHOOT" as affixed to clothing (and other goods upon which the Opposition is based), will not necessarily convey a meaning of the word "SHOOT" as described by the Opponent in its Statement of Grounds. There is no evidence to suggest that an

average consumer would immediately connect the word “SHOOT” with the meaning provided by the Opponent, upon seeing the Mark affixed to clothing. As stated by the Opponent at paragraph 5h in its Statement of Grounds, the word “SHOOT” has no meaning in relation to the Class 25 goods.”

36. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer[4]. The word SHOOT has several dictionary meanings including:

    a. To fire a bullet or an arrow, or to hit, injure or kill a person or animal by firing a bullet or arrow at him/her/it;
    b. To try and score points for yourself or your team, in sports involving a ball, by kicking, hitting or throwing the ball towards the goal;
    c. To move in a particular direction very quickly and directly; and
    d. To move through or past something quickly.[5]

    As the opponent’s mark consists solely of the word SHOOT, I consider that the average consumer could reasonably attribute any of the above meanings to this word, particularly in respect of the goods for which it is registered, as the mark is not descriptive or directly allusive of the goods.

37. In respect of the contested mark the device includes a ball, and therefore clarifies that SHOOT, in this instance, is related to sports involving a ball as the device reinforces this. The words, SHOOT FOR LOVE, suggest the bringing together of people and a sense of community or unity which will be gained through sport. This is also reinforced by the device element of the mark which is in the shape of a heart and features a globe and a ball. I consider that the meaning of the common element, SHOOT, will be shared in both marks. However, when considering the contested mark as a whole (both the words and the device), it brings to mind a different concept to that of the earlier mark, as above, as SHOOT forms part of a

[4] *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R
[5] SHOOT | English meaning - Cambridge Dictionary

phrase. Therefore, I find that the marks are conceptually similar to a low degree, owing to the common element.

Distinctive character of the earlier mark

38. In *Lloyd Schuhfabrik Meyer* 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 *WindsurfingChiemsee 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)."

39. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it. However, the opponent has not filed any evidence of use in relation to its mark. Consequently, I have only the inherent position to consider.

40. The opponent's word only mark consists of the word SHOOT. The word is a widely used dictionary word to the average consumer in the UK. Being a dictionary word which is not descriptive or directly allusive of the goods I consider the earlier mark to be inherently distinctive to a medium degree.

Likelihood of confusion

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

42. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle, i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

43. I have found as follows:

- My primary position is that all the goods are identical, save that if I am wrong in relation to waist belts then these goods are similar to a medium degree;

- I have identified that the average consumer will be members of the general public. They will select the goods primarily by visual means, although I do not discount an aural component;

- I have concluded that an average degree of attention will be paid;

- The contested mark is visually similar to the earlier mark to a low degree;
- The contested mark is aurally similar to the earlier mark to a medium degree;
- I have found the contested mark and the earlier mark to be conceptually similar to a low degree;
- I have found the contested mark overall to be inherently distinctive to a medium degree;

44. Taking all of the above into account and bearing in mind the principle of imperfect recollection, I do not consider that consumers would misremember or inaccurately recall which mark was which. Even though both marks share the identical word SHOOT (which is not descriptive or allusive to the goods at issue), the additional elements in the contested mark will not be overlooked. As a result, I do not find that consumers will be directly confused by the marks as a result of the common presence of SHOOT and I do not find that the consumer is likely to mistake one mark for another. Consequently, I do not consider that there exists a likelihood of direct confusion between the marks, even on identical goods.

45. Moving on to consider indirect confusion. Indirect confusion was described in the following terms by Iain Purvis QC (as he then was), sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*:[6]

> "16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognised that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: 'The later mark is different from the

[6] BL O/375/10

earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark'.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

> (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ("26 RED TESCO" would no doubt be such a case).
>
> (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as "LITE", "EXPRESS", "WORLDWIDE", "MINI", etc.).
>
> (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ("FAT FACE" to "BRAT FACE" for example)."

46. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

47. These three categories are not exhaustive; rather, they were intended to be illustrative of the general approach, as has been confirmed by the Court of Appeal[7]. I recognise that a finding of indirect confusion should not be made merely because the competing marks share a common element. In this connection, it is not sufficient that a mark merely calls to mind another mark; this is mere association not indirect confusion[8]. The Court of Appeal has also emphasised that, where there is no direct confusion, there must be a "proper basis" for finding indirect confusion.

48. For indirect confusion to arise the average consumer must consider that as a result of the common element, there is an economic connection between the respective marks, such that the goods provided under one are regarded as a brand extension or sub brand of the other, for example.

49. I give consideration to the case of *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), where Arnold J. (as he then was) considered the impact of the CJEU's judgment in *Bimbo,* Case C-591/12P, on the court's earlier judgment in *Medion v Thomson.* The judge said:

> "18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.
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> 19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a

[7] *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207
[8] *Duebros Limited v Heirler Cenovis GmbH,* BL O/547/17

distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors."

50. In my view, I believe that the average consumer is likely to find that the words in the contested mark form a phrase with a distinct concept which is immediately graspable, and that this counteracts any visual and aural similarities between the common use of the word SHOOT. Therefore, in line with paragraph 20 of the judgment in *Whyte and Mackay Ltd,* I do not consider that the word SHOOT in the contested mark has a distinctive element independent of the whole, and I find that, on balance, the mark is more likely to be perceived as a unit and therefore the average consumer is unlikely to rely on the word SHOOT solus as being indicative of the contested mark's economic undertaking. Furthermore, I do not consider that consumers would view the differences between SHOOT and SHOOT FOR LOVE as alternations or additions that constitute a logical brand extension or sub-brand as the contested mark has its own meaning that is distinct from that of the opponent's mark (which also has its own meaning). This, combined with the use of the device in the contested mark is sufficient for the marks to be distinguished from one another. Whilst both marks share the use of SHOOT, in the contested

mark this forms part of a phrase, and when this phrase is considered in conjunction with the device, this is sufficient to enable the average consumer to distinguish between the marks. Consequently, I consider that there exists no likelihood of indirect confusion, even when the marks are viewed on identical goods.

CONCLUSION

51. The opposition fails in its entirety. Therefore, subject to appeal, the application may proceed to registration for all goods.

Costs

52. The holder has been successful and is entitled to a contribution towards their costs. Award of costs in proceedings are based upon the scale as set out in Tribunal Practice Note ("TPN") 1/2023.

53. As per paragraph 6, in their final submissions dated 10 January 2025, the holder requested that an off-scale costs award be made in their favour to reflect that the opponent requested a CMC, which was subsequently vacated by the opponent just before the hearing was due to take place. As per TPN 1/2023, off-scale costs may be awarded by the Tribunal in order to deal with the unreasonable behaviour of one of the parties. Examples of unreasonable behaviour include behaviour designed to delay, frustrate or unreasonably increase the costs/burden on the other party and/or repeated breaches of procedural rules. Whilst I accept that the holder may have incurred additional costs in preparing for a CMC, I do not consider the opponent to have been unreasonable in their behaviour to warrant an off-scale costs award. Whilst the holder submitted that they filed evidence and submissions in fact only a number of authorities were filed in advance the hearing. In the circumstances, taking into account any additional preparation time undertaken I award the opponent the sum of £800.00 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Considering the notice of opposition and filing a counterstatement:	£250.00

Preparing written submissions and considering the opponent's submissions in lieu	£350.00
Preparing for a CMC:	£200.00
Total:	**£800.00**

54. I therefore order Pedigree Licensed Properties Limited to pay Be Kind Co., Ltd. the sum of £800.00. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 26th day of August 2025
LA Bailey
For the Registrar