

**O/0810/24**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. UK00003850900**

**BY COSMO ERA LTD**

**TO REGISTER THE FOLLOWING TRADE MARK:**

**COSMO**

**IN CLASSES 14, 18 AND 25**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 439471 BY COSMO CONNECTED**

## **Background and Pleadings**

1. On 18 November 2022, Cosmo Era Ltd ('the Applicant') applied to protect the trade mark shown on the cover page of this decision, being no. UK00003850900. The application was published for opposition purposes in the Trade Marks Journal on 2 December 2022. Registration is sought for the following goods and services, the opposed terms shown in underlined text:

Class 14:

Jewellery, including imitation jewellery and plastic jewellery; fashion jewellery; jewellery cases; key rings; charms for key rings; key chains; none of the foregoing including or relating to watches.

Class 18:

Luggage and carrying bags; umbrellas and parasols;<sup>1</sup> bags; purses; beauty cases; key cases; none of the foregoing being for sport; none of the aforesaid for, containing, or in relation to electronic products (including, but not limited to computer software, computer hardware), tracking and communication technology, technology equipment, IT equipment, virtual reality or augmented reality equipment, virtual bags or virtual accessories.

Class 25:

Clothing; footwear; headwear; belts (clothing); none of the foregoing being for sport; none of the aforesaid for, containing, or in relation to electronic products (included, but not limited to computer software, computer hardware), tracking and communication technology, technology equipment, IT equipment, virtual reality or augmented reality equipment, virtual clothing or virtual accessories.

2. On 1 March 2023, the application was opposed by Cosmo Connected ('the Opponent'), based on section 5(2)(b) of the Trade Marks Act 1994 ('the Act'). The

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<sup>1</sup> Initially, all goods were opposed but the opposition was subsequently withdrawn in respect of this term.

opposition is directed against some of the goods, i.e. those underlined above. The Opponent relies upon the following earlier right:

UK801524232<sup>2</sup>

COSMO RIDE

Filing date: 31 January 2020

Date of entry in register: 1 September 2020

Priority date: 2 October 2019

Priority country: France

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

Class 9:

*Scientific apparatus and instruments; nautical apparatus and instruments; surveying apparatus and instruments; photographic apparatus and instruments; cinematographic cameras; optical apparatus and instruments; weighing apparatus and instruments; measuring apparatus and instruments; signaling apparatus and instruments; checking (monitoring) apparatus and instruments; teaching apparatus and instruments; sound recording apparatus; sound transmitting apparatus; sound reproduction apparatus; image recording apparatus; image transmission apparatus; image reproduction apparatus; digital recording media; mechanisms for coin-operated apparatus; cash registers; calculating machines; data processing equipment; apparatus and instruments for data communications, satellite communications and telecommunications; GPS (global positioning system) equipment, apparatus and devices; navigation apparatus for vehicles (on-board computers); navigational instruments; satellite navigation apparatus; computers; electronic tablets; smartphones; electronic book readers; game software; software (recorded programs); downloadable software in the nature of a mobile*

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<sup>2</sup> This is a comparable mark pursuant to article 56 of the Withdrawal Agreement, based on IR 4586829 which was registered in France prior to the withdrawal of the UK from the European Union.

*application for displaying and sharing a user location and for researching, locating, and interacting with other users; apparatus and software for GPS navigation systems and mapping systems; computer peripheral devices; detectors; electric wires; electric relays; diving suits; gloves for divers; divers' masks; clothing for protection against accidents, irradiation and fire; protection devices for personal use against accidents; fire extinguishers; spectacles (optics); 3D spectacles; virtual reality headsets; optical goods; spectacle cases; integrated circuit cards [smart cards]; bags designed for laptop computers; smartwatches; electric batteries; batteries for electronic cigarettes; charging stations for electric vehicles; diagnostic apparatus not for medical use; communication apparatus for headsets; helmet video cameras; hands-free headphones for mobile phones; headphones; audiovisual headsets for video games; headsets; music headphones; personal headphones for sound transmitting apparatus; wireless headsets for mobile telephones; cyclist helmets; American football helmets; batting helmets for baseball; ice hockey helmets; karate helmets; motorcyclist helmets; motorcycle helmets; skateboard helmets; diving helmets; protective helmets; protective helmets for sport use; helmets for protection against injury; helmets for protection against accidents; protective helmets for motorists; protective helmets for cyclists; protective helmets for motorcyclists; protective helmets for children; protective helmets for sports; protective helmets for the prevention of accidents or injuries; virtual reality headsets; catcher's helmets for baseball; safety helmets; ski helmets; welding helmets; helmets for sports; helmets for snowboarding; helmets for sports; headphones for telephones; helmets for mobile phones; protective helmets; protective helmets for sports; protective helmets for boxing; caps for protection against accidents; battery chargers for motor vehicles; headphone consoles; face-shields for protective helmets; equipment and accessories (electric and mechanical) for data processing; chin straps for baseball helmets; motorcycle goggles; micro-helmets for computers; micro-headsets for communication; balaclavas (helmet liners) for protection against accidents, radiation and fire; double plug sockets for headsets; protection (helmets for-); bags [shaped] to contain protective helmets; helmet-mounted camera supports; clothing for protection against accidents or injury for cyclists and motorcyclists;*

*holographic video headsets; connected mobile devices, namely, computer devices to be worn on or in the body of end users or to integrate clothing, footwear, headgear, protective helmets for prevention against accidents or injuries, bags, textiles, fabrics, and mobile accessories and materials and articles of all kinds usable in computing, detecting, scanning, recording, display, monitoring, information processing, remote control, forecasting, programming, connecting to computer networks or for telecommunications; mobile computer devices; devices with capability of being connected to computer networks.*

**Class 11:**

*Lighting apparatus; heating apparatus; steam generating apparatus; cooking apparatus; refrigeration apparatus; drying apparatus; water distribution apparatus; sanitary installations; air conditioning apparatus; air conditioning installations; freezers; electric flashlights; electric coffee machines; cookers (cooking stoves); lighting apparatus for vehicles; heaters for vehicles; air conditioners for vehicles; air-purifying apparatus and machines; water purifying apparatus and machines; sterilizers; cycle lights; motorcycle lights; cycle lamps; motorcycle lamps; lamps for helmets; headlights for motorcycles; headlights for motorbikes.*

**Class 12:**

*Vehicles; apparatus for locomotion by land; apparatus for locomotion by air; apparatus for locomotion by sea; suspension shock absorbers for vehicles; vehicle bodies; anti-skid chains; vehicle chassis; vehicle bumpers; sun-blinds adapted for motorized land vehicles; safety belts for vehicle seats; electric vehicles; caravans; tractors; mopeds; cycles; cycle frames; cycle kickstands; cycle brakes; cycle handlebars; bicycle rims; pedals for cycles; tires for cycles; cycle wheels; cycle saddles; strollers; handling carts; shock absorbers for cycles; shock absorbers for handlebars [parts of motorcycles]; shock absorbers for motorcycles; audible warning systems for cycles; horns for motorcycles; audio warning devices for motorbikes; bike grip tape; motorbike kickstands; motorcycle kickstands; swing arms for motorcycles; clutch cables*

*[parts of motorcycles]; brake cables [parts of motorcycles]; fork dust boots [parts of motorcycles]; motorcycle frames; motorcycle frames; roller chains for motorcycles; motorbike chains; motorbike chains; transmission chains for motorbikes; inner tubes for motorcycle tires; inner tubes for two-wheeled motor vehicles or bicycles; motorized luggage carts; foldable and non-motorized luggage carts; non-motorized carts for transporting food; carts in the form of motorized land vehicles; cases and bags for motorcycles; special boxes for motorcycles; motorized drive devices for land vehicles; brake disks [parts of bikes]; brake disks for motorbikes; front spacers [parts of motorcycles]; brake calipers [parts of motorcycles]; motorized wheelchairs for persons with disabilities and reduced mobility; front forks for motorcycles; mudguards for motorbikes; chain guards for two-wheeled motor vehicles; power trains for land vehicles; power trains, including motors for land vehicles; motorcycle handlebars; handlebars [parts of motorcycles]; motorized tailgates for trucks; adjustable covers for bikes; saddle covers for motorbikes; saddle covers for bicycles or motorcycles; saddle covers for bicycles or motorcycles; saddle covers for motorcycles; wheel rims for motorcycles; motorized food kiosks; handle bar control levers [motorcycle parts]; gear shifts [parts of motorcycles]; cranks for motorbikes; motorized drive mechanisms for land vehicles; minikikes;<sup>3</sup> motorbike engines; motorcycle engines; motorbikes; motorcycles; geared motors for land vehicles; bikes for motocross; wheel hubs for vehicles [motorcycles]; structural motorcycle parts; brake pedals [parts of motorcycles]; bike pedals; motorcycle drive gears; chain wheels for motorcycles; tires and inner tubes for motorcycles; tires for motorcycles; handlebar grips [parts of motorcycles]; twist grips for motorcycles; air pumps for motorbikes; luggage carriers for motorcycles; spokes for motorbikes; footrests for motorcycles; freewheels for motorbikes; wheels for bikes; motorbike saddles; saddles for bicycles or motorcycles; saddles for motorcycles; headlight holders [motorcycle parts]; front dash panels [parts of motorcycles]; motorized and non-motorized scooters for personal transportation; non-motorized scooters [vehicles]; two-wheeled motor vehicles; motorized and computerized golf carts; motorized golf carts.*

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<sup>3</sup> This is the term as registered, but it is presumed that this is intended to read 'minibikes'.

Class 25:

*Clothing, footwear, headwear; cyclist jackets; motorcycle jackets; boots for cycling; boots for motorcycling; waterproof suits for cyclists; waterproof suits for motorcyclists; cycling gloves; motorcycle gloves; suits for cyclists; suits for motorcyclists; leather clothing for cyclists; leather clothing for motorcyclists; shoe covers for cyclists.*

3. The Opponent claims that: the parties' marks are highly similar; and the respective goods are identical or similar, leading to a likelihood of confusion.
4. The Applicant filed a Defence and Counterstatement in which it:
  - denies that the parties' marks are highly similar and argues that any similarity is, at best, low;<sup>4</sup>
  - admits that the class 25 goods are identical;<sup>5</sup>
  - denies that any of the goods outside of class 25 are identical/similar;<sup>6</sup>
  - argues that the 'limited similarity' between the marks would offset the identity of the class 25 goods;<sup>7</sup>and
  - claims that that there is no likelihood of confusion.
5. The Opponent is represented by Bryers Intellectual Property Ltd. The Applicant is represented by Asenda Law Ltd.
6. Only the Opponent has filed evidence, which will be addressed in my decision, where appropriate. The evidence comes from Mr Romain Afflelou, CEO of the Opponent company. Mr Afflelou's Witness Statement is dated 22 September 2023 and is accompanied by 7 exhibits. The Opponent also filed written submissions during the evidence round in which it sets out where the alleged points of similarity

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<sup>4</sup> Applicant's Counterstatement, [15].

<sup>5</sup> As above, [18].

<sup>6</sup> As above.

<sup>7</sup> As above, [21d]

between the goods lie. A hearing was neither requested nor considered necessary. Only the Opponent has filed written submissions in lieu of a hearing, to which I will refer, where appropriate, in my decision.

## **RELEVANCE OF EU LAW**

7. 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.

### **Relevant legislation**

8. Section 5(2)(b) of the Act states:

'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 mark**

9. In accordance with section 6 of the Act, the Opponent's mark is an earlier mark by virtue of its priority date, which fell before the filing date of the applied-for mark.

## Section 5(2)(b) case law

10. The following principles are derived 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 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**

11. 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.

12. 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'.

13. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court stated that "complementary" means:

'...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking.'

14. Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281<sup>8</sup>, 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;

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<sup>8</sup> *British Sugar Plc v James Robertson & Sons Ltd* [1996] R. P. C. 281, pp 296-297.

(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. 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.’

16. Case law establishes that ‘... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise’ but ‘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.’<sup>9</sup>

### Class 25

17. The Applicant has conceded that the following goods are identical to those of the Opponent:

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<sup>9</sup> *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch).

*Clothing; footwear; headwear; belts (clothing); none of the foregoing being for sport; none of the aforesaid for, containing, or in relation to electronic products (included, but not limited to computer software, computer hardware), tracking and communication technology, technology equipment, IT equipment, virtual reality or augmented reality equipment, virtual clothing or virtual accessories.*

Class 14

18. The Opponent has set out where it alleges that the identity/similarity lies, as follows:<sup>10</sup>

Opponent's goods:	Applicant's goods:
<p>Class 9: <i>Smartwatches; optical goods; spectacles (optics); 3D spectacles;</i></p> <p>Class 25: <i>Clothing, footwear, headwear</i></p>	<p>Class 14: <i>Jewellery, including imitation jewellery and plastic jewellery; fashion jewellery; none of the foregoing including or relating to watches.</i></p>
<p>Class 9: <i>Smartwatches; optical goods; spectacles (optics); 3D spectacles; spectacle cases; bags designed for laptop computers; bags [shaped] to contain protective helmets; connected mobile devices, namely, computer devices to [...] integrate clothing, footwear, headgear, protective helmets for prevention against accidents or injuries, bags, textiles, fabrics [...];</i></p>	<p>Class 14: <i>jewellery cases; none of the foregoing including or relating to watches.</i></p>

<sup>10</sup> Opponent's written submissions in lieu of a hearing, [11]. I have presented the information slightly differently to the Opponent, i.e. the opposed goods being in the right-hand column.

<p>Class 12: <i>cases and bags for motorcycles; special boxes for motorcycles; luggage carriers for motorcycles</i></p> <p>Class 25: Clothing, footwear, headwear</p>	
<p>Class 9: <i>Smartwatches; optical goods; spectacles (optics); 3D spectacles; spectacle cases; bags designed for laptop computers; bags [shaped] to contain protective helmets; connected mobile devices, namely, computer devices to [...] integrate clothing, footwear, headgear, protective helmets for prevention against accidents or injuries, bags, textiles, fabrics [...].</i></p> <p>Class 12: <i>cases and bags for motorcycles; special boxes for motorcycles; luggage carriers for motorcycles.</i></p> <p>Class 25: Clothing, footwear, headwear.</p>	<p>Class 14: <i>key rings; charms for key rings; key chains; none of the foregoing including or relating to watches.</i></p>

19.I note that the Opponent has not identified which particular term within its specification provides its best case. I therefore have no alternative but to identify the closest comparator within the Opponent's specification based on my own understanding of the terms.

Contested goods: *Jewellery, including imitation jewellery and plastic jewellery; fashion jewellery; none of the foregoing including or relating to watches.*

20. Jewellery is coveted, essentially, for its decorative and aesthetic qualities and is typically worn on the body or about the person. I consider the most appropriate comparator to be the Opponent's class 25 term *clothing*. To my mind, clothing has several functions, *inter alia*: for warmth/protection from the elements; coverage for reasons of modesty; and as adornment or decoration. The goods will overlap in purpose somewhat; i.e. where both are sought for their aesthetic or decorative value. Users will overlap, albeit such overlap is of little import due to the fact that almost all of the general public will be users of clothing. Trade channels will overlap somewhat because it is not unusual for costume jewellery and clothing to originate from the same undertaking. Methods of use will be similar to the extent that both will be 'put on' the person. The goods are not in competition, neither being substitutable for the other. I do not find complementarity either; the goods being neither necessary nor important for each other. The goods will differ in physical nature. I find the goods to have a very low level of similarity.

Contested goods: *jewellery cases; none of the foregoing including or relating to watches.*

21. I consider the Opponent's class 9 term *spectacle cases* to be the most appropriate comparator. The purpose of *jewellery cases* is to store jewellery; to protect it from damage and/or prevent it from getting lost (jewellery items typically being small and fragile). The purpose of *spectacle cases* is the storage of spectacles to protect them from damage. The parties' goods will therefore coincide in purpose to the broad extent that both are intended to store items to protect them from damage. However, their specific purposes will differ by virtue of the different goods encased by them. Users will overlap; many consumers of spectacle cases will also be wearers of jewellery for which they require jewellery cases. Trade channel overlap will not, to my mind, be commonplace. Methods of use will coincide, i.e. items will be placed inside both. In my view, although both are typically used to store small items, the goods cannot be considered competitive because neither is a commercially realistic substitute for the other. There is no complementarity

between them, either. The goods will have some similarity in terms of their physical nature to the extent that both take the form of cases which can be opened and closed. I find a fairly low level of similarity between the goods.

Contested goods: *key rings; key chains; none of the foregoing including or relating to watches.*

22. Key rings and key chains are rings/chains to which keys are attached in order to keep them together. I have borne in mind the purposes, users, trade channels, physical natures and methods of use of the parties' goods, together with the matters of competition and complementarity. I do not consider there to be any level of similarity between the contested goods and the goods identified as comparators by the Opponent. I find the goods to be dissimilar. I recognise that users and trade channels will overlap, but these factors, without more, are insufficient to support a finding of similarity.

Contested goods: *charms for key rings; none of the foregoing including or relating to watches.*

23. The Applicant's goods are trinkets which are attached to key rings, whose function is purely decorative. For analogous reasons to those given above at [22], I do not find any similarity between the parties' goods – they are dissimilar.

### Class 18

24. The Opponent has set out where it alleges that the identity/similarity lies, as follows:<sup>11</sup>

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<sup>11</sup> Opponent's written submissions in lieu of a hearing, [11]. I have presented the information slightly differently to the Opponent, i.e. the opposed goods being in the right-hand column.

Opponent's goods:	Applicant's goods:
<p>Class 9:  <i>spectacle cases; bags designed for laptop computers; bags [shaped] to contain protective helmets; connected mobile devices, namely, computer devices to [...] integrate clothing, footwear, headgear, protective helmets for prevention against accidents or injuries, bags, textiles, fabrics [...];</i></p>	<p>Class 18:  <i>Luggage and carrying bags; bags; purses; beauty cases; key cases; none of the foregoing being for sport; none of the aforesaid for, containing, or in relation to electronic products (including, but not limited to computer software, computer hardware), tracking and communication technology, technology equipment, IT equipment, virtual reality or augmented reality equipment, virtual bags or virtual accessories.</i></p>

25. The Opponent has submitted that:<sup>12</sup>

'Class 9 of the Earlier Mark lists a number of items which are intended for use for carrying and protecting other items. These include spectacle cases, bags designed for laptop computers and bags shaped to contain protective helmets. Mr Afflelou [in his Witness Statement] explains [that] luggage producers typically sell a variety of bags and cases and he exhibits bags and cases from a leading producer, Samsonite. [...] Mr Afflelou also describes a collaboration with Delsey in relation to the incorporation of a light into its technology adapted back pack. [...] the adapted luggage is available in a variety of forms and with other more general functions and promoted and sold to match non adapted luggage. There is an extremely high degree of similarity between bags designed for laptop computers and partially or non-adapted luggage as both are produced using the same materials, from the same producer, for the purpose of conveniently and safely carrying items, such methods of use being

<sup>12</sup> Opponent's written submissions in lieu of a hearing, [15].

similar (zips, closures, hand straps, shoulder straps all being common features) and sold alongside one another and so sharing trade channels and users’.

26. I note the following from Mr Afflelou’s evidence:

a. Screenshots of product listings, undated but annotated as ‘taken 12 September 2023’, show examples of bags and clothing on the market which incorporate LED lights including:<sup>13</sup>

- a backpack with an integrated LED light on the back, which is USB rechargeable, from the website ‘studentcomputers.co.uk’;
  - a ‘bicycle reflective safety LED backpack bag with wireless remote control safety light, listed on Amazon.co.uk;
  - an LED beanie hat, listed on the website ‘uk.rs-online.com’;
  - a Hi-vis jacket featuring LED lights across the chest, which is USB rechargeable, from the website ‘kootchyproducts.co.uk’;
- and
- a ‘Hi-vis Torch E-Bike jacket’ featuring four LED lights, from the website ‘showerspass.co.uk’.

b. Undated screenshots from the website of luggage retailer ‘Samsonite’ show product listings for the following cabin bags and suitcases which incorporate some sort of electronic functionality or utility for devices:<sup>14</sup>

- a cabin bag and suitcases with smart charging;
- backpacks and crossbody bags with compartments for laptops/tablets.

27. The Opponent’s essential argument is that the Applicant’s luggage/bags are highly similar to bags designed for laptops. However, it is not clear why the Opponent is also likening the Applicant’s goods to luggage adapted to have certain technological features. Such comparison might be helpful if the Opponent’s

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<sup>13</sup> Exhibits 5 and 6.

<sup>14</sup> Exhibit 7.

specification included such adapted luggage/bags, but it does not. Although the Opponent's specification includes computer devices which can be integrated into bags, it does not include the adapted bags/luggage as finished products. The aforementioned evidence is therefore of little assistance.

28. The Applicant's class 18 specification contains the exclusion '*none of the aforesaid for, containing, or in relation to electronic products (including, but not limited to computer software, computer hardware), tracking and communication technology, technology equipment, IT equipment, virtual reality or augmented reality equipment, virtual bags or virtual accessories*'. This limitation explicitly excludes from the Applicant's term laptop bags. Furthermore, the NICE classification system itself excludes from class 18 'bags and cases adapted to the product they are intended to contain, for example, bags adapted for laptops'. There cannot, therefore, be identity between the Opponent's *bags designed for laptop computers* and the Applicant's luggage and bags. I will therefore proceed to apply the usual 'Treat' factors to assess whether there is similarity.

Contested goods: *Luggage and carrying bags; bags; none of the foregoing being for sport; none of the aforesaid for, containing, or in relation to electronic products (including, but not limited to computer software, computer hardware), tracking and communication technology, technology equipment, IT equipment, virtual reality or augmented reality equipment, virtual bags or virtual accessories*.

29. I compare the Applicant's goods to the Opponent's *bags designed for laptop computers*. Luggage/carrying bags and bags, at large, function as portable receptacles for items. The parties' goods will overlap in purpose on a general level, both being receptacles, albeit their specific purposes will differ; the Opponent's bags being specifically for laptop computers. Users will overlap. Trade channels may overlap somewhat: I consider that some undertakings will produce both 'ordinary' bags/luggage as well as laptop bags. Methods of use will overlap to the broad extent that, for both goods, items are placed inside them, and they can be carried around. The goods will be similar in nature in some instances; where 'ordinary' bags are similar in shape and size to 'laptop' bags and/or fashioned from

similar materials. Although, in practice, laptops can be carried around in any bag that fits them, I do not consider this to give rise to a competitive relationship. In my view, the goods are not commercially realistic substitutes for one another; a prospective purchaser specifically seeking a laptop bag, which will be specifically designed to fit the shape of a laptop and protect it from damage, will unlikely settle for an 'ordinary' bag instead. Conversely, a purchaser seeking an 'ordinary' bag is even less likely to deliberate over whether to purchase a 'laptop' bag as an alternative. I do not find complementarity, either; neither party's offering being necessary or important for the other. In the light of the foregoing, I find the goods to have no more than a medium level of similarity.

*Contested goods: purses; none of the foregoing being for sport; none of the aforesaid for, containing, or in relation to electronic products (including, but not limited to computer software, computer hardware), tracking and communication technology, technology equipment, IT equipment, virtual reality or augmented reality equipment, virtual bags or virtual accessories.*

30. I compare the Applicant's goods to the Opponent's *bags designed for laptop computers*. A purse is, essentially, a receptacle for cash (coins and notes) and/or payment cards. The parties' goods will overlap in purpose only on the general level outlined above at [29]. Their specific purposes will differ by virtue of the items contained in them. Users will overlap. I consider trade channel overlap to be fairly uncommon. Methods of use for the goods will coincide only in the very general way noted above. The goods will differ in physical nature to the extent that purses will be significantly smaller in size than laptop bags. The goods are neither competitive nor complementary, neither being substitutable nor necessary/useful for the other. I find the goods to have a very low level of similarity.

*Contested goods: beauty cases; none of the aforesaid for, containing, or in relation to electronic products (including, but not limited to computer software, computer hardware), tracking and communication technology, technology*

*equipment, IT equipment, virtual reality or augmented reality equipment, virtual bags or virtual accessories.*

31. Beauty cases are, to my mind, intended to house items such as cosmetics, toiletries and grooming tools such as brushes/combs. I compare the Applicant's goods to the Opponent's *bags designed for laptop computers*. Although both goods are receptacles, the goods will have distinct specific purposes by virtue of the different items housed in them. Users will overlap. Trade channel overlap is unlikely, although not impossible. The goods will differ in terms of their methods of use and physical natures in a similar manner to that outlined above at [30]. They are neither competitive nor complementary. All things considered, I find the goods to be dissimilar. An overlap in user and the shared general purpose of being a receptacle of some sort are, in my view, insufficient to support a finding of similarity. If I am wrong about that, the goods will have only a very low level of similarity.

*Contested goods: key cases; none of the foregoing being for sport; none of the aforesaid for, containing, or in relation to electronic products (including, but not limited to computer software, computer hardware), tracking and communication technology, technology equipment, IT equipment, virtual reality or augmented reality equipment, virtual bags or virtual accessories.*

32. The Applicant's goods are receptacles for keys. I compare these goods to the Opponent's *bags designed for laptop computers* and find them to be dissimilar, for reasons analogous to those given above at [31]. If I am wrong, then any similarity will be very low.

33. Some similarity between the parties' goods and services is essential in order to find a likelihood of confusion between the parties' marks. In the case of *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

'49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover, I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be

shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity'.

34. The opposition against the goods that I have found to be outright dissimilar therefore fails at this point. For ease of reference, I set out those goods here:

Class 14:

*key rings; charms for key rings; key chains; none of the foregoing including or relating to watches.*

#### **Average consumer and the purchasing act**

35. 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*.

36. The average consumer of the relevant goods in this opposition will be the general public. The purchasing act will be primarily visual; the goods first encountered either in physical shops or by way of product listings on websites. In physical shops, the goods will likely be self-selected by the consumer and examined before purchase. I acknowledge that there may be an aural aspect to the purchasing process in some instances where purchases are made following recommendations, ‘word-of-mouth’ mentions or where enquiries are made to retail staff. In my view, the average consumer will likely pay a medium degree of attention during the purchasing act, taking into account factors such as, *inter alia*, size, fabric/ materials, durability, how the goods look when worn (in the case of clothing or jewellery).

## Comparison of the marks

37. 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.’

38. 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.

39. The marks to be compared are:

Opponent's mark:	Applied-for mark:
COSMO RIDE	COSMO

### Overall impression of the marks

40. The earlier mark is a word mark<sup>15</sup> comprising the words 'Cosmo Ride' rendered in a plain typeface. I consider both words to play a role within the overall impression of the mark, with 'Cosmo' playing the greater role owing to the fact that 'ride' might be seen as alluding to the possibility that the goods are used when engaged in a 'riding' activity; for example, cycling or horse-riding.
41. The Applicant's mark, also a word mark, comprises the single element 'Cosmo' rendered in a plain typeface. No other elements or stylistic aspects being present, the overall impression of the mark can only reside in the word 'Cosmo'.

### Visual comparison

42. Both marks contain the word 'COSMO', the only visual difference being the presence of the word 'RIDE' in the Opponent's mark, which is absent from the Applicant's mark. I consider the level of visual similarity to be above 'medium' but below 'high'.

### Aural comparison

43. The words 'Cosmo' and 'Ride' will be articulated in the usual way, i.e. 'COZZ-MOE' and 'RIDE'. 'Cosmo' will sound the same in each mark. The only point of aural difference resides in 'Ride', the second element of the Opponent's mark which will not, in my view, escape the attention of the average consumer. I find the marks to have a level of aural similarity of above 'medium' but below 'high'.

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<sup>15</sup> 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).'

### Conceptual comparison

44. The Opponent has submitted that 'COSMO is not an English word' and that it 'has no inherent meaning'.<sup>16</sup> The Applicant has argued that 'the relevant public would understand 'COSMO' as relating to the universe or world'.<sup>17</sup> The Opponent has argued that although 'COSMO' forms the first part of the words 'cosmonaut' and 'cosmopolitan', 'those words have a clear and well accepted meaning, but without a clear common, recognizable [sic] connection'.<sup>18</sup>
45. According to the Collins English Dictionary, the word 'cosmo' is a prefix which indicates the world or universe.<sup>19</sup> Strictly speaking, the Opponent's analysis is incorrect; the word 'cosmo' does, in fact, have a meaning and words including the prefix can be said to have a common connection in so far as the 'cosmo' element contributes the notion of 'world' or universe. However, my assessment is concerned with the knowledge of the average consumer. My view is that, although many average consumers will understand the meaning of 'cosmo', there will also be a significant proportion who may be unaware of its dictionary definition and who will, therefore, perceive 'cosmo' as an invented word or, perhaps, a real word whose meaning is unknown.
46. The word 'ride' is a commonly-used English word with which the average consumer will be very familiar. It will be likely be understood as the verb meaning either to control/propel, perhaps a horse/bicycle or to be carried along by a vehicle of some sort.
47. My view is that a significant proportion of average consumers may be unfamiliar with the meaning of the word 'Cosmo' and perceive the Opponent's mark as denoting a brand by the name of 'Cosmo' whose goods might have a connection with cycling or horse-riding. The Applicant's mark would be perceived as a made-up word or, perhaps, a word whose meaning is not known. For a significant proportion of average consumers, the marks will be more or less conceptually neutral. Although the word 'ride' will be understood to convey the idea of riding

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<sup>16</sup> Opponent's written submissions in lieu of a hearing, [22] and [25].

<sup>17</sup> Applicant's counterstatement, [17].

<sup>18</sup> Opponent's written submissions in lieu of a hearing, [22].

<sup>19</sup> Collins English Dictionary, Third Edition, (1991).

(bicycles or horses, for example), this 'conceptual' aspect will likely be seen as an allusion to the goods themselves or the context in which they are used.

### **Distinctive character of the earlier marks**

48. *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).'

49. 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.

50. I have found that a significant proportion of average consumers will likely perceive the word 'Cosmo' as either an invented word or a real word whose meaning is unknown. The word 'ride' is a commonly used word with which the average consumer will be familiar. 'Cosmo' neither describes nor alludes to the relevant goods. I have found that a significant proportion of average consumers might see 'ride' as an allusion to cycling or horse-riding and might surmise that the goods have some connection with those activities; for example, a laptop bag designed to be carried while cycling. My view is that the mark 'Cosmo Ride' will have a medium to high level of inherent distinctive character.

51. I now consider whether the earlier mark enjoys a level of enhanced distinctiveness. The Opponent has provided evidence of its collaboration with a brand 'Delsey' on a line of bags.<sup>20</sup> A Wikipedia entry states that 'as of 2010, [Delsey] held second place in the global luggage market, behind Samsonite.'<sup>21</sup> This is accompanied by a screenshot showing a close-up of the bag which, despite the poor resolution, I am able to see bears both the 'Delsey' and 'Cosmo' marks.<sup>22</sup> There is evidence of another collaboration with the brand 'b&sh' by way of a screenshot showing a close-up photograph of a helmet bearing the marks 'Cosmo Connected' and 'ba&sh'.<sup>23</sup> These pieces of evidence are undated but for the annotation from the Opponent that the screenshots/prints were 'taken 12 September 2023', which is after the relevant date for assessing enhanced distinctiveness (i.e. the filing date of the Applicant's mark). The Opponent's mark 'Cosmo Ride' does not appear in the evidence. Based on the limited material provided, it is not possible to discern what, if any, level of exposure the earlier mark has had in the UK market. Although Mr Afflelou has mentioned that the goods shown in Exhibit 3 incorporate 'Cosmo Ride' as a key feature, there is no elaboration on what this feature is, nor are there any clear examples of the mark 'Cosmo ride' in use.<sup>24</sup> It is my view that the material available to me is insufficient to support a finding that the earlier mark enjoys a level of distinctiveness beyond the 'medium to high' level that I have found in assessing the inherent position. The provision of, *inter alia*, UK sales

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<sup>20</sup> Exhibit 3.

<sup>21</sup> As above.

<sup>22</sup> As above.

<sup>23</sup> Exhibit 4.

<sup>24</sup> Witness statement of R. Afflelou, [23].

figures/advertising and marketing expenditure, information on the Opponent's position in the UK market and examples of the 'Cosmo Ride' mark in use in the UK would have been helpful.

### **Likelihood of confusion**

52. 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*<sup>25</sup>. Direct confusion occurs when one mark is mistaken for another. In *Lloyd Schuhfabrik*<sup>26</sup>, 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 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.

53. 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 [10]. 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.

54. It is my view that, despite the identity and similarity between the parties' goods, the net effect of the visual and aural differences that I have identified is sufficient to mitigate against a likelihood of direct confusion. I have found the marks to be visually and aurally similar to a level above medium but below high. Although the Applicant's mark 'Cosmo' is wholly incorporated into the earlier mark as its first

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<sup>25</sup> Case BLO/375/10 at [16].

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

element, the only visual and aural difference between the marks being the presence/sound of 'ride' in the latter mark, this difference will, to my mind, unlikely escape the attention of the average consumer. I have found the marks to be more or less conceptually neutral for a significant proportion of average consumers. Even though the element 'ride' is the less distinctive element of the Opponent's mark, its presence will nevertheless be registered. Visually speaking, it occupies 4 out of the 9 characters of which the fairly short mark is composed and cannot, in my view, be considered a negligible component. Although I have found that 'Ride' will, for a significant proportion of average consumers, be seen as somewhat allusive, this does not necessarily render the word aurally invisible.<sup>27</sup> I have also borne in mind the 'rule of thumb' that the beginnings of word marks generally tend to have more visual and aural impact than the ends.<sup>28</sup> However, this is not a 'principle' to be applied rigidly. Taking all of the above into account, and even bearing in mind the possibility of imperfect recollection, I find that there is no likelihood of confusion between the marks. In reaching this conclusion, I have borne in mind that a greater degree of similarity *may* mitigate against a lesser degree of similarity between marks. In the instant case, however, even where the level of attention paid during the purchasing act will only be medium, I do not consider the fact that the parties' services are identical to diminish the impact upon the consumer of the differences between the marks. I find that there is no likelihood of direct confusion between the marks.

55. I now consider whether there is a likelihood of indirect confusion. I note that in the case of *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.

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<sup>27</sup> BLO-115-22 PURITY HEMP, per Philip Harris sitting as the Appointed Person.

<sup>28</sup> *El Cort Inglés, SA v OHIM*, cases T-183/02 and T-184/02.

56. I bear in mind that in *L.A. Sugar Limited v Back Beat Inc*<sup>29</sup> Mr Iain Purvis Q. C. (as he then was), as the Appointed Person, explained that [my words in parentheses]:

‘17. Instances where one may expect the average consumer to reach such a conclusion [i.e. to conclude that marks relate to the same or economically linked undertakings] 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)’

57. I acknowledge that these categories are not intended to be exhaustive. I consider the instant case to align most closely with the second category identified by Mr Purvis. The Applicant’s mark ‘Cosmo’ is wholly replicated within, and forms the first element of, the earlier mark, with neither modification to its appearance, nor change to its inherent distinctive character. In my view, the presence of the lesser distinctive element ‘Ride’ in the Opponent’s mark will likely be seen as an ‘add-on’ to the distinctive element ‘Cosmo’ and, therefore, a sub-brand or brand extension. I find that a significant proportion of average consumers will notice the differences between the parties’ marks but conclude that both marks originate from the same

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<sup>29</sup> Case BL O/375/10

or economically-related undertakings. I find that there is a likelihood of indirect confusion.

58. For the goods that I have found to have only a 'very low' level of similarity, I find that the 'distance' between the goods is sufficient to offset the similarities between the marks and that there is, therefore, no likelihood of indirect confusion.

### **Conclusion**

59. This partial opposition has succeeded in respect of some of the opposed goods. Subject to a successful appeal, the application:

- Is refused for the following;

Class 14: <i>jewellery cases; none of the foregoing including or relating to watches.</i>
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Class 18: <i>Luggage and carrying bags; bags; none of the foregoing being for sport; none of the aforesaid for, containing, or in relation to electronic products (including, but not limited to computer software, computer hardware), tracking and communication technology, technology equipment, IT equipment, virtual reality or augmented reality equipment, virtual bags or virtual accessories.</i>
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Class 25: <i>Clothing; footwear; headwear; belts (clothing); none of the foregoing being for sport; none of the aforesaid for, containing, or in relation to electronic products (included, but not limited to computer software, computer hardware), tracking and communication technology, technology equipment, IT equipment, virtual reality or augmented reality equipment, virtual clothing or virtual accessories.</i>
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- May proceed to registration for the following:

Class 14:

*Jewellery, including imitation jewellery and plastic jewellery; fashion jewellery; key rings; key chains; charms for key rings; none of the foregoing including or relating to watches.*

Class 18:

*purses; beauty cases; key cases; none of the foregoing being for sport; none of the aforesaid for, containing, or in relation to electronic products (including, but not limited to computer software, computer hardware), tracking and communication technology, technology equipment, IT equipment, virtual reality or augmented reality equipment, virtual bags or virtual accessories.*

## **COSTS**

60. Both parties have enjoyed some measure of success. I therefore make no order as to costs.

**Dated this 22<sup>nd</sup> day of August 2024**

**N. R. Morris**

**For the Registrar,**

**the Comptroller-General**