O/0840/24

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATIONS NOS. UK00003751374, UK00003751369 AND UK00003751376
BY ROBERT NIGHTINGALE AND JONATHAN CAZZOLA
TO REGISTER THE FOLLOWING TRADE MARKS:

Malle London

IN CLASSES 12, 18 AND 25

&

The Malle Mile

IN CLASSES 9, 25 AND 41

&

Malle Rally

IN CLASSES 9, 25 AND 41

AND

IN THE MATTER OF THE OPPOSITIONS THERETO
UNDER NOS. 433753, 433754 AND 433755
BY MALLET. FOOTWEAR LTD

BACKGROUND AND PLEADINGS

1. These are consolidated opposition proceedings brought by Mallet. Footwear Ltd ("the opponent") against three applications jointly filed on 04 February 2022 by Robert Nightingale and Jonathan Cazzola ("the applicants") to register the following trade marks and their goods and services in the UK:

UK00003751374 ("the 374 mark") Malle London **Class 12:** *Panniers; Panniers and Bags for motorcycles, Bags [panniers] for bicycles, Panniers adapted for bicycles, Panniers adapted for cycles, Panniers adapted for motorcycles.* **Class 18:** *Bags, holdalls, haversacks, rucksacks, wallets, purses, brief cases and umbrellas.* **Class 25:** *Articles of outerclothing; articles of protective clothing (other than clothing for protection against accident or injury) and footwear being articles of clothing; Clothing; footwear; headgear; t-shirts, caps, baseball caps, hats, sweatshirts, jackets; trousers and socks.*
UK00003751369 ("the 369 mark") The Malle Mile **Class 9:** *Recordings of sounds or images; photographs, records, video recordings, or publications, in digital form, all captured, created or relating to the entertainment and the event.* **Class 25:** *Clothing; footwear; headgear; t-shirts, caps, baseball caps, sweatshirts, jackets; all relating to the event.* **Class 41:** *Organising of motor racing events; Organisation of automobile racing events; Organisation of vehicle racing events; Organisation of motorcycle racing; Organisation of automobile rallies, tours and racing events; Organisation of cultural*

events; Organisation of sporting events; Organising community cultural events; Organisation of musical concerts.
UK00003751376 (“the 376 mark”) Malle Rally **Class 9:** *Recordings of sounds or images; photographs, records, video recordings, or publications, in digital form, all captured, created or relating to the entertainment and the event.* **Class 25:** *Clothing; footwear; headgear; t-shirts, caps, baseball caps, sweatshirts, jackets; all relating to the event.* **Class 41:** *Organisation of motorcycle rallies, tours and racing; Organising of motor racing events; Organisation of vehicle racing events; Organisation of motorcycle racing; Organisation of automobile rallies, tours and racing events; Organisation of sporting events.*

2. These applications were all published for opposition purposes on 25 February 2022.

3. On 24 May 2022, the opponent filed respective oppositions nos. 433753, 433754 and 433755, opposing the applications under Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The oppositions are only partial, being directed at some of the goods for which the applicants seek to register their marks, namely those in class 25. In each opposition, the opponent relies on the following registrations and the goods covered by the same, as shown below:

UK00003312944 (“the first earlier mark”) Mallet London Filing date: 23 May 2018 Registration date: 19 October 2018 Goods: **Class 25:** *Clothing, footwear, headgear.*

UK00003640464 (“the second earlier mark”) MALLET Filing date: 12 May 2021 Registration date: 05 November 2021 **Class 25:** *Clothing; footwear; headgear; belts.*

4. The opponent claims that the respective goods are identical or similar and that the respective marks are similar, such that there exists a likelihood of confusion, including a likelihood of association. In particular, the opponent argues that the distinctive elements of the parties’ marks are the words ‘MALLE’ and ‘MALLET’ which differ only by the omission of the final letter ‘T’ in the applicant’s marks. Further, the opponent argues that (a) the word ‘LONDON’ is commonly used in relation to the goods at issue to denote the location where the goods are designed or sold (opposition to the 374 mark); (b) the word ‘MILE’ is a commonly used measurement of distance, whereas the article ‘THE’ is often overlooked or dropped (opposition to the 369 mark) and (c) the word ‘RALLY’ is commonly used to refer to an event or public gathering and therefore has little distinctiveness in relation to the contested goods (opposition to the 374 mark).

5. By virtue of their earlier filing dates, the trade marks relied upon by the opponent are “earlier marks” in accordance with Section 6 of the Act. As the opponent’s earlier marks had not been registered for five years or more at the filing date of the applied-for marks, they are not subject to proof of use. Consequently, the opponent may rely on all of the goods it has identified without demonstrating that it has used the marks.

6. The applicants filed counterstatements in all of the oppositions wherein they denied the claims made. In particular, the applicants argue that the competing marks are conceptually different because the words ‘MALLET’ and ‘MALLE’ have different meanings, the former referring to *“a long-handled wooden stick with a head like a hammer, used for hitting a croquet or polo ball”* and the latter being *“the old word for a trunk, a large leather bag, or wooden travel-case”.* Further, the applicants argue that although there is only one letter that distinguishes the words ‘MALLET’ and ‘MALLE’, that does not mean that the marks are confusingly similar because, they state, there

are *"hundreds of thousands of other words that share all but one letters"* mentioning, by way of examples, the brands "Nike" and "Nice" which are said to operate in the market for shoes and wet-wipes, respectively, without being confused.

7. Other arguments put forward by the applicants are, as observed by the opponent in its submissions in lieu, irrelevant or go beyond what the applicant can plead. For example, the applicants state that they are a London-based motorcycle luggage company which make trunks, bags and luggage for motorcycles, as well as hosting motorcycle events such a motorcycle festival promoted under the trade mark 'The Malle Mile', and various motorcycle rallies promoted under the trade marks 'The Great Malle Rally' (for a UK rally), 'The Great Malle Mountain Rally' (for an Austria-Monaco rally), 'The Great Malle Arctic Rally' (for a Copenhagen-Arctic rally) and 'The Great Malle Desert Rally' (for a Sahara rally). The applicants explain that they have used the term 'Malle Rally' for the official expedition luggage and kit they make for the riders, including tents, towels, camp wear and outerwear and claim that their *"reputation and offerings could and would never been confused for [the opponent] who is a shoe retailer".* Lastly, the applicants claim to be the owners of a registration for the trade mark 'Malle London' (no. UK00003093844) which pre-dates the earlier marks, having a filing date of 11 February 2015, and refer to potential invalidity proceeding that could be launched against the opponent's earlier marks.

8. None of the facts relied upon by the applicants, including the differences in the goods and services effectively offered by the parties and the segments of the market in which the parties operate have any bearing on the assessment I am required to make. When considering the likelihood of confusion under Section 5(2)(b) the assessment must be based, in fact, on the concept of 'notional and fair use' which involves carrying out the comparison of the goods and services based on the specifications before me, not the goods and services effectively provided by the parties.[1] This is the approach I will take.

9. Likewise, the applicants' reliance on their ownership of a trade mark which pre-dates the filing dates of the earlier marks and could potentially be used by the

[1] *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06 at [66] and *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 at [22]

applicants to invalidate the earlier marks is not a viable argument. Tribunal Practice Notice ("TPN") 4/2009 *"Trade mark opposition and invalidation proceedings – defences"* explains the position with regard to defences based on a claim that the applicant for registration has a registered trade mark that predates the trade mark upon which the attacker relies for grounds under Section 5(2) of the Act. It states as follows:

> "4. The viability of such a defence was considered by Ms Anna Carboni, sitting as the appointed person, in I*on Associates Ltd v Philip Stainton and Another,* BL O-211-09. Ms Carboni rejected the defence as being wrong in law.
>
> 5. Users of the Intellectual Property Office are therefore reminded that defences to section 5(1) or (2) grounds based on the applicant for registration/registered proprietor owning another mark which is earlier still compared to the attacker's mark, or having used the trade mark before the attacker used or registered its mark are wrong in law. If the owner of the mark under attack has an earlier mark or right which could be used to oppose or invalidate the trade mark relied upon by the attacker, and the applicant for registration/registered proprietor wishes to invoke that earlier mark/right, the proper course is to oppose or apply to invalidate the attacker's mark."

10. This approach was communicated to the parties with the official letter of 25 November 2023 under the heading *"Applicant's comments regarding potential counterclaim".* The letter invited the applicants to note that there is no mechanism for counterclaims within opposition proceedings and stated that if they had filed invalidity proceedings, they should provide the cancellation number. No response has been received to date.

11. The proceedings were consolidated on 22 March 2023 under Rule 62(1)(g) of the Trade Marks Rules 2008.

12. The opponent is represented by Murgitroyd & Company. The applicants are litigants in person acting without legal representation. Neither party filed evidence during the proceedings and neither party requested a hearing, however, the opponent

filed submissions in lieu of a hearing. I make this decision having taken full account of all the papers, referring to them as necessary.

RELEVANCE OF EU LAW

13. 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)

14. Section 5(2)(b) of the Act reads as follows:

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

15. Section 5A of the Act is as follows:

> "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."

16. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG,* Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc,* Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV,* Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH,* Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM,* Case C-334/05P and *Bimbo SA v OHIM,* Case C-591/12P:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a greater 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 to mind the earlier mark, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

17. 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 for Lernsysterne 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."

18. The goods to be compared are as follows:

The applicant's marks	The opponent's marks
The 374 mark **Class 25:** *Articles of outerclothing; articles of protective clothing (other than clothing for protection against accident or injury) and footwear being articles of clothing; Clothing; footwear; headgear; t-shirts, caps, baseball caps, hats, sweatshirts, jackets; trousers and socks.*	The first earlier mark **Class 25:** *Clothing, footwear, headgear.*
The 369 mark and the 376 mark **Class 25:** *Clothing; footwear; headgear; t-shirts, caps, baseball caps, sweatshirts, jackets; all relating to the event.*	The second earlier mark **Class 25:** *Clothing; footwear; headgear; belts.*

19. The applied-for goods are various articles of clothing, footwear and headgear which fall within the terms *clothing, footwear, headgear* in the specification of the earlier marks. The applied-for goods are all identical to the opponent's goods on the principle outlined in *Meric*.

20. The limitation *"all relating to the event"* in the specification of the 369 mark and the 376 mark refers to the way in which the applicants intend to market their goods, i.e. as branded event merchandising. Aside from the fact that the limitation in the applicants' marks does not identify a sub-category of goods (and I am not convinced that it should be taken into account),[2] the opponent's terms *Clothing; footwear; headgear* are sufficiently broad to encompass goods relating to the same events as those hosted by the applicants; consequently, the limitation, even if taken into account, would not prevent the goods from being identical.

[2] See Tribunal Practice Notice 1/2024: Restricting specifications of applications and registrations subject to Tribunal proceedings.

Average consumer

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. (as he then was) 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 words "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 parties' goods is the general public. By and large, consumers pay a medium degree of attention during the selection of goods such as clothing, footwear and headgear, giving consideration to factors such as quality, material, fit, suitability and aesthetics.

23. The goods will be selected mainly from displays in shops, or from catalogues and websites. This means that the selection process is predominantly visual.[3] Having said that, I do not discount the aural aspect altogether in that advice may be sought from shop assistants and word of mouth recommendations may also play a part.

Comparison of marks

24. 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

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

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."

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

26. The respective marks are shown below:

The applicants' marks	**The opponent's mark**
Malle London The Malle Mile Malle Rally	Mallet London MALLET

Overall impression

The opponent's marks

'Mallet London'

27. The earlier mark ‘Mallet London’ is a word-only mark that consists of the two words ‘Mallet’ and ‘London’. The word ‘London’ will be seen simply as the geographical location of the undertaking and plays a lesser role in the overall impression of the mark, which is dominated by the word ‘Mallet’.

‘MALLET’

28. The earlier mark ‘MALLET’ is also a word-only mark that consists of the word ‘MALLET’. There are no other elements to contribute to the overall impression of the mark, which lies in the word itself.

The applicants’ marks

‘Malle London’

29. The applicants’ mark ‘Malle London’ is a word-only mark that consists of the two words ‘Malle’ and ‘London’. The word ‘London’ will be seen simply as the geographical location of the undertaking and plays a lesser role in the overall impression of the mark, which is dominated by the word ‘Malle’.

‘The Malle Mile’

30. The applicants’ mark ‘The Malle Mile’ is a word-only mark that consists of the three words ‘The’, ‘Malle’ and ‘Mile’. Cambridge online dictionary contains the following definitions of “mile”:

> (1) a unit of distance equal to 1,760 yards or 1.6 kilometres:
>
> - *a ten-mile drive*
> - *The nearest town is ten miles away.*
>
> (2) a race over a distance of a mile:
>
> - *He held the world record for running the mile.*
> - *In 2001, Webb ran the mile in 3:53.43.*

31. The mark as a whole is a phrase in which the three words form a unitary term that conveys the meaning of a mile called ‘Malle’, the word “Mile” being understood in this context as a reference to a path which is a mile long, or a race over a distance of a mile. The distinctive character of the mark lies in the overall phrase, and no individual word in the mark dominates the overall impression.

‘Malle Rally’

32. The applicants’ mark ‘Malle Rally’ is a word-only mark that consists of the words ‘Malle’ and ‘Rally’. Cambridge online dictionary contains the following definitions of “rally”:

(1) a public meeting of a large group of people, especially supporters of a particular opinion:

- *5,000 people held an anti-nuclear rally.*
- *an election/campaign rally*

(2) a car or motorcycle race, especially over long distances on public roads:

- *The French driver has taken the lead in the Paris-Dakar rally.*

33. The structure of the mark ‘Malle Rally’ is closer to the second definition insofar as the word ‘Rally’ is preceded by a name and the mark as a whole conveys the meaning of a car or motorcycle race known by the name ‘Malle’. The distinctive character of the mark lies in the overall phrase and neither word in the mark dominates the overall impression.

Visual, aural and conceptual similarity

The applicants’ mark ‘Malle London’

34. The earlier mark that is closer to this mark is ‘Mallet London’. I will limit my considerations to this mark.

35. Visually, the marks share the letters ‘M’, ‘a’, ‘l’, ‘l’, ‘e’ which appears at the beginning of both marks, and the word ‘London’, which appears at the end of both marks. The marks differ in that, in the opponent’s mark, there is an additional ‘t’ at the end of the word ‘Mallet’. The fact that the first five letters of the applied-for mark are identical to those of the earlier mark and appear in the same order, and that the second element of the marks, namely the word London, is identical, means that the marks have a significant number of letters in the same position in common. This, in my view, reduces the impact of the additional letter ‘t’ in the word ‘Mallet’ of the earlier mark; I say this because the change of one letter does not make a striking impression when it appears in the middle of a mark which is 12-letter long. Taking all of the above into account, I consider that the marks are visually similar to a high degree.

36. Aurally, the opponent’s mark will be articulated as ‘MAL-LET LUN-DUN’ whereas the applicant’s mark will be articulated as ‘MAL-LE-LUN-DUN’. The only difference relating to the last letter of the first element of the marks does not counteract the important aural similarity arising from the coincidence of the other letters. Overall, I consider that the marks are aurally similar to a high degree.

37. On a conceptual level, the word ‘MALLET’ in the opponent’s mark will be understood as *“a tool like a hammer with a large, flat end made of wood or rubber”* or *“a wooden hammer with a long handle used in sports such as croquet and polo”* (Cambridge online dictionary).

38. The applicants allege that the word ‘MALLE’ in the contested marks is *“the old word for a trunk, a large leather bag, or wooden travel-case”.* Cambridge online dictionary indicates that “malle” is a French word meaning “trunk” but, I agree with the opponent, that there is no evidence that the word will be understood as such by a significant part of the UK public. In view, the element ‘malle’ in the contested mark will be seen as an invented word and will convey no particular concept. There is no conceptual similarity between these elements of the marks.[4] Although the word LONDON will convey the meaning of the same geographical location in both marks, I accept that it such concept has little or no distinctiveness.

[4] *Unicorn Studio Inc v Veronese* [2024] EWHC 1098 (Ch) paragraph 16

The applicant's mark 'The Malle Mile'

39. The earlier mark that is closer to this mark is 'MALLET'. I will limit my considerations to this mark.

40. Visually, registration of a word-only mark covers use in any casing; consequently, the fact that the applicants' mark is presented in title case and the opponent's mark is presented in upper case is not a point of visual difference. The applicants' mark 'The Malle Mile' and the opponent's mark 'MALLET' coincide in the five letters 'M', 'A', 'L', 'L', 'E', however, these letters are not placed in the same position within the marks. In the applicants' mark they are preceded by the article 'The' and are followed by the word 'Mile', whereas in the opponent's mark they are presented as the first five letters of the single six-letter word 'MALLET'. Overall, I consider the marks to be visually similar to a low to medium degree.

41. Aurally, the opponent's mark will be pronounced as MAL-LET. The applicants' mark will be pronounced as D- MAL-LE-MAIL. Therefore, as the beginning and the end of the marks are different, I consider that the marks are aurally similar to between a low and medium degree.

42. On a conceptual level, the word 'MALLET' in the opponent's mark will be understood as set out above. As it will be recalled, the applicants' mark will convey the meaning of a mile-long path or race called 'Malle'. Since each mark conveys a concept, but the two concepts are quite different, the marks are conceptually different.

The applicants' mark 'Malle Rally'

43. The earlier mark that is closer to this mark is 'MALLET'. I will limit my considerations to this mark.

44. Visually, the applicants' mark 'Malle Rally' and the opponent's mark 'MALLET' coincide in the five letters 'M', 'A', 'L', 'L', 'E' at the beginning of the marks. The first elements of the respective marks, 'Malle/MALLET' differ in only one letter ('T') which is placed at the end of the word 'MALLET'. In the applicants' mark the word 'Malle' is

followed by the five-letter word ‘Rally’, which has no counterpart in the opponent’s mark. Overall, I consider the marks to be visually similar to a medium degree.

45. Aurally, the opponent’s mark will be pronounced as MAL-LET. The applicants’ mark will be pronounced as MAL-LE- RAL-EE. Therefore, as the end of the marks are different, I consider that the marks are aurally similar to a medium degree.

46. On a conceptual level, the word ‘MALLET’ in the opponent’s mark will be understood as set out above. As it will be recalled, the applicants’ mark will convey the meaning of a car or motorcycle race known by the name ‘Malle’. Since each mark conveys a concept, but the two concepts are quite different, the marks are conceptually different.

Distinctive character of earlier mark

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

> “22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *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)."

48. Registered trade marks possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, 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 made of it.

49. As the opponent has not filed any evidence to show that the distinctiveness of its marks has been enhanced through use, I only have the inherent position to consider.

50. As I have highlighted above, the earlier marks consist of the words 'MALLET' and 'Mallet London'. The word 'MALLET' is a dictionary word which will be recognised as having the meaning discussed above; the word is neither descriptive nor allusive of the registered goods in class 25 and has an average degree of distinctiveness. The word 'LONDON', in the context of the class 25 goods at issue, will be recognised as the location where the goods are manufactured or where the undertaking is based, and does not materially increase the distinctiveness of the earlier mark.

Likelihood of confusion

51. 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 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 earlier 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 marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

52. Confusion can be direct or indirect. The difference between these two types of confusion was explained in *L.A. Sugar Trade Mark,* BL O/375/10, where Iain Purvis Q.C. (as he then was) as the Appointed Person explained that:

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

53. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ approved Mr Purvis's formulation but added:

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

54. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C. (as he then was), as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

The applicants' mark 'Malle London'

55. I shall start with the mark 'Malle London'.

56. While it is true that the last letter 't' of the first element of the earlier mark 'Mallet London' is missing in the applied-for mark, five out of six letters, i.e. 'M', 'a', 'l', 'l', 'e', are identical in both signs. Moreover, the marks at issue do not share only the element 'Malle', those marks also share the word 'London'. In those circumstances, the fact that the word 'Mallet' in the earlier mark conveys a concept, whereas the word 'Malle' in the application does not, cannot counteract the high similarity resulting from the fact that both signs are of nearly identical length, sharing the first five letters in the same

order and the word ‘London’.[5] In my view, the impact of the missing letter ‘t’ in the application will not be sufficient to avoid direct confusion, through imperfect recollection of the earlier mark on account of the high visual and aural similarity between the marks, the identity of the goods, the medium degree of distinctiveness of the earlier mark and the medium degree of attention displayed by the average consumer. There is a likelihood of direct confusion.

The applicants’ marks ‘The Malle Mile’ and ‘Malle Rally’

57. Turning to the marks ‘The Malle Mile’ and ‘Malle Rally’, the opponent’s primary position is that there is a likelihood of direct confusion between these applications and the earlier marks due to the dominance of the words “MALLET” and “MALLE” in the overall impression of the marks. Alternatively, the opponent states that there is a likelihood of indirect confusion for the same reasons (i.e. the dominance of the words “MALLET” and “MALLE” in the respective marks), without setting out any further detail to provide a proper basis for concluding that the average consumer would consider the applied-for marks to be sub-brands or brand extensions of the earlier marks.

58. I have already rejected the conclusion that the word ‘Malle’ is the dominant component of the marks ‘The Malle Mile’ and ‘Malle Rally’. As noted above, ‘The Malle Mile’ and ‘Malle Rally’ are unitary terms, and the distinctive character of the marks lie in the overall phrase; consequently, the meaning of the whole signs is different from that of the earlier mark. Further, I found that these marks are visually and aurally similar to the earlier mark ‘MALLET’ to a low to medium, and a medium degree, respectively. The visual, aural and conceptual differences between these marks and the earlier mark ‘MALLET’ are, in my view, sufficiently pronounced that it is unlikely that consumers paying a medium degree of attention will mistake one mark for the other. There is no likelihood of direct confusion here.

59. As regard indirect confusion, I am not persuaded that the average consumer would consider the marks ‘The Malle Mile’ and ‘Malle Rally’ to be a sub-brand or brand extension of the earlier mark ‘MALLET’. The additional conceptual differences

[5] BL-O/566/19 *Pimkie vs Pinkies*

between these marks and the earlier mark and the different overall visual impression conveyed by the marks are such that it safely set them apart. Even if the earlier mark is brought to mind, I cannot see why the applications would be considered to be a sub-brand or brand extension of the earlier marks. There is no likelihood of indirect confusion.

OUTCOME

60. The partial opposition against the trade mark application no. UK00003751374 for the mark 'Malle London' is successful. Subject to any successful appeal against my decision, the application will be refused registration for the opposed goods in class 25. The application will proceed to registration for the unopposed goods in classes 12 and 18.

61. The partial opposition against the trade mark application no. UK00003751369 for the mark 'The Malle Mile' fails. Subject to any successful appeal against my decision, the application can proceed to registration for the opposed goods in class 25 and for the unopposed goods and services in classes 9 and 41.

62. The partial opposition against the trade mark application no. UK00003751376 for the mark 'Malle Rally' fails. Subject to any successful appeal against my decision, the application can proceed to registration for the opposed goods in class 25 and for the unopposed goods and services in classes 9 and 41.

COSTS

63. While the opponent has succeeded in one opposition, I am of the view the applicant enjoyed the greater degree of success and ordinarily would be entitled to a contribution towards its costs. As a matter of practice, litigants in person are asked to complete a costs proforma. As the applicant has not instructed professional representatives, on 30 January 2024 it was advised that if it intended to request costs it needed to complete and return a costs pro-forma, a copy of which was provided by the Tribunal.

However, the applicant has not provided a completed cost proforma, notwithstanding the invitation from the Tribunal to do so. On this basis, no costs are awarded.

Dated this 30th day of August 2024

TERESA PERKS
For the Registrar