

O/0962/24

TRADE MARKS ACT 1994
IN THE MATTER OF
APPLICATION NO. 3797899
IN THE NAME OF CHARLES DONKOR
TO REGISTER



AS A TRADE MARK IN CLASS 25
AND
OPPOSITION THERETO (UNDER NO. 435460)
BY
F-LUX ACTIVEWEAR LTD

Background and pleadings

1. On 11 June 2022, Charles Donkor (“***the Applicant***”) applied to register in the UK the trade mark shown on the cover page of this decision, under number UK00003797899 (“***the Contested Mark***”). Details of the application were published for opposition purposes on 1 July 2022. Registration is sought for the following goods:

Class 25 Clothes; Sportswear.

2. F-LUX ACTIVEWEAR LTD (“***the Opponent***”) opposes the application under section 5(2)(b) of the Trade Marks Act 1994 (“***the Act***”)¹. The Opponent relies upon the following prior trade mark registration (“***the Earlier Mark***”):

UKTM No 3604398 (series of two marks)



3. The Earlier Mark was filed on 4 March 2021 and became registered on 9 July 2021 in respect of the following goods:

Class 25: Clothing; Clothes; Tops [clothing]; Knitted clothing; Hoods [clothing]; Leisure clothing; Sports clothing; Plush clothing; Knitwear [clothing]; Playsuits [clothing]; Slipovers [clothing]; Jerseys [clothing]; Casual clothing; Combinations [clothing]; Shorts [clothing]; Cashmere clothing;

¹ The opposition was, however, originally filed in the names of Ms Charlotte Emily Brundle and Ms Karoline Huber (see, in this connection, my later comments at paragraph 4).

Bandeaux [clothing]; Women's clothing; Bodies [clothing]; Embroidered clothing; Jackets [clothing]; Slips [clothing]; Wraps [clothing]; Athletic clothing; Sports garments; Sports pants; Sport stockings; Sports vests; Sports wear; Sports jackets; Sports socks; Sport shirts; Sports jerseys; Sports bras; Clothes for sports; Clothes for sport; Clothing for sports.

4. The opposition was initially filed by Ms Charlotte Emily Brundle and Ms Karoline Huber. However, at the conclusion of the evidence rounds, it came to the attention of the tribunal that the earlier mark was, in fact, registered in the name of F-Lux Activewear Ltd. As such, the tribunal wrote to Ms Brundle and Ms Huber inviting them to make a request to substitute the opponent as F-Lux Activewear Ltd instead². Ms Brundle then made such a request³ and the tribunal gave a preliminary view to accept the request.⁴ No adverse comments against that preliminary view were received from the applicant in the time allowed and therefore F-Lux Activewear Ltd is now the opponent in these proceedings.
5. By virtue of its earlier filing date of 4 March 2021, that registration constitutes an earlier mark within the meaning of section 6 of the Act. As the Earlier Mark had not completed its registration process more than five years before the filing date of the application in issue, it is not subject to proof of use pursuant to section 6A of the Act. Consequently, the Opponent is entitled to rely upon all the goods identified, without having to demonstrate genuine use. For the purposes of the opposition, the Opponent relies upon all the goods for which the Earlier Mark is registered, as indicated above.
6. Neither party has a legal representative. The Opponent contends that due to the similarity between the Contested and Earlier Mark and the identity or similarity of the goods, the contested application should be refused under section 5(2)(b) of the Act.
7. Mr. Donkor filed a defence and counterstatement, denying the grounds of opposition. He submits that the parties have a completely different market audience (the Applicant sells gym gear, and the Opponent specialises in pole

² See official communication dated 23 May 2024.

³ See email dated 24 May 2024.

⁴ See official communication dated 18 June 2024.

dancing clothes). Further, the Applicant contends that the respective marks differ insofar the Opponent's mark consists of the hyphenated "F-Lux" (being composed of the letter 'F' and the capitalised 'Lux'), whilst the Applicant's sign is the word 'Flux'.

8. Subsequent to the filing of the counterstatement, a preliminary indication was issued to the parties under the provision of Rule 19 of The Trade Marks Rules 2008.⁵ That indication was that the opposition would succeed. The Applicant gave notice that it nevertheless wished to proceed to evidence rounds.⁶ The preliminary indication, given by a different Hearing Officer, is not binding upon me and will have no bearing upon my decision.

Relevance of EU law

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

Evidence and submissions

10. During the evidence rounds both the Opponent⁷ and the Applicant⁸ filed evidence which will not be summarised here but will be referred to as and where appropriate during this decision. Neither party requested a hearing nor filed submissions in lieu. This decision is taken following a careful perusal of the papers.

Preliminary matters

11. In his counterstatement the Applicant argued that the Opponent offers women's pole dance wear whilst the Applicant markets sports clothing. Therefore, the parties address different sectors of the clothing market.
12. Differences between the goods currently provided by the parties, such as the specific type of sportswear the Opponent markets or whether the goods are

⁵ Official letter dated 9 January 2023.

⁶ As per form TM53, filed on 6 February 2023.

⁷ Witness statement by Charlotte Emily Brundle and Exhibits FA1-FA4 dated 18 May 2023.

⁸ Witness statement by Charles Donkor and Exhibits FG1-FG12 dated 27 July 2023.

exclusively aimed at women, are not relevant to my assessment. Since the Opponent's Earlier Mark is not subject to proof of use, it is entitled to protection in relation to all the goods for which the mark is registered. It is the goods relied upon by the Opponent and the goods applied for by the Applicant that I will be comparing later in this decision. The assessment I must make between the goods is a notional and objective assessment, rather than a subjective one.

13. Furthermore, marketing strategies, including the targeting of specific consumers, are temporary and may change over time.⁹ As such, it is not appropriate to take that factor into account in my assessment. However, I will make an assessment, later in this decision, as to who the average consumer is for the goods at issue.

14. In the Applicant's pleadings he also makes a reference to online searches.¹⁰ The claim regarding the online searches is made on the basis that online searches for the competing marks bring up different results showing that there is no online brand crossover. Evidence as to returns of online search results is not a consideration for determining likelihood of confusion (or lack thereof). The assessment I must make between the marks is a notional and objective assessment based on the marks themselves.

Approach

15. The Earlier Mark consists of a series of two marks. It seems to me that the Opponent's strongest case clearly lies with the first mark of the series (due to the additional circular element in the second mark which introduces a further point of difference between it and the Contested Mark (at least visually)). Thus, I will proceed accordingly.

Decision

The law

16. The relevant parts of section 5 of the Act are as follows:

“5 (1) [...]

(2) A trade mark shall not be registered if because—

⁹ *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P.

¹⁰ Exhibit FG5 in the Witness Statement dated 27 July 2023.

(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.”

“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.”

Case law

17. The leading authorities which guide me are from the Court of Justice of the European Union (“CJEU”): *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The Principles

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

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

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

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

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

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

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

Comparison of goods

18. The competing goods are as follows:

Applicant's goods	Opponent's goods
<u>Class 25</u>	<u>Class 25</u>
Clothes; Sportswear.	Clothing; Clothes; Tops [clothing]; Knitted clothing; Hoods [clothing];

	Leisure clothing; Sports clothing; Plush clothing; Knitwear [clothing]; Playsuits [clothing]; Slipovers [clothing]; Jerseys [clothing]; Casual clothing; Combinations [clothing]; Shorts [clothing]; Cashmere clothing; Bandeaux [clothing]; Women's clothing; Bodies [clothing]; Embroidered clothing; Jackets [clothing]; Slips [clothing]; Wraps [clothing]; Athletic clothing; Sports garments; Sports pants; Sport stockings; Sports vests; Sports wear; Sports jackets; Sports socks; Sport shirts; Sports jerseys; Sports bras; Clothes for sports; Clothes for sport; Clothing for sports.
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- *Clothes*

19. The Applicant's term "*clothes*" is self-evidently identical to the Opponent's "Clothing".

- *Sportswear*

20. The Applicant's term "*Sportswear*" is identical to the Opponent's term "*Sports clothing*".

The average consumer and the nature of the purchasing act

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

"60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well

informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The 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 of the category of products concerned is deemed to be reasonably well-informed and reasonably observant and circumspect (see, to that effect, Case C-210/96, *Gut Springenheide and Tusky* [1998] ECR I-4657, paragraph 31).
23. For the purposes of assessing the likelihood of confusion, it must be borne in mind that the average consumer’s level of attention is likely to vary according to the category of goods in question.¹¹
24. The average consumer for the goods in Class 25 (clothing and sportswear) will be members of the general public. The cost of purchase is likely to vary, although it is unlikely to be particularly high. The frequency of the purchase is also likely to vary, but they are likely to be bought fairly frequently. However, various factors are still likely to be taken into consideration during the purchasing process, such as materials used, aesthetic appearance, wearability, suitability, and durability. Consequently, I consider that a medium degree of attention will be paid by the average consumer when selecting the goods.
25. The goods are likely to be obtained by self-selection from the shelves of a clothing retail outlet, online or catalogue equivalent. This means that the mark will be seen and so the visual element of the mark will be the most significant (see *New Look Limited v OHIM*, Joined cases T-117/03 to T-119/03 and T-171/03, paragraph 50). Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount that there will also be an aural component to the purchase, as advice may be sought from a sales assistant or representative.

Comparison of trade marks

26. It is clear from *Sabel BV v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to

¹¹ *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel BV*, (Case C-342/97, para 26).

analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components.

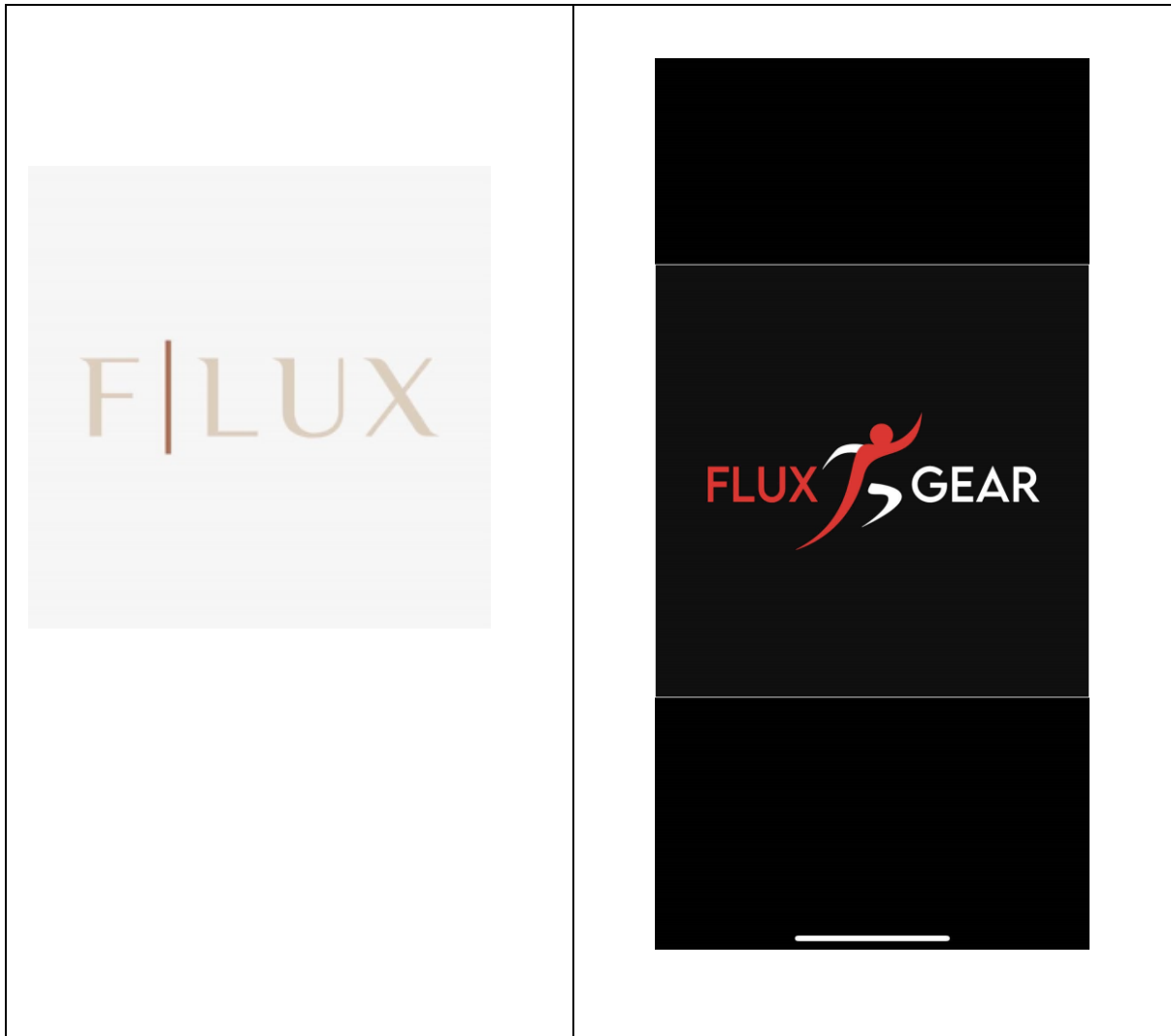
27. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....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”.

28. 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 trade marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the trade marks.

29. The trade marks to be compared are as follows:

Earlier trade mark	Contested trade mark
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Overall impression

30. The Earlier Mark features the letter combination “F | LUX” in beige with a brown “|” symbol separating “F” and “LUX”. The mark is placed on a grey background.

31. The stylisation of the Opponent’s Mark makes some contribution to the mark’s overall impression. However, that stylisation does not prevent the mark from being read through, instantly, as the letter combination “F | LUX” or “FLUX” and it is that element which is the most dominant element of the mark overall.

32. The Contested Mark features the words “FLUX” in red and “GEAR” in white. The depiction of a stylised running cartoon in red and white separates the two words composing the mark. The verbal elements and the figurative device are placed on a black background. The figurative device in the Contested Mark makes some contribution to the mark’s overall impression, however, the stylisation does not

prevent the mark being read through, instantly, as “FLUX GEAR” and it is those words that form the most dominant element of the mark overall. Furthermore, I am of the view that in the context of the goods at issue, “GEAR” will be seen as descriptive and, therefore, within the phrase “FLUX GEAR”, “GEAR” plays a lesser role than the more distinctive word “FLUX”. The stylised running cartoon plays a lesser role than the words and the black background makes the least contribution to the overall impression of the mark.

Visual similarity

33. The Earlier Mark comprises the verbal element “F | LUX” in beige. A brown vertical line separates the letters “F” and “LUX”. Those elements are presented on a square grey background.
34. The Contested Mark contains the words “FLUX GEAR” respectively in red and white on a black background; the mark features a stylised silhouette of a running man in red and white cutting across the words “FLUX” and “GEAR”.
35. The Earlier and Contested Marks share the same letters “FLUX” in that order. This is a clear point of coincidence between the marks. However, in the earlier mark there is a vertical line after the initial letter ‘F’ which is not present in the contested mark, creating a point of visual difference. Additionally, the competing marks use different colour combinations, and the Contested Mark features a stylised figurative device placed in a clearly visible position.
36. Taking into account the overall impressions, I find that the competing marks have a medium degree of visual similarity.

Aural similarity

37. Bearing in mind the overall impression of the Contested Mark, it will be pronounced as the two ordinary dictionary words it comprises, as two syllables i.e. FLUX-GEER. Consumers will not attempt to articulate the device element.
38. Insofar as the Earlier Mark is concerned, the word forming the Earlier Mark is written in a standard font and the “F” is separated by “LUX” merely by a vertical line without the addition of any specific effect. I find that a significant proportion of relevant consumers, when confronted with the Earlier Mark, will recognise and,

therefore, vocalise the common and well-known word “flux”. This is because, when faced with a string of letters/word(s) it is a natural instinct to attempt to make sense of it. In my view, the presence of the vertical line is not such as to disguise the presence of the well-known word ‘FLUX’ for a significant proportion of consumers who are likely to immediately recognise that word and will therefore pronounce the mark accordingly. Regarding this section of consumers, I find the respective marks to be aurally similar to a medium degree.

39. I accept, though, that a separate, significant proportion of consumers are likely to split “F” and “LUX” and voice the Earlier Mark as “ef - lux”. With regard to that part of consumers, I find that the competing marks have a low degree of aural similarity.

Conceptual similarity

40. The Applicant argued¹² that the Earlier Mark “F | LUX” seems to derive from the initial letter of the words “Feminine” and “Functional” and the first part of the word “luxurious”. The Applicant derives the interpretation of the Earlier Mark’s meaning from the description the Opponent provided in the Instagram page of the “F | LUX” brand. I must remind myself that for a concept to be relevant, it must be capable of immediate grasp by the relevant consumer (*The Picasso Estate v OHIM*, Case C-361/04 P). Considering that neither the letter “F” nor “LUX” are common abbreviations, respectively, of “Feminine”, “Functional”, and “luxurious” I do not believe that the relevant consumers will understand the Opponent’s Mark as conveying such a meaning. I find that, for consumers who perceive the earlier mark as the letter ‘F’ and the separate word ‘LUX’, the mark has no clear concept.¹³ However, for the significant proportion of consumers who perceive the word ‘FLUX’ in that mark, the concept derived from that word will be something that is constantly changing or flowing.

41. The Contested Mark is formed by the two English dictionary words “FLUX” and “GEAR”. In his counterstatement the Applicant submitted that “*for my business the word “Flux” means “the action or process of flowing or flowing out” [...]*”. I agree with the Applicant since the relevant consumers are likely to understand “FLUX”

¹² See Applicant’s witness statement dated 27 July 2023.

¹³ “Lux” is the Latin word for “light”, however in line with *Picasso* the relevant consumer is unlikely to immediately grasp such concept from the Earlier Mark.

with one of its dictionary meanings. I appreciate that the presence of “GEAR” does act as a point of conceptual difference, however, as “gear” is entirely descriptive of the goods at hand, I find that its conceptual impact is limited.

42. Regarding the proportion of consumers who will understand the Earlier Mark as “flux”, both competing marks convey the concept of something that is constantly changing or flowing. Therefore, I find the competing marks to be conceptually similar to a high level.

43. Concerning the section of consumers who will read and perceive “F” and “LUX” separately in the Earlier Mark, I find that, for those consumers, the respective marks have no conceptual similarity.

Distinctive character of the Earlier Mark

44. 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 *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).”

45. Registered trade marks possess varying degrees of inherent distinctive character. These range from the very low, such as those which are suggestive or allusive of the services, to those with high inherent distinctive character, such as invented words. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark, the greater the likelihood of confusion.
46. Dealing first with the inherent distinctiveness of the Earlier Mark, it comprises of the verbal element “F | LUX” in beige with a brown vertical line separating “F” and “LUX” on a grey square background.
47. The Applicant argued¹⁴ that “FLUX” lacks distinctive character as it is “*generic and widely used*” contending that “*numerous companies, including Adidas, have incorporated the term “flux” in their product names*”. In support of his argument, the Applicant submitted one screenshot of the internet home page for the brand “F.LUX”.¹⁵ I find that the evidence the Applicant provided is insufficient for me to conclude that “FLUX” is non-distinctive or low in distinctiveness in the relevant market.
48. A significant proportion of the relevant public is likely to read the mark separating the letter “F” from “LUX”, whilst another, separate, significant proportion of the relevant consumers is likely to read the Earlier Mark as the English dictionary word “FLUX”. In both circumstances I find that the Earlier Mark does not have any clear descriptive or allusive meaning in relation to sportswear or clothing at large and, for this reason, I believe the Earlier Mark possesses a medium inherent distinctive character. The mark’s stylisation does not elevate its distinctiveness beyond this level.
49. Turning to the question of whether the inherent distinctiveness of the Earlier Mark has been enhanced through use, the Opponent provided evidence that the Earlier Mark has been used for various years for online and offline retail, at tradeshow and sports competitions throughout the UK, and on social media platforms. The Opponent also provided evidence that the Earlier Mark has been used in

¹⁴ As per Witness Statement dated 27 July 2023.

¹⁵ Exhibit 12 of the Applicant’s witness statement dated 27 July 2023.

advertising material¹⁶ and that the advertising spend has been roughly £2,000 per year between 2020 and 2023.¹⁷

50. In light of this evidence, I appreciate that the Opponent has showed some use of the Earlier Mark during the past years. However, the Opponent did not provide evidence showing the market share it occupies, or a long-standing use of the mark. Indeed, the scale of use appears small in what is, undoubtedly, a huge market. Thus, I do not believe that the evidence provided shows that the Earlier Mark has acquired enhanced distinctiveness through use.

Likelihood of confusion

51. There is no simple formula for determining whether there is a likelihood of confusion. The factors considered above have a degree of interdependency (*Canon* at [17]). I must make a global assessment of the competing factors (*Sabel* at [22]), considering the various factors from the perspective of the average consumer and deciding whether the average consumer is likely to be confused. In making my assessment, I must keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

52. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. The concept of indirect confusion was explained by Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10 as follows:

“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

¹⁶ Exhibit FA3.

¹⁷ Exhibit FA4.

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. I have found the respective goods to be identical. The consumer is likely to pay a medium level of attention in their selection. The distinctiveness of the Earlier Mark is medium. The visual similarity is medium, the aural similarity varies from low to medium according to how the Earlier Mark is read; conceptually the marks are either highly similar or have no similarity depending on how the Earlier Mark is perceived. The purchase of the contested goods is considered to be mainly visual but the potential for aural use is borne in mind. Weighing all of these factors, and bearing in mind the effects of imperfect recollection, I find that the marks are unlikely to be mistakenly recalled or misremembered as each other by any of the relevant consumers. Thus, I do not consider there to be a likelihood of direct confusion.

54. It now falls to me to consider the likelihood of indirect confusion.

55. The three categories identified in *L.A. Sugar* are not exhaustive; rather, they were intended to be illustrative of the general approach, as has been confirmed by the Court of Appeal.¹⁸ I recognise that a finding of indirect confusion should not be made merely because the competing marks share a common element. In this connection, it is not sufficient that a mark merely calls to mind another mark: this is mere association not indirect confusion.¹⁹ The Court of Appeal has also emphasised that, where there is no direct confusion, there must be a “proper basis” for finding indirect confusion.²⁰

56. Bearing all of the above in mind, I am of the view that it is likely that a significant proportion of average consumers would, upon being confronted with the parties’ marks, believe that they originate from the same or economically linked undertakings. I say this because, for a significant proportion of consumers, the dominant element of both marks is the word “FLUX” which, in my view, will be indicative of a common undertaking responsible for the marks. Further, the difference created by the use of the word “GEAR” on the goods at issue is such that those consumers will likely consider them to be logical indicators of a sub-brand or brand extension. For example, upon seeing the contested mark on a range of clothing articles, the consumer will consider that the Opponent has created a new sub-brand clothing line (for example, for sportswear). As for the other points of difference (namely the presence of the stylised running cartoon and the red/white colours), I am of the view that consumers will consider them to be alternative stylisations used by the same (or economically connected) undertaking across its portfolio of trade marks. Consequently, I consider that there is a likelihood of indirect confusion between the marks at issue.

57. For the avoidance of doubt, I would have reached the same conclusion even if I had found that the common element, FLUX, was low in inherent distinctive character, as contended by the applicant, bearing in mind the identity between the goods and the overall similarity of the competing marks.

Conclusion

¹⁸ *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207.

¹⁹ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17.

²⁰ *Liverpool Gin Distillery*.

58. The opposition succeeds and the application will be refused.

Costs

59. The opponent has been successful and is entitled to an award of costs.

60. At the conclusion of the evidence rounds, the official letter, dated 21 September 2023, advised the Opponent that, if it intended to make a request for an award for costs it should complete and return the relevant costs proforma by 19 October 2023. The same letter stated, inter alia, that:

“If the pro-forma is not completed and returned, costs, other than official fees arising from the action (excluding extensions of time), may not be awarded.”

61. No costs proforma has been filed by the Opponent in response to the abovementioned letter. As such, I consider it appropriate to award the Opponent £100 only (which is the official fee which accompanied the Form TM7).

62. I order Charles Donkor to pay F-LUX ACTIVEWEAR LTD the sum of **£100**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 9th day of October 2024

Andrea Rossi

For the Registrar