

**O/1020/25**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. UK00004041713**

**BY GIANLUCA RONDELLI**

**TO REGISTER:**

**Euphoria Running**

**IN CLASS 25**

**AND**

**IN THE MATTER OF OPPOSITION THERETO**

**UNDER NO. OP000448892 BY**

**S.E SATISFY**

## Background and pleadings

1. On 20 April 2024, Gianluca Rondelli (“the applicant”) applied to register in the UK the trade mark shown on the cover page of this decision (“the applicant’s mark”). The application was accepted and published for opposition purposes on 3 May 2024 and registration is sought for the following goods:

Class 25: Clothing; Jackets [clothing]; Ready-to-wear clothing; Headbands [clothing]; Clothes; Gloves [clothing]; Jerseys [clothing]; Shorts [clothing]; Embroidered clothing; Hoods [clothing]; Windproof clothing; Wristbands [clothing]; Belts [clothing]; Casual clothing; Rainproof clothing; Waterproof clothing; Jackets being sports clothing; Visors [clothing]; Clothing for leisure wear; Ready-made clothing; Bottoms [clothing]; Woven clothing; Clothing for sports; Sports clothing; Leisure clothing; Athletic clothing; Tops [clothing]; Weatherproof clothing; Water-resistant clothing; Triathlon clothing; Men's clothing.

2. On 1 August 2024, the applicant’s mark was opposed in full by S.E Satisfy (“the opponent”). The opposition is based on section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon the following mark:

EUFORIA

(the “opponent’s mark”)

UK registration no.UK00004070355

Filing date 1 July 2024; registration date 22 November 2024

Priority date: 12 March 2024 (France)

Relying on all goods, being:

Class 25: Sports footwear; shoe soles.

3. By virtue of relying on section 5(2)(b) of the Act, the opponent’s case is that the marks at issue are aurally identical and visually and conceptually highly similar. Additionally, the opponent submits that the goods of the parties are highly similar

based on a number of factors including, inter alia, their nature, end consumer, trade channels, point of sale and complementarity, resulting in a likelihood of confusion.

4. The applicant filed a counterstatement stating that the applicant's mark does not infringe upon or create confusion with the opponent's mark.
5. The opponent is represented by Wynne-Jones IP Limited. The applicant is not represented. The applicant filed evidence. No hearing was requested and neither party filed written submissions in lieu of the same. This decision is taken following a careful perusal of the papers.
6. 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**

7. The applicant's evidence came in the form of the witness statement in their own name dated 20 December 2024. The applicant states that they filed the application for the applicant's mark on 20 April 2024 to establish a start-up brand called "Euphoria Running" and as the application is at the "intended use" stage, no sales or marketing data is currently available. Their statement sets out that the applicant's mark and the opponent's mark are sufficiently distinct, both visually, aurally and conceptually, and occupy different sub-categories thereby minimising any risk of consumer confusion. Gianluca Rondelli states that the applicant's mark should be allowed to proceed to registration as it does not infringe upon or create confusion with the opponent's mark. Their statement is not accompanied by any exhibits.
8. I do not intend to summarise the applicant's evidence any further here. However, I confirm that I have taken all filed documents into account and will summarise them to the extent deemed necessary below.

## **DECISION**

### **Section 5(2)(b): legislation and case law**

9. 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”.

10. Section 5A of the Act states as follows:

“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.”

11. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“(6)(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark or international trade mark (UK) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.

12. Given its earlier priority date, the opponent's mark qualifies as an earlier trade mark under the above provisions. As the opponent's mark had not completed its registration process more than five years before the filing date of the applicant's mark, it is not subject to proof of use pursuant to section 6A of the Act. Consequently, the opponent may rely on the goods highlighted in his notice of opposition.

13. The following principles are gleaned from the decisions of the Court of Justice of the European Union ("CJEU") in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v Office for Harmonization in the Internal Market (Trade Marks and Designs) ("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 great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

## Comparison of goods

14. The parties goods are as follows:

The opponent's goods	The applicant's goods
Class 25: Sports footwear; shoe soles.	Class 25: Clothing; Jackets [clothing]; Ready-to-wear clothing; Headbands [clothing]; Clothes; Gloves [clothing]; Jerseys [clothing]; Shorts [clothing]; Embroidered clothing; Hoods [clothing]; Windproof clothing; Wristbands [clothing]; Belts [clothing]; Casual clothing; Rainproof clothing; Waterproof clothing; Jackets being sports clothing; Visors [clothing]; Clothing for leisure wear; Ready-made clothing; Bottoms [clothing]; Woven clothing; Clothing for sports; Sports clothing; Leisure clothing; Athletic clothing; Tops [clothing]; Weatherproof clothing; Water-resistant clothing; Triathlon clothing; Men's clothing.

15. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account, as per *Canon*, where the CJEU stated at paragraph 23 of its judgement:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended

purpose and their method of use and whether they are in competition with each other or are complementary.”

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

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

17. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services* (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

18. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the GC 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”.

19. I bear in mind that it is permissible to group goods together for the purposes of assessment: *Separode Trade Mark*.<sup>1</sup>

20. The opponent’s position is that the applicant’s goods which consist essentially of clothing at large, are highly similar to the opponent’s goods, based on a number of factors including, inter alia, their nature, end consumer, trade channels, point of sale and complementarity.

21. The applicant’s position is that the opponent’s goods are distinctly different from the applicant’s goods, “sport clothing” and “ready-to-wear clothing”. The applicant states that footwear and clothing are often sold in distinct sections of retail stores, with specialised footwear stores or sections focusing on shoes, and clothing stores or sections focusing on apparel. The applicant states that this separation in retail channels further reduces the risk of confusion among consumers.

22. I do not intend to summarise the remaining comments of the parties in full here. However, I confirm that I have taken all filed documents into account and will summarise them to the extent deemed necessary below.

### Class 25

*Jackets being sports clothing; Clothing for leisure wear; Clothing for sports; Sports clothing; Leisure clothing; Athletic clothing; Triathlon clothing.*

23. The closest comparable term in the opponent’s specification to the above applicant’s goods is “sports footwear”. The goods are likely made from different

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<sup>1</sup> BL O-399-10 (AP)

materials and worn on different parts of the body. Having said that, the above applicant's goods are all worn when performing sporting activities and are also likely to be worn on the user's body to provide protection. As such, I find that the goods overlap to some extent in purpose. The goods will also overlap in user and trade channels, being sold by the same sporting apparel and footwear undertakings and located in close proximity within the same retail stores. While I appreciate that footwear and apparel may be found in different sections of larger stores, many sporting apparel undertakings produce sports footwear, and vice versa, sometimes as part of the same range. Whilst the applicant states that there is a separation in retail channels between footwear and clothing, I disagree this is the case when considering sports footwear and sports clothing. Consequently, the goods are similar to between a low and medium degree.

*Clothing; Jackets [clothing]; Ready-to-wear clothing; Clothes; Gloves [clothing]; Jerseys [clothing]; Shorts [clothing]; Embroidered clothing; Windproof clothing; Casual clothing; Rainproof clothing; Waterproof clothing; Ready-made clothing; Bottoms [clothing]; Woven clothing; Tops [clothing]; Weatherproof clothing; Water-resistant clothing; Men's clothing.*

24. The applicant's above goods are not limited in any way so encompass sporting variants of those articles of clothing. Therefore, the same comparison applies as per the preceding paragraph. I find the goods to be similar to between a low and medium degree.

*Headbands [clothing]; Hoods [clothing]; Wristbands [clothing]; Visors [clothing].*

25. The closest comparable term in the opponent's specification to the above applicant's goods is "sports footwear". The goods can all be worn when performing sporting activities. The opponent's goods are worn on the user's body to provide protection and to improve performance. The applicant's goods are worn on the users body to absorb sweat which is likely to be produced during a sporting activity, to provide protection from the weather and to improve performance. The goods, therefore, overlap to some extent in purpose. However, I appreciate that the goods are worn on different parts of the body, with the applicant's goods protecting the

user's head and wrists and the opponent's goods protecting the user's feet. The goods will be sold by the same undertakings. The goods also clearly overlap in user. The goods are not complementary to each other as one is not essential for the other. Therefore, taking all of the above into account, I consider that the goods are similar to between a low and medium degree.

*Belts [clothing].*

26. The closest comparable term in the opponent's specification to the above applicant's goods is "sports footwear". *Belts [clothing]* is a broad term that includes all types of belts, such as leather belts and sporting belts. Sporting belts encompass various types of belts such as different coloured fabric belts used in martial arts to hold uniform in place or an adjustable leather belt used in softball or baseball to hold uniform in place. Both *belts [clothing]* and "sports footwear" can be worn when performing sporting activities. Whilst "sports footwear" are used to protect the user's feet, *belts [clothing]* are used to hold a sports uniform in place. The purpose is clearly different. However, the goods are likely to be produced and sold by the same undertakings and found in the same retail environments, even if they are not found in close proximity to one another. The goods also clearly overlap in user. The goods are not complementary to each other as one is not essential for the other. Taking all of the above into account, I consider that the goods are similar to a low degree.

**The average consumer and the nature of the purchasing act**

27. The case law, as set out earlier, requires that I 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.”

28. The opponent submits that:

“[T]he average consumer of the goods in question will be a member of the general public who typically pays an average level of attention, and the act of purchasing clothing is primarily a visual process. Nevertheless, aural considerations may also play a role via word-of-mouth recommendations, or where a shopper is assisted by sales staff.”

29. The applicant did not comment on the identity of the consumer nor the selection process for the goods. They did, however, comment on the level of attention paid and I will deal with this further below. In respect of the identity of the consumer, I agree with the opponent that they will be members of the general public at large. As to the selection process, I also agree that the visual component will dominate on the basis that the goods will be displayed on shelves or racks where they will be self-selected by the consumer. When the selection takes place online or via a catalogue, the goods will be selected after viewing an image of them on a webpage or in a catalogue. In terms of the aural component, I also agree that this cannot be discounted as suggestions may come from word-of-mouth recommendations or advice from sales assistants. The cost of purchase is likely to vary and the goods will be purchased on a reasonably frequent basis as the need for them arises.

30. Turning to the level of attention paid, I note that the applicant’s position is that:

“[T]he average consumer of sportswear and athletic products is likely to pay more than just an ‘average level of attention’ when selecting such goods, as they consider factors like performance, brand reputation and specific functionality. Given the importance of these considerations, consumers are less likely to be confused by similar-sounding or similar-looking marks when the

products they pertain to are associated with different uses or activities, such as specialised running clothing versus footwear.”

31. While the above is noted, the goods at issue are ordinary consumer goods so I see no justification for a finding that the level of attention be higher than average. When selecting the goods, the consumer is likely to consider ordinary factors such as the suitability of the goods, materials used, cut, quality, aesthetic appearance and durability. The consumer may not know the performance or specific functionality of the good they are considering. Generally speaking, I consider that the average consumer will pay a medium degree of attention when selecting the goods.

### **Comparison of marks**

32. 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.

33. 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.”

34. It would be wrong, therefore, to dissect the trade marks artificially, although it is necessary to take into account the distinctive and dominant components of the 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.

35. The respective trade marks are shown below:

The opponent's mark	The applicant's mark
EUFORIA	Euphoria Running

36. In its notice of opposition and statement of grounds, the opponent submits that the element 'Euphoria' is the dominant and distinctive element of the applicant's mark and the word 'Running' will be understood as being merely descriptive of the goods. The opponent states that the element 'Euphoria' is aurally identical to the opponent's mark, the marks are visually similar to a high degree sharing 6 letters in the same order and the marks are conceptually highly similar.

37. The applicant has provided comments in respect of the comparison of the marks that I do not intend to address here but will discuss below.

38. While I do not intend to reproduce the comments from both the opponent and applicant in relation to the comparison of the marks fully here, I can confirm that I have taken them into account in making the following comparison.

#### Overall impression

39. Both parties' marks are word only marks. The opponent's mark consists of the word 'EUFORIA' in a black font. The applicant's mark consists of two words 'Euphoria Running' in a black font.

40. In its counterstatement, the applicant submits that the overall impression of the marks should be considered in their entirety and adding the word "Running" in the applicant's mark creates a distinct overall impression that differentiates it from the opponent's mark. The applicant states that the two word structure makes the applicant's mark more complex and thus less likely to be confused with the single word opponent's mark. Moreover, the applicant states that "Running" is a crucial

component that alters the meaning and scope of the mark, associating it specifically with running-related products and causing a significant visual and aural difference in the applicant's mark. The applicant submits that the term "Running" not only differentiates the applicant's mark from the opponent's mark but also reduces the likelihood of confusion, as it clearly indicates the type of product being offered.

41. Additionally, the applicant states that "the addition of the word "Running" would likely be seen by consumers not as a mere descriptor but as an indicator of a specialised product line. This awareness and the specific context in which the marks are used (clothing versus footwear) would guide consumers away from any potential confusion". I disagree. As far as I am aware, 'running' sub brands are relatively common in the clothing industry and I see no reason why the word "Running" would be seen as anything other than highly allusive to the nature of the goods as all of the applicant's goods can be designated as clothing goods worn during running activities. Given this, I consider the word "Running" to play a lesser role in the applicant's mark as it is allusive of the goods, resulting in "Euphoria" being the dominant element of the applicant's mark.

#### Visual comparison

42. At the outset of this comparison, I consider it necessary to set out that as both marks are word only marks, they are protected for use in any case. As such, the use of different cases is not a point of consideration for the present assessment. Visually, the opponent's mark and the applicant's mark overlap through the use of the letters "EU" at the beginning of each mark and the shared use of the letters "O", "R", "I" and "A" at the end of the opponent's mark and at the end of the first word of the applicant's mark. The marks differ in that the first word of the opponent's mark is composed of 8 letters with "P" and "H" as the third and fourth letters, whereas the opponent's mark is composed of one seven letter word where the third letter is "F". Further, the marks differ as the applicant's mark includes the word 'Running' after the word 'Euphoria'. Regardless of the various roles those elements play in their respective marks, they all contribute as points of visual difference between the marks. In its counterstatement, the applicant states that "neither trade

marks share six letters as stated by the opponent, “EUFORIA” has 7 letters whilst “EUPHORIA” has 8 letters”. I think the applicant was mistaken by what the opponent meant when the opponent stated “the marks are visually similar to a high degree, sharing 6 letters in the same order”. I understood the opponent’s statement to mean that both marks shared the same six letters in the same order being “E-U-O-R-I-A”, which is factually correct. Overall, I am of the view that the shared use of the six letters in the first word of both marks being “E-U-O-R-I-A” (regardless of the different letters in the middle of the word being “F” in the opponent’s mark and “PH” in the applicant’s mark) combined with “Running” being an allusive word, and bearing in mind that consumers tend to focus on the beginning of marks,<sup>2</sup> is sufficient to result in a finding that the marks at issue are visually similar to a medium degree.

#### Aural comparison

43. The opponent’s mark consists of four syllables and will be pronounced as “YOU-FOR-REE-AH”. Turning to the applicant’s mark, it is my view that despite being an allusive word, “Running” will be pronounced by the consumer. As such, the applicant’s mark consists of six syllables and will be pronounced as “YOU-FOR-REE-AH-RUN-ING”. While the words ‘EUPHORIA’/‘EUFORIA’ are identical, the word ‘Running’ will act as a point of aural difference between the marks. The applicant states that the word “Running” adds a different cadence and rhythm when pronounced, making the marks phonetically distinguishable. While noted, this does not take away from the identity of the ‘EUPHORIA’/‘EUFORIA’ elements, which sits at the beginning of the marks. As such, I find the marks are aurally similar to a medium to high degree.

#### Conceptual comparison

44. The opponent submits that the marks are conceptually highly similar, as although “EUFORIA” in the opponent’s mark may appear an unusual spelling, it will nonetheless be recognized by the consumers as an obvious misspelling of the word “EUPHORIA”. Additionally, the opponent submits that ‘EUFORIA’ is the

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<sup>2</sup> *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

correct spelling of the word in several Latin-based European languages, including Spanish and Italian, and will therefore be perceived by a significant number of UK consumers as the usual form. I have no evidence to determine whether a significant number of UK consumers would know that “EUFORIA” is the correct spelling of the word in several Latin-based languages. That being said, I am of the view that a significant proportion of consumers are likely to see the word as a deliberate misspelling of “Euphoria”.

45. Conceptually, the applicant submits while both marks may evoke the idea of ‘euphoria’, the applicant’s mark introduces an additional concept related to the activity of running. The applicant states that this association creates a different conceptual meaning in the minds of consumers, suggesting that the products under the applicant’s mark are specifically tailored for running activities, as opposed to the broader and more generic concept of ‘euphoria’ associated with the opponent’s mark.

46. I agree that both marks evoke the idea of ‘euphoria’ being extreme joy, even with the opponent’s mark being spelt differently as “EUFORIA”. This is on the basis that “EUFORIA” is aurally identical to ‘euphoria’ and would, therefore, evoke the same concept. I say this because consumers will generally identify elements of a mark that suggest a meaning or resemble words they understand.<sup>3</sup> While “Running” will impact on the concept of the applicant’s mark, it will only act as a slight point of difference due to its allusive nature. Therefore, due to the shared concept conveyed in respect of feeling extreme joy / ‘euphoria’, I find the marks to be conceptually similar to a high degree.

### **Distinctive character of the opponent’s mark**

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

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<sup>3</sup> See paragraphs 62 – 68 of the General Court decision in *Usinor SA v OHIM*, Case T-189/05

“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).”

48. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods 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 that has been made of it. The opponent has not pleaded that its mark has obtained an enhanced level of distinctiveness and no evidence has been filed to that effect. Therefore, I only have the inherent position to consider.

49. The opponent’s mark comprises the word “EUFORIA”. As previously outlined in my comparison of the marks, the majority of consumers will perceive “EUFORIA” as a deliberate misspelling of the well-known dictionary word, “euphoria”. As above “euphoria” will be understood as meaning extreme joy. This neither describes nor alludes to the goods upon which the opponent relies. I appreciate that it could be

argued that a consumer experiences a euphoric feeling from exercise or sports, however, I do not consider that consumers will necessarily take this meaning away from the mark. Overall, I do not consider that the opponent's mark carries a particularly distinctive message from a trade mark perspective. Therefore, I am of the view that it is inherently distinctive to a medium degree.

### **Likelihood of confusion**

50. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

51. Whilst conducting a global assessment of the likelihood of confusion I must be aware of the fact that not all aspects of the respective marks will necessarily have the same impact. For example, the importance of the respective visual, aural and conceptual aspects will be dependent on factors such as the way the goods at issue are marketed, and in which type of store/platform they are made available.

52. Throughout the course of this decision, I have found the respective goods range from being similar to a low degree to between a low and medium degree. The average consumers are members of the general public who will select the goods via primarily visual means, although I do not discount an aural component. I have

concluded that the average consumer will pay a medium degree of attention during the selection process. I have found the marks to be visually similar to a medium degree, aurally similar to a medium to high degree and conceptually similar to a high degree. I have found the opponent's mark to possess a medium degree of inherent distinctive character.

53. Taking all of the above factors into account and bearing in mind the principle of imperfect recollection, I consider the present case represents an example of direct confusion. I base this finding primarily in reliance upon the similarity between the sole element of opponent's mark being "EUFORIA" and the dominant part of the applicant's mark being "EUPHORIA". I consider that the consumer would attempt to pin their recollection of the marks on the words "EUFORIA" and "Euphoria" and, as such, the word "Running" being allusive to the nature of the applicant's goods, is likely to be overlooked. In making this point, I note that the point of difference between the marks, being the letters 'F' / "PH", are subsumed within the body of the dominant element of the marks. With F/PH being aurally identical, consumers may confuse these letters easily. I consider that this is especially the case given the principle of imperfect recollection which will lead consumers to misremember which mark included the word 'Euphoria' and which included 'EUFORIA', regardless of the presence of the allusive word 'Running'. As a result, I consider that there exists a likelihood of direct confusion between the marks. Given the higher level of similarity between the dominant element of the marks (being that which the consumer will pin their recollection on), I am of the view that this finding applies regardless of the degree of similarity between the goods at issue.

54. In the event I am incorrect about this case being an example of direct confusion, I will now consider whether there is a likelihood of indirect confusion. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., 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)".

55. I can confirm I have taken into account both the opponent's and the applicant's statements regarding brand extensions and sub-brands they have put forward in their statement of grounds and counterstatement, respectively.

56. While indirect confusion requires an assessment on the basis that the differences are noticed by consumers, it does not follow that all differences are always noticed. In the present case, for the same reasons set out above, I find that consumers will still overlook the differences between "EUFORIA" and "Euphoria". Therefore, the

present assessment of indirect confusion is focused on the consumer noticing the additional word “Running”. In the present circumstances, I consider it likely that consumers would, when confronted by the parties’ marks, believe them to originate from the same or economically connected undertakings. In my view the addition of the word “Running” to the word “Euphoria” will be seen as a logical addition that consumers would consider to be consistent with a brand extension. For example, on the basis that the differences between ‘EUFORIA’ and ‘Euphoria’ are overlooked, the applicants mark will be seen as a sub-brand of the opponent that offers running related goods. Even where the goods are not expressly reserved for running, they are clothing items that are not limited in any way so can cover clothing worn for running. Taking all of this into consideration, I consider there to be a likelihood of indirect confusion, even in circumstances where the goods are only similar to a low degree.

## **CONCLUSION**

57. The opposition succeeds in full and, subject to any successful appeal, the applicant’s mark is refused registration for all goods for which protection was sought.

## **COSTS**

58. As the opponent has been successful in opposing the applicant’s mark, it is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award the opponent the sum of £950 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Official fee:	£100
Preparing a statement and considering the other side’s statement:	£250
Considering the other side’s evidence:	£600
<b>Total:</b>	<b>£950</b>

59. I therefore order Gianluca Rondelli to pay S.E Satisfy the sum of £950. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

**Dated this 31<sup>st</sup> day of October 2025**

**N Barratt**

**For the Registrar**