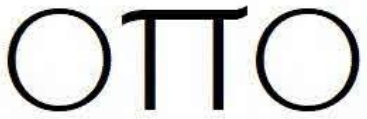
O/1176/24

TRADE MARKS ACT 1994

IN THE MATTER OF
TRADE MARK APPLICATON NO. 3870065
BY CRAFTMASTER MICROBREW LTD TO REGISTER AS A TRADE MARK:



IN CLASS 9

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NO. 441146
BY ESSENTIAL EXPORT, LIMITADA

BACKGROUND AND PLEADINGS

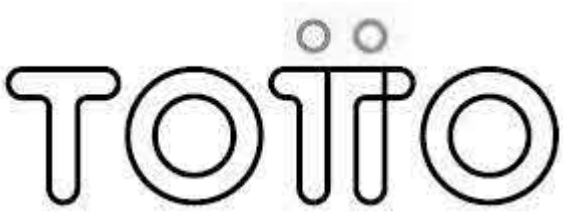
1. On 20 January 2023, Craftmaster Microbrew Ltd ("the applicant") applied to register the trade mark displayed on the cover page of this decision, under number 3870065 ("the applicant's mark"). It was accepted and published in the Trade Marks Journal on 03 March 2023 in respect of the following goods:

> Class 9: Storage cells [electric]; Electricity storage apparatus; Ultracapacitors for energy storage; Battery boxes.

2. On 02 June 2023, the applicant's mark was opposed by ESSENTIAL EXPORT, LIMITADA ("the opponent"). The opposition is brought under section 5(2)(b) of the Trade Marks Act 1994 ("the Act") and is directed against all of the goods specified in the application.

3. The opponent relies upon the following registration:

> UK trade mark registration no. UK00003694923 (series of 2)



> Filing date 15 September 2021.
>
> Registration date 17 December 2021.

Relying upon some of the goods for which its mark is registered, namely:

Class 9: Apparatus and instruments for conducting electricity; Apparatus and instruments for carrying out the distribution of electricity; Apparatus and instruments for transforming the distribution of electricity; Apparatus and instruments for accumulating electricity; Apparatus and instruments for controlling electricity; solar batteries; battery chargers; chargers for electric accumulators.

4. The mark in the opponent's registration is an earlier mark, in accordance with Section 6 of the Act. However, as it had not been protected for five years or more at the filing date of the application, it is not subject to the proof of use requirements specified within Section 6A of the Act.

5. In its notice of opposition, the opponent submits that the marks at issue are visually and phonetically similar. They state that both marks consist of words of similar length presented in relatively basic stylisation. Additionally, it contends that the applicant's mark contains the identical last four letters of its mark, with the only difference being the initial letter 'T'. The opponent also argues that the goods contained in the applicant's mark are identical or confusingly similar to those contained within its earlier registration. As such, the opponent submits that the applicant's mark should be refused in its entirety and that an award of costs be made in their favour.

6. The applicant filed a counterstatement denying that the marks are visually or phonetically similar. They state that the opponent's mark is presented in a completely different font, as well as combining the two middle letter 'Ts' in a stylised fashion with a diacritic mark which appears to be similar to an umlaut. Additionally, they argue that it is inconceivable to confuse a distinct TEH sound with an OH sound. It is also not possible to confuse an OH sound with a TOE sound therefore there is no confusion. The applicant also submits that the goods are not the same as the opponent's. Finally, the applicant argues that

the opponent's mark has co-existed with a number of other 'OTTO' marks on the Register.

7. The opponent is represented by Vault IP Ltd, and the applicant is unrepresented. Neither party requested a hearing but both filed submissions in lieu. I therefore make this decision having taken full account of all the papers, referring to them as necessary.

RELEVANCE OF EU LAW

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

DECISION

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

9. The opposition is based upon section 5(2)(b) of the Act which reads as follows:

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

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. 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 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

12. Section 60A of the Act provides:

"(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the "Nice Classification" means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1979."

13. In the judgment of the Court of Justice of the European Union ("CJEU") in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

"In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary."

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

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

15. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

> "… Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question".

16. In *Avnet Incorporated v Isoact Limited,* [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

> "In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase."

17. For the purposes of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Albingia SA v Axis Bank Limited,* BL O/253/18, a decision of the Appointed Person, Professor Phillip Johnson, at paragraph 42).

18. 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 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."

19. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (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."

20. In *Sanco SA v OHIM,* Case T-249/11, the GC indicated that goods and services may be regarded as 'complementary' and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amalia Mary Elliot v LRC Holdings Limited* BL O/255/13*:*

> "It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes."

Whilst on the other hand:

> ".....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together."

21. The goods to be compared are:

The opponent's goods	**The applicant's goods**
Class 9: Apparatus and instruments for conducting electricity; Apparatus and instruments for carrying out the distribution of electricity; Apparatus and instruments for transforming the distribution of electricity; Apparatus and instruments for accumulating electricity; Apparatus and instruments for controlling	**Class 9:** Storage cells [electric]; Electricity storage apparatus; Ultracapacitors for energy storage; Battery boxes.

electricity; solar batteries; battery chargers; chargers for electric accumulators.	

Storage cells [electric]; Electricity storage apparatus; Ultracapacitors for energy storage

22. The opponent argues that they fall within the opponent's goods *"Apparatus and instruments for conducting electricity; Apparatus and instruments for carrying out the distribution of electricity; Apparatus and instruments for transforming the distribution of electricity; Apparatus and instruments for accumulating electricity; Apparatus and instruments for controlling electricity"* claimed in the earlier mark and are therefore identical, or at least confusingly similar. The applicant submitted in their TM8 that the applied for goods are not the same as the opponent's goods. In my view, I agree that the above terms listed in the opponent's specification are considered broad enough to encompass the terms contained within the applicant's i.e., they are all goods that are types of apparatus used to accumulate and store electricity. Therefore, considering the principals from *Meric,* I find these goods to be identical. However, if I am wrong in this finding, it is considered that the goods are similar to a high degree. I say this because although it could be argued that 'conducting', 'distribution', 'transforming', 'accumulating', or 'controlling' are not the same as 'storage', the goods themselves are similar in nature, in that they are all types of electrical equipment. The purpose of the goods is also highly similar as they all play a role in the supply of electricity, resulting in a shared user of the goods. Additionally, the channels of trade will be the same, and there is likely to be a complementary relationship between them.

Battery boxes

23. The opponent submits that battery boxes are used for containing and protecting batteries and are therefore similar to the goods claimed in the earlier

registration, as they are complementary goods. In general, I agree with the opponent that the primary purpose of the contested goods is to be used to contain or protect batteries. As such there is a difference in nature and purpose to the opponent's goods. The goods may share the same end user, namely specialist consumers who wish to protect or store their electricity storage apparatus e.g., batteries. The distribution channels are considered to be similar in that both the opponent's and the applicant's goods would be sold through specialist retailers. There is, however, no element of competition between the goods neither do I believe there to be a complementary relationship. I say this because there is no evidence to suggest that manufacturers of batteries also manufacture boxes for storing or protecting them. As a result, I find the goods to be similar to a low degree.

The average consumer and the nature of the purchasing act

24. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question (see *Lloyd Schuhfabrik Meyer,* Case C-342/97).

25. 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."

26. Given the technical nature of the goods they are likely to be aimed at specialist business users and they are likely to be purchased relatively infrequently. I would expect them to be sold through specialist retailers, be that from bricks and mortar premises, through tele-sales, or via the internet. The selection of the goods will be relatively important to the average consumer, with the purchasing act likely to follow a measured thought process such that the goods are unlikely to be purchased casually or as a matter of routine. Considerations such as technical reviews of the goods, price, quality, ease of use, and suitability of the product would be taken into account before purchasing. The selection process would be a combination of visual and aural; some consumers would seek information from written reviews and recommendations, particularly on the internet, whereas others would receive verbal advice from sales representatives, particularly in the case of tele-sales. Considering all of these factors, it is my view that the consumer is likely to pay an above average, but not high, level of attention during the purchasing process.

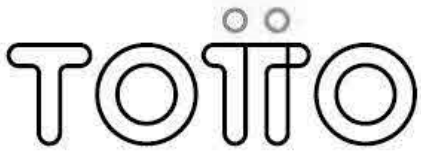
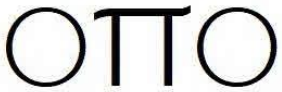
Comparison of trade marks

27. 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 analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgement 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:

The opponent's mark	The applicant's mark
UK00003694923 (series of 2)  	UK00003870065 

30. The opponent contends that the 'TOTTO' element of the earlier mark is the dominant component and that whilst figurative, the stylisation present is relatively basic, therefore rendering the word itself the most recognisable part of the mark. They state that the applicant's mark consists of 'OTTO', again with relatively basic stylisation. The opponent argues that the applicant's mark shares 4 out of the 5 letters contained in the earlier mark, presented in the same sequence and the marks are of a similar length. However, whilst the applicant's mark is missing the initial letter 'T', when considering the concept of imperfect recollection, consumers could easily misremember the earlier mark and confuse OTTO with TOTTO. Further the opponent submits that whilst differences at the beginning of a mark are more prominent than at the end, differences at the beginning do not necessarily lead to a finding that the marks

are different, referring to a decision of the Registrar (O-156-09) where the hearing officer stated:

> *"In visual terms, both marks are of similar, but not exactly the same length, both comprising three syllables. They share the same suffix, string or stem – "LIVA", and differ as regards the opening letters, being "A" and "ES". Molar say that "ES" and "AL" elements are very different visually, but I am obliged to consider the marks as totalities. Given that the marks share the same suffix, string or stem, globally, I regard them as being visually similar to a reasonable degree."*

As a result, they consider the two signs to be visually similar.

31. Next, the opponent submits that the signs are phonetically similar to a high degree. They state that the earlier mark would be pronounced as "TOT" "TOH" or "TOH" "TOH". Similarly, the applicant's mark would be pronounced "OT" "TOH" or "OH" "TOH", continuing to argue that both marks contain two syllables and the additional letter 'T' at the beginning of the initial syllable makes only a small phonetic difference overall.

32. Finally, the opponent argues that neither mark has a recognised dictionary meaning and therefore the marks cannot be differentiated on a conceptual basis.

33. On the other hand, the applicant submitted, in their TM8, that the marks are not visually similar, arguing that the font and stylisation are completely different. Additionally, they state that their mark is stylised by the joining of the two 'Ts' in the word to form a stylised version of the mathematical symbol Pi. Conversely, the opponent's mark appears to show the 'Ts' combined in a stylized fashion with a diacritic mark which appears to be similar to an umlaut, adding that this mark alone creates significant difference between the conjoined 'T' symbol/stylisation.

34. The applicant also contends that the marks are not phonetically similar, and that it is inconceivable to confuse a distinct TEH sound with an OH sound. It is also not possible to confuse an OH sound with a TOE sound and therefore there is no confusion.

Overall Impression

35. The opponent's mark is a figurative mark that consists of the word 'TOTTO' whereby the two middle letter 'Ts' are conjoined and presented with one red and one yellow (or greyscale in mark 2) circle above them. While the device element is noticeable, one's eye is drawn to the word element which makes the greater contribution in forming the overall impression. On the other hand, the applicant's mark consists of the word 'OTTO' in a basic font. The two letter 'Ts' are again conjoined, however the way in which they have been done so appears to be representative of the mathematical symbol for Pi. Again, the device is noticeable but one's eye is drawn to the word element which makes the greater contribution in forming the overall impression.

Visual Comparison

36. The opponent's mark consists of one word being made up of five letters. The applicant's mark consists of one word made up of four letters. The applicant's mark contains four of the same letters in the same order as the opponent's mark. The difference is the addition of the letter 'T' at the beginning of the opponent's mark. As stated above, the two middle letter 'Ts' in the opponent's mark are conjoined and presented with one red and one yellow circle above them (greyscale in mark 2). Whereas the applicant's mark uses the mathematical symbol for Pi in place of the two letter 'Ts'. Regardless of the different impressions these elements have in their respective marks, they are points of visual difference. Bearing in mind my assessment of the overall impression of the marks, I consider that there is no more than a medium degree of visual similarity between the marks at issue.

Aural Comparison

37. Aurally, and as the opponent contends, I agree that both marks will be articulated as two syllables. The opponent's, either being pronounced 'TOT-TOH', or 'TOH-TOH', and the applicant's being pronounced either 'OT-TOH' or 'OH-TOH'. In their submissions, the applicant states that it is 'inconceivable to confuse a distinct TEH sound with an OH' sound. I am unsure as to what this is intended to mean because in my view, neither marks would be pronounced using a 'TEH' sound in either of the pronunciations I have discussed above. Whilst I appreciate that the last syllable is identical in both marks, in my view the letter 'T' sound in both pronunciations at the beginning of the opponent's mark would not go unnoticed by the consumer due to it being the first letter of the word. I say this because neither mark is particularly lengthy and while there is no special test which applies to the comparison of 'short' marks,[1] I am of the view that, in the present case, the shortness of the marks at issue means that the average consumer is more likely to notice the differences. Given the difference in pronunciation caused by the initial letter 'T' in the opponent's mark, it is considered that the marks are aurally similar to between a medium and high degree.

Conceptual Comparison

38. The word 'TOTTO' in the opponent's mark does not convey a concept. I consider that the relevant average UK consumer will ascribe no meaning to the word and instead conclude that 'TOTTO' is an invented word or a word in a foreign language. The inclusion of the two, coloured dots above the two middle letter 'Ts' in the opponent's mark adds to the notion that the word 'TOTTO' could be perceived as a foreign word, as it may be recognised as an umlaut by some consumers. On the other hand, the word OTTO in the applicant's mark would, in my opinion, be perceived as a masculine forename. I do not agree with the opponent that because the word has no dictionary meaning it does not convey a concept. Additionally, some consumers would perceive the conjoined letter

[1] See paragraph 44 of *BOSCO*, BL O/301/20

'Ts' as representative of the mathematical symbol for Pi. This element serves as a further conceptual distinction between the two marks. As a result, I find that the marks are conceptually dissimilar.

Distinctive character of the opponent's mark

39. 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)."

40. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive

of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctive character of a mark can be enhanced by virtue of the use that has been made of it. The opponent has not claimed that its mark has acquired an enhanced degree of distinctiveness and has not filed any evidence to that effect. As such, I have only the inherent position to consider.

41. The opponent's mark consists essentially of the word 'TOTTO' which, of itself, is likely to be perceived as invented, or a word in a foreign language. Consequently, no particular meaning will be attributed to it. Further, the stylisation of the two middle letter 'Ts' is unlikely to be overlooked by the consumer which only adds to the distinctive character of the sign as a whole. As a result, I consider it to be inherently distinctive to a high degree.

Likelihood of confusion

42. 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.

43. 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 (see *Sabel*, C-251/95, para 22). 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 services and vice versa (see *Canon*, C-39/97, para 17). It is necessary for me to keep in mind the distinctive character of the earlier marks, the average consumer for the goods and services, and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade

marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

44. 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.

45. Throughout the course of this decision, I have determined that:

- The respective goods range from being similar to a low degree, to identical, or at least a high degree as explained above.

- The average consumers are professional businesses who will demonstrate an above average but not high level of attention during the purchasing process.

- The purchasing process for the goods would be a combination of visual and aural.

- The opponent's mark possesses a high degree of inherent distinctive character.

- The marks at issue are visually similar to no more than a medium degree. The marks are aurally similar to between a medium and high degree. The marks are conceptually dissimilar.

46. Taking all of the above into account, and even bearing in mind the principle of imperfect recollection, I consider that the differences between the marks are such that the consumers would be able to accurately recall and sufficiently remember which mark was which. I appreciate that the marks share an identical string of four letters, however, the inclusion of the initial letter 'T' in the

opponent's mark is such that it would not be overlooked by the consumer in a relatively short mark. As previously mentioned, I appreciate that there is no special test which applies to the comparison of 'short' marks however I am of the view that, in the present case, the shortness of the marks at issue means that the average consumer is more likely to notice the differences. Additionally, whilst I have concluded the aural similarity of the marks to be between medium and high, the conceptual dissimilarity, in that the applicant's mark would be understood both as a masculine forename, as well as a reference to the mathematical number Pi, is considered to be a significant factor in how the mark is recalled. It is, therefore, my conclusion that the average consumer will not be directly confused by the marks at issue, even on identical goods.

47. That leaves indirect confusion to be considered. In *L.A. Sugar Limited v By Back Beat Inc,* Case BL O/375/10, Mr Iain Purvis QC, (as he then was) sitting 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)."

48. These three categories are not exhaustive; rather, they were intended to be illustrative of the general approach, as has been confirmed by the Court of Appeal. 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.

49. Furthermore, in *Liverpool Gin* [2] Arnold LJ referred to the comments of James Mellor Q.C. (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

[2] *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207

50. Consumers, having recognised the difference created by the initial letter 'T' at the beginning of the opponent's mark, as well as the stylistic and conceptual differences between the contested marks, would not then assume that they are economically linked undertakings. Consumers would have no reason to artificially dissect the marks to separate the common string of letters 'OTTO' from the rest of the mark. I do not consider it logical that an undertaking would remove the initial letter of their mark; this is more than simply removing a non-distinctive element. Whilst I appreciate that the *L.A. Sugar* categories (referred to above) are not exhaustive, I do not see any other plausible basis on which to conclude that consumers would see the competing marks as deriving from economically linked undertakings. Instead, in my opinion, the shared string of letters will be seen as merely coincidental. Consequently, and bearing in mind the comments of Arnold LJ and Mr Mellor Q.C in the preceding paragraph, I do not consider there to be a likelihood of indirect confusion.

Conclusion

51. The opposition has failed in its entirety. Therefore, subject to any successful appeal, the application may proceed to registration for all of the goods contained within the specification.

Costs

52. The applicant has been successful, and, in the ordinary course of these proceedings, would be entitled to a contribution towards its costs. However, the applicant is unrepresented meaning that, in order to claim its costs, it is required to file a completed costs pro-forma. It did not do so. I note that a blank costs pro-forma was provided to the opponent under the cover of a letter from the Tribunal dated 22 March 2024. I also note that this letter set out 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."*

The applicant incurred no official fees to file the Counterstatement and therefore, as no costs pro-forma was filed, I make no award of costs in these proceedings.

Dated this 13th day of December 2024

Oliver Rose'Meyer
For the Registrar