BL O/1182/25

TRADE MARKS ACT 1994

IN THE MATTER OF

TRADE MARK APPLICATION NUMBER 3945253

BY SERHII BELINSKYI

TO REGISTER THE TRADE MARK:

IN CLASSES 25, 35 AND 42

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NUMBER 444366

BY WOOLWORTH GMBH

BACKGROUND AND PLEADINGS

1. On 14 August 2023, Serhii Belinskyi ("the applicant") applied to register in the UK the trade mark shown on the cover page of this decision, under number 3945253 ("the contested mark"). The contested mark was published in the Trade Marks Journal for opposition purposes on 1 September 2023 in respect of the following goods and services:

   Class 25: Clothing; Footwear; Headgear; Sportswear; Swimwear; Underwear and nightwear.

   Class 35: Online retail services relating to clothing; Retail services in relation to clothing; Wholesale services in relation to clothing.

   Class 42: Design of clothing, footwear and headgear; Clothing design services.

2. On 29 November 2023, Woolworth GmbH, ("the opponent") filed a notice of opposition, opposing the application in full, under section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opponent relies upon the following UK trade mark:

   UK registration number: 3699722

   Infinity

   Filing date: 23 September 2021
   Registration date: 11 March 2022

   For the purposes of these proceedings, the opponent relies upon on the following goods in its opposition, for which the mark is registered, namely:

Class 25: Clothing, apparel; Shoes; Headgear; Neck scarves [mufflers]; Gloves [clothing]; Waist belts; Socks; Tights.

3. In its notice of opposition, the opponent claims that the contested mark is highly visually and phonetically similar and conceptually identical to the dominant and distinctive element of the earlier mark. The opponent further submits that the contested goods and services are in part identical and where there is no identity, there is a high degree of similarity with the earlier goods, resulting in a likelihood of confusion including a likelihood of association on the part of the public.[1]

4. The applicant filed a defence and counterstatement denying the grounds of the opposition.[2]

5. Given the filing dates, the opponent's mark is an earlier mark, in accordance with section 6 of the Act. However, as it had not been registered 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. As a consequence, the opponent may rely upon all of the goods for which the earlier mark is registered without having to establish genuine use.

6. The opponent is represented by Taylor Wessing LLP and the applicant is represented by Trama Legal s.r.o. Neither party chose to file evidence. Both parties were given the option of an oral hearing but neither requested to be heard on this matter, however, the opponent filed written submissions in lieu of a hearing. This decision is taken following a careful review of the papers before me, keeping all submissions in mind.

RELEVANCE OF EU LAW

[1] Form TM7, pages 11 - 12
[2] Form TM8, pages 6 - 9

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

PRELIMINARY ISSUES

Relevant customers and market

8. The applicant has raised points in its counterstatement which I intend to address before going any further into the merits of this opposition. This is because it is necessary to explain why, as a matter of law, these points will have no bearing on the outcome of this opposition.

9. In its counterstatement, the applicant submits the following:

> "The customers of the Applicant and the Opponent are English-speaking following the fact that relevant signs are UK trademark applications. In the assessment of the likelihood of confusion the average consumer is considered to be reasonably well informed, observant and circumspect. However, it is important to underline that although the marks of the Opponent are registered in the UK, there is no indication whatsoever that the Opponent is using the marks in the territory of the UK. The Opponent's chain of supermarkets has been previously operating in the UK but following the information available in the internet this is not the case since 2009. For this reason it might be assumed that the relevant market for the Opponent is based in Germany."[3]

10. The opponent responded in its written submissions as follows:

[3] Amended counterstatement filed 6 February 2024, Page 7.

"In the Applicant's Defence, it is submitted that the Opponent is not using the Earlier Mark in the UK and that the relevant public is based in Germany.

Given that the proof of use is irrelevant in these opposition proceedings, the Opponent submits that the comparison of the goods and services must be determined on an objective basis taking into account the Earlier Goods as registered. Only the group of goods and services protected by the marks at issue must be taken into account, and not the goods and services actually marketed under those marks (case T-66/11 Present-Service Ullrich GmbH & Co. KG).

Where the goods and services at issue are intended for all consumers, the relevant public must be deemed to be composed of average consumers, reasonably well- informed and reasonably observant and circumspect (Alcon/OHIM - Biofarma, C- 412/05 P, paragraph 62). The average consumer of the Contested Goods and Services will be the normal consumer, i.e., a member of the general public in the UK. Consumers based in Germany are not relevant."[4]

11. As this opposition is not subject to the 'proof of use' requirement, the opponent is entitled to protection in relation to all the goods for which the earlier mark is registered, without having to show that it has actually used its mark in relation to any of those goods. Furthermore, I am required to make the assessment of the likelihood of confusion notionally and objectively based on the opponent's goods in accordance with the relevant case law. As such it is not appropriate to take the comments provided by the applicant into account. However, I will make an assessment later in this decision, as to who the average consumer could be for the goods and services at issue.[5]

Earlier rights

[4] Opponent's written submissions in lieu filed 31 December 2024, Pages 3-4
[5] *Roger Maier and Another v ASOS,* [2015] EWCA Civ 220

12. In its Notice of Opposition, the opponent relied on two earlier rights, UK00917980704 and UK00003699722. However, in the opponent's written submissions in lieu, the opponent stated that in the interest of procedural economy they only intended to rely on UK00003699722. Therefore, I will proceed on the basis of this one earlier right.[6]

DECISION

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

13. Section 5(2)(b) and 5A of the Act is 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."
>
> "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."

14. 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 OHIM*,

[6] Opponent's written submissions in lieu filed 30 December 2024, Paragraph 4.

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. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant, but someone who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them they have kept in their mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

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

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

i) mere association, in the strict sense that the later mark brings 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 and services

15. Section 60A of the Act provides:

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

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

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

(2) In subsection (1), the "Nice Classification" means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975."

16. In comparing the respective specifications, all relevant factors should be considered, as per *Canon*, where the CJEU stated at paragraph 23 of its judgment:

> "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."

17. 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.

18. In *Gérard Meric v OHIM*, Case T- 133/05, the General Court ("GC") stated that:

"29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut 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."

19. Further, in *Kurt Hesse v OHIM*,[7] 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 OHIM*,[8] the General Court ("GC") stated that "complementary" means:

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

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

21. 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

[7] Case C-50/15 P
[8] Case T-325/06

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."

22. In *Sky v Skykick* [2020] EWHC 990 (Ch), Lord Justice Arnold considered the validity of trade marks registered for, amongst many other things, the general term 'computer software'. In the course of his judgment he set out the following summary of the correct approach to interpreting broad and/or vague terms:

> "…the applicable principles of interpretation are as follows: (1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services. (2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms. (3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers. (4) A term which cannot be interpreted is to be disregarded."

23. In *Avnet Incorporated v Isoact Limited* [1998] FSR 16, Jacob J (as he then was) said at [19]:

> "[…] definitions of services … are inherently less precise than specifications of goods. […] 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."

24. I bear in mind that it is permissible to group goods together for the purposes of assessment: *Separode Trade Mark*:[9]

> "The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision."

25. The competing goods and services are as follows:

Opponent's goods	**Applicant's goods and services**
Class 25: Clothing, apparel; Shoes; Headgear; Neck scarves [mufflers]; Gloves [clothing]; Waist belts; Socks; Tights.	Class 25: Clothing; Footwear; Headgear; Sportswear; Swimwear; Underwear and nightwear.
	Class 35: Online retail services relating to clothing; Retail services in relation to clothing; Wholesale services in relation to clothing.
	Class 42: Design of clothing, footwear and headgear; Clothing design services.

Class 25

Clothing; Headgear.

[9] BL O/399/10

26. The above goods for which the applicant seeks registration are present in the specifications of the earlier mark relied upon by the opponent and are, therefore evidently identical.

Footwear.

27. The opponent's mark is registered for '*Shoes*' which is encompassed in the applicant's '*Footwear*'. Therefore, these goods are identical in line with the principle set out in *Meric.*

Sportswear; Swimwear; Underwear and nightwear.

28. The opponent's mark is registered for '*clothing',* which as a broad term encompasses the above goods. Therefore, these goods are identical in line with the principle set out in *Meric.*

Class 35

29. In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the GC held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

30. In *Tony Van Gulck v Wasabi Frog Ltd,* Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services v goods. He said (at paragraph 9 of his judgment) that:

> "9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services

for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent's earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are 'similar' to goods are not clear cut."

31. However, on the basis of the European courts' judgments in *Sanco SA v OHIM*, Case C-411/13P and *Assembled Investments (Proprietary) Ltd v. OHIM*, Case T105/05, at paragraphs [30] to [35] of the judgment, upheld on appeal in *Waterford 23 Wedgewood Plc v. Assembled Investments (Proprietary) Ltd* Case C-398/07P, Mr Hobbs concluded that:

i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer's point of view, they are unlikely to be offered by one and the same undertaking;

ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent's goods and then to compare the opponent's goods with the retail services covered by the applicant's trade mark;

iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;

iv) The GC's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

32. As highlighted in *Oakley* above, the GC held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

Online retail services relating to clothing; *Retail services in relation to clothing*; *Wholesale services in relation to clothing*

33. Here, I compare the applicant's above services with the opponent's "clothing". The opponent's goods will be sold through the same trade channels to the same users, who may assume the goods and services come from the same undertaking and would therefore be complementary. I therefore find the respective goods and services to be similar to a medium degree.

Class 42

Design of clothing, footwear and headgear; Clothing design services.

34. I compare the above class 42 services with the opponent's, "Clothing", "Shoes" and "Headgear". Although their nature, method of use and specific purpose will differ, the goods and services share the same end purpose – the provision of clothing, footwear and headgear. Although the respective goods and services are not in competition or considered to be complementary where the consumer of the design services is a clothing company, I find that where the consumer is a member of the public, these design services are important for the production of the goods and it would therefore be reasonable for them to assume these goods and services would come from the same undertaking, leading to a finding of complementarity. There will also be competition where a member of the public choses between the finished goods and getting a garment or pair shoes or a hat designed for them. Accordingly, I find these goods and services to be similar to a medium degree.

The average consumer and the nature of the purchasing act

35. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited,* [2014] EWHC 439 (Ch), Birss J. 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 word "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

36. The average consumer for the goods in class 25 will predominantly be the general public at large. The goods will be sold through a range of retailers and their online equivalents. In physical stores, the goods will be displayed on shelves or racks, where they will be viewed and self-selected by the consumer. For their online equivalent, a similar process will apply where the consumer will select the goods after viewing an image on a webpage. Therefore, the selection of the class 25 goods will be primarily visual although I do not discount aural considerations such as advice from a sales assistant or word of mouth recommendations. Cost of the goods will vary, as well as frequency of purchase. The average consumer will take various factors into account when selecting the goods, such as, fashion trends, material, durability and suitability for its intended purpose. Accordingly, I find the average consumer for the class 25 goods will pay a medium degree of attention during the purchasing process.

37. For the class 35 and 42 services, business users as well as the general public should be considered. The visual aspect of the purchase will likely dominate the selection of these services, not discounting any aural factors. Furthermore, the consumer is likely to bear in mind the reputation or reliability of the service provider and other factors such as the range of goods on offer and knowledge and

experience of staff. For the class 42 services, the costs are also likely to be higher. I do not consider these factors to be anything other than relatively ordinary considerations, therefore I find that the average consumer for the class 35 and 42 services will pay at least a medium degree of attention during the purchasing process.

Comparison of marks

38. It is clear form *Sabel* 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 states at paragraph 34 of its judgment in *Bimbo*, 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 relevant 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."

39. 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 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 marks.

40. The marks to be compared are as follows:

Contested mark	**Earlier mark**

	Infinity

Overall impression

41. The contested mark is a figurative mark that consists of a device element situated above the invented word, 'INJINITY', which is presented in capital letters in a black, slightly stylised typeface with the 'foot' of the 'J' not appearing to be fully formed. The opponent describes the figurative device as a "*distinctive figurative rhombus shaped element containing the letters 'i' and 'j' presented in a creative way*." I am minded not to agree with the description put forward by the opponent and consider that although a proportion of the relevant public may see an 'i' and a 'j', it would not be a significant proportion. Rather, I find that a significant proportion of the relevant public would simply see a geometric diamond shape device with broken lines. As the average consumer is drawn to the elements of the mark that can be read, being the word, 'INJINITY' and due in part to its size, I find that it is the word that dominates the overall impression of the mark with the device element playing a much lesser role. As for the stylisation used in the word element, this is very limited and will not, in my view, contribute to the overall impression of the mark.

42. The earlier mark is a plain word mark, 'INFINITY', presented on the register as a capitalised word, but which could just as easily be in all capital letters through normal and fair use. There are no other elements to contribute to the overall impression of the mark, which resides in the word itself.

Visual Comparison

43. Visually, the marks coincide in that they share the letters, 'IN_INITY'. The marks differ in that the third letter of the earlier mark contains the letter 'F' and the identically positioned letter in the contested mark contains the letter 'J'. With regards to the figurative element present in the contested mark, this is not replicated in the earlier mark, but it is relatively unremarkable and the slight stylisation of the word in the contested mark makes very little visual difference. Accordingly, weighing up the similarities with the differences, I find the respective marks to be visually similar to at least a medium degree.

Aural Comparison

44. Aurally, the earlier mark consists of 4 syllables and is likely to be pronounced as 'IN-FIN-Y-TI'. The contested mark consists of 4 syllables and is likely to be pronounced as 'IN-JIN-Y-TI'. The figurative device will not be articulated. Overall, I find the respective marks to be aurally similar to a high degree.

Conceptual Comparison

45. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R 29. The assessment must, therefore, be made from the point of view of the average consumer.

46. The word 'INFINITY' in the earlier mark can be described as something which is boundless, endless or larger than any natural number and in itself has no conceptual connection to the goods at issue.

47. The contested mark, 'INJINITY' is an invented word and as such has no conceptual meaning. I find that the figurative element is likely to be attributed little trade mark significance, as it has no conceptual connection to the mark and will merely be viewed as decorative.

48. Accordingly, the contested mark is clearly an invented word devoid of any clear meaning and the figurative element is of little significance, whereas the earlier mark conveys a clear concept. Therefore, I find the respective marks to be conceptually dissimilar.

Distinctive character of the earlier mark

49. In *Lloyd Schuhfabrik Meyer*, 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 Alternberger* [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)."

50. 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.

51. In its counterstatement, the applicant states:

> "..there are 33 active trademarks in the UKIPO register containing the word "INFINITY" by itself or combined with other words, filed or registered in Class 25. Following the relevant case law in this matter, the possibility cannot be ruled out that the coexistence of two marks on a particular market might contribute to diminishing the likelihood of confusion between those marks on the part of the relevant public (03/09/2009, C-498/07 P, La Española, EU:C:2009:503, **§** 82). In one of the other cases it has been established that the coexistence of earlier marks in the market could reduce the likelihood of confusion found between two conflicting marks (11/05/2005, T-31/03, Grupo Sada, EU:T:2005:169, **§** 86). As such, the existence of other marks containing the word "INFINITY" clearly shows that a peaceful coexistence is possible between the marks."[10]

52. The opponent responds in its written submissions as follows:

> "The Opponent submits that the mere fact that a number of trade marks that include the word element 'INFINITY' exist in the UK register is insufficient. The Applicant has to prove that the trade marks are actually being used (and how) before any inferences can be made about a possible peaceful coexistence. No evidence to support this allegation was submitted and, as such, it should be dismissed."[11]

53. In *Zero Industry Srl v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM),* Case T-400/06 the General Court ("GC") stated that:

[10] Amended counterstatement filed 6 February 2024, page 9.
[11] Opponent's written submissions in lieu filed 31 December 2024, paragraph 11.

"73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word 'zero', it should be pointed out that the Opposition Division found, in that regard, that '… there are no indications as to how many of such trade marks are effectively used in the market'. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word 'zero' is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T-135/04 *GfK v OHIM – BUS(Online Bus)* [2005] ECR II-4865, paragraph 68, and Case T-29/04 *Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH)* [2005] ECR II-5309, paragraph 71)."

54. The mere fact that there are multiple marks on the Register which contain the word 'INFINITY' for class 25 goods in the UK is not relevant to my assessment and without any evidence from the applicant to show that the distinctive character of the word 'INFINITY' has been weakened because of its frequent use in the field of clothing, I have nothing further to consider.

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

56. The earlier mark is comprised of the word 'INFINITY'. I do not consider the mark to be allusive or descriptive of the goods it is registered for and therefore, I find the earlier mark to be inherently distinctive to a medium degree.

Likelihood of confusion

57. In determining whether there is likelihood of confusion, I must take all of the above factors into account and consider if there is a likelihood of confusion for the average consumer.

58. 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 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 goods and services may be offset by a greater degree of similarity between the marks and vice versa. I must bear in mind the distinctive character of the earlier marks, the average consumer for the goods and services and the nature of the purchasing act. To do so, I must recognise 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.

59. The following factors must be considered to determine if a likelihood of confusion can be established:

- I have found the marks to be visually similar to at least a medium degree and aurally highly similar and in relation to the conceptual comparison, I have found the marks to be conceptually dissimilar.
- I have found the opponent's mark to be inherently distinctive to a medium degree.
- I have identified the average consumer for the class 25 goods to be the general public, who will pay a medium degree of attention when purchasing these goods. As for the class 35 and 42 services, I have found the average consumer to be the general public and business users who will pay at least a medium degree of attention during the purchasing process. I have concluded that the purchasing process is likely to be visual but do not discount aural considerations.
- I have found the goods and services to range between identical and similar to a medium degree.

60. While the contested mark contains a device, it is a relatively unremarkable one and the the 'i' and the 'j' that the applicant claims are there would not be seen by a significant proportion of average consumers. Rather, they would simply see a geometric diamond shape with broken lines which could easily be mis-recalled as belonging to the opponent's mark. This leaves the words in the marks, the applicant's being in slightly stylised capital letters and the opponent's being in plain text which could be presented in capital letters through normal and fair use. The respective words both have eight letters and share seven out of eight letters that are positioned identically in both marks. The third letter in each mark is different, being an 'f' in the earlier mark and a 'j' in the contested mark, the 'j' being a capital letter whereby its 'foot' does not appear to be fully formed. Given the level of visual and aural similarity between the marks, I consider that the average consumer paying between a medium to at least a medium degree of attention is likely to mis-remember the marks and, through imperfect recollection, mistake one for the other. I therefore find that there is a likelihood of direct confusion.

Conclusion

61. The opposition under Section 5(2)(b) of the Act has been successful. Subject to any successful appeal, the application will be refused.

Costs

62. The opponent has been successful and it is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023.[12] The sum is calculated as follows:

Official fee for the form	£100
Filing a notice of opposition and considering the applicant's counterstatement	£250
Preparing written submissions in lieu of a hearing	£350

[12] As the proceedings were commenced after 01 February 2023

Total	**£700**

63. I therefore order Serhii Belinskyi to pay Woolworth GmbH, Inc the sum of £700. This 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 18th day of December 2025

Mrs Joanne Roberts
For the Registrar