

O-288-11

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION  
No.2464121A  
BY GAFRUS LIMITED  
TO REGISTER THE TRADE MARK  
FESTIVAL REPUBLIC  
IN CLASSES 9 & 25**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER No. 97190A BY  
REPUBLIC (RETAIL) LIMITED**

## BACKGROUND

1) On 14 August 2007 Festival Republic Music Group Limited (hereinafter the applicant), applied to register the trade mark FESTIVAL REPUBLIC in respect of goods and services in Classes 9, 16, 25, 35, 39, 41, 43 & 45. The mark was divided with the opposed goods in Classes 9 & 25 split onto this application. The goods applied for in these two classes are:

Class 9: optical apparatus and instruments; sunglasses.

Class 25: Clothing articles; waterproof clothing; t-shirts; sweatshirts; sweatpants; sweaters; suits; singlets; vests; headscarves; shirts; blouses; gloves; stockings; dressing gowns; underwear; capes; shawls; jeans; pyjamas; children's clothing; pullovers; knitwear; jogging suits; anoraks; bomber jackets; jackets; wind-cheaters; overcoats; shorts; socks; rugby shirts; fleece tops; jumpers; belts; polo shirts; dresses; swimwear; cardigans; coats; trousers; mini-skirts; pinafores; waistcoats; overalls; dance clothing; leotards; leggings; scarves; ties; footwear; shoes; boots; trainers; sandals; espadrilles; slippers; headgear; caps and baseball caps; bandannas; hats.

2) The application was examined and accepted, and subsequently published for opposition purposes on 22 February 2008 in Trade Marks Journal No.6724. On 1 September 2008 the applicant changed its name to GAFRUS Limited.

3) Republic (Retail) Limited (hereinafter the opponent), filed a notice of opposition, dated 22 May 2008, subsequently amended. The ground of opposition is in summary:

- a) The opponent is the proprietor of the following trade mark which is registered for goods in Classes 3, 14, 18 & 35 in addition to the following classes which are the relevant ones for this opposition:

Trade Mark	Number	Application Date and Registration Date	Specification
REPUBLIC	CTM 2838712	30.08.2002 / 25.10.2004	Class 9: Sunglasses; sunglasses frames; spectacles; spectacle frames; parts and fittings for all the aforesaid goods. Class 25: Articles of clothing; footwear; headgear; belts.

b) The opponent states that the mark applied for is similar to the opponent's earlier registration and that "optical apparatus and instruments, sunglasses" in Class 9 and all the goods applied for in relation to Class 25 are identical and/or similar to those for which its' mark is registered. The opponent states that the application offends against Section 5(2)(b) of the Trade Marks Act 1994.

4) On 1 September 2008, the applicant filed a counterstatement which denied the opponent's claims. It states that the applicant is one of the UK's leading music promoters. Originally formed in 1982, the applicant states that it largely created the modern music festival market in the UK. In August 2007 it changed its name from MEAN FIDDLER to FESTIVAL REPUBLIC. Due to its pre-eminent position this change of name received significant amounts of publicity. The

applicant accepts that some of the goods and services of the two parties are identical or similar but does not identify which ones.

5) Both sides filed evidence. Both parties seek an award of costs in their favour. The matter came to be heard on 22 July 2011. At the hearing, the opponent was represented by Mr Marsh of Messrs Wilson Gunn and the applicant was represented by Mr Malynicz of Counsel instructed by Messrs SK Sport & Entertainment LLP.

### **OPPONENT'S EVIDENCE**

6) The opponent chose not to file any evidence.

### **APPLICANT'S EVIDENCE**

7) The applicant filed a witness statement, dated 12 June 2009, by Melvin John Benn the Managing Director of Gafrus Limited, the owner of the Festival Republic mark, a position he has held for thirteen years. He states that his company has been responsible for the operational management of the Glastonbury Festival since 2002, (under the Mean Fiddler mark) and currently is also responsible for Reading, Leeds and Latitude Festivals. He states that revenue is generated through a variety of means including sponsorship, merchandise and ticket sales. He states that the change of name in August 2007 was widely reported. At exhibit MJB1 he provides a copy of a page from the website [www.virtualfestivals.co.uk](http://www.virtualfestivals.co.uk) which reported the change of name on 14 August 2007. He also provides turnover figures for 2006-2008 inclusive. However, part of these are of little assistance as the 2006 and part of the 2007 figures refer to trading under a different trade mark (Mean Fiddler). I note that the company has a considerable turnover with regard to music festivals after the relevant date. The figures provided for merchandising are reasonable but within the realms of the UK clothing market they are very small. He provides a large amount of information about the company's trade under its MEAN FIDDLER trade mark and he claims that as a result the applicant was well-known and had considerable reputation which would have transferred to the new name. He states that the sale of merchandising is a significant part of the company's income. The actual figures are confidential but although a considerable percentage of the company's turnover they would represent less than 1% of the UK clothing industry which must be in the billions although no contextual figures have been provided. He provides a large number of exhibits which are all dated after the relevant date of 14 August 2007 and show use of the mark in suit or which refer to Mean Fiddler.

8) The applicant also filed written submissions dated 12 June 2009. They accept that the goods of the two parties are identical or similar. The applicant provides its views on the similarity of the marks which I shall refer to as and when required later in my decision. They also rely upon "state of the register" evidence which they assert shows that the mark REPUBLIC is commonly used by other businesses in the UK. There are over one hundred such marks on the register.

## OPPONENT'S EVIDENCE IN REPLY

9) The opponent filed submissions, dated 24 February 2010 which comments on the admissibility of the applicant's evidence and also provides their opinion on the similarity of the marks.

10) The opponent filed a witness statement, dated 12 February 2010, by Guy Daltry the Brand Manager of the opponent, a position he has held since January 2004. He states that the opponent began trading in 1986, opening a second store in 1989. By 2000 the opponent had 20 stores, by 2005 they had 80 stores nationwide. An online store was opened in 2007. The opponent sells clothing under its own label as well as other brands in its shops. He provides the following figures:

Year	Total Turnover £million	Units (million)	Turnover of Republic branded clothing £ million	Units	Promotion overall £	Promotion of republic branded clothing £
1997	21	1.1	4.2	221,000	275,000	55,000
1998	24	1.2	4.8	252,000	340,000	68,000
1999	25	1.3	5	263,000	325,000	65,000
2000	25	1.3	5	263,000	340,000	68,000
2001	33	1.7	6.6	347,000	350,000	70,000
2002	42	2.2	8	442,000	400,000	80,000
2003	57	3	11.4	600,000	445,000	89,000
2004	78	4.1	15.6	821,000	600,000	120,000
2005	108	5.6	37.8	1,900,000	1,120,000	392,000
2006	128	6.7	44.8	2,300,000	1,050,000	367,000

## APPLICANT'S EVIDENCE IN REPLY

11) The applicant filed two witness statements. The first, dated 2 September 2010, is by Mr Benn who has provided evidence earlier in this case. He states that all his information comes from personal knowledge and/or the records of the applicant. He states that on 10 August 2007 the name Mean Fiddler and all venues were sold and that since that date the focus of the business has been festival promotion and production under the name Festival Republic. He provides evidence of music festivals run by Mean Fiddler (prior to August 2007) and also by Festival Republic (post August 2007). These figures are the subject of a confidentiality order, but whereas the applicant could claim a substantial reputation with regard to its main business (music festivals) it cannot claim anything other than an average reputation for clothing.

12) The second witness statement, dated 2 September 2010, is by Jeremy Neville Summers the applicant's Trade Mark Attorney. He provides a list of "republic" marks on the UK Trade Marks Register as at 12 June 2009, and evidence from the internet of use of some of the marks. The internet pages show use of the following marks prior to the relevant date (14 August 2007) in the instant case: Rock and Republic (clothing); Chat Republic and device (games); Wild Republic (toys).

## APPLICANT'S ADDITIONAL EVIDENCE

13) The applicant filed a witness statement, dated 30 March 2011, by Sally Louise Britton the applicant's Trade Mark Attorney. She provides the following exhibits:

- SLB1: a report by Farncombe International dated 20 December 2010. This has numerous pages from the internet attached. The report refers to a number of trade marks which have the word "republic", "republiq" or "republika" as part of the overall mark. A number of the companies were formed after the relevant date, under the "use" column some say "current" others state "believed to be current". Some were shops selling other branded goods. A number of the references were clearly the opponent. The internet pages have the following which are clearly dated prior to the relevant date of 14 August 2007.
- A website for "Mount Republic Ltd". The homepage states that the company has been online since the beginning of 2007 and is an online boutique.
- "Banana Republic" announces that they are coming to the UK on 29 January 2007, however their first store opens on 20 March 2008.
- A member of the public asks a website if they have the website address for "Fashion Republic" as she has asked for a catalogue twice but not received it. They refer her to [www.republic.co.uk](http://www.republic.co.uk). This would appear to be the opponent.
- A website for "Punk Republic": stated to be "clothing the revolution" and then the words "new site coming soon".
- A Companies House entry for "Republique of Cult Clothing Limited", formed in March 1991, last return made in 1994 and the company is listed as dissolved.
- A Companies House entry for "Stone Republic Clothing Company Limited" incorporated in October 1984 under the name "Sergio Ramani Sports and Casual Wear Ltd". It changed its name on 22 May 2001; its last return/accounts were filed in April 2010. It is listed as a "wholesaler of clothing and footwear".
- A website for "Urban Republic". The website was started in 2003. This appears to be offering clothing from manufacturers such as French Connection, Golddigga, Full Circle etc.
- A website for "Rock and Republic". This is clearly a USA site as the prices are in US\$. However, eight stores such as Harrods, Selfridges and Mimi in the UK are listed as stockists. They sell clothing, accessories, footwear, pet accessories etc.
- A webpage from Cancer Research offering three "World Republic Clothing Company Inc." Jumpers. Presumably donated by someone who had purchased them from the American company.

- A webpage from “Cotton Republic”. The first page with images of male underwear carries a date of March 2011. However, the wayback site states that the website “www.cotton-republic.com has been crawled 10 times going all they back to May 23 2006.”
- A webpage from “Fishing Republic”. This states that the site was set up on 11 August 2007 and at that time offered only fishing tackle, although subsequently it now offers specialised fishing clothing such as neoprene socks.
- A webpage for “Royal Republiq” a Netherlands company. It is not clear what they do or precisely when the site originated.
- A webpage for “ONEREPUBLIC”. This shows clothing offered as at March 2011. The archive suggests that there are results from 2005, but it is unclear what they offered for sale at this date.

#### **OPPONENT’S ADDITIONAL EVIDENCE**

14) The opponent filed a witness statement, dated 5 April 2011 by Timothy Maxwell Rose their Trade Mark Attorney. He provides printouts from Companies House relating to the “Republic” companies of the opponent; print outs of store locators showing the addresses of all the opponent’s stores and opening times in the UK; print outs from the opponent’s website and registration documents relating to the opponent’s ownership of the marks “SOUL CAL”, “CRAFTED” and “MISO”. None of which assists me in my decision.

15) That concludes my summary of the evidence filed, insofar as I consider it necessary.

#### **DECISION**

16) The only ground of opposition is under section 5(2)(b) which reads:

“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.”

17) An “earlier trade mark” is defined in section 6, the relevant part of which states:

“6.-(1) In this Act an "earlier trade mark" means -

- (a) a registered trade mark, international trade mark (UK) or Community trade mark 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.”

18) The opponent is relying upon its trade mark listed in paragraph 3 above which is clearly an earlier trade mark. It was registered on 25 October 2004 and is therefore not subject to The Trade Marks (Proof of Use, etc) Regulations 2004.

19) In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P (LIMONCELLO). In the recent case of *La Chemise Lacoste SA v Baker Street Clothing Ltd* [ALLIGATOR O/333/10] Mr Hobbs QC acting as the Appointed Person set out the test shown below which was endorsed by Arnold J. in *Och-Ziff Management Europe Ltd and Oz Management Lp v Och Capital LLP; Union Investment Management Ltd & Ochocki*, [2010] EWCH 2599 (Ch).

- (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/ 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; nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;
- (e) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 in that mark;

(f) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa;

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

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

(i) 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;

(j) if the association between the marks causes the public to wrongly believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

20) In essence the test under section 5(2)(b) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion I am guided by the judgments mentioned above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity in the goods, the category of goods in question and how they are marketed. Furthermore, I must compare the applicant's mark and the mark relied upon by the opponent on the basis of their inherent characteristics assuming normal and fair use of the marks on the goods previously outlined.

21) The effect of reputation on the global consideration of a likelihood of confusion under Section 5(2)(b) of the Act was considered by David Kitchin Q.C. (as he was then) sitting as the Appointed Person in *Steelco Trade Mark* (BL O/268/04). Mr Kitchin concluded at paragraph 17 of his decision:

“The global assessment of the likelihood of confusion must therefore be based on all the circumstances. These include an assessment of the distinctive character of the earlier mark. When the mark has been used on a significant scale that distinctiveness will depend upon a combination of its inherent nature and its factual distinctiveness. I do not detect in the principles established by the European Court of Justice any intention to limit the assessment of distinctiveness acquired through use to those marks which have become household names. Accordingly, I believe the observations of Mr. Thorley Q.C in *DUONEBS* should not be seen as of general application irrespective of the circumstances of the case. The recognition of the earlier trade mark in the market is one of the factors which must be taken into account in making the overall global assessment of the likelihood of confusion. As observed recently by Jacob L.J. in *Reed Executive & Ors v. Reed Business Information Ltd & Ors*, EWCA Civ 159, this may be particularly important in the case of marks which contain an element descriptive of the goods or services for which they have



been registered. In the case of marks which are descriptive, the average consumer will expect others to use similar descriptive marks and thus be alert for details which would differentiate one mark from another. Where a mark has become more distinctive through use then this may cease to be such an important consideration. But all must depend upon the circumstances of each individual case.”

22) To my mind the opponent has singularly failed to show that it has a significant reputation in the goods for which its mark has been used. The opponent has provided turnover figures relating to its shops which will sell its clothing and accessories but has shown no evidence of market share or any independent trade evidence. The turnover figures provided are not, in my opinion, sufficient for them to enjoy enhanced protection because of reputation. However, to my mind the opponent’s mark is not descriptive of the goods for which it is registered and is inherently very distinctive. The applicant has sought to imply that its mark has reputation and enhanced distinctiveness as a result of its use of its *Mean Fiddler* mark. The *Mean Fiddler* mark was used in regard of concerts and some merchandising, although the latter was not quantified. The change of name occurred one day prior to the filing of the instant application and it is this date, 14 August 2007 that is the relevant date. The applicant cannot claim any reputation in its mark as at the relevant date.

23) I must now determine the average consumer for the goods of the parties, which are broadly, clothing, headgear, footwear and spectacles. It was accepted by both parties that the average consumer is the general public. Such items can vary enormously in price and so the level of attention paid by the consumer will vary. However, given that clothing etc needs to fit, and that fabrics are increasingly a consideration in the purchasing decision, in addition to colour and price, it is likely that a reasonable level of attention will be paid by the average consumer. The types of goods in this case are likely to be selected by the average consumer visually either self selected in a retail environment, from a catalogue or on-line. I take into account the views of Mr Thorley sitting as the Appointed Person in the *REACT* case [2000] RPC 285 where he said:

“[*Counsel*] ...drew my attention to the fact that in relation to clothing of the type for which the mark is to be registered, anybody using the mark aurally would be informed to some extent of the nature of the goods they were proposing to purchase; they will therefore know of a mark; and they will know what they want. I think there is force in this in the context of purchasing clothes. The Hearing Officer was prepared of his own experience to hold that the initial selection of goods would be made by eye, and I believe this is correct. I must therefore, in taking into account the likelihood of aural confusion, bear in mind the fact that the primary use of the trade marks in the purchasing of clothes is a visual act.”

24) I also note that in *Update Clothing Ltd* BL O/258/98 the Hearing Officer said:

“There is no evidence to support Ms Clarke’s submission that, in the absence of any particular reputation, consumers select clothes by eye rather than by placing orders by word of mouth. Nevertheless, my own experience tells me it is true of most casual shopping. I have not overlooked the fact that catalogues and telephone orders play a significant role in this trade, but in my experience the initial selection of goods is still made by eye and subsequent order usually placed primarily by reference to a catalogue number. I

am therefore prepared to accept that a majority of the public rely *primarily* on visual means to identify the trade origin of clothing, although I would not go so far as to say that aural means of identification are not relied upon”.

25) It was accepted by both parties that the goods are identical or very similar. I now turn to consider the marks of the two parties. For ease of reference these are reproduced below:

Applicant’s Trade Mark	Opponent’s Trade Mark
FESTIVAL REPUBLIC	REPUBLIC

26) The opponent contended:

“The FESTIVAL element of FESTIVAL REPUBLIC is either a descriptor, in which case the REPUBLIC mark of the opponent is the dominant element of the mark, or it is equally distinctive with REPUBLIC, in which case the decision in *Medion v Thomson* is pertinent, whereby there is a likelihood of confusion because REPUBLIC constitutes a standalone distinctive element of FESTIVAL REPUBLIC.”

27) However, the applicant contended that the *Medion* case was not on all four’s with the instant case. Mr Malynicz instead invited me to consider a number of decisions by the General Court, Case T-34/04 *TURKISH POWER* [2005] ECR II-2401; joined cases T-183/02 and T-184/02 *MUNDICOR* [2004] ECR II-965; Case T-112/03 *FLEXI AIR* [2005] ECR II-949; as well as *Typhoon* [2000] E.T.M.R. 1071 and Case C-206/04 *Muhlen’s GmbH & Co KG v OHIM* [2006] E.T.M.R. 57. He contended that these cases showed that when it comes to the visual comparison of marks the first component of word marks is more likely to catch the consumer’s attention; that the beginnings of marks are more important phonetically and speakers tend to slur or underplay the ends of words; and that conceptual counteraction is a relevant concept.

28) When applied to the instant case, he contended that:

“Visually, the marks are similar in that the earlier mark is for the word REPUBLIC, whereas the later mark is for the words FESTIVAL REPUBLIC. The first word FESTIVAL is visually striking and noticeable in its own right.”

“Phonetically ( a consideration which is perhaps of less importance in relation to these goods, which are generally bought by eye) there is also a strong dissimilarity in that the first three syllables of the applicant’s mark “FEST-I-VAL” have to be pronounced before one even gets to the identical “REP-U-BLIC” syllables.”

“Even if there is some minimal visual or phonetic similarity because of the shared REPUBLIC element, this is offset by the fact that consumers will understand the word FESTIVAL as meaning a series of cultural events or a day of celebration, which in and of itself has nothing to do with a REPUBLIC, which is a system of elected government. So you have one meaning, FESTIVAL, leading in an entirely different direction from the word REPUBLIC.”

29) I was also referred to *Digipos Store Solutions v. Digit International* [2008] RPC 24 where Mr Alexander QC, sitting as a Deputy High Court judge said:

“63 That was said in the context of a case where absolute grounds were relied on as the basis for refusing registration. However, in the present case, this material is not relied on in support of an argument that a mark which shares characteristics with those already registered should, for that reason, also be registered: the register is not relied on for its precedent value, in my judgment, rightly so. The register is not in this case deployed to show actual use of the marks recorded there either: for that purpose too, it would be of limited, if any, evidential value. Instead, the register is relied upon to show that, as a matter of fact, a significant number of traders have expressed the intention of using (and *may* be using) the prefix DIGI- as part of a mark in relation to class 9 goods which (one is invited to infer, in the absence of detailed specifications) involve a digital or computer-related element. It does not seem to me to be illegitimate, as a matter of principle, to deploy material of this kind for that limited purpose and, for that purpose, it is of some value as part of a larger body of material.”

30) However, in *GfK AG v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-135/04 the General Court (GC) stated:

“68. As regards the search of the Cedex database, the mere fact that a number of trade marks relating to Class 35 contain the word ‘bus’ is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned. Firstly, the search in question does not provide any information on the trade marks actually used in relation to the services concerned. Secondly, it includes a number of trade marks in which the word ‘bus’ is used descriptively by public transport businesses.”

31) This was a view re-iterated by the GC in *Zero Industry Srl v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-400/06.) In *Digipos* Mr Alexander was not referred to the judgment of the GC in *GfK AG*. I also note that in his judgment Mr Alexander referred to the *Madame* case being an absolute grounds case and appeared to consider this of some significance. The GC cases referred to above are relative grounds cases; clearly the GC considered that the principle of not giving weight to state-of-the-register evidence also applies in cases involving relative grounds issues. As in the *GfK* case mentioned above, no evidence has been provided by the opponent to show that the trade marks identified by them are actually being used in relation to the goods concerned.

32) The applicant has shown that there are other REPUBLIC marks upon the register and that there is third party use of REPUBLIC in the marketplace. They also point out that there have been no instances of confusion.

33) I fully accept and agree with the analysis of the marks at paragraph 29 above and fully accept the points made at paragraph 33. The applicant’s mark contains more than one word or element and is, therefore, a composite mark. The *Medion* case acknowledges that the overall impression conveyed to the relevant public by a composite mark may, in certain circumstances, be

dominated by one or more of its components. The applicant has contended, and I agree that both words are equally distinctive and that they do not form a single conceptual image as some of the other REPUBLIC marks such as BANANA REPUBLIC. I note the comments of the ECJ in *L'Oréal SA v Office for Harmonization in the Internal Market* (Trade Marks and Designs) (OHIM) Case C-235/05 P, where they stated:

“45 The applicant's approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders.”

34) I must now take all the above into account and consider the matter globally taking into account the interdependency principle- a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods and vice versa. To my mind, whilst there are differences in the marks, they are such that when used on identical or similar goods, as in the instant case, there is a likelihood of consumers being confused into believing that the goods provided by the applicant are those of the opponent or provided by some undertaking linked to them. The opposition under Section 5(2) (b) therefore succeeds.

#### **COSTS**

Preparing a statement and considering the other side's statement	£300
Preparing evidence and considering and commenting on the other side's evidence	£100
Preparing for and attending a hearing	£600
Expenses	£200
<b>TOTAL</b>	<b>£1,200</b>

35) When considering the costs I have factored in the behaviour of both sides during the evidence rounds and the unnecessary case management conference caused by the opponent. As the opponent has been successful it is entitled to a contribution towards its costs. I order the applicant to pay the opponent the sum of £1,200. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 16 day of August 2011**

**George W Salthouse  
For the Registrar,  
the Comptroller-General**