

**O-540-17**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3169056 BY  
RICHARD THOMAS-PRYCE  
TO REGISTER:**

*Bluebird  
West*

**AS A TRADE MARK IN CLASS 35**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 407535 BY RWH (BLUEBIRD) LIMITED**

## BACKGROUND & PLEADINGS

1. On 10 June 2016, Richard Thomas-Pryce (“the applicant”) applied to register the trade mark shown on the cover page of this decision for the following services in class 35:

Retail services in relation to jewellery; Retail services in relation to luggage; Retail services in relation to bags; Retail store services in the field of clothing.

The application was published for opposition purposes on 1 July 2016.

2. On 30 September 2016, the application was opposed in full by RWH (Bluebird) Limited (“the opponent”). The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon the following United Kingdom and European Union Trade Mark (“EUTM”) registrations:

EUTM No. 5435987 for the trade mark **THE SHOP AT BLUEBIRD** which was applied for on 2 November 2006 and entered in the register on 28 February 2008. It is registered for the following goods and services:

**Class 18** - Bags, briefcases, card cases, suitcases, handbags, wallets, purses, suitcases, waterbags, credit card holders, diary cases, hat boxes, key fobs, key cases, straps, luggage labels, note pads holders, sport bags, trunks and travelling bags; umbrellas, parasols and walking sticks.

**Class 25** - Clothing, footwear, headgear; boots; shoes; slippers; neckwear; underclothing; sleeping garments; stockings, tights, socks; aprons, smocks; bibs; swimwear; gloves; mittens; layettes; scarves, sashes and shawls; bathing caps; belts; braces; suspenders; collars, cuffs; ear muffs; fittings for boots and shoes.

**Class 35** - The bringing together, for the benefit of others, of a variety of clothing, footwear, headgear, furniture, printed matter stationery, boxes, bags, cases, ornaments of precious metals, ornaments and decorations for Christmas trees, decorative pencil-top ornaments, cast-stone garden and household ornaments, electronic equipment, belts and scarves, jewellery, sunglasses, toiletries enabling customers to conveniently view and purchase those goods from a clothing, clothing accessories, furniture and home decorating products catalogue, or a general merchandise catalogue, by mail order or by means of telecommunications; the bringing together, for the benefit of others, of a variety of clothing, footwear, headgear, furniture, printed matter, stationery, boxes, bags, cases, ornaments of precious metals, ornaments and decorations for Christmas trees, decorative pencil-top ornaments, cast-stone garden and household ornaments, electronic equipment, belts and scarves, jewellery, sunglasses, toiletries enabling customers to conveniently view and purchase those goods in a department or retail store; the bringing together, for the benefit of others, of a variety of clothing, footwear, headgear, furniture, printed matter, stationery, boxes, bags, cases, ornaments of precious metals, ornaments and decorations for Christmas trees, decorative pencil-top ornaments, cast-stone garden and household ornaments, electronic equipment, belts and scarves, jewellery, sunglasses, toiletries enabling customers to conveniently view and purchase those goods from a general merchandise Internet web site; provision of information relating to the sale of goods, advisory services and consultancy services relating to the aforesaid; professional intermediation and consultancy services in relation to the sale of goods, advisory and consultancy relating to all the aforesaid.

UK no. 2438489 for the trade mark **THE SPA AT BLUEBIRD** which was applied for on 15 November 2006 and entered in the register on 15 February 2008. It is registered for the following goods and services:

**Class 3** - Foundations, concealers, face powders, blushers, lip liners, lip gloss, mascara, eye shadow, eye liner, nail polish remover, eye cleansers, face cleansers, skin toners, exfoliators, eye masks, face masks, moisturisers, eye make up remover, eye cream, eye gel, lip moisturisers, hand cream, body lotions, body washes, shower gels, foot balms, body scrubs, deodorants, talcum powder, soap, bath essences, shampoo, conditioner, hair styling preparations, hair dyes, sun tanning preparations, shaving preparations, dentifrices, facial packs, nail care preparations, emery boards, pumice stones, cotton sticks and wool for non-medical purposes, all for use on the body.

**Class 35** - Retail services connected with the sale of beauty products, healthcare products and personal care products.

**Class 44** - Spa services, beauty salons, hair salons, health clinics, health clubs, provision of information and consultancy services relating to health, beauty and body care.

UK no. 2431381 for the trade mark **BLUEBIRD** which was applied for on 31 August 2006 and entered in the register on 22 February 2008. It is registered for the following services:

**Class 35** - The bringing together, for the benefit of others, of a variety of clothing and clothing accessories, furniture, homewares and books, enabling customers to conveniently view and purchase those goods from a clothing, clothing accessories, furniture and home decorating products catalogue, or a general merchandise catalogue, by mail order or by means of telecommunications; the bringing together, for the benefit of others, of a variety of clothing and clothing accessories, furniture, homewares and books, enabling customers to conveniently view and purchase those goods in a department or retail store; the bringing together, for the benefit of others, of a variety of clothing and clothing accessories, furniture, homewares and books, enabling customers to

conveniently view and purchase those goods from merchandise Internet web site; information relating to retail services, information relating to consultancy services in relation to the sale of goods; professional intermediation and consultancy services in relation to the sale of goods, advisory and consultancy relating to all the aforesaid

3. The applicant filed a counterstatement in which the basis of the opposition is denied. The applicant states:

“RWH (Bluebird) Limited a/k/a “The Shop at Bluebird” is operating a clothing retail store selling various third-party designer branded products, none of which are names or labelled with anything related “bluebird”.

The trade mark “Bluebird West” is totally and undeniably irrelevant to the opposition. Bluebird West is a clothing brand where as “The Shop at Bluebird” is the name of an online e-commerce website.

Bluebird West is printed on our products and it is the combination of “Bluebird” and “West” which makes this unique. Only the word “Bluebird” connects the opponent which is a breed of bird and I am pretty certain the word Bluebird isn’t Trade Marked under RWH (Bluebird) Limited.”

4. In his counterstatement, the applicant put the opponent to proof of use. He stated that he sought proof of use in relation to: “Leather Duffle Bags”, “Leather Backpacks”, “Leather Wallets” and “Leather Purses”. The tribunal responded to that request in a letter dated 1 November 2016. The tribunal stated:

“It is noted at question 7 that you have ticked yes for proof of use. However, you have not provided the trade mark number of the earlier trade mark(s) you wish the opponent to provide proof of use for.

...If you choose not to amend the counterstatement the Registrar may move to strike out any grounds which are not adequately particularised...”

5. A period expiring on 22 November 2016 was allowed for the applicant to clarify its position. As the applicant did not respond to that request, in an official letter dated 21 December 2016, he was allowed until 4 January 2017 “to file an amended counterstatement”. That letter included the following sentence:

“If an amendment is not filed, the registry will proceed on the basis that you do not require the opponent to provide proof of use.”

6. In an official letter dated 25 January 2017, the tribunal wrote to the applicant again. In that letter it stated:

“I refer to our letter dated 21 December 2016, in which you were invited to file an amended counterstatement. In the absence of a response, the proof of use at box 7 will not be considered.”

7. In these proceedings, the opponent is represented by Clarke Willmott LLP; the applicant represented himself. Only the opponent filed evidence; evidence which was accompanied by written submissions. Neither party asked to be heard nor did they elect to file written submission in lieu of attendance at a hearing.

## **DECISION**

8. 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.”

9. An earlier trade mark is defined in section 6 of the Act, which states:

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

(a) a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) 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,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

10. In these proceedings, the opponent is relying upon the three trade marks shown in paragraph 2 above, all of which qualify as earlier trade marks under the above provisions. As these earlier trade marks had been registered for more than five years at the date when the application was published, they are, in principle, subject to proof of use, as per section 6A of the Act. In its Notice of Opposition, the opponent indicated that its earlier trade marks had been used upon all the goods and services for which they are registered and upon which it relied. The circumstances surrounding the applicant’s request for proof of use are explained above. The consequence of the applicant failing to respond to the tribunal’s letters of 1 November and 21 December 2016 is that, as the tribunal pointed out in its letter of 25 January 2017, his request for proof of use is to be disregarded. The opponent can, as a consequence, rely upon all the goods and services it has identified without having to make good its claim to have used its trade marks upon these goods and services.

## **Opponent's evidence**

11. This consists of a witness statement from Daniel Berry (accompanied by five exhibits); Mr Berry is a senior associate at Clarke Willmott LLP. Mr Berry states:

“5. In support of the opposition, I have conducted searches on the internet and identified the following examples in which the services covered by the application are offered alongside one another by the same undertakings.”

12. I will, if necessary, return to Mr Berry's evidence later in this decision.

## **Section 5(2)(b) – case law**

13. The following principles are gleaned from the decisions of the courts of the European Union 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.

## **The principles:**

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the



imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

**The opponent’s strongest case**

14. In these proceedings, the opponent relies upon three earlier trade marks which either consist of or contain the word BLUEBIRD as a separate component. Although the earlier trade mark for the word BLUEBIRD alone is, arguably, the most visually, aurally and conceptually similar to the applicant’s trade mark (and contains services which are identical to some of the services in the application), having reviewed all of the opponent’s earlier trade marks and their specifications, it is the registration of THE SHOP AT BLUEBIRD which, in my view, represents its strongest case overall, and it is on the basis of this trade mark that I shall conduct the comparison.

**Comparison of services**

15. The opponent’s EUTM is registered in classes 18, 25 and 35. For present purposes, only the services in class 35 are relevant. Approached on that basis, the comparison is between:

The opponent’s services – EUTM 5435987	The applicant’s services
<p><b>Class 35 - The bringing together, for the benefit of others, of a variety of clothing, footwear, headgear, furniture, printed matter stationery, boxes, bags, cases, ornaments of precious metals, ornaments and decorations for Christmas trees, decorative pencil-top ornaments, cast-stone garden and household ornaments,</b></p>	<p><b>Class 35 -</b> Retail services in relation to jewellery; Retail services in relation to luggage; Retail services in relation to bags; Retail store services in the field of clothing.</p>

electronic equipment, belts and scarves, **jewellery**, sunglasses, toiletries **enabling customers to conveniently view and purchase those goods from a clothing, clothing accessories, furniture and home decorating products catalogue, or a general merchandise catalogue, by mail order or by means of telecommunications; the bringing together, for the benefit of others**, of a variety of **clothing**, footwear, headgear, furniture, printed matter, stationery, boxes, **bags, cases**, ornaments of precious metals, ornaments and decorations for Christmas trees, decorative pencil-top ornaments, cast-stone garden and household ornaments, electronic equipment, belts and scarves, **jewellery**, sunglasses, toiletries **enabling customers to conveniently view and purchase those goods in a department or retail store; the bringing together, for the benefit of others**, of a variety of **clothing**, footwear, headgear, furniture, printed matter, stationery, boxes, **bags, cases**, ornaments of precious metals, ornaments and decorations for Christmas trees, decorative pencil-top ornaments, cast-stone garden and household ornaments, electronic equipment, belts and scarves, **jewellery**, sunglasses, toiletries **enabling**

<p><b>customers to conveniently view and purchase those goods from a general merchandise Internet web site;</b> provision of information relating to the sale of goods, advisory services and consultancy services relating to the aforesaid; professional intermediation and consultancy services in relation to the sale of goods, advisory and consultancy relating to all the aforesaid. (my emphasis)</p>	
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16. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court stated:

“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 fur 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”.

17. In its submissions, the opponent responds to comments contained in the applicant’s counterstatement regarding what he considers to be the actual use the opponent makes of its THE SHOP AT BLUEBIRD trade mark. The opponent states:

“21...The actual use the opponent has made of the earlier marks is irrelevant to these opposition proceedings. What is relevant are the goods and services covered by the earlier marks...”

18. As the applicant’s request for proof of use was struck out for want of particularisation, the opponent is correct. In reaching a conclusion, what I am required

to do in the circumstances I have described is compare the specifications of the earlier trade marks relied upon as they appear on the Trade Marks Register with the specification of the application for registration.

19. Approached on that basis, the applicant seeks registration for retail services in relation to jewellery, luggage, bags and clothing, whereas the opponent's specification in class 35 includes the services I have highlighted in paragraph 15 above.

20. The competing services are, self-evidently, identical.

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

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

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

22. The average consumer for the retail services at issue is, as the opponent submits, “the general public.” As to how such an average consumer will select the services at issue, my own experience (as a member of the general public), informs me that they are most likely to be selected having considered, inter alia, websites, advertisements and


signage on the high street (indicating the importance of visual considerations); aural considerations will also play their part, for example, in the form of word-of-mouth recommendations. As to the degree of care with which such services may be selected, in my experience, the average consumer is likely to be mindful of a range of considerations such as the breadth of goods/brands stocked, customer reviews, delivery times/costs and in relation to a bricks and mortar outlet, proximity to their home, opening times, parking etc. all of which, as the opponent submits, suggests an average degree of attention being paid during the selection process.

### **Comparison of trade marks**

23. 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 them, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

24. It would be wrong, therefore, artificially to dissect the trade marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions they create. The trade marks to be compared are:

Opponent's trade mark	Applicant's trade mark
THE SHOP AT BLUEBIRD	

25. The opponent's trade mark consists of the words THE SHOP AT BLUEBIRD presented in block capital letters. Although the words THE SHOP AT appear as the first three words in the opponent's four word trade mark and will contribute to the overall impression it conveys, when considered in the context of the retail services upon which the opponent relies, the words THE SHOP AT have very little, if any, distinctive character. Notwithstanding the rule of thumb where words which appear at the start of trade marks generally have more relative weight than those appearing at the end, rather unusually, it is the final word in the opponent's trade mark i.e. BLUEBIRD which will make the overwhelming contribution to both the overall impression it conveys and its distinctiveness.

26. As to the applicant's trade mark, this consists of the words Bluebird and West presented in title case in a modestly stylised cursive script. In his counterstatement, the applicant states that "it is the combination of Bluebird and West which makes this unique", whereas in its submissions, the opponent states:

"13.1...The relevant public would understand the additional element of the [applicant's trade mark] WEST to be a geographical reference which has very little or no distinctive character..."

27. As the words Bluebird and West do not, in my view, create a unit, the meaning of which is different to the individual words of which it is composed, the word Bluebird plays an independent role within the applicant's trade mark. Although both words contribute to the overall impression the applicant's trade mark conveys, as the distinctive word Bluebird appears first and as the second word is, as the opponent suggests, likely to be seen by the average consumer as geographical in nature, it is the

word Bluebird that will make by far the greater contribution to the overall impression the applicant's trade mark conveys and its distinctiveness.

28. Having reached the above conclusions, I must now compare the competing trade marks from the visual, aural and conceptual standpoints. Notwithstanding the presence of the words THE SHOP AT in the opponent's trade mark and the word West in the applicant's trade mark, the fact that both parties' trade marks contain the distinctive word BLUEBIRD/Bluebird as an independent component, a word which will make by far the most important contribution to the overall impression conveyed by the competing trade marks, results, in my view, in a medium degree of visual similarity between them.

29. As to the aural comparison, as the words in the competing trade marks will be well-known to the average consumer, their pronunciation is entirely predictable. Given the descriptive/non-distinctive nature of the words THE SHOP AT in the opponent's trade mark, it is, in my view, entirely possible that they will not be articulated at all. I am far less convinced that despite its geographical significance, the word West in the applicant's trade mark will not be articulated. In those circumstances, the aural comparison will be between BLUEBIRD and Bluebird West leading to a fairly high degree of aural similarity. However, if I am wrong in that regard and the opponent's trade mark is articulated in full, the comparison is between THE SHOP AT BLUEBIRD and Bluebird West leading to a medium degree of aural similarity.

30. Finally, the conceptual comparison. Both parties appear to agree that the word BLUEBIRD/Bluebird will be understood as a reference to either a bird with blue in its plumage or the bird of the same name. As the words THE SHOP AT and West are unlikely to modify the meaning of the word BLUEBIRD/Bluebird or create a different overall concept, the competing trade marks are, if not identical, conceptually similar to a high degree.



## **Distinctive character of the earlier trade mark**

31. The distinctive character of a trade mark can be appraised only, first, by reference to the services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the services for which it has been registered as coming from a particular undertaking and thus to distinguish those services from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

32. As the opponent has not provided any evidence of the use it may have made of its earlier trade mark, I have only its inherent characteristics to consider. In its submissions, the opponent states:

“17.2 the earlier marks are highly distinctive for the goods and services for which they are registered (BLUEBIRD does not call to mind either “retail services” or “retail store services”)...”

33. When considered as a totality, the opponent’s THE SHOP AT BLUEBIRD trade mark is neither descriptive of nor non-distinctive for the retail services I have found to be identical to those of the applicant. It is, absent use, possessed of an above average degree of inherent distinctive character. It is, of course, only the distinctiveness of the shared element i.e. the word BLUEBIRD that matters. I shall return to this point below.

## **Likelihood of confusion**

34. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of

similarity between the respective services and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark, as the more distinctive it is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the services, the nature of the purchasing process and 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 he has retained in his mind. Earlier in this decision I concluded that:

- the opponent's THE SHOP AT BLUEBIRD trade mark represented its strongest case;
- the applicant's services are identical to the opponent's services in class 35 I have identified;
- the average consumer of the retail services at issue is a member of the general public;
- such an average consumer will select the retail services at issue using a combination of visual and aural means (with visual considerations being the most important) and will pay an average degree of attention during that process;
- the word BLUEBIRD makes the overwhelming contribution to both the overall impression the opponent's trade mark conveys and its distinctiveness;
- the word Bluebird makes by far the greater contribution to the overall impression the applicant's trade mark conveys and its distinctiveness;
- the competing trade marks are visually similar to a medium degree, aurally similar to at least a medium degree and conceptually similar to at least a high degree;

- the opponent's trade mark is possessed of an above average degree of inherent distinctive character.

35. Insofar as the last bullet point is concerned, in *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He stated:

"38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that 'the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion'. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it."

36. In other words, simply considering the level of distinctive character possessed by the earlier trade mark is not enough. It is important to ask "in what does the distinctive character of the earlier trade mark lie?" Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

37. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and services down to the responsible undertakings being the same or related.

38. I have concluded that the competing trade marks are visually similar to a medium degree and that visual considerations are likely to be the most important when selecting the retail services at issue. When considered in the context of a consumer paying an average degree of attention to the selection of the identical retail services at issue, that degree of visual similarity (resulting from the presence of the above averagely distinctive word BLUEBIRD/Bluebird in the competing trade marks), combined with the (at least) highly similar conceptual images the competing trade marks are likely to trigger in the average consumer's mind (which will then act as a hook to aid the average consumer's often faulty imperfect recollection) are, in my view, more than sufficient to lead to a likelihood of confusion. Despite the visual differences between the competing trade marks, the effects of imperfect recollection are, in my view, likely to result in direct confusion.

39. However, even if I am wrong in the above conclusion, the presence of the word BLUEBIRD/Bluebird in the competing trade marks, together with words which point to the retail services at issue i.e. THE SHOP AT and West (the latter being geographical), are, at the very least, likely, in my view, to lead the average consumer to conclude the identical services at issue emanate from the same or related undertakings i.e. there will be indirect confusion. As a consequence of those conclusions, the opposition succeeds.

## **Conclusion**

**40. The opposition has been successful in full and, subject to any successful appeal, the application will be refused.**

## **Costs**

41. As the opponent has been successful, it is entitled to a contribution towards its costs. Awards of costs in proceedings commenced after 1 July 2016 are governed by Annex A of Tribunal Practice Notice ("TPN") 2 of 2016. Using the TPN mentioned as a

guide, but making no award to the opponent in respect of its evidence which played no part in these proceedings, I award costs to the opponent on the following basis:

Preparing a Notice of Opposition and considering the applicant's counterstatement:	£200
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Written submissions:	£300
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Official fee:	£100
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<b>Total:</b>	<b>£600</b>
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42. I order Richard Thomas-Pryce to pay to RWH (Bluebird) Limited the sum of **£600**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 25<sup>th</sup> day of October 2017**

**C J BOWEN**  
**For the Registrar**