

O-615-18

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION 3228021
BY ROB MOORE
TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 42:**

Disruptive Entrepreneur

AND

**OPPOSITION THERETO (NO. 410806)
BY DISRUPTIVE DESIGN LIMITED**

Background and pleadings

1. The above trade mark was filed by Rob Moore (“the applicant”) on 30 April 2017. It was accepted and published in the Trade Marks Journal on 18 August 2017. Registration of the mark is opposed by Disruptive Design Limited (“the opponent”). The opponent relies on UK trade mark UK3018583, which consists of the single word “DISRUPTIVE” which was filed on 16 August 2013 and registered on 20 June 2014. The opponent relies on sections 5(1), 5(2)(a) and 5(2)(b) of the Trades Mark Act 1994 (“the Act”) to oppose the application. The respective specifications are set out in paragraph 3 below.
2. The applicant initially applied to register the applied for mark in three classes: 35, 41 and 42. Registration in Classes 35 and 41 was refused at examination stage under Sections 3(1)(b) and (c) of the Act. The applicant did not challenge the partial refusal by requesting a hearing or appealing the decision. In a letter of 15 August 2017, the applicant was therefore informed his classification had been amended and his applied for trade mark would be published in Class 42 alone.
3. The opponent’s trade mark is registered for a detailed specification in Class 42, however they limit their specified services relied upon for the purpose of this opposition. As a result of the above the respective marks and specifications in play are:

Applied for mark	Earlier mark
Disruptive Entrepreneur	DISRUPTIVE
Class 42: Business card design	Class 42: Commercial and packaging design; commercial art design; commercial design services; design of packaging; graphic art design; graphic design services; packaging design for

	<p>others; packaging design services; product design; product design services; product design and development; brand design services.</p>
--	---

4. The opponent’s notice of opposition and statement of grounds is dated 16 November 2017. In support the opponent states:

“Disruptive Design Limited is a well established design and business consultancy that specialises in developing products from concept to commercialisation.

The earlier mark DISRUPTIVE is identical to the first and most significant word of the applied for mark DISRUPTIVE ENTREPRENEUR.

The mark applied for includes the whole of the opponent’s mark. Use of the opponent’s mark would be likely to mislead customers that the applicant’s services are associated with the opponent.

In addition, the services for which the earlier mark is registered are identical or similar to those applied for.

There is a high likelihood of confusion in the marketplace and accordingly we request that registration of the applicant’s mark is refused with an award of costs in the opponent’s favour.”

5. The applicant’s notice of defence and counterstatement is dated 17 January 2018. In support the applicant states:

“The co-opposing party has one word registered, and it is not really relevant to their business so we feel that their opposition is unfair, especially as there are prior registrations and later registrations with the word in that have been granted. We feel they are restricting our

application unfairly. “Disruptivedesign” and “Disruptive Entrepreneur” are in no way similar, related or competitive. Further, their opposition is irrelevant to their company, and we have a strong basis that their trademark should not have been granted and there are grounds for ourselves, to oppose their mark.”

6. Neither party filed evidence, submissions or a request for a hearing. This decision is therefore taken following careful consideration of the papers.
7. The applicant represents himself. The opponent is represented by Hepworth Browne.

Preliminary Matters

8. In his notice of defence and counterstatement the applicant sought to put the opponent to proof of use of their trade mark. However, as the earlier mark had not been registered for five years or more at the publication date of the opposed application, it is not subject to the proof of use provisions contained in section 6A of the Act. The opponent can, as a consequence, rely upon all of the services identified without proof of use. For the record, I record that, given its filing date, the opponent’s mark qualifies as an earlier mark in accordance with Section 6(1) of the Act.
9. The applicant submits that he has grounds for arguing that the opponent’s trade mark should not have been granted and that he has grounds for opposing the opponent’s mark. However, the opponent’s mark is registered and the opponent is entitled to rely upon it. There are no invalidation proceedings in train and these arguments are therefore irrelevant to the current proceedings which concern registration of the applicant’s mark. It is also not relevant that the register already contains marks containing the word “DISRUPTIVE.”¹

¹ See for example *Zero Industry Srl v OHIM*, T-400/06

Sections 5(1), 5(2)(a) and 5(2)(b)

10. Sections 5(1), 5(2)(a) and 5(2)(b) of the Act state:

“5. - (1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

(2) A trade mark shall not be registered if because –

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or

(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.”

Sections 5(1) and 5(2)(a)

11. To successfully oppose a trade mark application under Sections 5(1) and 5(2)(a) of the Act the competing trade marks must be identical. In *S.A. Société LTJ Diffusion v Sadas Vertbaudet SA*, Case C-291/00, the Court of Justice of the European Union (“CJEU”) held that:

“54 [...] a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the

trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer”.

12. In *Compass Publishing BV v Compass Logistics Ltd* [2004] EWHC 520 (Ch) Laddie J. similarly explained that identity applied in cases where the marks are so close that one could be considered a counterfeit of the other and that:

“However, identity still exists where the marks look and sound identical save to the eye or ear of an expert. Differences which ordinary members of the public will not notice, save by close side-by-side comparison or the pronunciation of a 1940’s BBC news reader, can be ignored. Where such small differences exist, in the market place the mark and sign are identical.”

13. Laddie J. found that “COMPASS LOGISTICS” was not identical to “COMPASS.” The differences between the two was apparent and would be identified without difficulty or prior coaching by members of the public².
14. Applying the above principle here, I have no doubt that the addition of the word “Entrepreneur” will be noticed by the average consumer. It follows I find that “Disruptive Entrepreneur” is not identical to “DISRUPTIVE.” The opposition under sections 5(1) and 5(2)(a) is dismissed accordingly.

Section 5(2)(b) - The Principles

15. The following principles are gleaned from the judgments of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-*

² See also *OCH-ZIFF Management Europe Limited, OZ Management LP v OCH Capital LLP, Union Investment Management Limited, Thomas Tadeus Antoni Ochoki* [2010] EWHC 2599 (Ch) at paragraphs [67] to [71].

Goldwyn-Mayer Inc, Case C-39/97, Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V. Case C-342/97, Marca Mode CV v Adidas AG & Adidas Benelux BV, Case C-425/98, Matratzen Concord GmbH v OHIM, Case C-3/03, Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH, Case C-120/04, Shaker di L. Laudato & C. Sas v OHIM, Case C-334/05P and Bimbo SA v OHIM, Case C-591/12P:

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a 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.

Comparison of services

16. When making the comparison, all relevant factors relating to the services in the specifications should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*, 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. Guidance on this issue has also come from Jacob J. (as he then was) in the *British Sugar Plc v James Robertson & Sons Limited* [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- “(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. I also remind myself of the guidance given by the courts on the correct interpretation of specifications. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

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

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

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

20. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) OHIM* case T-133/05, the General Court (“GC”) 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 the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II- 4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T110/01 *Vedial V OHIM France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

21. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the 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”.

22. In *Sanco SA v OHIM*, Case T-249/11, the General Court indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a

degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

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

Whilst on the other hand:

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

23. The opponent argues that the respective services are identical or similar. The applicant submits that “Disruptivedesign” and “Disruptive Entrepreneur” are in no way similar, related or competitive” and that his application has no relevance to the opponent’s business or company. When comparing services, however, I am not concerned with the trading names of the parties’ businesses or their actual or intended use in trade. Instead I must compare the notional use of the marks across the full width of the specifications³.
24. The applicant’s specification in Class 42 is limited to “business card design.” The specification relied upon by the opponent for the purposes of its opposition

³ See *Compass Publishing BV v Compass Logistics Ltd* ([2004] RPC 41) at paragraph [22] and *Roger Maier v ASOS* ([2015] EWCA Civ 220) at paragraphs [78] and [84].

is set out at paragraph 3 above. It includes, inter alia, “commercial design services” and “graphic design services.”

25. A business card is a small printed card that can fit inside a wallet and which displays a professional individual's name, job title, company and contact details. They often include a stylised element or logo in keeping with the commercial undertaking's corporate identity. They are usually used for business development purposes to provide potential customers or contacts with an easy, retainable source of contact information. The design of business cards is itself a commercial activity. The design will incorporate the necessary contact information. Sometimes the designer will also be seeking to convey, in the small space available, a message about the overall image of the business or to present a corporate or individual profile that is memorable in order to generate business or at least to reinforce the undertaking's corporate profile.
26. “Commercial design services” and “graphic design services” all include, as a commercial activity, the design of graphics or other corporate material used by businesses that require a design element. The ordinary meaning of those services would, in my view, include the design of business cards as one element of the range of services likely to be on offer.
27. As can be seen from the *Meric* case cited above, where the services of the applied for mark are included in a more general specification designated in the opponent's earlier mark they are considered identical. As explained above, in my view the opponent's “commercial design services” and “graphic design services” would, applying an ordinary, natural meaning to the terms, encompass the applicant's “business card design.” Applying the principle in *Meric* those services are therefore identical.
28. If I am incorrect as to identity of services, then I would find that the services identified are highly similar. The users of “business card design” services are likely to be professional individuals or commercial undertakings who wish to have business cards designed for them. The users of “commercial design services” and “graphic design services” are similar users seeking the design of

corporate designed material. Both services are likely to be available for purchase through the same trade channels, such as online, a face to face purchase, or by telephone, or a mixture of these. The services will be in competition in the sense that a service provider providing commercial design services would be likely to take on a commission to design business cards as part of their broader range of services. The respective services could also be considered complementary, in the sense identified in the case law set out above, as the average consumer may well perceive that responsibility for business card designing would lie with the same undertaking that provides commercial or graphic design services.

29. The opponent argues that the remaining services in the specification relied upon in their opposition are also similar. Above I have focussed on what, in my view, are the strongest comparisons with the applicant's specification. I will not undertake an analysis of the remaining services as they cannot improve the opponent's position.

The average consumer and the purchasing act

30. As the case law above indicates, it is necessary for me to determine who the average consumer is for the specified 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. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schufabrik Meyer, Case C-342/97*. 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), Bliss 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.”

31. Neither party has commented upon the characteristics of the average consumer or the purchasing process. I must assess the average consumer for the identical business card design services at issue. The average consumer is likely to be a professional individual (for example a trades person) or a representative of a business. It is likely to be an infrequent purchase. The price will vary from low for the purchase of a straight forward business card design to more expensive where it incorporates a bespoke branding element. Whilst this creates some variance, in general terms the average consumer is likely to pay a normal, medium degree of attention when deciding which service provider to use.
32. The selection of these services will largely be visual by way of internet searching, perusing websites, advertisements, brochures or through research locally on the high street, or other media. Part of the selection process may be through word of mouth recommendations and oral negotiations, though they will virtually invariably, also include written dealings. I therefore do not discount aural considerations but the selection process overall is likely to be largely visual.

Comparison of trade marks

33. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and

dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

34. It would be wrong, therefore, to artificially 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 created by them.

35. The trade marks to be compared are:

Applied for mark	Earlier mark
Disruptive Entrepreneur	DISRUPTIVE

36. The opponent submits that their earlier mark is identical to the first and most significant word of the applied for mark and that the applied for mark includes the whole of their earlier mark. The applicant submits that ““Disruptivedesign” and “Disruptive Entrepreneur” are in no way similar, related or competitive.” I must, however, compare the marks as notified to the registry, and as already set out “Disruptivedesign” is not the earlier registered mark.

37. The opponent’s trade mark consists of the word “DISRUPTIVE” presented in block capital letters. That is the overall impression it will convey and where its distinctiveness lies.

38. The applicant's applied for mark consists of two words "Disruptive" and "Entrepreneur" in upper and lower case. By way of overall impression, the average consumer would perceive the word "Disruptive" as qualifying the word "Entrepreneur" such that the words combined together as "Disruptive Entrepreneur" would form a unit or phrase with its own meaning. It is not the case that either word has a greater visual prominence. Therefore, in my view, neither individual word dominates the applied for mark. Further, as a matter of overall impression, I do not find that "Disruptive" has an independent distinctive role in the mark applied for separately from its role in "Disruptive Entrepreneur."
39. Visually, there is an obvious point of similarity due to the presence in both marks of the word "disruptive." On the other hand, in the applied for mark the addition of the long word "Entrepreneur" does add a distinct visual addition which the average consumer is likely to notice. I therefore find the marks are visually similar to a medium degree. I should add that the difference in casing between the marks has not been a factor in my assessment because the respective marks could notionally be used in upper case and/or upper and lower case lettering.
40. Aurally the average consumer is likely to vocalise the earlier mark as the 3 syllable word "DISS-RUP-TIV". The average consumer is likely to vocalise the whole of the applied for mark as two separate words "DISS-RUP-TIV" "ON-TRA-PREN-ERR". I do not believe the average consumer, when vocalising the applied for mark, is likely to fail to articulate the second word and shorten it to the first word only. There is therefore some similarity in "disruptive" being vocalised first in both marks (and is the whole of the earlier mark), but some difference on account of the addition/absence of Entrepreneur. The marks are therefore aurally similar to a medium degree.
41. So far as the conceptual position is concerned, in respect of the earlier mark the average consumer is likely to understand "DISRUPTIVE" as referring to something which disturbs or upsets the natural order of things or is unconventional. The earlier mark of "DISRUPTIVE" does not link the disruption to an individual person; conceptually it just refers to the act of being disruptive.

For the applied for mark the average consumer is likely to understand “Entrepreneur” as referring to a business person. The average consumer is likely to appreciate that the word “Disruptive” qualifies the nature of the “Entrepreneur” and therefore that the words hang together as a unit to create the overall meaning of a business person who acts in a disruptive manner. “Disruptive Entrepreneur” as a unit therefore has a different meaning compared with the meaning of its component elements taken separately.⁴ I therefore find that the marks are conceptually similar to a low degree, based on the fact that both marks make reference to being disruptive in some capacity.

Distinctive character of the earlier trade mark

42. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, based either on inherent qualities or because of general use made, the greater the likelihood of confusion (see *Sabel BV v Puma AG*, paragraph 24). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for

⁴ See for example paragraph [30] in *White & Mackay Ltd v Origin Wine UK Ltd* [2015] EWHC 1271 (Ch) where Arnold J concludes that JURA ORIGIN would be understood by the average consumer as meaning the goods originated from the producer called JURA and that the expression would be understood as a unit, such the word ORIGIN did not have an independent distinctive role in the JURA ORIGIN mark.

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).”

43. Absent evidence, I need only consider the inherent distinctiveness of the earlier mark. Neither party has made submissions on the point. It is a rough rule of thumb that invented words usually have the highest level of distinctiveness; words which are allusive of the goods usually have the lowest. The opponent’s mark consists of the word “DISRUPTIVE”. It is not an invented word. The average consumer is unlikely to perceive it as allusive. It is a standard word in the English language. Bearing these factors in mind, I am of the view that the earlier word mark of “DISRUPTIVE” is possessed of an average degree of inherent distinctive character.

Likelihood of confusion

44. The factors considered above have a degree of interdependency (*Canon* at [17]), so that a higher degree of similarity between the services may offset a lower degree of similarity between the marks, and vice versa. I must make a global assessment of the competing factors (*Sabel* at [22]), considering them from the perspective of the average consumer and deciding whether the average consumer is likely to be confused. In making my assessment, I must keep in mind 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 (*Lloyd Schuhfabrik* at [26]).

45. In *Whyte and Mackay Limited v Origin Wine UK limited, Dolce Co Invest Inc* [2015] EWHC 1271 (Ch) Arnold J. summarised the findings of the CJEU in *Bimbo* as including three important points:

“19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks – visually, aurally and conceptually – as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20. The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composition mark as a unit having a different meaning to the meanings of the separate components. This includes the situation where the meaning of one of the components is qualified by another component, as with a surname and first name (e.g. BECKER and BARBARA BECKER).

21. The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

46. Confusion can be direct or indirect. In *L.A. Sugar Limited v By Back Beat Inc*; Case BL O/375/10 Mr. Iain Purvis Q.C., sitting as the Appointed Person, explained these types of confusion as follows:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognised that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

47. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr. James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made simply because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.
48. The opponent submits there is a high likelihood of confusion in the market place and that use of the mark would be likely to mislead customers that the applicant's services are associated with theirs. The applicant submits that "Disruptivedesign" and "Disruptive Entrepreneur" are in no way similar, related or competitive and by implication therefore argue that it is unlikely there would be confusion in the market.
49. Earlier in this decision I concluded:
- that the respective services are identical or highly similar;
 - the average consumer is a professional individual or business user whose selection will be dominated by visual considerations whilst paying a medium degree of attention;
 - the competing trade marks are aurally and visually similar to a medium degree;
 - the earlier mark has a medium degree of inherent distinctiveness;
 - the overall impression of the applied for mark, in the mind of the average consumer, is of both words together forming a single unit that has its own distinct meaning compared with the meaning of the component elements taken separately.
50. The identity or high level of similarity between the services is important as a lesser degree of similarity between the marks may be offset by a greater degree of similarity (or identity) between the services. In terms of direct confusion, even taking into account imperfect recollection, I do not consider it likely that the average consumer, with overall impressions in mind, will mistake the applicant's mark for the opponent's as the average consumer would be

likely to notice the differences between “DISRUPTIVE” and “Disruptive Entrepreneur”. I bear in mind here, in particular, that the average consumer is likely to notice the visual difference and that visual considerations are likely to dominate the purchasing process. I also bear in mind that the average consumer’s overall mental image of the earlier mark is the word “DISRUPTIVE” whereas the average consumer’s mental image of the mark applied for is the more complex “Disruptive Entrepreneur” which, as I have found, is likely to be viewed and remembered as a whole single unit or phrase with a particular and different meaning.

51. Turing to indirect confusion, I have borne in mind that the examples given by Mr Purvis in *L.A. Sugar* were intended to be illustrative in the context of that case, and not to impose rigid rules.⁵ The categories of case where indirect confusion may be found are not closed. Each case must be assessed on its own facts, and my assessment must take account of the overall impression created by the marks. I must try to envisage the instinctive reaction in the mind of the average consumer when encountering the later mark with an imperfect recollection of the earlier. I must assess whether the average consumer will make a connection between the marks and assume that the goods or services in question are from the same or economically linked undertakings.

52. I have found that the average consumer will have recognised that the applied for mark of “Disruptive Entrepreneur” is different from the earlier mark of “DISRUPTIVE.” The common element here is “disruptive” which is far from strikingly distinctive. In my view, the sharing of the word “disruptive” at the beginning of the marks cannot be said to be so unusual that the average consumer, when selecting a business card design service, would assume that no other trader would use this element as a part of their trade marks so that the parties must be economically linked. The applicant’s mark does not simply add an element to the opponent’s mark, which would suggest to the average consumer that it was merely a sub-brand or extension of the earlier known

⁵ See *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17 at paragraphs [81] to [82]

brand. Firstly, the word “Entrepreneur” is not the type of word likely to be perceived by the average consumer as designating a sub brand or brand extension. Secondly, I have found that “Entrepreneur” hangs together with “Disruptive” as a complete phrase to form a cohesive whole with a different meaning to its constituent elements and that complete phrase is an important element of the overall impression held by the average consumer when selecting business card design services. That difference in overall impression held by the average consumer, in my view, precludes an instinctive reaction that the respective marks are variants or sub-brands or that overall the services in question are from the same or economically linked undertakings. I therefore find there is no likelihood of indirect confusion.

53. The opposition under section 5(2)(b) is therefore unsuccessful.

Conclusion

54. The opposition has been unsuccessful and, subject to appeal, the application will be granted.

Costs

55. Under cover of a letter dated 7 July 2018 the applicant was sent a costs proforma which he was directed to complete and return by 6 August 2018 if he intended to request an award of costs. The letter informed the applicant that if the proforma was not completed and returned no costs would be awarded other than any official fees paid. The proforma has not been returned and I therefore do not make any costs award in favour of the applicant. There are no official fees to reimburse.

Dated this 28th day of September 2018

**Rachel Harfield
For the Registrar
The Comptroller-General**