

**O/191/19**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3274574 BY  
ASAPRODUCTS LTD  
TO REGISTER:**

**ZENA**

**AS A TRADE MARK IN CLASS 3**

**AND**

**IN THE MATTER OF THE OPPOSITION THERETO  
UNDER NO. 412021 BY  
CONSITEX S.A.**

## Background and pleadings

1. ASProducts Ltd (“the applicant”) applied to register the trade mark **ZENA** in the United Kingdom on 1 December 2017. It was accepted and published in the Trade Marks Journal on 22 December 2017 in respect of the following goods and services:

### Class 3

*Body Glitter, Make Up*

2. The application was opposed by Consitex S.A. (“the opponent”). The opposition was based upon Section 5(2)(b) and Section 5(3) of the Trade Marks Act 1994 (“the Act”), but the claim under section 5(3) was withdrawn on 2 July 2018. The opposition concerns all goods covered by the application.
3. The opponent is relying upon the following Trade Marks:

- a) IR (International Registration) 1235259 **Z ZEGNA**. The mark is based on Swiss Trade Mark 667867, from which a priority date of 31 July 2014 is claimed. The mark was designated for protection in the EU on 6 August 2014 in respect of goods and services in Classes 3, 9, 18, 25 and 35. Protection was conferred on 15 December 2015. The opponent is relying on the following goods:

### Class 3

*Perfumes; eau de Cologne; toilet water; body care products; cosmetics; cosmetic preparations for baths; cosmetic products for skin care; beauty masks; cosmetic creams; facial creams; oils for cosmetic use; oils for perfumes and scents; essential oils; lotions for cosmetic use; face lotions; body lotions; body creams; body sprays; body atomizers; hair lotions; after-shave lotions; hair balms; hair styling waxes; hair gels; hair sprays; make-up products; lipstick; mascara; cosmetic powders; lip glosses; cosmetics for eyelashes; eyebrow cosmetics; pencils for cosmetic use; eyebrow pencils; make-up removing products; dentifrices; deodorants (perfumery); cleaning*

*products; air fragrances; shaving products; soaps; shaving soap; hand soap; body soaps; bath soaps; shampoos; nail care products; bleaching products for laundry use; polishing products; degreasing and abrasive preparations; shoe wax; polish for footwear; creams for leather.*

- b) EUTM (EU Trade Mark) 11679792 **ZEGNA**. The mark was applied for on 22 March 2013 and registered on 1 August 2013 in respect of goods and services in Classes 3, 14, 18, 24, 25, 28 and 35. The opponent is relying on the following goods:

**Class 3**

*Bleaching preparations and other substances for laundry use; Cleaning, polishing, scouring and abrasive preparations; Soaps; Perfumery, essential oils, cosmetics, hair lotions; Dentrifrices; Abrasives; Eau de Cologne; Lavender water; Toilet water; Scented water; Nail art stickers; Adhesives for cosmetic purposes; Adhesives for affixing false hair; Adhesives for affixing false eyelashes; Scouring solutions; Ammonia [volatile alkali] [detergent]; Aloe vera preparations for cosmetic purposes; Amber [perfume]; Starch glaze for laundry purposes; Fabric softeners for laundry use; Canned pressurized air for cleaning and dusting purposes; Aromatics [essential oils]; Flavorings for beverages [essential oils]; Cake flavorings [essential oils]; Astringents for cosmetic purposes; Balms other than for medical purposes; Bases for flower perfumes; Joss sticks; Cotton sticks for cosmetic purposes; Make-up; Whiting; Laundry blueing; Javelle water; Laundry bleach; Carbides of metal [abrasives]; Silicon carbide [abrasive]; Polishing paper; Emery paper; Sandpaper; Abrasive paper; Volcanic ash for cleaning; Non-slipping wax for floors; Shoemakers' wax; Depilatory wax; Mustache wax; Laundry wax; Polishing wax; Floor wax; Tailors' wax; Shoe wax; Polish for furniture and flooring; False eyelashes; Make-up powder; Hair dyes; Colorants for toilet purposes; Corundum [abrasive]; Quillaia bark for washing; Cosmetics; Cosmetics for animals; Cosmetic preparations for eyelashes; Eyebrow cosmetics; Cosmetic creams; Shoe cream; Waxes for leather; Polishing creams; Skin whitening creams; Washing soda, for cleaning; Bleaching preparations [decolorants] for cosmetic purposes; Dentifrices; Deodorants*

*for pets; Deodorants for human beings or for animals; Detergents other than for use in manufacturing operations and for medical purposes; Diamantine [abrasive]; Heliotropine; Badian essence; Mint essence [essential oil]; Oil of turpentine for degreasing; Bergamot oil; Ethereal essence; Drying agents for dishwashing machines; Extracts of flowers [perfumes]; Massage gels other than for medical purposes; Dental bleaching gels; Petroleum jelly for cosmetic purposes; Geraniol; Cleaning chalk; Greases for cosmetic purposes; Henna [cosmetic dye]; Incense; Ionone [perfumery]; Hair spray; Nail polish; Almond milk for cosmetic purposes; Cleansing milk for toilet purposes; Scented wood; Non-slipping liquids for floors; Windscreen cleaning liquids; Soda lye; After-shave lotions; Hair lotions; Lotions for cosmetic purposes; Lip glosses; Shoe polish; Mascara; Beauty masks; Eyebrow pencils; Cosmetic pencils; Mint for perfumery; Decorative transfers for cosmetic purposes; Musk [perfumery]; Cosmetic kits; Neutralizers for permanent waving; Oils for toilet purposes; Ethereal oils; Essential oils of cedarwood; Essential oils of lemon; Oils for perfume and scents; Oils for cleaning purposes; Oils for cosmetic purposes; Essential oils of citron; Gaultheria oil; Jasmine oil; Lavender oil; Almond oil; Rose oil; Cotton wool for cosmetic purposes; Pastes for razor strops; Cobblers' wax; Hydrogen peroxide for cosmetic purposes; Smoothing stones; Polishing stones; Pumice stone; Alum stones [astringents]; Shaving stones [astringents]; Pomades for cosmetic purposes; Potpourris [fragrances]; Sun-tanning preparations [cosmetics]; Cosmetic preparations for baths; Douching preparations for personal sanitary or deodorant purposes [toiletries]; Laundry glaze; Preparations for cleaning dentures; Polishing preparations; Hair waving preparations; Denture polishes; Sunscreen preparations; Preparations for unblocking drain pipes; Scale removing preparations for household purposes; Cosmetic preparations for slimming purposes; Color-brightening chemicals for household purposes [laundry]; Antistatic preparations for household purposes [laundry]; Antistatic preparations for household purposes; Cosmetic preparations for skin care; Depilatories; Perfumery; Laundry preparations [polish]; Preparations to make shiny the leaves of plants; Fumigation preparations [perfumes]; Dry-cleaning preparations; Make-up preparations; Leather preservatives [polishes]; Mouth*

*washes, not for medical purposes; Nail care preparations; Cleaning preparations; Shaving preparations; Toiletries; Smoothing preparations [starching]; Laundry soaking preparations; Sachets for perfuming linen; Wallpaper cleaning preparations; Rust removing preparations; Leather bleaching preparations; Degreasers other than for use in manufacturing processes; Make-up removing preparations; Paint stripping preparations; Lacquer-removing preparations; Color-removing preparations; Varnish-removing preparations; Perfumes; Air fragrancing preparations; Lipsticks; Polishing rouge; Safrol; Laundry starch; Bath salts, not for medical purposes; Bleaching salts; Almond soap; Shaving soap; Cakes of soap; Soaps; Soap for foot perspiration; Antiperspirant soap; Deodorant soap; Disinfectant soap; Medicated soap; Soap for brightening textile; Shampoos; Shampoos for pets; Dry shampoos; Stain removers; Emery; Bleaching soda; Furbishing preparations; Breath freshening sprays; Breath freshening strips; Cloths impregnated with a detergent for cleaning; Floor wax removers [scouring preparations]; Talcum powder, for toilet use; Sandcloth; Emery cloth; Glass cloth; Terpenes [essential oils]; Cosmetic dyes; Beard dyes; Tissues impregnated with cosmetic lotions; Turpentine, for degreasing; Tripoli stone for polishing; False nails.*

4. The opponent claims that the marks are similar and that the goods covered by the applicant's specification are identical or similar to goods covered by the earlier marks, leading to a likelihood of confusion on the part of the public. Therefore, registration of the contested mark should be refused under section 5(2)(b) of the Act.
5. The applicant filed a defence and counterstatement, denying the grounds.
6. The applicant and opponent filed evidence in these proceedings on 17 November 2018 and 6 December 2018 respectively. This will be summarised to the extent that I consider it necessary.
7. The opponent and applicant also filed written submissions, including written submissions in lieu of a hearing, on 2 July 2018 and 5 February 2019 (for the

opponent) and 3 September 2018 and 31 January 2019 (for the applicant). These will not be summarised but will be referred to as and where appropriate during this decision.

8. In these proceedings, the opponent is represented by Freeths LLP. The applicant originally represented itself, but is now represented by Wood IP Limited.

### **Preliminary Issues**

9. In its written submissions in lieu of a hearing, the applicant requests that the case based upon section 5(3) be dismissed summarily. As I have already mentioned in paragraph 2 above, the opponent withdrew its section 5(3) claim on 2 July 2018. There is therefore no need for me to consider the applicant's request.
10. In paragraph 10.2 of its written submissions in lieu of a hearing, the opponent states that *body glitter* is the only good specified in the application. On publication, the application also included *make up* (see paragraph 1 of this decision). The Registry has received no notification from the applicant that it seeks to amend its application, and in its own written submissions the applicant maintains that the specification is as it was at the time of publication. The opponent has not stated that it is withdrawing any part of its opposition under section 5(2)(b), which was raised against all the goods and services covered by the application. I shall therefore take my decision on the basis of the specification shown in paragraph 1.

### **Evidence**

11. The applicant's evidence comes from Mr Sabahat Hussain, Director of ASAprducts Ltd since August 2017. It is dated 17 September 2018. The opponent's evidence comes from Mr Lloyd Andrew Lane, a solicitor at Freeths LLP, the opponent's representative. It is dated 6 December 2018.
12. A large part of both the opponent's and the applicant's later submissions is taken up with a critique of the other party's evidence and arguments about the weight that can be placed upon it. It is the case that some parts of the witness statements

are submissions, rather than evidence. I have read these statements and the accompanying exhibits carefully and I set out below the facts that I consider to be contained therein:

- ZENA can be a female name.<sup>1</sup>
- ZENA is also the Ligurian name for Genoa. Ligurian is spoken by about 450,000, mainly elderly, people in northwest Italy.<sup>2</sup>
- Some cosmetic companies use people's names for their brands.<sup>3</sup> It is not clear what proportion of cosmetic brands have this type of name.
- The retailers Amazon and Superdrug sell body glitter. The top results of the searches provided in evidence show that most of the items these retailers stock cost under £10.<sup>4</sup>

## **Decision**

### **Section 5(2)(b) ground**

13. Section 5(2)(b) of the Act states that:

“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.”

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<sup>1</sup> Exhibit SH1.

<sup>2</sup> Exhibit SH2.

<sup>3</sup> Exhibit SH3. The witness statement refers to the Exhibit in this form, but the actual exhibit is labelled as “AP3”.

<sup>4</sup> Exhibit LAL1.

14. An “earlier trade mark is defined in section 6(1) of the Act:

“In this Act an ‘earlier trade mark’ means –

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

15. The registrations upon which the opponent relies qualify as earlier trade marks under the above provision. In this opposition, the opponent is relying upon all the goods in Class 3 for which the earlier marks are protected or registered. As the marks were protected or registered within the five years before the date on which the applicant’s mark was published, they are not subject to proof of use and the opponent is therefore entitled to rely on all the Class 3 goods for which the marks stand registered.

16. In considering the opposition under this section, I am guided by the following principles, gleaned from the decisions of the courts of the European Union in *SABEL BV v Puma AG* (C-251/95), *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* (C-39/97), *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* (C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (C-425/98), *Matratzen Concord GmbH v OHIM* (C-3/03), *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* (C-120/04), *Shaker di L. Laudato & C. Sas v OHIM* (C-334/05 P) and *Bimbo SA v OHIM* (C-519/12 P):

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

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



marks and must instead rely upon the imperfect picture of them 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 goods**

17. The applicant accepts that the contested goods are identical to goods protected by the opponent's marks, on the grounds that the opponent's *cosmetics* includes within its ambit both *body glitter* and *make up*.

### **Average consumer and the purchasing act**

18. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, I must bear in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: see *Lloyd Schuhfabrik Meyer*.
19. 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:

“The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The word ‘average’ denotes that the person is typical. The term ‘average’ does not denote some form of numerical mean, mode or median.”<sup>5</sup>

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<sup>5</sup> Paragraph 60.

20. The average consumer for the goods at issue is a member of the general public. The opponent, focusing on *body glitter*, submits that the goods are inexpensive and likely to be an impulse purchase. In support of this submission, it adduces the evidence of searches of the Amazon and Superdrug websites to show the relatively low cost of the goods. The applicant criticises this evidence and submits that these retailers represent the cheaper end of the market. It has not, however, provided any evidence itself to illustrate the price range of such products. Based on what is before me, I find that body glitter is relatively inexpensive. Absent evidence, it is not obvious to me that body glitter is sold at a much higher price level.

21. In contrast to the above, I accept that *make up* and *cosmetics* more generally are often available at a wide range of prices, and are sold through high-street retailers, chemists, supermarkets, department stores, websites and specialist cosmetics suppliers. The visual element would be most significant in the purchasing process for all the goods in question, as the average consumer would tend to self-select what they wanted to buy. However, I do not ignore the aural element, as some cosmetics and make up choices will be assisted by sales staff.

22. The applicant submits that the average consumer of these products will be “highly careful” about their choice, and lists a series of considerations that might influence the purchasing decision. These include the colour of the products, the ethical values of the brand and the ingredients. The applicant concludes that the level of attention for make up is higher than average, and higher still for body glitter. With regards to the latter, it submits:

“Even if the unit cost of a pot were as low as Mr Lane submits it is (which is not strictly admitted), it does not follow from that price point that there would be a low level of attention: if an item’s single use cost is high and the occasions on which it is used are rare (as is the case here) then consumers would take more care than the norm, not less (as Mr Lane asserts).”

23. While I accept that the level of attention paid will not be low, as submitted by the opponent, it seems to me that it will not be as high as the applicant submits. In the case of make-up and cosmetics, these goods are purchased relatively frequently and are often (but I accept not always) inexpensive. That said, the average consumer will make a decision based on the suitability of the product and some of the factors suggested by the applicant. The average consumer is, as a construct, only reasonably circumspect and I would not expect them to run through all fourteen of the applicant's suggested considerations for what is often an everyday, relatively inexpensive purchase. In my view, they would be paying an average level of attention when purchasing make up and cosmetics.

24. I accept that the average consumer will purchase body glitter less frequently. While many consumers would use make up every day, it is not common to see individuals wearing body glitter as one goes about everyday life. The applicant submits that:

“... it is an item which is used sparingly or rarely, and the Registrar may well appreciate that the product is celebratory or playful in nature, and is likely not even to be worn on a ‘standard’ night out.”

25. This accords with my experience. However, it seems to me that the average consumer would still be paying no more than an average level of attention. I am not convinced that the average consumer would make a calculation about cost per use of an item and decide that what may be a relatively inexpensive item in terms of upfront cost deserves a higher level of attention. Consequently, I find that the average consumer would be paying an average level of attention.

### **Comparison of marks**

26. 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 the marks, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo SA v OHIM*, C-591/12 P, that:

“... it is necessary to ascertain in each individual case, the overall impression made on the target public by the sign for which the 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.”<sup>6</sup>

27. It would be wrong, therefore, artificially to dissect the 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 the marks.

28. The respective marks are shown below:

Earlier marks	Contested mark
EUTM (EU Trade Mark) 11679792 <b>ZEGNA</b>	<b>ZENA</b>
IR (International Registration) 1235259 <b>Z ZEGNA</b>	

29. Of the opponent’s two marks, EUTM 11679792 represents its better case. I shall therefore compare the contested mark to this one, as if the opposition fails with respect to this mark, it will also fail with respect to IR 1235259.

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<sup>6</sup> Paragraph 34.

30. The applicant's mark is the word "ZENA", presented in a standard font with no stylisation and in capital letters.<sup>7</sup> The overall impression of the mark lies in the word itself.

31. The opponent's EUTM is the word "ZEGNA", presented in a standard font with no stylisation and in capital letters. The overall impression of the mark lies in the word itself.

### *Visual comparison*

32. The applicant's mark consists of a single word of four letters, while the opponent's is a single word of five letters. All of the four letters of the applicant's mark appear in order in the opponent's mark, with a G inserted as the third letter. The opponent submits that:

"... this difference will have only a minor impact on the visual perception of the mark as a whole, as when reading word marks consumers tend to place particular emphasis on the beginning and ends of the dominant elements of the marks."

33. The applicant submits that:

"Where a mark is short, smaller differences may have greater effect. In the case of the marks ZENA and ZEGNA, the additional letter lengthens the mark and is far more prominent than other letters, such as (say) a letter I."

34. It is a rule of thumb that the beginnings of words tend to have more visual impact than the middle or ends: see *El Corte Inglés SA v OHIM*, Cases T-183/02 and T-184/02, particularly paragraph 83. However, this is not a general rule that holds in every circumstance. The similarities at the beginning and end of the marks need

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<sup>7</sup> Registration of a trade mark in capital letters covers use in lower case, as stated by Professor Ruth Annand, sitting as the Appointed Person, in *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17.

to be considered alongside the length and make-up of the marks as a whole. The case law already cited in paragraph 26 reminds me that the average consumer normally perceives the mark as a whole and does not analyse its details. I consider that the different length of the marks, and the impact of the additional letter G, has a noticeable impact in these short marks (although I accept that not all differences in short marks are noticeable) and I find them to have a medium level of similarity.

#### *Aural comparison*

35. The applicant's mark would be pronounced "ZEE-NA". The opponent submits that, although it is an Italian word, the average English speaker would pronounce its mark phonetically as "ZEG-NA". I agree that this is how an English speaker with no knowledge of Italian would pronounce the word. Both words have two syllables, of which the second is the same. The point of similarity between the first syllables is the initial letter; the opponent's mark has a short E, followed by a G, while the applicant's E is long. In my view, the marks have a medium level of aural similarity.

#### *Conceptual comparison*

36. The opponent submits that both marks are "personal names of foreign origin". It is possible that the applicant's mark may be recognised as a name, but I think the average consumer is more likely to consider it an invented word. It is my view that the average English-speaking consumer would also see the opponent's mark as an invented word. As invented words are conceptually neutral, there would be no conceptual comparison to be made between the marks.

#### **Distinctiveness of the earlier mark**

37. There is, as has already been noted, a greater likelihood of confusion if the earlier mark is highly distinctive. The CJEU provided guidance on assessing a mark's distinctive character in *Lloyd Schuhfabrik Meyer*:

"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 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).”

38. The opponent has not provided any evidence of use of its EUTM, and so I am required only to consider its inherent distinctiveness. As I found that the average consumer would believe it to be an invented word, I find that the distinctiveness of the mark is high.

### **Conclusions on likelihood of confusion**

39. In assessing the likelihood of confusion, I must adopt the global approach set out in the case law to which I have already referred in paragraph 16. I am required to have regard to the interdependency principle, that a lesser degree of similarity between the goods/services may be offset by a greater degree of similarity between the marks, and vice versa.<sup>8</sup> The distinctiveness of the earlier mark must also be taken into account.

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<sup>8</sup> *Canon Kabushiki Kaisa*, paragraph 17.



40. The applicant submits that I should consider “the fact that the consumer for the goods in question is used to distinguishing between marks that have some similarity, particularly in the context of marks which are understood to be names”. It goes on to say:

“It is the unchallenged evidence of the Applicant that the use of similar personal names in the industry is common, and that consumers distinguish between them as a matter of course. Examples are presented in the Applicant’s evidence, including evidence of them on the market. It is not an incredible allegation, it is supported by evidence and it is not challenged.”

41. However, I found that the average consumer would think that the marks were invented words, rather than names. The context is different from that set out by the applicant. In these circumstances, I shall consider this point no further.

42. I found the marks to be visually and aurally similar to a medium degree, and the distinctiveness of the earlier mark is high. However, the global assessment outlined in the previous paragraph does not imply an arithmetical exercise, where the factors are given a score and the result of a calculation reveals whether or not there is a likelihood of confusion. I must keep in mind the average consumer of the goods/services and the nature of the purchasing process. I note that it is generally accepted that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture they have kept in their mind.<sup>9</sup>

43. The average consumer would, I found, be paying an average degree of attention. While, as I have observed, I am not persuaded that the average customer runs through all the points suggested by the applicant, I do accept that they will have some criteria by which they judge the product, even if this is as simple as whether or not they like its colour. It is my view that, even bearing in mind the principle of imperfect recollection, the average consumer will not confuse the marks. In these

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<sup>9</sup> *Lloyd Schuhfabrik Meyer*, paragraph 27.

short marks, I found that the differences would be noticed<sup>10</sup> and so I find no likelihood of direct confusion.

44. It seems to me that there would not be indirect confusion either. In *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/15, Mr Iain Purvis QC, sitting as the Appointed Person, described indirect confusion as occurring when the consumer recognises the differences between the marks, but assumes that the undertakings responsible for them are either the same or economically connected. The average consumer would, in my view, not regard it as normal business practice simply to remove or add a letter to the middle of an existing mark to create a new brand. Consequently, I find no likelihood of indirect confusion.

45. As the opposition has failed in respect of the opponent's EUTM, it would also fail in respect of the opponent's other mark, which has a lower degree of similarity.

## **Conclusion**

46. The opposition has failed. The application by ASProducts Ltd may proceed to registration in respect of all the goods in the application.

## **Costs**

47. The applicant has been successful. In the circumstances, I award the applicant the sum of £800 as a contribution towards its costs. I have taken into account the fact that the applicant was initially unrepresented, and took on legal representation at the evidence round. The sum awarded for the earlier stage of the proceedings is lower than the scale minimum to reflect this. The sum is calculated as follows:

*Considering the other side's statement and preparing a counterstatement:*

*£100*

*Preparing evidence and considering and commenting on the other side's evidence: £500*

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<sup>10</sup> It is, of course, only a rule of thumb that small differences are more noticeable in shorter marks. Each case must be considered on its merits

*Preparation of written submissions: £300*

**Total: £900**

48. I therefore order Consitex SA to pay ASAprouducts Ltd the sum of £900. The above sum should 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 10<sup>th</sup> day of April 2019**

**Clare Boucher  
For the Registrar,  
Comptroller-General**