

O-253-19

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3306925 BY MR JAKE REEVE
TO REGISTER:**

Holyfield

AS A TRADE MARK IN CLASS 25

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 413211
BY CBM CREATIVE BRANDS MARKEN GMBH**

Background & Pleadings

1. On 27 April 2018, Mr Jake Reeve (“the applicant”) applied to register the above trade mark for *clothing, headwear and footwear* in Class 25. The application was published for opposition purposes on 25 May 2018.

2. On 25 July 2018, the application was opposed in full by CBM Creative Brands Marken GmbH. (“the opponent”). The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), in relation to which the opponent relies upon the following trade marks and all goods and services for which they are registered:

European Union Trade Mark (“EUTM”) 12142352:

HOLYS

Filing date: 16 September 2013

Registered on 7 February 2014 for:

Class 3: Bleaching preparations and other substances for laundry use; Cleaning, polishing, scouring and abrasive preparations; Soaps; Perfumery, essential oils, cosmetics, hair lotions, dentifrices.

Class 18: Leather and imitations of leather, and goods made of these materials and not included in other classes; Animal skins, hides; Trunks and travelling bags, bags, handbags, pocket wallets, purses, key cases, rucksacks, bags; Umbrellas, parasols and walking sticks; Whips, harness and saddlery.

Class 25: Clothing, footwear, headgear.

EUTM 17674301:

HOLY

Filing date: 9 January 2018

Registered on 3 August 2018 for:

Class 9: Optical instruments, in particular spectacles, sunglasses, skiing goggles, correction spectacles, spectacle frames, spectacle lenses, spectacle cases.

Class 14: Precious metals and their alloys and goods in precious metals or coated therewith, namely statues and figurines, and statues and figurines consisting of precious stones, semi-precious stones, imitations thereof or imitations of precious metals and semi-precious metals, all of the aforesaid being coated with precious metals or their alloys; Decorations and ornaments, horological and chronometric instruments, jewellery of precious metals or semi-precious metals or stones or imitations thereof, or coated therewith; Jewellery, precious stones; Horological and chronometric instruments.

Class 18: Luggage, trunks and travelling bags, bags, handbags, pocket wallets, purses, key cases, backpacks, pouches, shoulder belts and bandoliers, leather and imitations of leather, animal skins, hides and goods made of these materials, namely luggage, trunks and travelling bags, bags, handbags, pocket wallets, purses, key cases, backpacks, pouches, shoulder belts and bandoliers, leather straps, leather laces, bandoliers, sheets of imitation leather for further processing.

Class 25: Clothing, footwear, headgear.

Class 35: Advertising; Business management; Business administration; Office functions; Retailing, including via websites and teleshopping, in relation to clothing, footwear, headgear, bleaching preparations and; Other substances for laundry use, cleaning, polishing, scouring and abrasive preparations, soaps, perfumery, essential oils, cosmetics, hair lotions, dentifrices, sunglasses, precious metals and their alloys, jewellery, precious stones, horological and chronometric instruments, luggage, trunks and travelling bags, bags, handbags, pocket wallets, purses, key cases, backpacks, pouches, shoulder belts and; Bandoliers, leather and imitations of leather, animal skins and hides and goods made therefrom, namely luggage, trunks and travelling bags, bags, handbags, pocket wallets, purses, key cases, backpacks, pouches, shoulder belts and bandoliers, leather thongs, leather laces, bandoliers, sheets of imitation leather for further processing, clothing accessories, textile goods, haberdashery, bed and table linen, sports equipment, bags, forks, spoons, household or kitchen utensils and containers, glassware, porcelain and; earthenware, Products from the gastronomy sector (namely confectionery, coffee, smokers' accessories, alcoholic beverages), drinks, Spectacles and sunglasses and accessories therefor, Games, Toys, fixtures, Sound recordings and data storage apparatus, electric and electronic household goods, electric and electronic cosmetic goods, home appliances, Electric utensils for; Household, electrical cosmetic apparatus, lighting installations, heating apparatus, fans, tools, DIY products and gardening tools; Arranging and conducting of advertising events and customer loyalty programmes.

3. The opponent contends that a high level of similarity between the respective trade marks coupled with an identity in the goods for which they registered (or are due to be registered) is likely to result in a likelihood of confusion on the part of the public, including a likelihood of association.

4. The applicant maintains that an absence of conceptual similarity and a low degree (if any) of visual and aural similarity between the marks is sufficient to mitigate against a likelihood of confusion, despite what it admits are identical goods.

5. The opponent in these proceedings has been represented throughout by Bird & Bird LLP. Mr Reeve was originally unrepresented but later appointed Novagraaf UK¹. During the evidence rounds, the opponent filed written submissions and the applicant filed evidence in response. Neither party elected to request a hearing and only the opponent filed written submissions in lieu. This decision is taken following a careful reading of all the papers which I will refer to, as necessary.

Decision

6. 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.”

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

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

¹ In an email of 13 December 2018 (to which the applicant’s evidence was attached), Novagraaf indicated that it had been instructed to act on behalf of Mr Reeve. The register was officially updated to reflect the appointment on 18 December 2018.

(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.”

8. Given their filing dates, both of the opponent’s marks qualify as earlier trade marks under the provisions outlined above. In accordance with section 6A of the Act, as neither had completed its registration procedure more than five years prior to the publication date of the applicant’s mark, the opponent’s marks are not subject to the proof of use provisions. Consequently, the opponent is entitled to rely upon all goods and services identified in its Notice of Opposition.

Evidence

9. The applicant’s evidence comprises a witness statement from Mr Jake Reeve dated 12 December 2018 and supporting exhibits JR1 and JR2. Much of Mr Reeve’s statement is comprised of submissions pertinent to the opponent’s s.5(2)(b) claim. Such submissions will be referred to, where appropriate.

10. In his statement, Mr Reeve submits that *Holyfield* was not selected as a trade mark based on any knowledge of, or as a reference to, either of the opponent’s earlier marks. Instead, the mark was favoured by Mr Reeve and his colleagues on the basis that *Holyfield* has “a good resonance and has scope to be used in a multitude of fashion trends which is key to our business. It has a heritage sound and connotations to sport also, so for us this covers our two key areas of fashion.”

11. Enclosed at exhibit JR1 is an undated website print² detailing various pieces of information regarding the history of the *Holyfield* surname, which originated in

² <https://www.houseofnames.com/holyfield-family-crest>

Scotland. The headings listed on the site include 'Early Origins of the Holyfield family' and 'Contemporary Notables of the name Holyfield (post 1700)', under which American songwriter Wayland D. Holyfield (b. 1942) and professional boxer Evander Holyfield (b. 1962) are noted.

12. Exhibit JR2 comprises an undated printout from online directory 192.com³ which lists the results generated by searches undertaken for individuals with the surname *Holyfield* both throughout the UK and specifically in London. The results show that there are 186 individuals with the surname across the UK, 13 of whom are in London.

13. That concludes my summary of the evidence, insofar as I consider it necessary.

Section 5(2)(b) - Case law

14. 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;

³ <https://www.192.com/people/search/>

(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

15. The applicant seeks registration for *clothing, headwear* and *footwear* in class 25. The opponent's earlier marks are registered for, inter alia, *clothing, footwear* and

headgear (in the same class). To my mind, *headwear* and *headgear* are interchangeable terms. It is clear, and the applicant admits as such⁴, that the competing goods are, therefore, self-evidently identical.

The average consumer and the nature of the purchasing act

16. As the case law above indicates, it is necessary for me to determine who the average consumer is for the goods at issue. I must then determine the manner in which these goods 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*⁵, 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.”

17. In *New Look Ltd v Office for the Harmonization in the Internal Market (Trade Marks and Designs)*, joined cases T-117/03 to T-119/03 and T-171/03, the General Court (“GC”) said in relation to the selection of clothing:

“50. The applicant has not mentioned any particular conditions under which the goods are marketed. Generally in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase.

⁴ See paragraph 6 of the witness statement of Mr Jake Reeve

⁵ [2014] EWHC 439 (Ch)

Accordingly the visual aspect plays a greater role in the global assessment of the likelihood of confusion.”

18. The parties agree that the average consumer for the goods at issue in these proceedings is a member of the general public. In its submissions, the opponent indicates that consumers are likely to apply an average (or normal) degree of attention whilst purchasing the applied for goods, but later describes the attention level as “relatively low”⁶. The applicant submits that an average degree of attention will be paid.

19. I agree that the average consumer is likely to be a member of the general public. The goods are often the subject of self-selection from traditional high street retail outlets, catalogues and websites. For this reason, and as the above case law indicates, visual considerations are likely to play the largest role in the selection process. I do not, however, overlook the aural impact of the marks as, in my experience, it would not be unusual for orders of such goods to be made via telephone or for sales assistants to provide oral recommendations, for example.

20. The goods in dispute are purchased fairly frequently and are available in a relatively broad range of prices, from very expensive designer goods to those sold by budget brands. Irrespective of cost, when selecting articles of clothing, consumers are likely to consider factors including size, compatibility, quality and so on. All things considered, I find it likely that the average consumer will pay an average degree of attention when making their selection.

Comparison of trade marks

21. 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

⁶ See paragraph 17 of the opponent’s written submissions filed in lieu of a hearing

components. The Court of Justice of the European Union (“CJEU”) stated in its judgment in *Bimbo SA v OHIM*⁷, that:

“34. ...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.”

22. 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 they create. I keep in mind the parties’ submissions regarding the similarity between the marks but will refer to them only where necessary.

23. The trade marks to be compared are displayed in the table below:

Opponent’s trade marks	Applicant’s trade mark
<u>EUTM 12142353:</u> HOLYS	Holyfield
<u>EUTM 17674301:</u> HOLY	

24. The overall impression of the opponent’s marks lies solely in the single word of which each is comprised (specifically HOLYS and HOLY), with neither having any additional elements to rely upon.

⁷ Case C-591/12P

25. The applicant's mark is also comprised of a single word; Holyfield. I note the opponent's comments regarding the dominance of *Holy* within the contested mark, particularly compared to *field* which it submits will be seen as a 'common suffix'. Whilst I would not go so far as to describe *field* as a 'common suffix', I accept that there are several ordinary English words, and place names for that matter, which end in '-field'. Still, in the current case, I find it likely that *Holyfield* will be viewed by consumers as a single unit, rather than two independent elements conjoined. The overall impression of the mark will lie in the word as a whole, with neither *Holy* nor *field* being viewed as more dominant or distinctive.

Visual comparison

26. I begin with the opponent's HOLYS mark. The competing marks are comprised of five and nine letters respectively, coinciding in their first four only (H-O-L-Y). As word marks are protected for use in a variety of cases and standard fonts, nothing turns on the opponent's mark being presented in capital letters and the applicant's mostly in lower case (save the initial letter H which is capitalised). I keep in mind the rule of thumb regarding the importance consumers often place on the beginnings of marks and, weighing all factors, find the visual similarity to be of a medium degree.

27. When it comes to the opponent's HOLY mark, much of the same reasoning applies. The marks coincide in their first four letters, but there are an additional five letters in the applicant's mark with no counterpart in the opponent's. I would, again, pitch the visual similarity at a medium degree.

Aural comparison

28. The opponent's HOLYS mark is likely to be articulated in two syllables, specifically HO-LEES. The applicant's mark is likely to be articulated in a total of three syllables, specifically HO-LEE-FIELD. On that basis, the first syllable in the competing marks is identical and the second is highly similar. The third syllable in the applicant's mark (FIELD) meets no counterpart in the opponent's. I find the aural similarity, on balance, to be of a medium degree.

29. The opponent's HOLY mark is comprised of two syllables which are likely to be articulated identically to the first two syllables of the applicant's mark, namely HO-LEE. The third syllable in the applicant's mark, again, has no counterpart. Though I accept that there is, consequently, an increased aural similarity compared to the other earlier mark (HOLYS), as the variation in articulation is fairly marginal I would, again, find the aural similarity to reside at a medium degree.

Conceptual comparison

30. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM*⁸. The assessment must, therefore, be made from the point of view of the average consumer.

31. Of the marks' conceptual similarity, the opponent submits:

“17. The word elements in the Sign and the Earlier Marks are common English words. The marks are clearly conceptually identical or at least highly similar.”⁹

32. In his witness statement, Mr Reeve states:

“13. Conceptually, the only significance that the mark 'HOLYFIELD' of my application has is as a surname whereas the earlier marks 'HOLY' and 'HOLYS' are of clear religious significance. Since the marks under comparison are entirely different in meaning they are entirely dissimilar conceptually.”

33. I begin this time with the opponent's HOLY mark. Mr Reeve has provided the Oxford Dictionary definition of the word 'holy' in his witness statement, which generally marries not only to my own understanding, but what I find likely to be the understanding of the average consumer. The definition reads: dedicated or consecrated to God or a religious purpose¹⁰. This is the concept consumers are likely to immediately retrieve

⁸ [2006] e.c.r.-I-643; [2006] E.T.M.R 29

⁹ See paragraph 17 of the opponent's written submissions

¹⁰ <https://en.oxforddictionaries.com/definition/holy>

from the earlier mark. Moving to the applicant's mark, though I accept that it is essentially comprised of two ordinary English words which would each present a unique concept (one being identical to the opponent's mark), I have found that the overall impression of *Holyfield* lies in the word as a whole. When treated as such, consumers are, in my view, likely to conceptually interpret *Holyfield* purely as a surname, albeit not a particularly common one, and will recall it in this way. Whilst I reach this conclusion based on my own experience and what I consider the likely approach of the average consumer, the applicant's evidence shows that *Holyfield* can (and does) function as a surname within the UK, which effectively supports my finding. On that basis, the marks are conceptually dissimilar.

34. I turn now to the opponent's HOLYS mark. As *holy* is predominantly, if not always, used as an adjective, consumers are unlikely to be well accustomed to its presentation in a seemingly pluralised format. Consumers *are* accustomed, however, to identifying the plural of many well-known dictionary words and, in my view, by their very nature, they will instinctively seek an element within the mark to which they can attribute a meaning. To my mind, consumers will, as a result, focus predominantly on the HOLY element of the mark and the easily retrievable concept it evokes (as above). Though admittedly unusual, consumers may subsequently conclude that the apparent pluralisation of HOLY is, conceptually, an indication of more than one holy entity or article. Even if consumers do not attempt to make sense of the word's pluralised format, they will at least be left with a concept of holiness, identical to that bestowed by the opponent's HOLY mark. In short, the opponent's mark will either present a concept of multiple holy entities or simply of holiness itself. In either case, the competing marks remain conceptually dissimilar.

Distinctive character of the earlier trade marks

35. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public. 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 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).”

36. The opponent has not claimed that either of its marks have acquired an enhanced distinctiveness, nor did it file evidence to support such a finding. Consequently, I have only the marks’ inherent distinctiveness to consider. It is widely accepted, though only a guideline, that words which are invented often possess the highest degree of distinctive character, whilst words which are suggestive or allusive of the goods and/or services relied upon generally possess the lowest.

37. The opponent’s HOLY mark is comprised of a single word with a definition which will be readily understood by the average consumer (paragraph 33 refers). In the opponent’s HOLYS mark, a letter S has been added. Whilst the addition creates a word with no specific meaning necessarily, consumers are likely to view the mark as a plural form of the well-known word *holy*. Neither of the marks, to my knowledge, is descriptive, suggestive or allusive of the goods at issue, nor of the goods’ characteristics. Weighing all factors, I find the inherent distinctiveness of the

opponent's HOLY mark to be of an average degree and its HOLYS mark slightly higher than average, but not at the highest level given that it is more likely to be viewed as an adaptation of the word HOLY, rather than an entirely invented word.

Likelihood of confusion

38. 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 goods 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.

39. Earlier in this decision I reached the following conclusions:

- The competing goods are identical;
- The average consumer is a member of the general public. Visual considerations are likely to dominate the selection process, though aural considerations are also relevant;
- An average degree of attention is likely to be paid to the selection of goods;
- Each of the opponent's earlier marks share a medium degree of visual and aural similarity with the contested mark;
- The competing marks are conceptually dissimilar;
- The opponent's HOLY mark possesses an average degree of inherent distinctiveness and its HOLYS mark a slightly higher than average degree (though not the highest degree possible).

40. 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 goods down to the responsible undertakings being the same or related. In *L.A. Sugar Limited v By Back Beat Inc*¹¹, Mr Iain Purvis

¹¹ Case BL O/375/10

Q.C., as the Appointed Person, provided further clarification on the matter. He explained that:

“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 recognized 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).”

41. To make the assessment, I must adopt the global approach advocated by the case law, whilst taking account of my earlier conclusions. I will also bear in mind that the average consumer rarely has the chance to make direct comparisons between trade marks and must, instead, rely upon the imperfect picture of them retained in its mind.

42. When it comes to the relevance of conceptual differences, in *The Picasso Estate v OHIM*, Case C-361/04 P, the CJEU found that:

“20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law.”

43. However, in *Nokia Oyj v OHIM*, Case T 460/07, the GC stated that:

“Furthermore, it must be recalled that, in this case, although there is a real conceptual difference between the signs, it cannot be regarded as making it possible to neutralise the visual and aural similarities previously established (see, to that effect, Case C-16/06 P *Éditions Albert René* [2008] ECR I-0000, paragraph 98).”

44. I begin by considering the likelihood of direct confusion and, in doing so, will bear in mind that the goods at issue are identical and how this is likely to interact with the interdependency principle. To my mind, the visual and aural differences between the respective marks are not of such a low degree that they could be easily overlooked or misplaced by the average consumer. Conceptually, consumers are likely to recall the meaning associated with both of the earlier marks, either in HOLY or HOLYS, and upon encountering the applicant’s mark, not only is the addition of four or five letters likely to be immediately recognisable visually but the distinct concept presented as a result of the addition is, in my view, sufficient to mitigate against direct confusion and will enable consumers to readily differentiate between the two. The similarities

between the contested mark and either of the earlier marks are simply not great enough for consumers to mistake one for the other.

45. I turn now to consider indirect confusion. Although I acknowledge that the examples given by Mr Purvis in *L.A. Sugar* are not intended to be exhaustive, they provide a useful focus. The common element in each of the competing marks is HOLY which, whilst I have by no means found to lack distinctiveness, I do not find so strikingly distinctive that the consumer will naturally be inclined to conclude that the coincidence is indicative of a shared undertaking; although 'holy' has no apparent relationship to the goods at issue, it is, essentially, an ordinary and well-known dictionary word. Furthermore, the *field* element in the applicant's mark is not so non-distinctive that consumers are likely to interpret its inclusion as a natural brand extension of either HOLY or HOLYS. It also serves to create a marked conceptual distinction between the respective marks, which is likely to be sufficient in counteracting any similarities which do exist and will allow consumers to recognise, correctly so, that they originate from separate undertakings. Still, given my findings regarding how the applicant's mark will be viewed by consumers, the distinctiveness of its independent elements is likely to have only a limited degree of relevance to my assessment. By viewing Holyfield as a single unit, I find it unlikely that consumers will need to consider its elements in isolation to establish whether the competing marks are related; the conceptual distinction is sufficient to steer consumers from confusion. Even in what I think is the very unlikely event of the average consumer 'bringing to mind' the earlier marks on account of their shared beginning, this is not enough to justify a finding of confusion.¹² All things considered, and notwithstanding the slightly higher than average inherent distinctiveness found in the opponent's HOLYS mark, I can see no reasonable or realistic circumstance whereby consumers would be led to believe that the applicant's mark is related to either of the earlier marks, or indeed, to the opponent. I dismiss a likelihood of indirect confusion.

Conclusion

46. The opposition has failed and, subject to any successful appeal, the application will proceed to registration.

¹² *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

Costs

47. As the applicant has been successful, it is entitled to a contribution toward its costs. Cost awards in proceedings are governed by Annex A of Tribunal Practice Notice (“TPN”) 2 of 2016. Applying the guidance in that TPN, I award costs to the applicant on the following basis:

Reviewing the Notice of Opposition and preparing a counterstatement:	£200
Preparing evidence:	£250 ¹³
Total:	£450

48. I order CBM Creative Brands Marken GmbH to pay Mr Jake Reeve the sum of £450. 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 14th May 2019

**Laura Stephens
For the Registrar**

¹³ This amount falls below the scale indication as the evidence filed was minimal and had little bearing on the outcome of the proceedings.