

O/439/21

TRADE MARKS ACT 1994

**IN THE MATTER OF THE REQUEST BY AUTOBAHN TANK & RAST FOR
PROTECTION IN THE UK OF THE FOLLOWING INTERNATIONAL
REGISTRATION WO0000001477384:**



IN CLASSES 3, 5, 10, 18, 28, 29, 30, 31, 32 AND 34

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 418933 BY FOX
UMBRELLAS LIMITED**

Background and Pleadings

1. On 30 January 2019, Autobahn Tank & Rast GmbH ('the Holder') applied to protect the trade mark, shown on the cover of this Decision, number 1477384, by way of International Registration designating the United Kingdom ('UK'). The Holder has claimed priority from its application in Spain dated 23 January 2019. The instant application was published for opposition purposes in the *Trade Marks Journal* on 4 October 2019. Registration is sought in respect of the goods in classes 3, 5, 10, 18, 28, 29, 30, 31, 32 and 34.¹
2. On 27 December 2019, the application was opposed by Fox Umbrellas Limited ('the Opponent') based on section 5(2)(b) of the Trade Marks Act 1994 ("the Act").² The Opposition is directed against the following of the Holder's goods only:

Class 18

Leather; imitations of leather; carrying bags; umbrellas; parasols; walking sticks.

3. The Opponent relies on the following two earlier trade mark registrations, and the respective Class 18 goods listed beneath them, for its section 5(2)(b) ground:

i) UK00001407222 FOX Filing date: 5 December 1989; Date of entry in register: 31 January 1992.	ii) UK00002485495 FOX Filing date: 21 April 2008; Date of entry in register: 5 February 2010.
Class 18:	Class 18

¹ The specifications are lengthy; and are, therefore, not reproduced in this Decision. Please refer to the Register: <https://trademarks.ipo.gov.uk/ipo-tmcase/page/Results/2/WO0000001477384> for the full specifications.

² The Opposition was initially based on sections 5(2)(b), 5(3) and 5(4)(a). In the absence of evidence filed by the Opponent, the 5(3) and 5(4)(a) grounds fell away. The matter therefore proceeds as a s5(2)(b) Opposition.

<i>Umbrellas; parasols and walking sticks; all included in class 18.</i>	<i>Umbrellas, parasols and walking sticks; handles for umbrellas, parasols and walking sticks; walking seats.</i>
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4. The Opponent claims that there is a likelihood of confusion under section 5(2)(b) and its opposition is directed against all of the goods *within the Holder's mark's Class 18 specification only*.
5. The Holder filed a defence and counterstatement in which it denies that the marks are similar. It states that its goods are 'only partially similar or identical'. The Tribunal assumes that what the Holder means is that *not all of its goods* are similar or identical to the Opponent's goods. Given that the parties' specifications both contain *umbrellas; parasols; and walking sticks*, the Tribunal will assume that the Holder is denying that its remaining terms, i.e. *Leather; imitations of leather; carrying bags*, are similar or identical to the Opponent's goods.
6. The Opponent filed written submissions in the first evidence round. Neither party has filed evidence or written submissions in lieu of a hearing.
7. The Opponent is represented by Forresters IP LLP; the Holder is represented by Redeker Sellner Dahs PartGmbH.
8. The following decision has been made after careful consideration of the papers before me.

Relevant dates

9. Section 6A of the Act provides that where the registration date of the earlier mark is more than 5 years prior to the application date of the applied-for mark, the Opponent may be required to prove use of the earlier mark. In the instant case, Section 6A is engaged because the registration dates of both earlier marks, i.e. 31 January 1992 and 5 February 2010, are more than 5 years prior to the priority

date claimed for the mark in respect of which protection in the UK is sought, i.e. 23 January 2019.

Although the Holder requested evidence of proof of use from the Opponent, due to defects in the Holder's request for proof of use in Form TM8 (Notice of Defence and Counterclaim), which the Holder failed to remedy in the time allowed for this purpose, the Tribunal directed that the Opposition proceed and struck out the defective proof of use request.

Decision

Section 5(2)(b) of the Act and related case law

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

“5(2) A trade mark shall not be registered if because –

(a) ...

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

There exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

11. The following principles are derived from the decisions of the CJEU³ 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;

³ Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH, Case C120/04; *Shake di L. Laudato & C. Sas v OHIM*, Case C-334/05P; and *Bimbo SA v OHIM*, Case C-591/12P

The principles:

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent

distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

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

Comparison of goods and services

12. Similarity of goods and services – Nice Classification

Section 60A of the Act provides:

“(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the

ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the ‘Nice Classification’ means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975.”

13. I must therefore be mindful of the fact that the appearance of respective goods in the same class is not a sufficient condition for similarity between those goods or services.

14. The Tribunal may group goods (or services) together for the purposes of assessment:

Separode Trade Mark BL O-399-10 (AP):

“The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”

15. The CJEU in *Canon*, Case C-39/97, stipulates that all relevant factors relating to the parties’ goods and services must be taken into account:

“[23] “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”.

16. Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281⁴, identified the following factors for assessing similarity of the respective goods and services:

- (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.

17. Goods or services will be found to be in a competitive relationship only where one is substitutable for the other.⁵

18. 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 [or services]. 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:

⁴ *British Sugar Plc v James Robertson & Sons Ltd* [1996] R. P. C. 281, pp 296-297.

⁵ *Lidl Stiftung & Co KG v EUIPO*, Case T-549/14.

“...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”.

19. 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.”

20. The goods to be compared are as follows:

Opponent's marks:	Applied-for mark:
<p>i) UK00001407222</p> <p>Class 18</p> <p><i>Umbrellas; parasols and walking sticks; all included in class 18.</i></p>	<p>Class 18</p> <p><i>Leather; imitations of leather; carrying bags; umbrellas; parasols; walking sticks.</i></p>

<p>ii) UK00002485495</p> <p>Class 18</p> <p><i>Umbrellas, parasols and walking sticks; handles for umbrellas, parasols and walking sticks; walking seats.</i></p>	
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21. I will make my comparison with reference to the Holder's goods. The comparison will be made against the Opponent's registration UK00002485495, noted at ii) above, owing to the fact that the class 18 specification is wider than that for the registration UK00001407222, and both the earlier marks are the same.

22. It is self-evident that the Holder's terms *umbrellas; parasols; and walking sticks* are identical to the Opponent's *Umbrellas, parasols and walking sticks*.

23. I group together the Holder's *leather and imitations of leather. Imitations of leather* are, by definition, substitutes for *leather*. I compare these goods against the Opponent's term *handles for umbrellas, parasols and walking sticks*.

24. The Holder's *leather and imitations of leather* are materials from which other goods are made; including saddlery and tack, clothing, footwear, luggage, straps, to name but a few. These materials are also often used to upholster furniture or the interiors of vehicles. The purpose of the Opponent's goods is different. *Handles for umbrellas, parasols and walking sticks* have the very specific purpose of functioning as the components which enable the user (of the umbrella, parasol or walking stick) to grip the object. The methods of use will also differ; *leather and imitations of leather*, as materials from which other goods are fashioned, will be cut, shaped or embellished, whereas the Opponent's *handles* are finished goods, albeit components, to be fitted to other goods. I consider users of the respective goods to overlap somewhat; purchasers of either goods will predominantly be professional purchasers, i.e. manufacturers, although I recognise that most purchasers of the Applicant's *handles* will be in the business of producing walking sticks, umbrellas or parasols.

25. The physical nature of the goods will differ to the extent that *leather* and *imitations of leather* are the materials from which other goods are fashioned (or, in the case of upholstery, the materials used to upholster) whereas, as noted above, *handles* are finished components i.e. they will not be fashioned into anything else (although they form part of a finished good e.g. an umbrella). However, I recognise that umbrella and parasol handles are often made from *leather* or *imitations of leather*. The handles of walking sticks are also sometimes made from these materials, though perhaps less often.
26. *Leather* will be purchased from leather merchants; *imitations of leather* can be purchased from fabric suppliers. These materials will be purchased from either physical premises, e.g. a warehouse or shop, or ordered online. I consider that *handles for umbrellas, parasols and walking sticks* will be purchased from businesses which specialise in supplying such articles to manufacturers, also from physical premises or online. I do not consider it likely that the Holder's *handles* will be purchased from the same outlets selling *leather* or *imitation leather*. Overlap in trade channels is, in my view, unlikely.
27. I do not find the respective goods to be in a competitive relationship. Although many *handles for umbrellas, parasols and walking sticks* will be made from *leather* or an *imitation of leather*, I do not find them to be complementary because the average purchaser will not expect them to be sold by the same undertaking.
28. Consequently, I find the Holder's *leather* and *imitations of leather* and the Opponent's *handles for umbrellas, parasols and walking sticks* to be dissimilar. This represents the strongest comparison between the Holder's *leather* and *imitations of leather* and the Opponent's goods. It is therefore unnecessary for me to compare this term with any other of the Opponent's goods.
29. I now compare the Holder's *carrying bags* against the Opponent's *umbrellas, parasols and walking sticks*. The purposes of the respective goods are distinct: *carrying bags* are receptacles enabling the user to carry items around with them easily, whereas the Opponent's goods are used to protect oneself from the rain (umbrellas) or sun (parasols) or to steady oneself when walking (walking sticks). I

recognise that in the case of walking sticks, the average consumer is most likely someone whose mobility is impaired by reason of age, illness or injury (although it is acknowledged that individuals not so encumbered may also use walking sticks e.g. when hiking over uneven terrain). The average consumers for *umbrellas* and *parasols* will be members of the general public seeking to protect themselves from the rain or sun; users of *walking sticks* will be seeking to steady themselves while walking. Users of *carrying bags*, on the other hand, will be seeking a receptacle to carry items around in. The physical nature of the goods will differ: *carrying bags* are often made of flexible materials; *umbrellas*, *parasols* and *walking sticks* are rigid objects whose central structure is a 'stick'. I consider trade channels to overlap. Both sets of goods will be found in physical shops or online. In physical shops, *carrying bags* are often found near or in the same section as *umbrellas* and *parasols* (e.g. in the 'Accessories' section of a department store). I find the respective goods to be neither competitive nor complementary.

30. Consequently, I find the Holder's *carrying bags* and the Opponent's *umbrellas*, *parasols* and *walking sticks* to similar to a low degree. This represents the strongest comparison between the Holder's *carrying bags* and the Opponent's goods. I do not consider it necessary to compare *carrying bags* to any other of the Opponent's goods.

Average consumer and the purchasing act

31. 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 Schuhfabrik Meyer*, Case C-342/97.

32. In *Hearst Holdings Inc*⁶ Birss J. described the average consumer thus:

⁶ *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).

“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 word “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

33. I consider the average consumers of *umbrellas; parasols; and walking sticks*, terms included in both parties’ specifications, to be the general public. The purchasing act will be primarily visual, the goods being self-selected from the shelves/displays in physical shops. In some instances, there will be an aural aspect e.g. by way of requests to retail staff. Goods will be purchased with an average level of attention. Factors considered might include durability, in the case of umbrellas and parasols, and, in the case of *walking sticks*, the height of the item.

34. My observations concerning the average consumer and their attention level, set out at [33] above, also apply to the Holder’s *carrying bags*. Factors considered before purchasing these goods will include durability and size.

35. In my view, the average consumers of the Holder’s *leather and imitations of leather*, and the Opponent’s *handles for umbrellas, parasols and walking sticks*, will, in most cases, be the professional public e.g. manufacturers of leather goods or *umbrellas, parasols and walking sticks*. Their attention level will therefore be high because the professional purchaser will be buying in bulk and will need to consider carefully the suitability of the goods for their manufacturing needs. A small number of average consumers may be the general public e.g. to replace a broken umbrella handle; or to obtain leather or imitation leather for a craft project.

Comparison of the marks

FOX	
Opponent's (earlier) mark	Holder's (contested) mark

36. 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 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.”

37. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks, and to give due weight to any other features which are not negligible and, therefore, contribute to the overall impressions created by the marks.

38. The Opponent's mark comprises the single word 'FOX' in a plain font, all characters of uniform size and in upper case. The overall impression resides in the mark in its entirety.

39. The Holder's mark comprises the single word 'FOXX' rendered in a plain font, all characters being of uniform size and in upper case. All characters are in white and heavily emboldened, set against a solid black background. The letters 'XX' are conjoined; where the conjoining of these letters would ordinarily create a diamond-shaped aperture between them, there is, instead, a small device that resembles the head of a fox. The negative space in the lower part of the final 'X' is curved to form the tail of the fox. The overall impression resides in the mark in its entirety, the word 'FOXX' having greater prominence owing to its size. The fox device will play a lesser visual role by virtue of its smaller size and its incorporation as the aperture between the two conjoined 'Xs'.

40. Visual comparison

The first three letters of each word mark, i.e. 'FOX', are identical. The points of difference are:

- The presence of the additional 'X' in the Holder's mark, absent from the Opponent's mark;
- The word 'FOXX' in the Holder's mark is in white, heavily emboldened and set against a black background, whereas as the Opponent's 'FOX', in plain black font, appears without a background.
- The presence of the fox device in the Holder's mark, as described above at [39], absent from the Opponent's mark.

41. Consequently, I find that the level of visual similarity between the respective marks is at least medium.

42. Aural comparison

The respective marks will be aurally identical, both being articulated as 'FOX'. The presence of the double 'X' in the Holder's mark will not be discerned aurally.

43. Conceptual comparison

Dealing with the Opponent's mark first, 'Fox' is a common word in the English language. The dictionary⁷ defines 'fox' as:

- A noun denoting 'a wild mammal belonging to the dog family that has a pointed face and ears, a wide tail covered in fur, and often reddish-brown fur;
- A noun denoting a person 'clever and good at deceiving'; or
- A verb meaning to confuse or deceive.

44. I also recognise that 'Fox' is not uncommon as a surname in the UK.

45. In my view, most average consumers would perceive 'FOX' as referring to the wild animal described above, at [43]; I consider the other two uses of the word to occur less often. To my mind, 'FOX', as a mark for the class 18 goods in respect of which it is registered (all of which are intended for outdoor use), would, for the average consumer, conjure the idea of the countryside and outdoor activities e.g. walking or attending agricultural or rural events. Foxes have long been associated with the countryside (though some are indeed urban dwellers), most controversially, in the context of hunting with horses and hounds, and often feature in designs with a 'country' theme.

46. I now turn to the Holder's mark. I consider that a very large majority of average consumers will see the word 'FOX' within the mark 'FOXX'. I do not consider the presence of the extra 'X' to diminish the extent to which the idea of a fox i.e. the wild mammal, is conveyed. Although, as noted above at [39], the fox device will play a lesser visual role, to the extent that the word 'FOXX' will be read first, it will nevertheless be discerned visually. Many average consumers will recognise the device as depicting a fox (or, at least, a canine creature), but even if it were not so recognised, the unusual shape cut by the device between the two 'Xs' lends a degree of separation between 'FOX' and the final 'X' in the word 'FOXX'. In my

⁷ <https://dictionary.cambridge.org/dictionary/english/fox>, accessed 7 June 2021 at 12:31.

view, the extra 'X' will be perceived by many average consumers merely as a design feature included for purely aesthetic reasons i.e. to facilitate the inclusion of the fox device by enabling the fox head and tail to be seen while retaining the black and white scheme. I consider the Holder's mark to convey the same concept of countryside and outdoor life underlined above at [45]. The fox device reinforces the concept of the word. Consequently, I find the respective marks to be conceptually identical.

Distinctive character of the earlier mark

47. *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).”

48. The Opponent's mark neither describes nor alludes to the class 18 goods in respect of which it is registered. 'FOX' is a dictionary word, not an invented one. Consequently, I find that the earlier mark is inherently distinctive to a medium degree. In the absence of any evidence from the Opponent, I am unable to consider whether there has been any use which might have enhanced the distinctive character of the mark.

Likelihood of confusion

49. Confusion can be direct or indirect. Mr Ian Purvis Q. C., as the Appointed Person, explained the difference in the decision of *L.A. Sugar Limited v By Back Beat Inc*⁸. Direct confusion occurs when one mark is mistaken for another. In *Lloyd Schuhfabrik*⁹, the CJEU recognised that the average consumer rarely encounters the two marks side by side but must rely on the imperfect picture of them that he has in his mind. Direct confusion can therefore occur by imperfect recollection when the average consumer sees the later mark before him but mistakenly matches it to the imperfect image of the earlier mark in his 'mind's eye'. Indirect confusion occurs when the average consumer recognises that the later mark is indeed different from the earlier mark, but, concludes that the later mark is economically linked to the earlier mark by way of being a 'sub brand', for instance.

50. Before arriving at my decision, I must make a global assessment taking into account all of the relevant factors, including the principles a) – k) set out above at [11].

51. When considering all relevant factors 'in the round', I must bear in mind that a greater degree of similarity between goods *may* be offset by a lesser degree of similarity between the marks, and vice versa.

⁸ Case BL O/375/10 at [16].

⁹ *Lloyd Schuhfabrik Meyer and Co GmbH v Klijsen Handel BV* (C-34297) at [26].

52. My comparison of the respective goods has determined that:

- The following goods are **identical** with the Opponent's goods:
Umbrellas; parasols; and walking sticks.
- The following goods are **similar to** the Opponent's goods to a **low degree**:
carrying bags.
- The following goods are **dissimilar** to the Opponent's goods:
Leather; Imitations of leather.

53. My comparison of the marks has determined that:

- The level of visual similarity between the marks is at least medium;
- The marks are aurally identical;
- The marks are conceptually identical.

54. I have found that the Opponent's mark is inherently distinctive to a medium degree. The CJEU held in *Sabel*¹⁰ that:

“24. The more distinctive the earlier mark, the greater will be the likelihood of confusion.”¹¹

¹⁰ *Sabel BV v Puma AG* (C-251/95), [1998] E. T. M. R. 1 (1997) at [24].

¹¹ This principle was given an important qualification by Mr Iain Purvis Q.C, as the Appointed Person, in the decision of *Kurt Geiger v A-List Corporate Limited* BL O-075-13:

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

55. I find that a significant proportion of average consumers would confuse the marks. The marks are conceptually identical. The Opponent's mark 'FOX' is wholly incorporated into the Holder's mark 'FOXX'. The presence of the additional 'X' does not, in my view, result in the Holder's mark conveying a different concept from that conveyed by the Opponent's mark. The fox device does not carry as much visual weight as the word element of the mark, owing to its small size. In these circumstances, it is my view that when the average consumer tries to recall the Holder's mark, the additional 'X' and fox device may be forgotten and therefore missing from the image in the 'mind's eye'. I find this to be the case even where the goods are purchased with a high level of attention.

56. I also conclude that, even if the average consumer *does* recall that the later mark is different from the applied-for mark, there will be *indirect* confusion. I consider that the presence of the fox device and the extra 'X' would lead some average consumers to presume that the Holder's mark was simply another variation of the Opponent's mark or a sub-brand of the overarching house brand 'FOX'. Consequently, I find that some average consumers will note the differences between the respective marks but conclude that the marks relate to economically-linked undertakings.

Final Remarks

57. The Opposition has been partially successful. The application for registration is therefore refused in respect of the following goods only:

umbrellas; parasols; walking sticks; carrying bags

The application may proceed to registration in respect of the following goods only:

Leather; imitations of leather.

COSTS

58. I award the Opponent the sum of **£400** as contribution towards its costs, calculated as follows¹². A reduction of one-third has been applied to take account of the Opponent's partial success i.e. four out of the six terms in respect of which registration of the mark has been sought:

Preparation of statement and consideration of the Holder's statement:	£200
Official fee for 5(2)(b) only:	£100
Written Submissions	£300
Sub-total:	£600
One-third reduction	- £200
Total:	£400

59. I therefore order Autobahn Tank & Rast GmbH to to pay to Fox Umbrellas Limited **the sum of £400**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 11th day of June 2021

Mx N. R. Morris
For the Registrar,
the Comptroller-General

¹² Based upon the scale published in Tribunal Practice Notice 2/2016.