

**O-1095-22**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. UK00003666215**

**BY JEMI VENTURES LIMITED**

**TO REGISTER:**

**FORGED**

**AS A TRADE MARK IN CLASSES 25, 30 AND 32**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 430200**

**BY TECNICA GROUP S.P.A.**

## Background & Pleadings

1. On 8 July 2021, Jemi Ventures Limited (“the applicant”) applied to register the trade mark **FORGED** in the United Kingdom. The applicant seeks registration for the following goods<sup>1</sup>:

*Class 25: Clothing, footwear, headwear.*

*Class 30: Coffee, tea, cocoa and artificial coffee; rice, pasta and noodles; pizzas; tapioca and sago; flour and preparations made from cereals; bread, pastries and confectionery; chocolate; ice cream, sorbets and other edible ices; sugar, honey, treacle; yeast, baking-powder; salt, seasonings, spices, preserved herbs; vinegar, sauces and other condiments; ice (frozen water).*

*Class 32: Beers; non-alcoholic beverages; mineral and aerated waters; fruit beverages and fruit juices; syrups and other non-alcoholic preparations for making beverages.*

The application was published for opposition purposes on 29 October 2021.

2. On 14 January 2022, Tecnica Group S.p.A. (“the opponent”) opposed the application, in part, under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against the goods applied for in class 25 only and, for the purpose of the opposition, the opponent relies upon the following comparable mark and the following goods for which it is registered, as laid out below:

United Kingdom Trade Mark (“UKTM”) 916903809<sup>2</sup>

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<sup>1</sup> The record shows a Form TM21B was filed on 18 October 2022 requesting deletion of all services in class 33. The form was processed on the same date and the parties were advised that the proceedings were to continue.

<sup>2</sup> On 1 January 2021 the UK left the EU. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable trade marks for all right holders with an existing EU trade mark (“EUTM”). As a result of the opponent’s EUTM number 16903809 being registered before the end of the transition period, a comparable UKTM (the earlier mark) was created. Comparable trade marks are recorded on the UK trade marks register and retain their EU filing date. They are enforceable rights in the UK, consisting of the same sign, for the same goods or services.

# FORGE

Filing date: 21 June 2017

Registration date: 17 October 2017

*Class 25: Leisure shoes and sports shoes; Ski boots; Walking shoes; Running shoes; Footwear for trail running; Climbing sportswear, including shirts, jerseys, T-shirts, jumpers (pullovers), sweaters, cardigans, windcheaters, trousers, shorts, blouses, skirts, gloves, scarves, coats, camisoles, jackets (clothing), waterproof clothing and socks; Hats and caps.*

3. The opponent contends that there exists a likelihood of confusion, including a likelihood of association, on the part of the public, due to the high visual, aural and conceptual similarity between the respective marks and the identity or similarity between the parties' goods, particularly given the effects of imperfect recollection.

4. In its counterstatement, the applicant denies that the respective trade marks are highly similar and instead contends that they can be "readily distinguished", such that there would be no likelihood of confusion.

5. The applicant is represented by FRKelly and the opponent by Keltie LLP. Neither party filed evidence during the evidential rounds and, on conclusion of the evidence rounds, both parties were given the opportunity to request a hearing or file written submissions in lieu, and both declined to do either.

6. 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 my decision will continue to make reference to the trade mark case law of EU courts.

## Decision

7. 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.”

8. Under the provisions laid out in section 6 of the Act, the opponent’s trade mark clearly qualifies as an earlier mark. In accordance with section 6A of the Act, as it had not completed its registration procedure more than five years prior to the filing date of the applicant’s mark, it is not subject to the proof of use requirements. Consequently, the opponent can rely upon its earlier mark and all goods for which it is registered without providing evidence of use.

### **Section 5(2)(b) - Case law**

9. 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 Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case C-3/03, *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

### **The principles:**

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

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

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

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

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### **Comparison of goods**

10. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut fur Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

11. The above case makes clear that goods (or services) which are encompassed by a broader term in the competing specification are to be considered identical, even if they are not literally so. Applying that principle, I find the opponent’s *leisure shoes and sports shoes; ski boots; walking shoes; running shoes and footwear for trail running* encompassed by, and therefore identical to, the applicant’s *footwear*. I find the opponent’s *climbing sportswear, including shirts, jerseys, T-shirts, jumpers (pullovers), sweaters, cardigans, windcheaters, trousers, shorts, blouses, skirts, gloves, scarves, coats, camisoles, jackets (clothing), waterproof clothing and socks* identical to the applicant’s *clothing*. Finally, I find the opponent’s *hats and caps* identical to the applicant’s *headwear*.

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

12. 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 in question<sup>3</sup>. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc*,

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<sup>3</sup> *Lloyd Schuhfabrik Meyer*, Case C-342/97

*Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

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

13. In *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03, the GC stated that:

“49. However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (*BUDMEN*, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumer choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs.”

And

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

14. The average consumer of the goods at issue here is likely to be a member of the general public. Members of the general public will generally self-select the goods from the shelves of a traditional retail establishment or an online equivalent. As the above case law suggests, the marks’ visual impression is consequently likely to carry the greater weight during the purchasing process. However, I do not overlook the relevance of the marks’ aural impressions as the consumer could seek guidance from a sales representative or a peer, for example. The goods can widely vary in price and can be selected fairly frequently, with the consumer likely to be alive to factors including quality, compatibility and sustainability. Weighing all factors, I find the average consumer will typically apply a medium degree of attention to its selection of the relevant goods.

### **Comparison of trade marks**

15. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union (“CJEU”) stated in *Bimbo SA v OHIM*, Case C-591/12P, 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.”



16. 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.

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

<b>Opponent's mark</b>	<b>Applicant's mark</b>
<b>FORGE</b>	<b>FORGED</b>

18. The opponent's mark comprises a single word of five letters. In the absence of any additional components, its overall impression resides solely in the word itself.

19. The applicant's mark comprises a single word of six letters. The mark's overall impression lies solely in that word.

20. Visually, the five letters which make up the opponent's mark are identical to the first five letters of the applicant's mark. The later mark ends in a final letter 'D', and this represents the only visual difference between the respective trade marks. Generally speaking, the beginnings of marks tend to make more of an impression on the consumer than their endings, though I accept this is just a rule of thumb. Still, in this case, I find the visual similarity to be of a high degree.

21. Each mark comprises an ordinary dictionary word which the average consumer will be well accustomed to articulating. The earlier mark will be articulated in one syllable; FORGE, and the later mark will also be articulated in one syllable; FORGED. Aside from the percussive effect of the 'D' in the applicant's mark, positioned at the end, I find the parties' marks are aurally highly similar.

22. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.<sup>4</sup> As I've said, each mark comprises an ordinary dictionary word and, to my mind, the average consumer will readily identify a concept in each. FORGE is likely to be understood as meaning to create or bind something together, to forge a relationship, for example, and FORGED will likely evoke the same meaning simply in the past tense. I find the marks' conceptual similarity fairly high.

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

23. 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

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<sup>4</sup> *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R 29

commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

24. Registered trade marks possess varying degrees of inherent distinctive character. These range from the very low, such as those which are suggestive or allusive of the goods or services for which they are registered, to those with high inherent distinctive character, such as invented words. Dictionary words which do not allude to the goods or services will typically fall somewhere in the middle. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; generally, the more distinctive the earlier mark, the greater the likelihood of confusion. The distinctive character of a mark may be enhanced as a result of it having been used in the market.

25. Given that the opponent has not made a pleading of enhanced distinctiveness, and in the absence of evidence showing the use made of the earlier mark, I have only its inherent distinctiveness to consider. Whilst the earlier mark may comprise an ordinary, dictionary word, I do not consider it to have any apparent relationship to the goods on which the opponent relies; it has no descriptive nor allusive connotation. On balance, I find the earlier mark’s inherent distinctiveness to be of a medium degree.

### **Likelihood of confusion**

26. 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.

27. 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.

28. I take note of the comments made by Mr Iain Purvis Q.C., as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, where 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)”.

29. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

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

31. I will begin by considering a likelihood of direct confusion. I have found that the parties’ respective goods are identical and that the parties’ trade marks are visually and aurally similar to a high degree, with both the visual and aural impact relevant to the purchasing process (with greater weight going to the visual impression). The marks also share a fairly high degree of conceptual similarity. I have further found that the average consumer will likely apply a medium degree of attention when approaching its selection of the goods. Particularly keeping in mind the effects of imperfect recollection, those factors coupled together, in my view, will likely result in the average consumer mistaking one mark for the other. In other words, direct confusion will occur.

32. As I have found a likelihood of direct confusion, it is not strictly necessary for me to go on to consider a likelihood of indirect confusion. However, if I were to express a brief opinion on the matter, I find that the average consumer would be minded to erroneously conclude that the parties’ marks originate from a shared or related undertaking, in light of the marks’ conceptual similarity and that they are intended for use on identical goods. The marks’ similarities may not be consistent with the examples identified in *L.A. Sugar*, however these are not intended to be exhaustive. In the context of the goods at issue, it is not, in my experience, particularly unusual for brands to offer multiple ranges, for example, and the relationship between the marks, one being an ordinary word expressed in the present tense, and the other the same word simply expressed in the past tense, I find it likely that the consumer would be

indirectly confused (though I maintain that I find direct confusion the most likely outcome).

## Conclusion

36. The opposition has succeeded and, subject to any successful appeal, the application will be refused in respect of the following goods in class 25:

*Clothing, footwear, headwear*

37. The application will proceed to registration in respect of:

*Class 30: Coffee, tea, cocoa and artificial coffee; rice, pasta and noodles; pizzas; tapioca and sago; flour and preparations made from cereals; bread, pastries and confectionery; chocolate; ice cream, sorbets and other edible ices; sugar, honey, treacle; yeast, baking-powder; salt, seasonings, spices, preserved herbs; vinegar, sauces and other condiments; ice (frozen water).*

*Class 32: Beers; non-alcoholic beverages; mineral and aerated waters; fruit beverages and fruit juices; syrups and other non-alcoholic preparations for making beverages.*

## Costs

38. The opponent has succeeded and is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (“TPN”) 2/2016. In accordance with that TPN, I award costs as follows:

Filing a Notice of Opposition (official fee):	£100
Preparing a Notice of Opposition and considering the counterstatement:	£250
<b>Total:</b>	<b>£350</b>

**39. I order Jemi Ventures Limited to pay Tecnica Group S.p.A. the sum of £350. 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 12<sup>th</sup> day of December 2022**

**Laura Stephens  
For the Registrar**