

O/1129/22

TRADE MARKS ACT 1994

**IN THE MATTER OF THE REQUEST BY SINGULAR AB FOR PROTECTION IN
THE UK OF THE FOLLOWING INTERNATIONAL REGISTRATION**

WO0000001629144:



IN CLASSES 3, 8, 9, 16, 18, 20, 21, 24, 25, 28, 30, 33 AND 35

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 600002410 BY
CORTINA N. V.**

Background and Pleadings

1. On 4 March 2021, Singular AB ('the Holder') applied to protect the trade mark, shown on the cover of this Decision, number WO0000001629144 by way of International Registration designating the United Kingdom ('UK'). The Holder has claimed priority from its application in the European Union Intellectual Property Office dated 4 September 2020. The instant application was published for opposition purposes in the *Trade Marks Journal* on 25 March 2022. Registration is sought in respect of a range of goods and services in classes 3, 8, 9, 16, 18, 20, 21, 24, 25, 28, 30, 33 and 35.

2. On 17 June 2022, the application was opposed by Cortina N. V. ('the Opponent') based on section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The Opponent relies on three earlier registrations (details of which are set out below at [3]). The Opposition, in respect of all three earlier registrations relied upon, is directed against the following of the goods and services for which registration is sought:
 - All goods in classes 18 and 25;¹
and
 - Class 35 services: *Retail store services and online retail store services connected with the sale of [...] clothing, footwear, headgear, leather belts [clothing], [...] garment bags, [...], rucksacks, handbags, beach bags, shopping bags, shoulder bags, attaché-cases, briefcases, pouches, tote bags, satchels, cosmetic bags, wallets, pocket wallets, purses, key-holders, umbrellas, leather, travelling bags made of imitation leather, [...] trunks [luggage], valises, wallets including cardholders, athletic bags, sports bags, all purpose sports bags, duffle bags, knapsacks, backpacks [...].*

3. The Opponent relies on the following three earlier registrations:

¹ The Opponent's arguments subsequently set out in its statement of case in respect of the Holder's class 9 goods will be disregarded because, at the outset, at Q11 of its Form TM7F, the Opponent has stated that the Opposition is directed against classes 18, 25 and part of class 35, only.

i) Earlier registration UK00917910294



Filing date: 1 June 2018

Date of entry in register: 27 September 2018

Registered for a range of goods and services in classes 18, 25 and 35.²

The Opponent relies on all of its goods and services.

ii) Earlier registration UK00917911081



Filing date: 1 June 2018

Date of entry in register: 25 September 2018

Registered for the same goods and services as registration i) UK00917910294.³

The Opponent relies on all of its goods and services.

iii) Earlier registration UK00917910298



SPROX

Filing date: 1 June 2018

² Set out below in the section on 'Comparison of Goods and Services'.

³ The specifications for all three of the Opponent's earlier marks are identical save for the presence of the word 'clothing' in parenthesis after certain terms within the class 25 specification for registration UK00917910294. This additional text has no consequence for the purposes of comparing the parties' goods and services.

Date of entry in register: 25 September 2018

Registered for the same goods and services as registration i) UK00917910294.

The Opponent relies on all of its goods and services.

4. The Opponent claims that:

- the parties' respective marks are highly visually similar;
- the parties' respective goods and services are highly similar/identical;
and
- that there is a likelihood of confusion between the parties' marks.

5. The Holder filed a Defence and Counterstatement in which it denies the claim against it in its entirety.⁴

6. The Opponent is represented by KOB NV; the Holder is represented by Rouse AB.

7. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Marks Rules 2008, but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

8. The net effect of these changes is to require parties to seek leave in order to file evidence in fast track oppositions. No leave was sought in respect of these proceedings.

9. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be

⁴ The Holder has subsequently conceded in its written submissions that '[...] some, but not all, of the Goods and Services' have 'a low degree of similarity', however it has not specified which goods have a low level of similarity, paragraph 10.4.1 of the Holder's written submissions in lieu of a hearing.

taken. A hearing was neither requested nor considered necessary. Only the Holder has filed written submissions in lieu of a hearing.

10. The following decision has been made after careful consideration of the papers before me.

Decision

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

11. 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.”

12. In accordance with section 6 of the Act, the Opponent’s three marks are earlier marks by virtue of their filing dates (1 June 2018, in each case) which fall before the date from which the Holder claims priority for its International Registration (4 September 2020).

13. Section 6A of the Act provides that where the date on which the registration procedure of the earlier mark was completed more than 5 years prior to the application date (or priority 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 not engaged because each of the Opponent’s marks had been registered for less than 5 years on the date from which the Holder claims priority for its International

Registration. The Opponent is therefore entitled to rely upon all of the goods that it seeks to rely upon.

14. The following principles are derived from the decisions of the Court of Justice of the European Union⁵ (“CJEU”) 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 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;

⁵ 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.

(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

15. 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.”

16. In making an assessment between the competing goods and services, I bear in mind the decision of the General Court (‘GC’) in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05:

“29. ... 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 für 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”.

17. The CJEU in *Canon*, Case C-39/97, stated:

“[23] “In assessing the similarity of the goods or services concerned [...] 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”.

18. Goods or services will be found to be in a competitive relationship only where one is substitutable for the other.⁶ In *Boston Scientific Ltd v OHIM*, Case T-325/06, the General Court described “complementary” in the following terms: “[...] 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”.⁷ In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous

⁶ *Lidl Stiftung & Co KG v EUIPO*, Case T-549/14.

⁷ Paragraph 82

criterion capable of being the sole basis for the existence of similarity between goods.

19. Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281,⁸ 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.

20. For the purpose of considering the issue of similarity of goods (or services), it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way for the same reasons.⁹

21. The goods and services to be compared are as follows:

Opponent's earlier marks: ¹⁰	Holder's contested mark:
Class 18:	Class 18:

⁸ *British Sugar Plc v James Robertson & Sons Ltd* [1996] R. P. C. 281, pp 296-297.

⁹ *Separode Trade Mark* BL O-399-10 and *BVBA Management, Training en Consultancy v BeneluxMerkenbureau* [2007] ETMR 35 at paragraphs 30 to 38.

¹⁰ The goods and services specifications are the same for all three earlier rights relied upon.

<p><i>Leather and imitation leather; Casual bags; Handbags; Travelling bags; Shoulder bags; Travelling sets (Letherware) [sic]; Satchels; Portfolio cases [briefcases]; Suitcases; Traveling trunks; Purses; Purses; Wallets; Suitcases; Vanity cases, not fitted; Shopping bags; Boxes of leather or leatherboard; Trunks [luggage]; Card wallets [leatherware]; Garment carriers; Backpacks; Beach bags; Key cases; Sport bags; Weekend bags; Credit-card holders; Animal skins, hides.</i></p>	<p><i>Travelling sets; suitcases; garment bags; boxes of leather or leather board; rucksacks; handbags; beach bags; shopping bags; shoulder bags; attaché-cases; briefcases; pouches; tote bags; satchels; cosmetic bags; wallets; pocket wallets; purses; umbrellas; leather; travelling bags made of imitation leather; imitations of leather; trunks [luggage]; valises; wallets including card holders; athletic bags; sports bags; all purpose sports bags; duffle bags; knapsacks; backpacks; wrist mounted carryall bags; key holders being key cases.</i></p>
<p><i>Class 25: Footwear; Insoles; Shoe soles; Belts [clothing]; Belts [clothing]; Socks and stockings; Clothing; Headgear; Shawls; Gloves [clothing]; Sportswear and boots for sports, other than for fishing.</i></p>	<p><i>Class 25: Clothing; footwear; headgear; leather belts [clothing].</i></p>
<p><i>Class 35: Arranging the buying of goods for others; Purchasing agency services; Telephone order-taking services for others; Stock control services; Administration of sales promotion incentive programs; Administration of the business affairs of retail stores; Administration of the business affairs of franchise; Ordering services for third parties; Clerical services for the taking</i></p>	<p><i>Class 35: Retail store services and online retail store services connected with the sale of [...] clothing, footwear, headgear, leather belts [clothing], [...] garment bags, [...], rucksacks, handbags, beach bags, shopping bags, shoulder bags, attaché-cases, briefcases, pouches, tote bags, satchels, cosmetic bags, wallets, pocket wallets, purses, key-holders, umbrellas, leather, travelling bags made of imitation leather, [...] trunks</i></p>

<p><i>of sales orders; Administrative data processing; Administrative order processing; Administrative processing of purchase orders; Administrative processing of purchase orders within the framework of services provided by mail-order companies; Administrative processing and organising of mail order services; Advice and information concerning commercial business management; Management advisory services related to franchising; Business management consulting; Business advice relating to marketing; Business planning consultancy; Advice in the field of business management and marketing; Advisory services relating to commercial transactions; Advisory services relating to electronic data processing; Arranging of buying and selling contracts for third parties; Business consultancy, in the field of transport and delivery; Computerized file management; Management of customer loyalty, incentive or promotional schemes; Mediation of agreements regarding the sale and purchase of goods; Arranging of commercial and business contacts; Mediation of contracts for purchase and sale of products; Business management for shops; Business</i></p>	<p><i>[luggage], valises, wallets including cardholders, athletic bags, sports bags, all purpose sports bags, duffle bags, knapsacks, backpacks [...].</i></p>
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networking services; Provision of information concerning commercial sales; Retailing in relation to clothing, clothing accessories, sportswear and boots for sports, other than for fishing; Mail-order retailing in the field of footwear, shoe soles and insoles, clothing, clothing accessories, sportswear and boots for sports, other than for fishing; Retailing using global computer networks in the field of footwear, shoe soles and insoles, clothing, clothing accessories, sportswear and boots for sports, other than for fishing; Demonstration of goods for promotional purposes; Catalogue retailing in the field of footwear, shoe soles and insoles, clothing, clothing accessories, sportswear and boots for sports, other than for fishing; Retailing in the field of footwear, shoe soles and insoles; Import-export agency services; Electronic order processing; Electronic commerce services, namely providing information about products via telecommunication networks and for advertising and sales purposes; Wholesaling in the field of footwear, shoe soles and insoles, clothing, clothing accessories, sportswear and boots for sports, other than for fishing; Import and export services; Internet

<p><i>marketing; Online retailing relating to footwear, shoe soles and insoles; Online ordering services; Online retailing in the field of clothing, clothing accessories, sportswear and boots for sports, other than for fishing; Presentation of goods on communication media, for retail purposes; Advertising services relating to the sale of goods; Sales promotion; Sales administration; Business management and wholesaling and retailing.</i></p>	
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Class 18

22. The following of the Holder's terms also appear in the Opponent's specifications: *suitcases; boxes of leather or leather board; handbags; beach bags; shopping bags; shoulder bags; satchels; purses; wallets; trunks [luggage]; sports bags¹¹; backpacks*. The parties' goods are therefore self-evidently identical.
23. The Holder's *Travelling sets* will encompass the Opponent's *Travelling sets (Letherware)* [sic]. These goods are 'Merix' identical.
24. The Holder's *garment bags* will be encompassed by the Opponent's *Garment carriers*. These goods are 'Merix' identical.
25. The Holder's *briefcases* will encompass the Opponent's *Portfolio cases [briefcases]*. These goods are 'Merix' identical.
26. The Holder's *all purpose sports bags* will be encompassed by the Opponent's *Sport bags*. These goods are 'Merix' identical.

¹¹ The corresponding term in the Opponent's specifications is *sport bags*; the pluralisation of 'sports' in the Holder's term is of no consequence.

27. The Holder's *valises*¹² will be encompassed by the Opponent's term *Suitcases*. These goods are 'Meric' identical.
28. The Holder's *attaché-cases* are synonymous with the Opponent's *Portfolio cases [briefcases]*. These goods are 'Meric' identical.
29. The Holder's *rucksacks* and *knapsacks* are synonymous with the Opponent's *Backpacks*. These goods are 'Meric' identical.
30. The Holder's *travelling bags made of imitation leather* will be encompassed by the Opponent's *Travelling bags*. These goods are 'Meric' identical.
31. The Holder's *pocket wallets* will encompass the Opponent's *Card wallets [leatherware]*. These goods are 'Meric' identical.
32. The Holder's *wallets including card holders* is identical to the Opponent's *wallets* and will also be encompassed by the Opponent's term *Credit-card holders*. These goods are 'Meric' identical.
33. The Holder's term *key holders being key cases* is synonymous with the Opponent's term *Key cases*. These goods are 'Meric' identical.
34. The Holder's *tote bags* will be encompassed by the Opponent's *Shoulder bags*. These goods are 'Meric' identical.
35. The Holder's *leather* will be encompassed by the Opponent's *Animal skins, hides*. These goods are 'Meric' identical.
36. The Holder's *athletic bags* are, in my view, synonymous with the Opponent's *Sport bags*. These goods are 'Meric' identical.

¹² A valise is a small travelling suitcase.

37. The Holder's *duffle bags* will, in my view, fall under several of the Opponent's terms: *Casual bags*; *Beach bags* and *Weekend bags*. These goods are 'Merix' identical.
38. The Holder's term *imitations of leather* will be encompassed by the Opponent's *Leather and imitation leather*. These goods are 'Merix' identical.
39. The Holder's term *wrist mounted carryall bags* will, to my mind, be encompassed by the Opponent's *Casual bags*. These goods are 'Merix' identical.
40. I compare the Holder's term *cosmetic bags* to the Opponent's *Vanity cases, not fitted*. The respective goods will overlap in purpose to the extent that both are intended as receptacle for cosmetic items. Methods of use will differ to the extent that vanity cases include an integrated mirror so that the user can apply makeup, whereas *cosmetic bags* are, in most cases, mere receptacles. Users will overlap; both goods will be used by consumers of cosmetics. The goods will differ in nature to the extent that *cosmetic bags* will be composed of fabric or some such soft/flexible material, whereas *vanity cases* will tend to be made of rigid materials. I consider that trade channels will often be shared. In my view, the respective goods will be in a competitive relationship in some instances; one might deliberate over whether to purchase a cosmetics bag or a vanity case to store one's cosmetic items. The respective goods are not complementary; although the average consumer may presume both goods to originate from the same undertaking, neither good is necessary or important for each other. I find the goods to have a medium-high level of similarity.
41. I compare the Holder's **pouches** to the Opponent's term **Purses**. In my view, a 'pouch' is a flexible bag-like receptacle, usually small in size, that often opens and closes by way of a drawstring. The parties' goods share a purpose to the broad extent that both are receptacles, albeit the specific purpose of a purse is to hold coins, banknotes and cards, and pouches are often used to protect the objects that they contain. Users may overlap; users of purses may also purchase pouches. Trade channels may overlap; both goods might be sold by the same retailers. The parties' goods will often have similar physical natures; they may be

fashioned out of the same sorts of materials e.g. fabric, leather. Even though, strictly speaking, a pouch may be used to hold coins and banknotes, I do not consider the respective goods to be realistic substitutes for each other. In my view, a consumer would unlikely deliberate over whether to purchase a purse or a pouch. I do not find complementarity between the goods either. I find the parties' goods to have a medium level of similarity.

42. I compare the Holder's *umbrellas* to the Opponent's *casual bags*¹³. The goods have very distinct purposes; umbrellas are used to protect the user from wet weather whereas bags function as receptacles to hold and carry objects. Users may overlap somewhat; a user of bags may also use umbrellas. Trade channels will overlap somewhat; retail outlets often sell umbrellas as well as bags. In my view, where both parties' goods are sold in the same physical shop, umbrellas are sometimes found in the same section as luggage/bags, or nearby. The goods differ greatly in terms of physical nature; *umbrellas* being wire-framed canopies affixed to a handled stick, as compared to the Opponent's bags. The goods are neither competitive nor complementary. Although an average consumer might presume both to originate from the same undertaking, neither good is necessary nor important for the other. In my view, user and trade channel overlap, without more, are insufficient to support a finding of similarity between the goods. I find the parties' goods to be dissimilar.

Class 25

43. The following of the Holder's terms also appear in the Opponent's specifications:

Clothing; footwear; headgear.

The parties' goods are therefore self-evidently identical.

44. The Holder's *leather belts [clothing]* will be encompassed by the Opponent's *Belts [clothing]*. These goods are 'Merici' identical.

Class 35

¹³ The Opponent's specification contains several types of bag, none of which is more or less appropriate as a comparator for umbrellas.

Contested services: *Retail store services and online retail store services connected with the sale of [...] clothing, footwear, headgear, leather belts [clothing], [...]*

45. I compare this term to the Opponent's term *Retailing in relation to clothing, clothing accessories, sportswear and boots for sports, other than for fishing*. The goods to which the Opponent's retail services relate are identical to the goods to which the Holder's retail services relate. The parties' services are therefore identical.

Contested services: *Retail store services and online retail store services connected with the sale of [...] garment bags, [...], rucksacks, handbags, beach bags, shopping bags, shoulder bags, attaché-cases, briefcases [...] tote bags, satchels [...] wallets, pocket wallets, purses, key-holders [...] eather, travelling bags made of imitation leather, [...] trunks [luggage], valises, wallets including cardholders, athletic bags, sports bags, all purpose sports bags, duffle bags, knapsacks, backpacks [...]*.

46. I compare these services to the Opponent's class 18 goods.

47. When comparing goods against the retailing of goods, I bear in mind *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, in which the General Court held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

48. I also note that on the basis of the European courts' judgments in *Sanco SA v OHIM*,¹⁴ and *Assembled Investments (Proprietary) Ltd v. OHIM*,¹⁵ upheld on appeal in *Waterford Wedgwood Plc v. Assembled Investments (Proprietary)*

¹⁴ Case C-411/13P

¹⁵ Case T-105/05, at paragraphs [30] to [35] of the judgment

Ltd,¹⁶ Geoffrey Hobbs QC (as he then was) sitting as the Appointed Person in the MissBoo case,¹⁷ concluded that:

- i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer's point of view, they are unlikely to be offered by one and the same undertaking;
- ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent's goods and then to compare the opponent's goods with the retail services covered by the applicant's trade mark;
- iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;
- iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

49. The Holder's services entail bringing together and making available for sale, either in physical outlets or online, the goods: *garment bags, rucksacks, handbags, beach bags, shopping bags, shoulder bags, attaché-cases, briefcases, tote bags, satchels, wallets, pocket wallets, purses, key-holders, leather, travelling bags made of imitation leather, trunks [luggage], valises, wallets including cardholders, athletic bags, sports bags, all purpose sports bags, duffle bags, knapsacks, backpacks*. I have found these goods to be identical to the Opponent's goods in class 18. The Opponent's goods are intended as receptacles for various items. The respective goods and services will therefore differ in purpose and methods of use.

¹⁶ Case C-398/07P

¹⁷ *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14; see paragraph 9 of that ruling.

There will be user overlap; purchasers of the Opponent's goods will, in many cases, necessarily also be consumers of the Holder's retail services. The goods and services are different in nature; the Opponent's goods being tangible items as compared to the Holder's acts of service. Trade channels are shared; both the Holder's retail services and the goods to which they relate will be accessed/purchased from the same physical or online stores. The respective goods and services will be complementary; the Opponent's goods are necessary in order to deliver the retail services in respect of those goods, and the average consumer may presume both to originate from the same undertaking, since it is quite normal for a retailer to sell goods under its own mark. I find the parties' goods and services to have a medium level of similarity.

Contested services: *Retail store services and online retail store services connected with the sale of [...] pouches [...] cosmetic bags [...] umbrellas [...]*



50. The goods to which the Holder's services relate are not included in the Opponent's specification. It would therefore be inappropriate to make a comparison against goods in the way set out in [49] above. I compare the Holder's services to the Opponent's term *Retailing in relation to clothing, clothing accessories, sportswear and boots for sports, other than for fishing*. The parties' services overlap in purpose to the extent that both services entail the bringing together and making available for sale of certain goods, albeit the goods in question are different. Users may overlap somewhat; users of the Holder's retail services might also use the Opponent's retail services. Trade channels might overlap in some instances; some retailers would sell 'pouches, cosmetics bags and umbrellas' as well as 'clothing, clothing accessories, sportswear and boots'. The nature of the services will be the same, albeit the services relate to different goods. I do not find the respective services to be in competition; an average consumer would not deliberate over whether to visit a retail store/website selling 'pouches, cosmetics bags and umbrellas' or one selling 'clothing, clothing accessories, sportswear and boots'. The services are not complementary, either. Although an average consumer might expect both parties' services to be offered by the same undertaking, neither service is necessary or important for the other. I find the respective services to be similar to no more than a medium degree.



Average consumer and the purchasing act

51. The average consumer is deemed to be reasonably well-informed and reasonably observant and circumspect. The word “average” denotes that the person is typical. 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*.

52. The average consumer of the goods and services in this opposition will be the general public. The purchasing act will be primarily visual. The bags and clothing will be picked up, examined or tried on before purchase, and those accessing the services will have entered a physical premises or accessed a retailer's website, before surveying the goods available for purchase. There may also be an aural aspect to the purchasing process, for instance, where a purchaser has accessed the services having first been alerted to the retailer by ‘word of mouth’. In my view, the average consumer would pay no more than a medium level of attention when accessing the services or selecting the goods, taking into account factors such as, *inter alia*: the range of goods available for sale; the size/fabric composition of the garment or suitability of the accessory, as the case may be.

Comparison of the marks

Opponent's (earlier marks)	Holder's (contested) mark
i) UK00917910294 	
ii) UK00917911081	

 <p>iii) UK00917910298</p>  <p>SPROX</p>	
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53. 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.”

54. 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.

55. The Opponent relies on three earlier marks. Marks UK00917910294 and UK00917911081 are identical, save that the former is presented in a red colour. In relation to the Opponent's mark UK00917910294, the Holder has submitted that 'the red colour serves as a visually distinguishing element'.¹⁸ While this is noted, this is an incorrect reading of the relevant law. Notional and fair use of the Holder's registration would cover use of the word in the same colour as the Opponent's red mark (UK. UK00917910294). The Court of Appeal has stated on two occasions following the CJEU's judgment in *Specsavers*, that registration of a trade mark in black and white covers use of the mark in colour.¹⁹ This is because colour is an implicit component of a trade mark registered in black and white (as opposed to extraneous matter). Thus, a black and white version of a mark should normally be considered on the basis that it could be used in any colour. Notional and fair use of the Holder's mark would include use in the same colour as the shape represented in the Opponent's mark.

56. The Opponent's marks UK00917910294 and UK00917911081 are identical figurative marks in the form of a geometric shape with a solid infill. The Opponent has described the shapes as 'two half circles and they are both placed above each other so the boarder [sic] corners touch'.²⁰ I disagree with this description. In my view, the shape consists of two halves of an ellipse, not a circle. The ellipse has been bisected through the centre on a vertical plane; the halves separated vertically such that one half is positioned at a higher level than the other, although not in alignment, and with the alternate corners touching. The overall impression resides in the mark in its entirety.

57. The Opponent's mark UK00917910298 is identical to the Opponent's earlier marks save for the presence of the word element 'SPROX' beneath the figurative element. Given that the Holder's mark consists only of a single figurative element, comparison with the Opponent's mark which has a word element will necessarily result in a greater visual distinction between the marks than comparison with the

¹⁸ Holder's written submissions in lieu of a hearing, at paragraph 9.5.5.

¹⁹ Paragraph 5 of the judgment of the Court of Appeal in *Specsavers* [2014] EWCA Civ 1294 and *J.W. Spear & Sons Ltd v Zynga, Inc.* [2015] EWCA Civ 290, at paragraph 47.

²⁰ Opponent's Statement of case, at paragraph 1.1.1.

Opponent's 'figurative only' mark. For this reason, I will not include the Opponent's mark UK00917910298 in my comparison of the marks.

58. The Holder's mark is also a figurative mark. It consists of what might be described as two halves of a 'pill' or 'capsule' shape²¹ that has been bisected diagonally through the centre, the resulting halves separated such that one half is arranged above the other with the obtuse-angled corners touching. The overall impression resides in the mark in its entirety. The shape has a solid black infill. The overall impression resides in the mark in its entirety.

Visual comparison

59. Both parties' marks are figurative marks comprised of two halves of geometric shapes with a solid infill, the halves having been moved apart but touching alternate corners. In both marks, one 'half' might be described as 'above' the other 'half'.

60. Points of visual difference are:

- In the Opponent's mark, each 'half' has just two edges/sides: a line and a curve. In the Holder's mark, each 'half' has four edges: a curve, two lines in parallel and a horizontal line.
- In the Opponent's mark, the 'halves' have been moved apart *vertically* but not in alignment i.e. one half does not lie beneath the other; whereas in the Holder's mark, the 'halves' have been moved apart *horizontally* but *are* in alignment i.e. one half lies beneath the other.

61. I find the marks to have a medium level of similarity.

Aural comparison

62. Figurative marks devoid of textual elements are incapable of articulation. There is therefore no aural comparison to be made.

²¹ A shape comprising a rectangle, the shortest sides of which have been capped off by semi-circles. An alternative description might be of a rectangle, the shortest edges of which have been chamfered.

Conceptual comparison

63. The parties are in agreement that neither party's mark conveys a concept.²² I therefore find the marks to be conceptually neutral.

Distinctive character of the earlier mark

64. 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).”

²² Holder's written submissions in lieu of a hearing, at paragraph 9.7.2; Opponent's Statement of case, at paragraph 1.1.1.

65. Registered trade marks possess varying degrees of inherent distinctive character: perhaps lower where a mark may be suggestive or allusive of a characteristic of the goods, ranging up to those with high inherent distinctive character, such as invented words which have no allusive qualities.
66. The Opponent's mark²³ will, in my view, be seen by the average consumer as a mere geometric shape which neither denotes nor calls to mind anything in particular. The mark neither describes nor alludes to the goods and services in respect of which it is registered. I do not consider the mark to be particularly striking or memorable. I find the mark to have a low level of inherent distinctive character.
67. No evidence has been submitted by the Opponent. I am therefore unable to make a finding in respect of enhanced distinctive character.

Likelihood of confusion

68. Confusion can be direct or indirect. Mr Iain Purvis Q. C., as the Appointed Person, explained the difference in the decision of *L.A. Sugar Limited v Back Beat Inc*²⁴. Direct confusion occurs when one mark is mistaken for another. In *Lloyd Schuhfabrik*²⁵, 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 they have kept in mind. Direct confusion can therefore occur by imperfect recollection when the average consumer sees the later mark but mistakenly matches it to the imperfect image of the earlier mark in their 'mind's eye'. Indirect confusion occurs when the average consumer recognises that the competing marks are not the same in some respect, but the similarities between them, combined with the

²³ The Opponent's marks UK00917910294 and UK00917911081 are identical.

²⁴ Case BL O/375/10 at [16].

²⁵ *Lloyd Schuhfabrik Meyer and Co GmbH v Klijsen Handel BV* (C-34297) at [26].

goods/services at issue, leads them to conclude that the goods/services are the responsibility of the same or economically linked undertaking.

69. I must keep in mind that a global assessment is required taking into account all of the relevant factors, including the principles a) – k) set out above at [14]. When considering all relevant factors ‘in the round’, I must bear in mind that a greater degree of similarity between goods/services *may* be offset by a lesser degree of similarity between the marks, and vice versa.

70. With the exception of the term *umbrellas* in class 12, I have found the Holder’s goods and services to have a level of similarity with the Opponent’s goods and services; ranging from identical to a medium level of similarity.

71. In my view, a significant proportion of average consumers would confuse the marks. The respective marks have a medium level of visual similarity. Because the marks are purely figurative, the marks are inarticulable, so there is no aural comparison to be made. Neither party’s mark has any conceptual aspect for the mind to fix upon. It is my view that when the average consumer encounters the Opponent’s mark, they may mistake it for the Holder’s mark (or vice versa) because the mind’s eye has failed to register or recall the visual differences between the shapes, and consumers do not compare marks side by side. The marks will, in my view, be seen by the average consumer merely as geometric shapes with a combination of lines and curves, and the differences that I have identified will escape recollection. The average consumer will pay no more than a medium degree of attention when accessing the parties’ goods and services. There is a likelihood of direct confusion based on imperfect recollection.

72. There will be no likelihood of confusion in respect of those of the Holder’s goods that I have found to be dissimilar to the Opponent’s goods or services:

Class 18: *umbrellas*.

Conclusion

73. The Opposition has been partially successful. Subject to any successful appeal:

- The request for protection of the International Registration in the UK is **refused** in respect of the following goods and services:

Class 18: Travelling sets; suitcases; garment bags; boxes of leather or leather board; rucksacks; handbags; beach bags; shopping bags; shoulder bags; attaché-cases; briefcases; pouches; tote bags; satchels; cosmetic bags; wallets; pocket wallets; purses; leather; travelling bags made of imitation leather; imitations of leather; trunks [luggage]; valises; wallets including card holders; athletic bags; sports bags; all purpose sports bags; duffle bags; knapsacks; backpacks; wrist mounted carryall bags; key holders being key cases.

Class 25: Clothing; footwear; headgear; leather belts [clothing].

Class 35: Retail store services and online retail store services connected with the sale of [...] clothing, footwear, headgear, leather belts [clothing], [...] garment bags, [...], rucksacks, handbags, beach bags, shopping bags, shoulder bags, attaché-cases, briefcases, pouches, tote bags, satchels, cosmetic bags, wallets, pocket wallets, purses, key-holders, umbrellas, leather, travelling bags made of imitation leather, [...] trunks [luggage], valises, wallets including cardholders, athletic bags, sports bags, all purpose sports bags, duffle bags, knapsacks, backpacks [...].

- The request for protection of the International Registration in the UK may proceed only in respect of the following class 18 term:

Umbrellas

COSTS

74. I award the Opponent the sum of **£400** as a contribution towards its costs, calculated as follows²⁶:

²⁶ <https://www.gov.uk/government/publications/tribunal-practice-notice-22015/tribunal-practice-notice-22015>. Costs awarded in fast track opposition proceedings are capped at £500, excluding official fees.

Preparation of statement and consideration of the Holder's statement:	£200	
Official fee for 5(2)(b) only:	£100	
Total:	£300	

75. I therefore order Singular AB to pay to Cortina N. V. the sum of £300. 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 20th day of December 2022

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