

O-750-22

**TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK APPLICATION NO. 3622515
BY IBEX FULFILMENT LIMITED
TO REGISTER**




**AS A TRADE MARK
IN CLASSES 35 & 39
AND OPPOSITION THERETO (UNDER NO. 427269)
BY
IBEX BEST LIMITED**

Background & Pleadings

1. Ibex Fulfilment Limited (“the applicant”) applied to register the trade mark set out on the title page of this decision on 7 April 2021. The application was published in the Trade Marks Journal on 2 July 2021 in classes 35 and 39, though only class 39 forms part of this opposition. The contested services will be set out later in this decision.

2. IBEX BEST LIMITED (“the opponent”) opposed class 39 of the application on 1 October 2022 under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies on class 39 in its two earlier UK trade marks, set out below:

UK TM No.917873202	UK TM No.3102485
 <p>Filing date: 13 March 2018 Registration date: 24 July 2018</p> <p>Travel arrangement; Travel information; Arranging for travel visas, passports and travel documents for persons travelling abroad; Escorting of travellers; Taxi transport; Rental of motor cars; Transport; Delivery of mail by courier; Transport and delivery of goods; Packaging and storage services; Packaging and storage of goods; Temporary storage of deliveries; Rental of storage containers; Storage of clothing; Storage of baggage; Storage</p>	 <p>Filing date: 2 April 2015 Registration date: 17 July 2015</p> <p>Travel arrangement; travel information; arranging for travel visas, passports and travel documents for persons traveling abroad; escorting of travellers; taxi transport; vehicle storage; packaging and storage of goods; rental of means of transportation; removal services; transportation and delivery of goods; transport services; removals; removal services; storage services; refrigerated storage; luggage storage; container storage; warehouse storage; furniture</p>

<p>information services; Bulk storage services; Furniture storage; Luggage storage; Refrigerated storage; Transport services; Removal services; Transportation and delivery of goods; Container storage; Removals; Rental of means of transportation; Vehicle storage; Storage of luggage; Storage of packages; Storage of vehicles; Storage consultancy; Warehouse storage services; Transport and delivery of machines and material for use in building, construction and engineering industries; Vehicle rental; Hire of land vehicles; Car Rental; Van rental; Bus rental; Truck rental; Provision of car parks and car parking services; Waste disposal [transportation]; Clearance [removal and transportation] of waste; Transportation and storage of waste and recycling materials; Collection, transportation and delivery of goods; Advisory, consultancy, and information services relating to all the aforesaid services.</p>	<p>storage; bulk storage services; storage information services; storage of baggage; storage of clothing; storage of goods; rental of storage containers; temporary storage of deliveries; transport and delivery of goods; delivery of mail by courier; advisory, consultancy, and information services relating to all the aforesaid services.</p>
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3. The opponent's trade marks both have a registration date that is earlier than the filing date of the application and, therefore, they are earlier marks, in accordance with Section 6 of the Act. As the registration procedure for UK TM No.3102485 was completed more than 5 years prior to the filing date of the contested application, it is subject to the proof of use conditions, as per section 6A of the Act. The opponent made a statement of use in respect of all the services it relies on. The remaining

earlier right, UK TM No.917873202, has not been registered for 5 years or more at the filing date of the application so is not subject to proof of use provisions.

4. The applicant filed a counterstatement in which it denied the ground of opposition and put the opponent to proof of use of its earlier mark UK TM No.3102485.

5. Both parties have been represented throughout proceedings. The applicant has been represented by Alpha & Omega, whilst the opponent has been represented by Trademarkit LLP. Both parties filed evidence but only the opponent filed submissions in lieu of a hearing.

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 Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

7. I make this decision following consideration of all the material before me.

Preliminary approach

8. The opponent relies on the two registrations set out in the table at paragraph 2. The registered marks are identical. Furthermore UK TM No. 3102485 is subject to proof of use whereas UK TM No. 917873202 is not and has a broader specification of services than the other earlier mark. Bearing all of this in mind, I will proceed initially on the basis of comparing UK TM No.917873202, returning to consider the other mark only if it becomes necessary to do so.

Section 5(2)(b)

9. Section 5(2)(b) of the Act is as follows:

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

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

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

10. The following principles are gleaned from the judgments of the EU courts 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 C3/03, *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 the 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 to mind the earlier mark, 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 services

11. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*¹, the court stated at paragraph 23 of its judgment that:

“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

¹ Case C-39/97

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”.

12. The relevant factors identified by Jacob J. (as he then was) in the Treat case², for assessing similarity were:

- (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.

13. The following case law is also applicable in relation to the contested services in these proceedings when in *Gérard Meric v Office for Harmonisation in the Internal Market*³, 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

² [1996] R.P.C. 281

³ Case T- 133/05

where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

14. The services to be compared are

Opponent's services	Applicant's services
<p>39: Travel arrangement; Travel information; Arranging for travel visas, passports and travel documents for persons travelling abroad; Escorting of travellers; Taxi transport; Rental of motor cars; Transport; Delivery of mail by courier; Transport and delivery of goods; Packaging and storage services; Packaging and storage of goods; Temporary storage of deliveries; Rental of storage containers; Storage of clothing; Storage of baggage; Storage information services; Bulk storage services; Furniture storage; Luggage storage; Refrigerated storage; Transport services; Removal services; Transportation and delivery of goods; Container storage; Removals; Rental of means of transportation; Vehicle storage; Storage of luggage; Storage of packages; Storage of vehicles; Storage consultancy; Warehouse storage services; Transport and delivery of machines and material for use in building, construction and engineering industries; Vehicle rental; Hire of land vehicles; Car Rental; Van rental; Bus rental; Truck rental; Provision of car</p>	<p>39: Warehousing; Transportation; Transportation and delivery of goods; Transportation and storage; Storage; Delivery [distribution] of goods; Delivery of goods; Distribution [transport] of retail goods; Transportation logistics; packaging of goods; advisory and consultancy service relating to the aforesaid services</p>

<p>parks and car parking services; Waste disposal [transportation]; Clearance [removal and transportation] of waste; Transportation and storage of waste and recycling materials; Collection, transportation and delivery of goods; Advisory, consultancy, and information services relating to all the aforesaid services.</p>	
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15. I find that these services are identical in the respective specifications: *Warehousing; Transportation and delivery of goods; Advisory and consultancy, services relating to all the aforesaid services.*

16. The following terms in the applicant's specification namely *transportation; Transportation and storage; storage; packaging of goods; Delivery [distribution] of goods; Delivery of goods; Distribution [transport] of retail goods; Transportation logistics* are broad enough terms to cover the following services in the opponent's specification: *transport; Transport and delivery of goods; Packaging and storage services; Packaging and storage of goods; Temporary storage of deliveries; Rental of storage containers; Storage of clothing; Storage of baggage; Storage information services; Bulk storage services; Furniture storage; Luggage storage; Refrigerated storage; Transport services; Container storage; Storage of clothing; Storage of baggage; Storage information services; Bulk storage services; Furniture storage; Luggage storage; Refrigerated storage; Transport services.* As such I find these terms to be identical under the *Meric* principle

Average Consumer

17. I next consider who the average consumer is for the contested services and how they are purchased. It is settled case law that the average consumer is deemed to be reasonably well informed and reasonably observant and circumspect⁴. For the

⁴ *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)

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 question⁵.

18. The average consumer for the contested services is the general public and businesses. The contested services are largely in the transport, delivery and storage areas. These are likely to be relatively expensive services and perhaps less frequently purchased by the general public than by businesses. However, all customers will be taking factors like price, frequency of delivery or suitability for storage into consideration. As such I find consumers would be paying a least a medium level of attention. The purchasing process will be primarily visual as consumers are likely to browse online materials, websites etc, although I do not rule out an aural aspect to purchase through word-of-mouth recommendations.

Mark comparisons

19. 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 the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo SA v OHIM*⁶, 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.”

⁵ *Lloyd Schuhfabrik Meyer*, Case C-342/97.

⁶ Case C-591/12P

20. 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.

21. The respective trade marks to be compared are:

Opponent's earlier registration	Applicant's mark
	

22. The opponent's mark is a composite arrangement of a device positioned above a word. The device consists of a stylised animal's head with curved horns in profile facing left, with the head portion positioned amongst several geometric shapes. The device is positioned above the word IBEX which is set out in bold block capitals. Given its size and position, I find the device make a significant contribution to the overall impression of the mark, but it is the word element that consumers will refer to, so I find that to be the dominant element in the mark.

23. The applicant's mark is also a composite arrangement of a device positioned above a word element. The device consists of a stylised animal's head with curved horns facing forward. It is positioned above the word element, which itself is presented as one word above another. The word IBEX is in block capitals and it is about twice as high as the word FULFILMENT. The device does play a significant role in the overall impression of the mark but the word IBEX will dominate with FULFILMENT playing a lesser role, given its meaning in relation to the services, namely the meeting of an order or delivery requirement.

24. In a visual comparison, both marks share the word IBEX as a point of similarity. As points of difference, they have different devices and the applicant has an

additional word, FULFILMENT, to consider. Taking all this into account, I find the marks are visually similar to a low degree.

25. In an aural comparison, where the devices will not feature, I find that the shared word IBEX will be pronounced identically. Even where the applicant's second word FULFILMENT is verbalised, the degree of aural similarity is high.

26. In a conceptual comparison, the shared word IBEX will bring to mind the identical concept of the animal. Although the devices are visually different, both contain the stylised head of a horned animal. Given the presence of the word IBEX in the mark, it will likely reinforce the idea that the animal head is that of an ibex. With regard to the applicant's additional word, FULFILMENT, the opponent contends in its written submissions that "the word fulfilment in the contested mark has reduced distinctiveness and thus reduced relevance in the comparison of the marks". I agree with the opponent. Consumers will understand FULFILMENT to mean something which has been achieved or satisfied and attribute it in some way to the word IBEX which precedes it. Overall I find the respective marks to be conceptual identical for the shared word and the devices and to be highly similar overall.

Distinctive character of the earlier mark

27. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, based either on inherent qualities or because of use made, the greater the likelihood of confusion. In *Lloyd Schuhfabrik Meyer*⁷ 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*

⁷ *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97

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).”

28. Registered trade marks possess varying degrees of inherent distinctive character starting from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, scaling up to those with high inherent distinctive character, such as invented words.

29. The word IBEX is an ordinary dictionary word but has no meaning in relation to the services for which it is registered. The device element also has no meaning in relation to the services. Taking this combination of the word and device into account, I find that the earlier mark is inherently distinctive to a high degree.

30. Although UK TM No.917873202 is not subject to proof of use provisions, nevertheless evidence has been provided so I next consider whether use made of this mark has enhanced its distinctiveness (a finding which, given the identity of the marks, would be transferable to the other mark). I remind myself of the *Windsurfing Chiemsee* factors set out above as to what I should consider.

31. In its witness statement the opponent states that it has used its earlier mark since 2012 for the relevant services namely *removal services* and since 2013 for *direct mail delivery, packaging, storage, transportation and delivery of goods*. The opponent has given its annual turnover for all the services provided under the IBEX mark, which ranged from £24k in 2012 up to £152k in 2020, but has not specified

how much of that turnover can be attributed to its class 39 services. The same issue occurs with the advertising expenditure figures. The opponent states it has used the mark throughout the UK, however it has only provided invoices showing a number of customers from the London region. There is also an advertisement dated October 2019 from the Islington Tribune which I imagine has a large London based readership. Applying the *Windsurfing Chiemsee* factors to the evidence provided I do not find that the earlier mark's distinctive character has been enhanced through use.

Likelihood of confusion

32. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them that they have kept in mind.⁸ I must also keep in mind the average consumer for the goods, the nature of the purchasing process and have regard to 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.

33. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related.

34. In *L.A. Sugar Limited*⁹, Mr Iain Purvis Q.C., sitting as the Appointed Person, 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

⁸ *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27

⁹ *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10

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

35. In *Kurt Geiger v A-List Corporate Limited*¹⁰, Mr Iain Purvis Q.C. again sitting as the Appointed Person pointed out that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

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.”

36. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask ‘in what does the distinctive character of the earlier mark lie?’ Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

¹⁰ BL O-075-13

37. So far in this decision I have found that,

- the services are identical
- The average consumer will pay a medium level of attention during the primarily visual purchasing process
- there is a low degree of visual similarity between the respective marks
- there is aural identity between the marks if the applicant's FULFILMENT element is not verbalised
- there is a high degree of aural similarity between the respective marks, if the applicant's FULFILMENT element is verbalised
- there is conceptual identity between the shared word and respective devices and the marks are overall highly similar.
- the earlier mark is inherently distinctive to a high degree.

38. Based on the marks and the services before me and taking into account the assessments set out above, I find the identical nature of the IBEX element and the conceptual identity of the device elements are the most pertinent factors to consider as per *Kurt Geiger*. As set out above a consumer rarely has the chance to make direct comparisons between marks but instead relies on an imperfect recollection. The dominant and distinctive word IBEX and the notion of an ibex head will have a lasting impact on consumers, the other word element FULFILMENT less so. I am not discounting FULFILMENT but I think consumers will see it as a lowly distinctive word in relation to the services and will attach no greater significance to it than that. In my view the effect of imperfect recollection will be such that a significant proportion of consumers will directly confuse the two marks for identical services.

39. In case I am wrong with my finding of direct confusion, I will go on to assess the likelihood of indirect confusion. I remind myself of the guidance given in *L.A. Sugar* that indirect confusion requires a consumer to undertake a thought process whereby they acknowledge the differences between the marks yet attribute the common element to the same or an economically connected undertaking, taking the later mark to be a possible brand extension or sub brand of the earlier mark. In this instant case consumers may note the fact that the visual representation of the animal head is different and the additional word element FULFILMENT, but given its meaning in relation to the services just assume that these are a merely a brand extension or

sub-brand of the IBEX services. As such I find there is a likelihood of indirect confusion.

40. It is not necessary for me to revisit the opponent's other earlier mark, UK TM No. 3102485, as it does not put the opponent in any stronger a position.

Conclusion

41. The opposition has been successful. Subject to any appeal of this decision I find that the application should be refused for class 39 but can proceed to registration for class 35 which did not form part of these proceedings.

Costs

42. The opponent has been successful and is entitled to a contribution to its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 2/2016. Bearing in mind the guidance given in TPN 2/2016, I award costs to the opponent as follows:

£100 Official fee for opposition
£300 Preparing Notice of Opposition and considering the counterstatement
£300 Preparing written submissions
£500 Evidence
£1200 Total

43. I order Ibex Fulfilment Limited to pay IBEX BEST LIMITED the sum of £1200. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 1st day of September 2022

**June Ralph
For the Registrar
The Comptroller-General**