

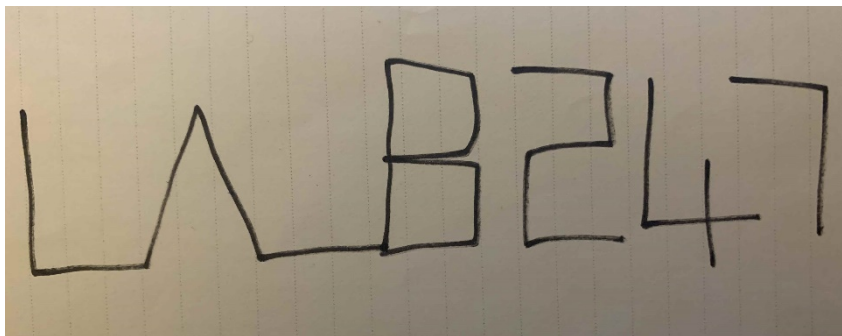
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TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003573165

BY RICHARD BURKE

TO REGISTER THE TRADE MARK:



IN CLASS 25

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 424666

BY ALEXANDER JAMES TRIMNELL

BACKGROUND AND PLEADINGS

1. On 29 December 2020, Richard Burke (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on the 26 February 2021. The applicant seeks registration for the following goods:

Class 25 Ankle socks; Anoraks; Anti-perspirant socks; Articles of clothing; Articles of outer clothing; Articles of sports clothing; Athletic clothing; Athletics vests; Balaclavas; Bandanas; Bandannas; Baseball caps and hats; Bathing trunks; Beach clothes; Beach clothing; Beanie hats; Bikinis; Body warmers; Bottoms [clothing]; Camouflage jackets; Camouflage pants; Camouflage shirts; Camouflage vests; Caps being headwear; Clothes for sport; Clothes for sports; Clothing for cycling; Clothing for gymnastics; Clothing for leisure wear; Clothing for men, women and children; Clothing for sports; Crop tops; Cycling shorts; Cycling tops; Exercise wear; Fitted swimming costumes with bra cups; Gym shorts; Gym suits; Gymwear; Headbands against sweating; Hooded sweat shirts; Hooded sweatshirts; Hooded tops; Hoodies; Jackets being sports clothing; Jogging bottoms; Jogging outfits; Jogging pants; Jogging sets [clothing]; Jogging tops; Jumpers; Jumpers [pullovers]; Jumpers [sweaters]; Jumpsuits; Light-reflecting coats; Light-reflecting jackets; Long sleeve pullovers; Long sleeved vests; Loungewear; Lumberjackets; Men's and women's jackets, coats, trousers, vests; Men's clothing; Men's socks; Men's underwear; Menswear; Money belts [clothing]; Neck scarves; Neck warmers; Neckwear; Outer clothing; Outerclathing; Outerclathing for men; Outerwear; Overcoats; Padded pants for athletic use; Padded shirts for athletic use; Padded shorts for athletic use; Parts of clothing, footwear and headgear; Polo neck jumpers; Polo shirts; Polo sweaters; Ponchos; Pop socks; Printed t-shirts; Pullovers; Quilted jackets [clothing]; Quilted vests; Rain capes; Rain coats; Rain hats; Rain jackets; Rain ponchos; Rain suits; Rain trousers; Rain wear; Raincoats; Rainproof clothing; Rainproof jackets; Rainwear; Ready-made clothing; Ready-made linings [parts of clothing];

Ready-to-wear clothing; Reversible jackets; Roll necks [clothing]; Rugby jerseys; Rugby shirts; Rugby shorts; Rugby tops; Running vests; Safari jackets; Sailing wet weather clothing; Sailor suits; Scarfs; Scarves; Scrimmage vests; Shell jackets; Shell suits; Short sets [clothing]; Short trousers; Shorts; Shorts [clothing]; Short-sleeve shirts; Short-sleeved shirts; Short-sleeved T-shirts; Shoulder scarves; Shoulder straps for clothing; Skating outfits; Ski balaclavas; Skirts; Skorts; Sleeveless jackets; Sleeveless jerseys; Sliding shorts; Slipovers [clothing]; Small hats; Snoods [scarves]; Socks; Socks and stockings; Socks for men; Sport coats; Sport shirts; Sport stockings; Sports bras; Sports caps; Sports caps and hats; Sports clothing; Sports clothing [other than golf gloves]; Sports garments; Sports headgear [other than helmets]; Sports jackets; Sports jerseys; Sports jerseys and breeches for sports; Sports over uniforms; Sports overuniforms; Sports pants; Sports shirts; Sports shirts with short sleeves; Sports shoes; Sports singlets; Sports socks; Sports vests; Sports wear; Sportswear; Strapless bras; Stretch pants; Sun hats; Sun visors; Sun visors [headwear]; Surf wear; Surfwear; Sweat bands; Sweat bands for the head; Sweat bands for the wrist; Sweat bottoms; Sweat jackets; Sweat pants; Sweat shirts; Sweat shorts; Sweat suits; Sweat-absorbent socks; Sweat-absorbent stockings; Sweat-absorbent underclothing; Sweat-absorbent underclothing [underwear]; Sweat-absorbent underwear; Sweatbands; Sweaters; Sweatjackets; Sweatpants; Sweatshirts; Sweatshorts; Sweatsuits; Swim briefs; Swim caps; Swim shorts; Swim suits; Swim trunks; Swim wear for gentlemen and ladies; Swimming caps; Swimming caps [bathing caps]; Swimming costumes; Swimming suits; Swimming trunks; Swimsuits; Swimwear; Tank tops; Tankinis; Tank-tops; Tee-shirts; Tennis dresses; Tennis pullovers; Tennis shirts; Tennis shorts; Tennis skirts; Tennis socks; Tennis sweatbands; Tennis wear; Thermal clothing; Tops; Tops [clothing]; Toques [hats]; Track jackets; Track pants; Track suits; Tracksuit bottoms; Tracksuit tops; Tracksuits; Training suits; Trench coats; Trenchcoats; Triathlon clothing; Trousers for sweating; Trunks; Trunks (Bathing -); Trunks being clothing; T-shirts; Vest tops; Vests; V-neck sweaters; Volleyball jerseys; Waist belts; Waistbands; Warm up

suits; Warm-up jackets; Warm-up suits; Waterproof capes; Waterproof clothing; Waterproof jackets; Waterproof outerclothing; Waterproof pants; Waterproof suits for motorcyclists; Water-resistant clothing; Weather resistant outer clothing; Weatherproof clothing; Weatherproof jackets; Weatherproof pants; Wind jackets; Wind resistant jackets; Wind-jackets; Windproof clothing; Windproof jackets; Wind-resistant jackets; Women's clothing; Womens' outerclothing; Woolly hats; Wristbands; Wristbands [clothing]; Yoga bottoms; Yoga pants; Yoga shirts; Yoga socks; Yoga tops.

2. The application was opposed by Alexander James Trimnell (“the opponent”) on 26 May 2021. The opposition was originally based upon sections 5(2)(b), 5(3) and 3(6) of the Trade Marks Act 1994 (“the Act”). However, the opponent withdrew the section 5(3) and 3(6) grounds in writing on the 24 January 2022.¹ The opponent relies upon the following trade mark:

LAB94

EUTM registration no. 017482332²

Filing date 15 November 2017.

Registration date 1 March 2018.

Relying upon all of the goods for which the earlier mark is registered, namely:

Class 25 Articles of clothing, footwear and headgear; articles of clothing, footwear and headgear for gymnastic and athletic use.

3. The opponent claims that there is a likelihood of confusion because of the identity and similarity of the goods, and the similarity of the signs.

¹ I will deal with and elaborate on this issue in the “preliminary issue” section of this decision.

² Although the UK has left the EU and the transition period has now expired, EUTMs, and International Marks which have designated the EU for protection, are still relevant in these proceedings given the impact of the transitional provisions of The Trade Marks (Amendment etc.) (EU Exit) Regulations 2019 – please see Tribunal Practice Notice 2/2020 for further information.

4. The applicant filed a counterstatement denying the claims made.

5. The opponent is represented by Edwin Coe LLP and the applicant is unrepresented. Neither party requested a hearing, but the applicant filed written submissions and the opponent filed submissions in lieu. This decision is taken following a careful perusal of the papers.

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 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.

PRELIMINARY ISSUE

7. As highlighted above, on 24 January 2022 the opponent wrote to the Registry, as follows:

“For the sake of good order, we confirm that although our client will be pursuing the section 5(2)(b) objection, he will not, of course, be pursuing the section 5(3) ground of opposition.

While writing, we have noted that the amended Form TM7 attached to the official letter of 4th October 2021 sent to the applicant appears to indicate that opposition has also been raised on section 3 of the Act. That is not our intention, the box to indicate that an objection is to be raised under section 3 appears to have been marked in error, and **for the avoidance of doubt, any objection under section 3 will not be pursued**. Our client will be maintaining the opposition only under section 5(2)(b) of the Act.”

8. The Registry confirmed this in a letter dated 2 February 2022, which stated that “the proceedings will continue under grounds of section 5(2)(b) only”.

9. However, in the opponent's submissions in lieu dated 28 July 2022, the opponent references the 3(6) claim, stating that the application was filed in bad faith. As noted above, this objection was not to be pursued. I also note that the applicant wouldn't have had any chance to respond to these submissions either.

10. Consequently, the above 3(6) ground will not be explored in these proceedings as it was officially withdrawn as not having been pleaded in the first place.

DECISION

11. Section 5(2)(b) reads as follows:

“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. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

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

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of IR for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b) subject to its being so registered.”

13. The trade mark upon which the opponent relies qualifies as an earlier trade mark because it was applied for at an earlier date than the applicant’s mark pursuant to section 6 of the Act. As the opponent’s mark had not completed its registration process more than 5 years before the filing date of the mark in issue, it is not subject to proof of use pursuant to section 6A of the Act. The opponent is entitled to rely upon all of the goods and services for which the mark is registered.

Section 5(2)(b) case law

14. The following principles are gleaned from the decisions 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 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:

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

15. 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 for 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.”

16. I consider that all of the applicant’s specification falls within the broader category of “articles of clothing, footwear and headgear” in the opponent’s specification. I consider them identical on the principle outlined in *Meric*.

The average consumer and the nature of the purchasing act

17. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [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.”

18. The average consumer for the goods will be members of the general public. The cost of purchase is likely to vary, and the goods will be purchased relatively frequently. However, various factors are still likely to be taken into consideration during the purchasing process, such as materials used, cut, aesthetic appearance and durability. Consequently, I consider that a medium degree of attention will be paid by the average consumer when selecting the goods.

19. The goods are likely to be obtained by self-selection from the shelves of a retail outlet, online or catalogue equivalent. This means that the mark will be seen and so the visual element of the mark will be the most significant: see *New Look Limited v OHIM*, Joined cases T-117/03 to T-119/03 and T-171/03, paragraph 50. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount that there will also be an aural component to the purchase, as advice may be sought from a sales assistant or representative.

Comparison of the trade marks

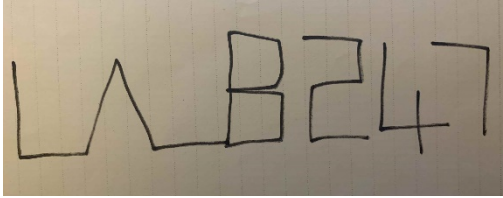
20. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed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

21. 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.

22. The respective trade marks are shown below:

Opponent's trade mark	Applicant's trade marks
LAB94	

23. The opponent's mark consists of the word 'LAB' followed by the number '94'. The overall impression of the mark lies in the combination of these elements.

24. The applicant submits that its "trademark is Lab247". I am satisfied that this is the manner in which a significant proportion of average consumers will read the mark. Therefore, despite the stylisation, including the letter 'A' missing the cross bar, I shall proceed on the basis that the majority of average consumers will read the mark as 'LAB247'. I consider that the 'LAB247' element plays a greater role in the overall impression of the mark, with the background and stylisation playing a lesser role.

25. Visually, the marks coincide in the fact that they share the word 'LAB' at the beginning of the marks. They also both contain the number 4. However, I note that the opponent's mark ends in the number '94', whereas the applicant's mark ends in the number '247'. The applicant's mark also contains the stylised letter 'A' which is connected to the letters L and B. These all act as visual points of difference. I bear in mind that consumers pay more attention to the beginning of the marks. Consequently, I consider that the marks are visually similar to at least a medium degree.

26. Aurally, the opponent's mark will be pronounced as LAB-NINE-TEE-FOR. The applicant's mark will be pronounced as LAB-TOO-FOR-SEV-EN. As the marks overlap

in the pronunciation of the first syllables, and the 'FOR' syllable, albeit in different positions, I consider that the marks are aurally similar to a medium degree.

27. Conceptually, both marks contain the word LAB, which I consider the average consumer would recognise as a shortening of the word 'laboratory', which is a room or building where scientific experiments are carried out.³ However, the applicant's mark ends in the number '247' and the opponent's mark ends in the number '94'. I therefore consider that both the applicant's and the opponent's mark have no overall meaning because the word LAB and the numbers '247' and '94' do not link together. They remain as separate elements with their own meanings. Regardless, as both marks share the conceptual meaning of laboratory, I consider that the marks are conceptually similar to a medium degree.

Distinctive character of the earlier trade mark

28. 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 C108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, 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

³ <https://www.collinsdictionary.com/dictionary/english/laboratory>

by the undertaking in promotion of 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).”

29. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

30. As the opponent has not filed any evidence to show that the distinctiveness of its mark has been enhanced through use, I only have the inherent position to consider.

31. As noted above, the average consumer will recognise the word LAB as a shortening of the ordinary dictionary word ‘laboratory’. The number 94 will be recognised, but not assigned any particular meaning. The opponent’s mark has no overall meaning because the word and the number do not link together. They remain as separate elements with their own meanings. I also do not consider that neither the word LAB or number 94 is descriptive or allusive of the opponent’s class 25 goods. Consequently, I consider that the opponent’s mark is inherently descriptive to above a medium degree.

Likelihood of confusion

32. 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 down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where 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. It is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

33. The following factors must be considered to determine if a likelihood of confusion can be established:

- I have found the marks to be visually similar to at least a medium degree.
- I have found the marks to be aurally similar to a medium degree.
- I have found the marks to be conceptually similar to a medium degree.
- I have found the opponent's mark to be inherently distinctive to above a medium degree.
- I have identified the average consumer as members of the general public, who will select the goods primarily by visual means, although I do not discount an aural component.
- I have concluded that a medium degree of attention will be paid during the purchasing process for the goods.
- I have found the parties' goods to be identical.

34. Taking all of the above into account and bearing in mind the principle of imperfect recollection, I am satisfied that the marks are unlikely to be mistakenly recalled or misremembered as each other. I do not consider that the average consumer would overlook, or misremember the different numbered endings of both the opponent's and applicant's mark, or the stylisation of the applicant's mark. Consequently, I do not consider that there would be a likelihood of direct confusion.

35. It now falls to me to consider the likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

“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.”

36. I also bear in mind the comments made in *Bimbo*. The CJEU stated (my emphasis):

“19. As to the merits, according to settled case-law, the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94 (see Case C-334/05 P *OHIM v Shaker* EU:C:2007:333, paragraph 33, and Case C-193/06 P *Nestlé v OHIM* EU:C:2007:539, paragraph 32).

20. The existence of a likelihood of confusion on the part of the public must be assessed globally, account being taken of all factors relevant to the circumstances of the case (see, to that effect, Case C-251/95 *SABEL* EU:C:1997:528, paragraph 22; *OHIM v Shaker* EU:C:2007:333, paragraph 34; and *Nestlé v OHIM* EU:C:2007:539, paragraph 33).

21. The global assessment of the likelihood of confusion, in relation to the visual, aural or conceptual similarity of the marks at issue, must be based on the overall impression given by the marks, account being taken, in particular, of their distinctive and dominant components. The perception of the marks by the average consumer of the goods or services in question plays a decisive role in the global assessment of that likelihood of confusion. In this regard, the

average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (see, to that effect, *SABEL* EU:C:1997:528, paragraph 23; *OHIM v Shaker* EU:C:2007:333, paragraph 35; and *Nestlé v OHIM* EU:C:2007:539, paragraph 34).

22. The assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole (*OHIM v Shaker* EU:C:2007:333, paragraph 41).

23. The overall impression conveyed to the relevant public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components. However, it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element (*OHIM v Shaker* EU:C:2007:333, paragraphs 41 and 42, and *Nestlé v OHIM* EU:C:2007:539, paragraphs 42 and 43 and the caselaw cited).

24. In this connection, the Court of Justice has stated that it is possible that an earlier mark used by a third party in a composite sign that includes the name of the company of the third party retains an independent distinctive role in the composite sign. Accordingly, in order to establish the likelihood of confusion, it suffices that, on account of the earlier mark still having an independent distinctive role, the public attributes the origin of the goods or services covered by the composite sign to the owner of that mark (Case C-120/04 *Medion* EU:C:2005:594, paragraphs 30 and 36, and order in Case C-353/09 P *Perfetti Van Melle v OHIM* EU:C:2011:73, paragraph 36).

25. None the less, a component of a composite sign does not retain such an independent distinctive role if, together with the other component or components of the sign, that component forms a unit having a different meaning as compared with the meaning of those components taken separately (see, to that effect, order in Case C-23/09 P *ecoblue v OHIM and Banco Bilbao Vizcaya*

Argentaria EU:C:2010:35, paragraph 47; *Becker v Harman International Industries* EU:C:2010:368, paragraphs 37 and 38; and order in *Perfetti Van Melle v OHIM* EU:C:2011:73, paragraphs 36 and 37).”

37. In *Deakins*, BL O/421/14, Mr Geoffrey Hobbs KC, sitting as the Appointed Person, stated:

“24. It is not correct to proceed on the basis that an element of a composite mark retains an independent distinctive role if, together with the other component or components of the mark, it *‘forms a unit having a different meaning as compared with the meaning of those components taken separately’*: *Bimbo SA v. OHIM* C-591/12P, EU:C:2014:305 at paragraph [25]. And even if a component of a composite mark is found to be sufficiently ‘unitary’ to retain an independent distinctive role, it still remains necessary for any assessment of ‘*similarity*’ to be made by reference to the composite mark as a whole in the manner summarised in *Bimbo SA* at paragraphs [34] and [35]:

[34] Indeed, as the Advocate General observed in points 25 and 26 of his Opinion, 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.

[35] The determination of which components of a composite sign contribute to the overall impression made on the target public by that sign is to be undertaken before the global assessment of the likelihood of confusion of the signs at issue. Such an assessment must be based on the overall impression produced by the trade marks at issue, since the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details, as has been stated in

paragraph 21 above. Therefore, this does not involve an exception, that must be duly substantiated, to that general rule.”

38. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. (as he then was) considered the impact of the CJEU’s judgment in *Bimbo*, Case C-591/12P, on the court’s earlier judgment in *Medion v Thomson*. The judge said:

“18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

39. In that case, Arnold J. considered the registrability of a composite word mark - JURA ORIGIN - which included the opponent’s earlier trade mark – ORIGIN. The judge found that the mark JURA ORIGIN formed a unit having a different meaning to those of the individual components. I have found the opposite in these proceedings; LAB247 does not form a unit, having a different meaning to those of the individual words. LAB retains an independently distinctive role.

40. Both marks share the distinctive ‘LAB’ element at the beginning of the marks, to which the consumer pays more attention to. Therefore, taking all of the above case law into account, I consider that the common use of the word LAB will lead the average consumer to conclude that the marks originate from the same or economically linked undertakings. I consider that the average consumer will see the addition of the different numbered endings, and perceive them as either a sub-brand, or a mark being used for a different clothing range. Taking all of the above into account, I consider there to be a likelihood of indirect confusion.

CONCLUSION

41. The opposition is successful in its entirety and the application is refused.

COSTS

42. The opponent has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the opponent the sum of **£650** as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Filing a Notice of opposition and considering the applicant's counterstatement	£200
Filing written submissions	£350
Official Fee	£100 ⁴
Total	£650

43. I therefore order Richard Burke to pay Alexander James Trimnell the sum of £650. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 21st day of September 2022

L FAYTER
For the Registrar

⁴ Although the official fee paid by the opponent was £200, the section 5(3) and 3(6) grounds were subsequently withdrawn. It is, therefore, only appropriate to award the opponent the sum of £100 in respect of the official fee which is the fee for an opposition brought solely under section 5(2)(b).