

O/0211/23

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3642356  
BY AALU LTD  
TO REGISTER THE FOLLOWING TRADE MARK:**



**IN CLASS 5**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 426114  
BY GUY LOCHNER**

## **Background and pleadings**

1. On 17 May 2021, Aalu Ltd (“the applicant”) applied to register the trade mark displayed on the cover page of this decision in the UK, under number 3642356 (“the contested mark”). Details of the application were published for opposition purposes on 30 July 2021. Registration is sought for ‘*delay sprays for sexual aid; (oil, gel, cream for men and women sexual aid); wipes for sexual aid*’ in class 5.

2. On 12 August 2021, Guy Lochner (“the opponent”) opposed the application in full under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”).<sup>1</sup> The opponent relies upon their UK trade mark number 3367674, **Viga Delay** (“the earlier mark”). The earlier mark was filed on 17 January 2019 and became registered on 5 April 2019 in respect of ‘*delay spray and cream*’ in class 5.

3. Given the respective filing dates, the opponent’s mark is an earlier mark in accordance with section 6 of the Act. As it had not completed its registration process more than five years before the filing date of the contested mark, it is not subject to the proof of use provisions specified in section 6A of the Act. Consequently, the opponent is entitled to rely upon the goods of the earlier mark, without having to demonstrate genuine use.

4. The opponent contends that the competing marks are highly similar due to the shared, dominant word ‘VIGA’, and that the parties’ respective goods are identical or similar. On this basis, they submit that there is a likelihood of confusion.

5. The applicant filed a counterstatement denying the ground of opposition. Although it accepts that the parties’ goods are similar, it highlights differences between the competing marks and disputes that confusion would arise on the part of the public.

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<sup>1</sup> I note that the opponent originally brought the opposition under additional grounds, namely, section 5(4)(a) and 3(6) of the Act. However, as the opponent did not file any evidence in support of those grounds, the Registry indicated in its letter dated 26 August 2022 that the proceedings would only continue on the basis of section 5(2)(b) of the Act. In the absence of a response from the opponent, that action was confirmed in the Registry’s letter dated 9 September 2022. Within its written submissions in lieu of a hearing, the opponent confirmed that it was not pursuing its claims under sections 5(4)(a) and 3(6) of the Act.

6. The opponent is professionally represented by Wilson Gunn, whereas the applicant represents itself. Only the applicant filed evidence in these proceedings. Neither party requested a hearing and only the opponent elected to file written submissions in lieu of attendance. Whilst I do not intend to summarise these submissions, I have read them and will return to them to the extent I consider necessary in the course of this decision. This decision is taken following a careful perusal of all the papers before me.

7. 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 and, therefore, this decision continues to refer to the trade mark case law of the EU courts.

### **Preliminary remarks**

8. The applicant filed evidence in the form of a witness statement of Shaheer Siddiqui, dated 9 July 2022, and six accompanying exhibits (1 to 5 and 7). Shaheer Siddiqui is the director of the applicant company. They explain that they applied for the contested mark due to the opponent's alleged misuse of the earlier mark and reporting facilities on eBay.<sup>2</sup> According to Shaheer Siddiqui, the opponent wants to stop the applicant and third parties from selling products which they falsely claim to own.<sup>3</sup> They state that the opponent has reported the applicant to eBay in relation to other trade marks and listings.<sup>4</sup> Shaheer Siddiqui believes that, from the evidence provided, it is clear that the opponent has a history of attempting to register third-party trade marks to misuse them.<sup>5</sup>

9. I note that the documentary evidence consists of the following:

- Emails from eBay (2020),<sup>6</sup> stating that "Your account has been restricted because activity on it didn't follow our VeRO Unauthorised Item Policy", "Your

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<sup>2</sup> Witness statement of Shaheer Siddiqui, §2

<sup>3</sup> Siddiqui, §3

<sup>4</sup> Siddiqui, §3

<sup>5</sup> Siddiqui, §3

<sup>6</sup> Exhibits 1 and 2

listing didn't follow our VeRO Unauthorised Item Policy” and “Unauthorised copies or counterfeits are illegal and not allowed on eBay”. They indicate that listings for product names containing the word ‘Viga’ were reported by Avrupa Ilac Kozmetik Ltd.

- Emails from eBay (2020),<sup>7</sup> in which it advised that “We had to remove your listing because it didn’t follow our VeRO Unauthorised Item Policy”, “Your listing didn't follow our VeRO Unauthorised Item Policy” and “Unauthorised copies or counterfeits are illegal and not allowed on eBay”. The emails indicate that listings for ‘TITAN’ branded products were reported by Avrupa Ilac Kozmetik Ltd.
- An email from eBay (2020),<sup>8</sup> confirming that a listing was reported by Avrupa Ilac Kozmetik Ltd in error.
- A decision of the Registrar (BL O/258/19), arising from prior proceedings between two third parties.<sup>9</sup> The decision concerned a successful opposition against a figurative ‘TITAN GEL’ mark. I note that the application was originally made by Guy Lochner before a sequence of assignments before the end of those proceedings.

10. Before proceeding to determine the opponent’s claim, it is important to clarify that Shaheer Siddiqui’s allegations and the evidence they provide will have no bearing on the outcome of this decision.

11. Section 72 of the Act stipulates that registration shall be taken as *prima facie* evidence of the validity of a registered mark. Section 5(2) of the Act turns upon whether the ‘attacker’ has an earlier trade mark compared to the mark under ‘attack’, as defined by section 6 of the Act. If the applicant of the mark under ‘attack’ believes there are grounds which could be used to invalidate the trade mark relied upon by the ‘attacker’, the proper course is to apply to invalidate the ‘attacker’s’ mark.

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<sup>7</sup> Exhibits 3 and 4

<sup>8</sup> Exhibit 5

<sup>9</sup> Exhibit 7

12. As I understand it, the applicant has not sought to invalidate the registration relied upon by the opponent in these proceedings. Consequently, the opponent's trade mark must be regarded as a validly registered mark. A likelihood of confusion between the marks in suit, based on their notional use throughout the UK, would be enough to justify the refusal of the contested mark. Neither the opponent's alleged intentions in registering the earlier mark nor their alleged use of it are relevant to that assessment.

## **Decision**

### **The law**

13. Sections 5(2)(b) and 5A of the Act read 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.”

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

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 *Canon*, the Court of Justice of the European Union (“CJEU”) stated at paragraph 23 of its judgment that:

“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”.

16. The relevant factors identified by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 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.

17. Moreover, the law requires that goods be considered identical where one party's description of its goods encompasses the specific goods covered by the other party's description (and vice versa).<sup>10</sup>

18. The opponent has contended that the parties' specifications both contain the identical goods '*delay sprays and creams*'. Moreover, they have argued that the remaining goods in the applicant's specification are similar to its goods due to similar uses, nature and purpose. As noted above, the applicant has conceded that the parties' goods are similar.

19. To my mind, the opponent's '*delay spray and cream*' could be used as a sexual aid. This term encompasses the applicant's '*delay sprays for sexual aid*' and, therefore, these goods are to be regarded as identical.

20. Similarly, the applicant's '*[...] cream for men and women sexual aid*' incorporates any creams used by men or women as sexual aids and could reasonably cover delay creams. As such, this term encompasses the opponent's goods, rendering them identical.

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<sup>10</sup> *Gérard Meric v OHIM*, Case T-133/05



21. The applicant's '*oil, gel for men and women sexual aid*' and the opponent's '*delay spray and cream*' differ somewhat in nature because the former comprises oils and gels whereas the latter consists of sprays and creams. Nevertheless, the opponent's goods could also be used as a sexual aid and, therefore, there is a shared purpose. Moreover, as both will be applied to the body, there is a significant overlap in method of use. The respective goods are likely to reach the market through the same trade channels and be offered by the same undertakings. As the goods are not indispensable or important for the use of one another,<sup>11</sup> they are not complementary. However, as a consumer could select the applicant's oils and gels over the opponent's sprays and creams, or vice versa, for the same purpose, they are in competition. Taking all of this into account, I find that there is a high degree of similarity between the respective goods.

22. Clearly, the applicant's '*wipes for sexual aid*' and the opponent's goods have a different nature, since the former consists of wipes while the latter comprises sprays and creams. However, there is an overlap in broad purpose and method of use insofar as both could be used as sexual aids and used in conjunction with the body. The respective goods are likely to reach the market through shared channels of trade and may be provided by the same undertakings. The goods are not complementary as they are not indispensable or important for the use of one another. Furthermore, as they have a different nature and different specific purposes, they are not interchangeable and there is no competition between them. Balancing the differences against the similarities, overall, I find that there is a medium degree of similarity between the respective goods.

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<sup>11</sup> *Boston Scientific Ltd v OHIM*, Case T-325/06

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

23. 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 (as he then was) 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.”

24. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods in question.<sup>12</sup>

25. The opponent has submitted that the average consumer will be the general public. I agree, though, due to their nature, this is likely to be confined to adult members of the general public. The goods are likely to be purchased relatively frequently for ongoing use. The purchasing of the goods is not likely to follow an overly considered thought process as they are relatively inexpensive. However, the average consumer will consider factors such as cost, size and whether the product aligns with desired outcomes when selecting the goods. As they will be used on the body, the average consumer may also be mindful of their ingredients. Taking all of the above into account, I find that the average consumer will demonstrate a medium level of attention during the purchasing process. The goods are likely to be purchased from retailers, or their online equivalents, after viewing information on physical displays, shelves or the internet. Therefore, it is my view that the purchasing process will be predominantly visual in nature. Nevertheless, I do not discount aural considerations entirely as it is

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<sup>12</sup> *Lloyd Schuhfabrik Meyer*

possible that the average consumer may wish to discuss the products with a sales assistant or receive word-of-mouth recommendations prior to purchasing the goods.

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

26. In *Lloyd Schuhfabrik Meyer*, 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 *WindsurfingChiemsee 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 *WindsurfingChiemsee*, paragraph 51).”

27. Registered trade marks possess varying degrees of inherent distinctive character. These range from the very low, such as those which are suggestive or allusive of the goods, to those with high inherent distinctive character, such as invented words. Dictionary words which do not allude to the goods will be somewhere in the middle. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark, the greater the likelihood of confusion.

28. Although the distinctiveness of a mark may be enhanced as a result of it having been used in the market, the opponent has filed no evidence of use; accordingly, I have only the inherent position to consider.

29. The earlier mark is in word-only format and comprises the words 'Viga Delay' with no other elements. The opponent has suggested that 'Viga' is an English word. However, they have not provided any evidence to that effect nor any details of its meaning. In my view, it is more likely to be perceived by the average consumer as an invented word with no discernible meaning. The word 'Delay' is clearly descriptive of the kind or intended purpose of the goods for which the earlier mark is registered. The distinctive character of the mark resides predominantly in the word 'Viga'. Given that it is descriptive, the word 'Delay' provides a minimal contribution of distinctiveness at best. Overall, due to the presence of an invented word, I find that the earlier mark possesses a high level of inherent distinctive character.

### **Comparison of trade marks**

30. It is clear from *Sabel* 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 *Bimbo* 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.”

31. Therefore, it would be wrong to dissect the trade marks artificially, though it is necessary to take into account the distinctive and dominant components of the marks;

due weight must be given to any other features which are not negligible and hence contribute to the overall impressions created by the marks.

32. The competing trade marks are as follows:

The earlier mark	The contested mark
<p>Viga Delay</p>	

### Overall impressions

33. The earlier mark consists of the words ‘Viga Delay’ with no additional elements. The overall impression is dominated by the word ‘Viga’. The word ‘Delay’, being a descriptive reference to the goods, plays a minimal role in the overall impression.

34. The contested mark is figurative and consists of several elements. The mark appears to be designed to resemble a spray canister and its packaging. Numerous words are displayed on the canister and packaging, which also feature a stylised depiction of an eagle, a blue background and, in the case of the canister, a black lid. Whilst they will not be itemised here, it suffices to say that most of the verbal elements present in the mark consist of descriptions of characteristics of the goods such as, for example, ingredients, or other non-distinctive indications such as, for example ‘NEW’ and ‘SUPER SPRAY’. Moreover, the number ‘150000’ is likely to be perceived as a product number. The non-English words at the bottom of the packaging are unlikely to be understood by the average consumer or, therefore, relied upon for identifying the economic origin of the goods. It is my view that the overall impression of the mark will

be dominated by the word 'VIGA', which, as an invented word, is highly distinctive. The eagle device, whilst still contributing, will play a lesser role because consumers tend to focus on elements of trade marks that can be read. The other verbal elements and the colours will play a minimal role in the overall impression of the mark as they are either non-distinctive, non-English words or decorative.

### Visual comparison

35. The competing marks are visually similar in the shared use of the invented word 'Viga'/'VIGA'. This word dominates the overall impressions of both. The competing marks also both contain the word 'Delay'/'DELAY'. The difference in letter case is not significant, since the registration of word-only marks (such as the earlier mark) provides protection for the words themselves, irrespective of whether they are presented in upper, lower or title case.<sup>13</sup> Neither are the particular fonts used in the contested mark a point of significant visual difference because they are standardised and are, thus, likely to go unnoticed by the average consumer. Clearly, the competing marks visually differ in all other respects. Bearing in mind my assessment of the overall impressions, I find that there is a low degree of visual similarity between the competing marks.

### Aural comparison

36. The earlier mark is likely to be pronounced as "VI-GA-DE-LAY". As for the contested mark, whilst I remind myself that the descriptiveness of an element does not necessarily render it aurally invisible,<sup>14</sup> I consider it highly unlikely that all of the verbal elements will be articulated. Consumers do not typically verbalise details on packaging such as ingredients, product numbers or other such information. The average consumer will make no attempt to verbalise the eagle device or the non-English words. As such, it is my view that the average consumer is likely to articulate the contested mark as either "SU-PER-VI-GA-SPRAY", "SU-PER-VI-GA", or simply "VIGA". In all three scenarios, the competing marks aurally coincide in the shared use of the

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<sup>13</sup> *Migros-Genossenschafts-Bund v EUIPO*, Case T-189/16

<sup>14</sup> *The Stockroom (Kent) Ltd v Purity Wellness Group Ltd*, Case BL O/115/22

identical syllables “VI-GA”. The other syllables in the possible pronunciations of the contested mark will render the competing marks aurally similar, overall, to between a low and medium degree, a medium degree, or between a medium and high degree, respectively.

### Conceptual comparison

37. The opponent has submitted that the competing marks share the same concept, due to the presence of the English word ‘Viga’/‘VIGA’. However, for a concept to be relevant, it must be capable of immediate grasp by the relevant consumer.<sup>15</sup> The opponent has neither suggested a meaning for the word nor provided any evidence to demonstrate how it would be understood by the average consumer. As explained previously, I consider it more likely that this element will be perceived as an invented word with no meaning; it is, therefore, conceptually neutral. The competing marks both contain the word ‘Delay’/‘DELAY’, which will be understood in accordance with its dictionary meaning. This is the extent of conceptual overlap, the other meanings conveyed by the contested mark having no counterparts in the earlier mark. Overall, I find that there is a low degree of conceptual similarity between the competing marks.

### **Likelihood of confusion**

38. 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. One such factor is the interdependency principle, i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods, and vice versa. As mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier trade 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 they have retained in their mind.

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<sup>15</sup> *The Picasso Estate v OHIM*, Case C-361/04 P

39. 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.

40. Earlier in this decision, I concluded that:

- The parties' respective goods are identical or similar to at least a medium degree;
- The average consumer of the goods at issue will consist of adult members of the general public, who will demonstrate a medium level of attention when selecting the goods;
- The purchasing process will be predominantly visual in nature, though aural considerations have not been excluded;
- The earlier mark possesses a high level of inherent distinctive character;
- The overall impression of the earlier mark is dominated by the word 'Viga', while the word 'Delay' plays a minimal role;
- The overall impression of the contested mark is dominated by the word 'VIGA', while the eagle device plays a lesser role, and the other verbal and non-verbal elements play a minimal role;
- The competing marks are visually and conceptually similar to a low degree;
- Aural similarity will depend upon which verbal elements the average consumer articulates but will likely range from between a low and medium degree to between a medium and high degree.



41. I acknowledge that the competing marks both contain the invented (and highly distinctive) word 'Viga'/'VIGA', and that this word dominates their overall impressions. I also accept that the other elements in the marks play lesser roles, albeit to varying degrees. Nevertheless, when considering the competing marks as wholes, there are differences between them which are not negligible. Firstly, the contested mark contains a stylised eagle device. This element, although playing a lesser role, still provides a significant contribution to the overall impression and has no counterpart in the earlier mark. Moreover, the contested mark contains a number of other verbal elements that are not replicated in the earlier mark. Whilst I have found that these words play a minimal role in the overall impression of the contested mark, they will not be overlooked entirely by the average consumer. Even if the goods were to be selected aurally (being circumstances where many of the additional verbal elements would not be pronounced), the additional and differing syllables are not negligible. Although they emanate from words which are descriptive or otherwise non-distinctive, they still constitute a point of aural difference between the competing marks. I also note that there is only a low level of conceptual overlap between the competing marks, which arises as a result of the shared use of the descriptive word 'Delay'/'DELAY'. Taking all the above factors into account, despite the earlier mark being highly distinctive, it is my view that the aforementioned differences between the competing marks are likely to be sufficient for the average consumer – paying a medium level of attention during the purchasing process – to distinguish between them and avoid mistaking one for the other. Accordingly, notwithstanding the principles of imperfect recollection and interdependency, it follows that there will be no direct confusion, even in relation to goods which are identical.

42. That leaves indirect confusion to be considered. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis QC, 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 is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the

later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

43. These three categories are not exhaustive. Rather, they were intended to be illustrative of the general approach, as has been confirmed by the Court of Appeal.<sup>16</sup> However, indirect confusion has its limits. I recognise that a finding of indirect confusion should not be made merely because the competing marks share a common element. In this connection, it is not sufficient that a mark merely calls to mind another

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<sup>16</sup> *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207

mark: this is mere association not indirect confusion.<sup>17</sup> The Court of Appeal has also emphasised that, where there is no direct confusion, there must be a “proper basis” for finding indirect confusion.<sup>18</sup>

44. Although I have found that the average consumer will immediately notice and recall the differences between the competing marks, they will also recognise the identical element ‘Viga’/‘VIGA’. Whether consciously or unconsciously, this will lead the average consumer through the mental process described in *L.A. Sugar*. This element is highly distinctive and dominates the overall impressions of the competing marks. As such, the average consumer may assume that no-one else other than the opponent would be using it in a trade mark. Alternatively, to my mind, the differences between the competing marks readily lend themselves to the use of a variant brand. In this connection, the contested mark is liable to be perceived as a variation of the earlier mark as applied to the product packaging, with additional descriptions to provide information about the goods (such as, for example, its ingredients and product number), additional promotional language (such as ‘NEW’ and ‘SUPER’) to attract custom, and additional decorative matter (such as the eagle device and blue background). In my view, this is particularly the case considering the level of distinctive character possessed by the earlier mark and the parties’ goods being identical or similar to at least a medium degree. Taking all of the above into account, I am satisfied that the average consumer – paying no more than a medium level of attention – would assume a commercial association between the parties, or sponsorship on the part of the opponent, due to the presence of the identical and highly distinctive word ‘Viga’/‘VIGA’. Accordingly, I find that there is a likelihood of indirect confusion.

## **Conclusion**

45. The opposition under section 5(2)(b) of the Act has succeeded in full. Subject to any successful appeal, the application will be refused.

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<sup>17</sup> *Duebros Limited v Heirler Cenovis GmbH*, Case BL O/547/17

<sup>18</sup> *Liverpool Gin Distillery*

## **Costs**

46. As the opponent has been successful, they are entitled to a contribution towards their costs. Based upon the scale published in Tribunal Practice Notice 2/2016, I award the opponent the sum of **£600** as a contribution towards the cost of the proceedings. This sum is calculated as follows:

Preparing a statement and considering the applicant's counterstatement	£200
Preparing written submissions	£300
Official fee <sup>19</sup>	£100
<b>Total</b>	<b>£600</b>

47. I order Aalu Ltd to pay Guy Lochner the sum of **£600**. 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 the proceedings if any appeal against this decision is unsuccessful.

**Dated this 28<sup>th</sup> day of February 2023**

**James Hopkins**  
**For the Registrar**

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<sup>19</sup> I note that the opponent paid a fee of £200 for the filing of its Form TM7. However, this fee relates to oppositions which are based on, or include, grounds other than sections 5(1) and/or 5(2). Given the 5(4(a) and 3(6) grounds were withdrawn for want of supporting evidence, it would not be proportionate to award this level of official fees. Rather, I consider it appropriate to award costs for the opponent's official fees in line with oppositions based on sections 5(1) and/or 5(2) of the Act.