

O/0321/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3731056
BY INDIGO COMMUNE LIMITED
TO REGISTER THE FOLLOWING TRADE MARK:

Indigo Commune

IN CLASSES 5, 41 & 44

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 432445
BY O2 WORLDWIDE LIMITED

Background and pleadings

1. On 9 December 2021, INDIGO COMMUNE LIMITED (“the applicant”) applied to register the trade mark **Indigo Commune** in the UK, under number 3731056 (“the contested mark”). Details of the application were published for opposition purposes on 7 January 2022. Registration is sought for the following goods and services:

Class 5: Homeopathic medicines; medicinal drinks; serotherapeutic medicines; medicinal herbs; medicinal oils; oils (medicinal -); herbal medicine; sulphonamides [medicines]; medicinal clays; medicinal beverages; infusions (medicinal -); mud (medicinal -); medicinal mud; medicinal sprays; medicinal alcohol; drinks (medicinal -); medicinal roots; medicinal ointments; medicinal infusions; antiallergic medicines; roots (medicinal -); tonics [medicines]; medicine tonics; herbs (medicinal -); medicinal tea; dragees [medicines]; sulfonamides [medicines]; sarsaparilla beverages [medicinal]; medicinal herb extracts; sediment (medicinal -) [mud]; medicinal herb infusions; constipation (medicines for alleviating -); medicines for human purposes; medicines for intestinal disorders; ginseng for medicinal use; medicinal hair growth preparations; medicines for alleviating constipation; medicine cases, portable, filled; Chinese traditional medicinal herbs; extracts of medicinal plants; medicinal hair growing preparations; extracts of medicinal herbs; sweets for medicinal purposes; seawater for medicinal bathing; decoctions of medicinal herb; confectionery for medicinal purposes; medicinal preparations and substances; hair growth preparations (medicinal -); herbs for medicinal purposes; alcohol for medicinal purposes; diagnostic reagents for medicinal use; beverages adapted for medicinal purposes; medicines for treating intestinal disorders; herbal tea for medicinal use; herb teas for medicinal purposes; artificial tea [for medicinal use]; herbal beverages for medicinal use; herbal teas for medicinal purposes; medicinal creams for skin care; anti-oxidants for medicinal use; medicinal preparations for stimulating hair growth; medicines for adjusting the menstrual cycle; breath-freshening chewing gum for medicinal purposes; medicinal herbal extracts for medical purposes; medicinal herbs in dried or preserved form; medicines for the treatment of gastrointestinal diseases; medicinal preparations for the treatment of infectious

diseases; plant and herb extracts for medicinal use; medicinal creams for the protection of the skin; dried Chinese boxthorn fruits for Chinese medicinal use.

Class 41: Information (Entertainment -).

Class 44: Dietary advice; nutritional advice; advice relating to cosmetics; advice relating to allergies; advice relating to nutrition; dietary and nutritional advice; alternative medicine services; regenerative medicine services.

2. On 7 April 2022, O2 Worldwide Limited (“the opponent”) partially opposed the application under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against the services in class 41 services only. The opponent relies upon its UK trade mark number 3680250,¹ which consists of the following:



(“the earlier mark”)

3. The earlier mark was filed on 11 August 2021 and became registered on 1 April 2022 in respect of a wide range of goods and services in classes 9, 29, 30, 32, 33, 35, 36, 37, 38, 39, 41, 42, 43, 44 and 45. For the purposes of the opposition, the opponent relies upon all its services in class 41. Whilst these are set out in full in the annex to this decision, it is sufficient to record that they include ‘*entertainment information*’ and ‘*information and advisory services relating to entertainment*’.

¹ I note that the opponent also originally sought to rely upon its comparable UK trade mark number 913031869. However, by email on 17 October 2022, the opponent informed the Registrar that it did not wish to submit any evidence. In its official letter dated 25 October 2022, the Registrar confirmed that, in accordance with rule 20(3) of the Trade Marks Rules 2008, the opposition based upon that mark would be withdrawn. This was because the mark was subject to the use requirements, proof of use had been requested by the applicant and no evidence had been filed. No objection to this action was received. Thereafter, the opposition proceeded on the basis of trade mark number 3680250 only.

4. 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 all the services identified, without having to demonstrate genuine use.

5. In its notice of opposition, the opponent contends that the competing marks are similar and that the parties' respective services are identical. Based upon these factors, the opponents submits that there is a likelihood of confusion, including the likelihood of association.

6. The applicant filed a counterstatement, denying the ground of opposition.

7. The opponent is professionally represented by Stobbs, whereas the applicant is not professionally represented. Neither party filed evidence in these proceedings, nor did they request an oral hearing. Neither party elected to file written submissions in lieu of attendance, though I note that the applicant filed written submissions during the evidence rounds. This decision is taken following a careful consideration of the papers before me, keeping all submissions in mind.

8. 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

9. In its counterstatement, the applicant submitted as follows:

“5. The applicant currently owns the business name Indigo Commune and all websites (.com and .co.uk). Since the start of business operations, there has never been any confusion amongst partners or customers regarding whether

the business is just 'Indigo' or 'Indigo Commune'. I will also draw your attention to other 'Indigo' trademarks registered in the UK. None of whom are opposing our mark 'Indigo Commune'."

10. Moreover, within its written submissions, the applicant stated:

"5. Indigo Commune Limited has been using the term 'Indigo Commune' on its website www.indigocommune.com and in all email and marketing correspondence. Not once has it caused confusion in the minds of the public.

[...]

7. The 02 mark 'indigo' is written in a specific colour and font, which is not similar in anyway our logo 'Indigo Commune' as shown below.



8. The Opposition has not provided conclusive evidence of the widespread use of the trademark 'Indigo'. Even if they were to do so, they cannot claim exclusive rights to a word in the English Language.

9. We considered the trademark registry carefully before putting in our application and found other businesses with the trademark 'Indigo' who have not opposed our mark."

11. Through the above, the applicant appears to be essentially arguing that there cannot be a likelihood of confusion because a) the opponent has not demonstrated use of the earlier mark, b) there has been no actual confusion between the competing marks, c) there are other trade marks on the UK register containing the word 'indigo', and d) the way the applicant uses (or intends to use) the contested mark differs from

the earlier mark. For reasons which I will now explain, the applicant's points on these issues will, as a matter of law, have no bearing on the outcome of this opposition.

12. A trade mark registration is essentially a claim to a piece of legal property. Every registered trade mark is entitled to legal protection against the use, or registration, of the same or similar trade marks for the same or similar goods if there is a likelihood of confusion. Once a trade mark has been registered for five years, section 6A of the Act is engaged and the opponent can be required to provide evidence of use of its mark. Until that point, however, the mark is entitled to protection in respect of the full range of goods or services for which it is registered.

13. As outlined above, the mark relied upon by the opponent had not been registered for five years at the date on which the application was filed. Consequently, the opponent is not required to prove its use of it. The earlier mark is, therefore, entitled to protection against a likelihood of confusion with the contested mark based on the 'notional' use of that earlier mark for the services listed in the register. The concept of notional use was explained by Laddie J in *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 like this:

"22. [...] It must be borne in mind that the provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to be a finding of infringement. Similarly, even when the proprietor of a registered mark uses it, he may well not use it throughout the whole width of the registration or he may use it on a scale which is very small compared with the sector of trade in which the mark is registered and the alleged infringer's use may be very limited also. In the former situation, the court must consider notional use extended to the full width of the classification of goods or services. In the latter it must consider notional use on a scale where direct competition between the proprietor and the alleged infringer could take place".

14. Moreover, while evidence of actual confusion may be persuasive where it exists, the absence of confusion in the marketplace is rarely significant. In *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchin LJ stated that:

“80. [...] the likelihood of confusion must be assessed globally taking into account all relevant factors and having regard to the matters set out in *Specsavers* at paragraph [52] and repeated above. If the mark and the sign have both been used and there has been actual confusion between them, this may be powerful evidence that their similarity is such that there exists a likelihood of confusion. But conversely, the absence of actual confusion despite side by side use may be powerful evidence that they are not sufficiently similar to give rise to a likelihood of confusion. This may not always be so, however. The reason for the absence of confusion may be that the mark has only been used to a limited extent or in relation to only some of the goods or services for which it is registered, or in such a way that there has been no possibility of the one being taken for the other. So there may, in truth, have been limited opportunity for real confusion to occur.”

15. Furthermore, in *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283 Millett LJ stated that:

"Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff's registered trade mark."

16. As noted above, neither party has filed any evidence in these proceedings. As such, there is nothing which would enable me to ascertain whether the competing marks have been used side by side, or whether there has been any real possibility for confusion between them to occur.

17. It may also be the case that there are other registered marks containing the word 'indigo'. However, the applicant has not provided any evidence of them. In any event, and perhaps more importantly, there is a distinct lack of evidence that any of those marks are in use and that consumers have become accustomed to differentiating

between them. In *Zero Industry Srl v OHIM*, Case T-400/06, the General Court stated that:

“73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word ‘zero’, it should be pointed out that the Opposition Division found, in that regard, that ‘... there are no indications as to how many of such trade marks are effectively used in the market’. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word ‘zero’ is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T-135/04 *GfK v OHIM – BUS(Online Bus)* [2005] ECR II-4865, paragraph 68, and Case T-29/04 *Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH)* [2005] ECR II-5309, paragraph 71).”

18. Even if it had been established that there are other ‘indigo’ marks on the UK register, the mere fact that the owners of those marks have not opposed the application is not a relevant factor. Whether parties are able to coexist, notwithstanding the existence of any similar trade mark registrations, is a matter for those parties. The same is true in respect of their commercial and/or legal strategies. These matters do not involve the Registrar. It is not open to me to infer the reasons for a party’s decision to oppose or not oppose an application, for example, simply on the basis of the state of the register.

19. Finally, as for the applicant’s claimed use of the contested mark, I must clarify that the figurative mark referred to is not the mark that has been applied for. Although the applicant has suggested the form in which the mark will be used, my assessment later in this decision must take into account only the contested mark – being the plain words ‘Indigo Commune’ – and any potential conflict with the earlier mark.

Decision

The law

20. 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.”

21. 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 services

22. As outlined above, the opponent has argued that the parties' respective services in class 41 are identical. The applicant has been silent on this issue. Arguably, this is tantamount to a tacit acceptance of the opponent's pleaded case.² However, it is not necessary for me to determine this point. This is because the applicant's '*information (entertainment -)*' is self-evidently identical to '*entertainment information*' and '*information and advisory services relating to entertainment*' in class 41 of the earlier mark.

The average consumer and the nature of the purchasing act

23. As the case law above indicates, it is necessary for me to determine who the average consumer is for the parties' services. I must then determine the manner in which the services 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 (as he then was) described the average consumer in these terms:

"60. [...] 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

² *Delta Air Lines, Inc v Ontro Limited*, Case BL O/044/21

“average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

24. For the purposes 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 services in question.³

25. The services at issue in these proceedings are available to the general public. They are likely to be purchased relatively frequently for the purposes of satisfying an ongoing interest in entertainment (such as, for example, films or music), or in preparation of purchasing entertainment services. The purchasing of the services is not likely to follow an overly considered though process; it will be more casual than careful. However, the general public will consider factors such as ease of access, the content of the information and the provider’s knowledge when selecting the services. In light of all this, I find that the average consumer will demonstrate a medium level of attention during the purchasing process. The services are likely to be obtained directly from the provider via websites or printed materials. As such, it is my view that the purchasing process will be predominantly visual in nature. However, aural considerations in the form of word-of-mouth recommendations or verbal discussions with the provider, for instance, cannot be excluded entirely.

Distinctive character of the earlier mark

26. In *Lloyd Schuhfabrik Meyer*, the Court of Justice of the European Union (“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-

³ *Lloyd Schuhfabrik Meyer*

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 services, to those with high inherent distinctive character, such as invented words. Dictionary words which do not allude to the services 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 figurative and comprises the word ‘indigo’ in a blue, standard typeface. The word ‘indigo’ will be immediately understood by the average consumer as referring to a bluish-purple colour. It has no descriptive or allusive qualities in the context of the services relied upon. The distinctive character predominantly lies in the word itself, with the font and colour providing a minimal contribution. Overall, I find that the earlier mark possesses a medium 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
	Indigo Commune

Overall impressions

33. The earlier mark is figurative and comprises the word ‘indigo’ presented in a blue, standard typeface. The word ‘indigo’ dominates the overall impression of the mark, while the font and colour play much lesser roles.

34. The contested mark is in word-only format and consists of the words 'Indigo Commune'. Both words in the mark provide a roughly equal contribution to its overall impression. The words in the mark do not combine to form a unit; each plays an independent distinctive role.

Visual comparison

35. The competing marks are visually similar in that they share the identical word 'indigo'/'Indigo'. This word dominates the overall impression of the earlier mark and appears at the beginning of the contested mark, a position which is generally considered to have more impact.⁴ The difference in letter case is not significant, since the registration of word-only marks (such as the contested mark) provides protection for the words themselves, irrespective of whether they are presented in upper, lower or title case.⁵ Moreover, given that it provides protection for use of the words in any colour or font type,⁶ I do not consider the difference created by the font or colour used in the earlier mark to be significant. Clearly, the competing marks are visually different insofar as the contested mark includes an additional word, i.e. 'Commune', that has no counterpart in the earlier mark. This renders the contested mark much greater in length than the earlier mark. Bearing in mind my assessment of the overall impressions, I find that there is a medium degree of visual similarity between the competing marks.

Aural comparison

36. The word 'indigo'/'Indigo' in the competing marks is a three-syllable word which will be given its ordinary pronunciation. These identical syllables form the entirety of the earlier mark and appear at the beginning of the contested mark. The word 'Commune' in the contested mark is a two-syllable word which will also be given its ordinary pronunciation. This acts as a point of aural difference between the competing

⁴ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

⁵ *Migros-Genossenschafts-Bund v EUIPO*, Case T-189/16

⁶ *LA Superquímica, SA v EUIPO*, Case T-24/17

marks and renders the contested mark longer than the earlier mark. Overall, I find that there is a medium degree of aural similarity between the competing marks.

Conceptual comparison

37. The word 'indigo'/'Indigo' in the competing marks will be understood in accordance with its dictionary meaning, namely, a bluish-purple colour. The word 'Commune' in the contested mark will be understood by the average consumer as groups of families or individuals living and working together sharing possessions and responsibilities. The two words in the contested mark hang together (in the sense that it is grammatically correct for a colour to describe a noun). However, for a concept to be relevant, it must be capable of immediate grasp by the relevant consumer.⁷ As it is not immediately apparent how a commune could be indigo in any logical sense, the words do not combine to form a unit with a different meaning than the two words taken separately. The competing marks conceptually overlap to the extent that they both refer to the same colour but differ in that the contested mark conveys an additional concept that is not replicated by the earlier mark. Bearing in mind my assessment of the overall impressions, I find that the competing marks are conceptually similar to a medium degree.

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 services, 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 services and the nature of the purchasing process. In doing so, I must be mindful 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.

⁷ *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 services down to the responsible undertakings being the same or related.

40. Earlier in this decision, I concluded that:

- The parties' respective services are identical;
- The average consumer of the services is a member of the general public, who will demonstrate a medium level of attention;
- The purchasing process is predominantly visual in nature, though aural considerations have not been discounted;
- The earlier mark has a medium level of inherent distinctive character;
- The overall impression of the earlier mark predominantly lies in the word 'indigo', while the font and colour play much lesser roles;
- Both words which comprise the contested mark provide a roughly equal contribution to its overall impression;
- The competing marks are visually, aurally and conceptually similar to a medium degree.

41. I acknowledge that the competing marks share the word 'indigo'/'Indigo'; this word comprises the entirety of the earlier mark and appears at the beginning of the contested mark, a position which is generally considered to have more impact. I accept that the differences created by the capitalisation, font and use of colour are not significant. Moreover, the common presence of the word creates a conceptual overlap.

Nevertheless, the contested mark contains an additional word, i.e. 'Commune', which is not replicated by the earlier mark. The inclusion of this word renders the contested mark greater in length than the earlier mark, both visually and aurally. Further, given that it co-dominates the overall impression of the contested mark, it is highly unlikely that it will be overlooked by the average consumer. Therefore, despite the distinctive character of the earlier mark, it is my view that the difference created by the additional word is likely to be sufficient for the average consumer – paying a medium level of attention during the purchasing process – to distinguish between the competing marks 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 services 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.⁸

44. 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*, 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

⁸ *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207

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.”

45. 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 mark: this is mere association not indirect confusion.⁹ The Court of Appeal has also emphasised that, where there is no direct confusion, there must be a “proper basis” for finding indirect confusion.¹⁰

46. I am conscious not to artificially dissect the competing marks and I acknowledge that the average consumer tends to perceive trade marks as wholes. However, I have found that the word ‘indigo’/‘Indigo’ dominates the overall impression of the earlier mark and co-dominates that of the contested mark. Further, it plays an independent

⁹ *Duebros Limited v Heirler Cenovis GmbH*, Case BL O/547/17

¹⁰ *Liverpool Gin Distillery*

distinctive role within the contested mark, i.e. it has a distinctive significance which is independent of the significance of the whole. It does not combine with 'Commune' in any logical way and the contested mark is likely to be seen by the average consumer as consisting of two separate and seemingly unconnected elements. The common element between the competing marks is visually, aurally and conceptually identical in all material respects; as explained previously, the differences in capitalisation, font and colour are not significant. Even if these elements were noticed, it is highly likely that they may be misremembered or mistakenly recalled by the average consumer. For instance, it is entirely plausible that the average consumer may not accurately recall the precise capitalisation, colour or typeface used. Although the common element may not be strikingly distinctive, it enjoys a medium level of distinctive character; to my mind, it is sufficiently distinctive to result in confusion occurring. In the circumstances, the differences between the competing marks appear to readily lend themselves to the use of a sub-brand or brand extension. It is my view that the addition of the word 'Commune' may be perceived by consumers as indicating a particular subsect of the 'indigo' brand, constituting entertainment information provided by community of contributors, i.e. a community-led approach to the provision of the services. While the contested mark could notionally be used in the same font and colour as the earlier mark, even where it is not, it is considered that consumers would attribute the presentational differences to a variation of the brand with additional decorative elements. Taking all of the above into account, as well as the parties' services being identical, 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 identical word 'indigo'/'Indigo'. Consequently, I consider there to be a likelihood of indirect confusion.

Conclusion

47. The partial opposition under section 5(2)(b) has been successful. Subject to any successful appeal, the application will be refused in respect of '*information (entertainment -)*' in class 41.

48. The application will proceed to registration in the UK in relation to the remaining goods and services in classes 5 and 44, which were not opposed.

Costs

49. As the opponent has been successful, it is entitled to a contribution towards its costs. Based upon the scale published in Tribunal Practice Notice 2/2016, I award the opponent the sum of £300 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
Official fee	£100
Total	£300

50. I order INDIGO COMMUNE LIMITED to pay O2 Worldwide Limited the sum of £300. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of the proceedings if any appeal against this decision is unsuccessful.

Dated this 31st day of March 2023

James Hopkins
For the Registrar

Annex

Services of registration number 3680250 relied upon

Class 41: Education; providing of training; entertainment; sporting and cultural activities; academies [education]; amusement parks; amusements; arranging and conducting of colloquiums; arranging and conducting of concerts; arranging and conducting of conferences; arranging and conducting of congresses; arranging and conducting of seminars; arranging and conducting of symposiums; arranging and conducting of workshops [training]; arranging of beauty contests; booking of seats for shows; cinema presentations; club services [entertainment or education]; coaching [training]; discotheque services; education information; educational examination; electronic desktop publishing; entertainer services; entertainment information; organisation of fashion shows for entertainment purposes; film production, other than advertising films; gambling; game services provided on-line from a computer network; games equipment rental; health club services [health and fitness training]; holiday camp services [entertainment]; music-halls; news reporters services; organization of shows [impresario services]; organization of sports competitions; party planning [entertainment]; personal trainer services [fitness training]; physical education; practical training [demonstration]; production of music; production of radio and television programmes; production of shows; providing amusement arcade services; providing karaoke services; providing on-line electronic publications, not downloadable; providing sports facilities; publication of books; publication of electronic books and journals on-line; publication of texts, other than publicity texts; radio entertainment; recording studio services; providing recreation facilities; sport camp services; subtitling; television entertainment; theatre productions; ticket agency services [entertainment]; timing of sports events; tuition; interactive entertainment services; electronic games services provided by means of any communications network; entertainment services provided by means of telecommunication networks; education, training, entertainment, sporting and cultural activities information provided by means of telecommunication networks; provision of news information; television production services; television programming services; television production and television programming services provided by means of Internet protocol technology; provision of musical events; entertainment club services; discotheque services;

presentation of live performances; night clubs; rental of music venues and stadiums; casino services; ticket reservations for entertainment, sporting and cultural events; ticket information services for entertainment, sporting and cultural events; ticket agency services for entertainment, sporting and cultural events; provision of on-line computer games; rental of computer games programs; computer and video game amusement services; provision of information, news and commentary in the field of computer games; arranging, organising and conducting computer game competitions; publishing services; providing on-line electronic publications, not downloadable; publication of books; publication of electronic books and journals on-line; publication of texts, other than publicity texts; arranging, organising and conducting of competitions, games and quizzes; arranging, organising and conducting of competitions, games and quizzes for entertainment, recreational, cultural and educational purposes; organisation of awards; career advisory services; conducting of phone-in competitions; booking agency services connected with the issuing of tickets for entertainment events; employment training; information and advisory services relating to the aforesaid; information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet; music recordings, concerts, performances, productions, publishing, instruction, competition services and composition services; musical performances and entertainment; live music services, concerts, shows and performances; music library services; recording of music; music entertainment services; music publishing and music recording services; music group services; tuition and teaching of music; music mixing services; music transcription services; musical performance, education and instruction services; musical composition for others; organisation of music concerts; entertainment services performed by musicians; consultancy on film and music production; rental of phonographic and music recordings; providing digital music [not downloadable] from the internet; ticket reservation and booking services for music concerts; information and advisory services relating to the aforesaid services provided over a telecommunications network.