

O-453-16



TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO 3 105 427 IN THE NAME
OF UFO TOWN LTD

AND IN THE MATTER OF OPPOSITION THERETO BY UFO CONTEMPORARY
INC

Background and pleadings

1. UFO Town Ltd (the applicant) applied to register the trade mark:



in the UK under number 3 105 427 on 23/04/2015. It was accepted and published in the Trade Marks Journal on 19/06/2015 in respect of the following goods in Class 25:

Clothing; menswear, childrenswear, womenswear and footwear.

2. UFO Contemporary Inc (the opponent) opposes the trade mark on the basis of, amongst others, Section 5(2)(b) of the Trade Marks Act 1994 (the Act). This is on the basis of, amongst others, its earlier European Union trade mark 1 801 869: UFO. The following goods are relied upon in this opposition:

Class 25:

Clothing, footwear and headgear.

3. The opponent argues that the respective goods are identical or similar and that the marks are similar.
4. The applicant filed a counterstatement denying the claims made (and requesting that the opponent provides proof of use of its earlier trade mark relied upon).
5. Only the opponent filed evidence in these proceedings. This will be summarised to the extent that it is considered necessary.

6. Only the opponent filed written submissions which will not be summarised but will be taken into account during this decision. No hearing was requested and so this decision is taken following a careful perusal of the papers.

Evidence

7. This is a witness statement from Lorna Brody, dated 3rd March 2016. Ms Brody is the President, Principal and Lead Designer of the opponent. It should be noted that this statement (and the accompanying exhibits) is not summarised in full. Rather, the summary highlights the most cogent evidence as regards proof of use. According to Ms Brody, the turnover figures for sales in the EU during the relevant period¹ was 270,000 (US Dollars); in the UK this was around 46,000 (US Dollars)

8. The exhibits filed include the following:

- A large number of invoices, all dated within the relevant period, in respect of numerous items of clothing. These are sent from the opponent company to distributors across the European Union. Countries include the UK, Greece, Germany, Sweden.
- A list of distributors are provided. It is noted that these include companies in France, UK, Germany, Finland, the Netherlands and Denmark. Screenshots from the various distributors' websites displaying UFO branded clothing is included in Exhibit LB2. It is noted that these include the following sign:



- A number of catalogues are included in exhibits LB3, LB4, LB5 and LB6. Since 2013 digital catalogues have been produced and a copy of this is included at Exhibit LB7.

¹ The relevant period is the five year period prior to the publication date of the application the subject of these proceedings. That is, 19th June 2015 (see section 6A(1)(c) of the Act).

- Details are also provided regarding the distribution of promotional items (stickers, totebags, postcards and the like) to the opponent's various EU distributors. Copies of some of these items are provided in the evidence. In respect of the UK, Fitnay (the UK distributor) used many of these promotional items at the UK's largest dance event *Move It*. At the same event in 2011, 2012 and 2013, UFO branded clothing product were promoted and sold. Exhibit LB17 refers. The clothes have also been exhibited and sold by Fitnay at *The Clothes Show Live* held at Birmingham NEC between 3-8 December 2010. Exhibit LB19 refers. Further, they clothing was also exhibited and sold at the 2011 *Dance Show* in December 2011.

Proof of use

Relevant statutory provision: Section 6A:

9. "Raising of relative grounds in opposition proceedings in case of non-use

6A. - (1) This section applies where -

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a),
(b) or (ba) in relation to which the conditions set out in section 5(1), (2)
or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed
before the start of the period of five years ending with the date of
publication.

(2) In opposition proceedings, the registrar shall not refuse to register the
trade mark by reason of the earlier trade mark unless the use conditions are
met.

(3) The use conditions are met if -

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

10. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. summarised the case law on genuine use of trade marks. He said:

“I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

Conclusions on the evidence filed

11. There are two points which require consideration:

- Can the opponent rely on the form of use shown?
- Is there genuine use? And if so, for which products?

12. I will consider the form of use shown first of all. In respect of invoices, it is noted that it is the earlier trade mark as registered which is used: UFO. The other evidence however (catalogues, photographs/screenshots of websites,

dance shows), show a different trade mark in use:



13. In this respect, I bear in mind the following guidance: In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the Court of Justice of the European Union found that:

“31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas ‘genuine use’, within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, ‘use’ within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish ‘use’ within the meaning of Article 15(1) for the

purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestlé*, the 'use' of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition by a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35 Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term 'genuine use' within the meaning of Article 15(1)". (emphasis added).

14. It is true that there are additional elements present in the use shown. However, the registered mark itself, namely UFO is unaltered. It is considered therefore that the use shown would clearly signify to the relevant class of

persons that it originates from the same undertaking as for the registered mark. The opponent therefore is able to rely on the use shown.

Is there genuine use?

15. It is considered that the evidence overwhelmingly demonstrates that the earlier European Union trade mark has been used in a number of European Union² countries and in respect of a range of different clothing items, including trousers, tops, vest tops, hoodies. It is noted however, that the extent of its use should be limited to clothing as no use has been shown in respect of footwear and minimal use has been demonstrated in respect of headgear. The opposition will therefore proceed on the basis of *clothing* only.

Final remarks: evidence

16. For the sake of completeness it is noted that at various points throughout the evidence, it would appear that the opponent's core market is in respect of those interested in dance, in particular street dance. That said, the items of clothing sold are not designed exclusively for dance and/or other fitness activities in the manner that, for example, ballet clothing is. They are more generic than this in the sense that they are also clearly fashion items that can be worn as everyday clothing. It is considered therefore that these are not exclusively clothing designed to dance in. Rather they are general items of clothing which can also be used to dance in.

² Use in the European Union therefore may constitute genuine use without also showing use in the UK.

Decision

Section 5(2)(b)

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

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

Comparison of goods

18. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut fur Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

19. The earlier goods are clothing. The later goods are *Clothing; menswear, childrenswear, womenswear*. They are self evidently identical.

20. In respect of *footwear*, the following guidance is taken into account:

In the judgment of the Court of Justice of the European Union in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be 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”.

21. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services
- c) The respective trade channels through which the goods or services reach the market
- d) 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;
- e) 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.

22. It is noted that the purpose of footwear is to cover and provide protection for the feet. Further, there is a fashion element to such products in that they are selected according to look, style, colour etc. This purpose and the considerations attached thereto coincide with that of the earlier *clothing* (albeit, for the body rather than the feet). It is acknowledged that they are not in competition with one another and that the trade channels may differ. Nonetheless, they are considered to be highly similar.


Comparison of marks

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

24. 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.

25. The respective trade marks are shown below:

<p style="text-align: center;">UFO</p>	
<p style="text-align: center;">Earlier trade mark</p>	<p style="text-align: center;">Contested trade mark</p>

26. Before comparing the respective marks, I must assess which elements (if any) are dominant and distinctive and as such, should be accorded greater relative weight. The earlier trade mark is comprised of UFO. This also appears in the later trade mark along with TOWN and a pictorial representation of an urban skyline. The word element is distinctive: UFO TOWN, though so is the skyline. There is, therefore, no stand out element which should be accorded greater relative weight.

27. Visually, the marks coincide in respect of UFO and differ in all other respects. It is noted that the letter O in the contested trade mark appears raised and in a smaller size. This has an impact to a certain extent. However, it is merely in keeping with the overall presentation of the later trade mark in that the third letter (W) of TOWN also appears raised and in a smaller size as shown. Further, the O is clearly visible. The word element is still clearly UFO TOWN. As such, it is considered that there is a moderate degree of visual similarity present between the trade marks.

28. Aurally, the marks coincide in respect of UFO, which is highly likely to be articulated as the separate letters – U – F – O which in effect is three syllables. They differ in respect of the addition of TOWN in the later trade mark which adds another (fourth) syllable. Nevertheless, they are considered to be aurally similar to a moderate to high degree.
29. Conceptually, the earlier trade mark is highly likely to be understood as an acronym for “unidentified flying object”. In the later mark, the same acronym appears with TOWN, the latter concept being reinforced by a urban skyline. Though this provides an additional concept, it is considered that it is not enough to overwhelm the idea of an unidentified flying object. It does not have the effect of creating a conceptual gap. Indeed, if anything, the later trade mark conveys the message that this is a UFO town where UFOs might be seen/experienced more frequently. They are conceptually similar to a moderate to high degree.

Average consumer and the purchasing act

30. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.
31. 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.”

32. The goods in question are general items of clothing and footwear and in respect of such, the case law informs that it is the visual impression of the mark that is the most important bearing in mind the manner in which such goods will normally be purchased. This would normally be from a clothes rail, a catalogue or a web site rather than by oral request. In respect of these goods, the average consumer will be the public at large which will display a medium degree of attention during the purchasing process and so can be seen to be reasonably well informed and reasonably observant and circumspect.

Distinctive character of the earlier trade mark

33. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for

which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

34. While the evidence provided by the opponent was sufficient in respect of proving use of its earlier trade mark, it falls short of demonstrating a reputation. However, nothing turns on this point as *prima facie*, UFO is entirely meaningless in respect of clothing. Indeed, it is a striking, distinctive sign. It is considered that it has an above average degree of distinctiveness.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.

35. 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.

The principles

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the

chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(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.

36. In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of 'distinctive character' is

only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

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

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.’

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

37. In respect of the earlier trade mark, it is comprised of only one element – UFO- and so it is within this that its distinctiveness lies. This element is also clearly visible within the later trade mark. Indeed it is half of the word element which itself has at least equal dominance to the non-word element.

38. These are goods that will primarily be sold visually (though aural and conceptual considerations also play a role), by consumers paying a medium degree of attention. The goods have been found to be identical and highly similar. The marks have been found to be aurally and conceptually similar to a moderate to high degree. Notably the concept in common- a UFO is unusual and strong and highly likely to create a hook in the mind of the relevant consumer. Further the marks are also visually similar to a moderate degree.

As regards the likelihood of confusion, the following guidance is taken into account:

39. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, Mr Iain Purvis Q.C. as the Appointed Person noted 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).”

40. It is considered that the circumstances here fall within category a) as described above. UFO is striking and distinctive. The addition of the element “TOWN” plus a graphic of a skyline to not detract from this. Indeed, it is considered highly likely that the later trade mark is likely to be seen as another brand of the owner of the earlier trade mark. As such, there is a clear likelihood of indirect confusion.

41. As such, the opposition succeeds in its entirety.

Final Remarks

42. As this earlier trade mark leads to the opposition being successful in its entirety, there is no need to consider the remaining trade marks upon which the opposition is based.

43. As the opposition is successful in its entirety based upon this ground, there is no need to consider the remaining grounds as they do not materially improve the opponent’s position.

COSTS

44. The opponent has been successful and is entitled to a contribution towards its costs. In the circumstances I award the opponent the sum of £1250 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Notice of Opposition and accompanying statement (plus statutory fee) - £500

Preparing and filing evidence - £750

TOTAL - £1250

45. I therefore order UFO Town Ltd to pay UFO Contemporary Inc the sum of £1250. The above sum should be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 29th day of September 2016

Louise White

For the Registrar