

O/539/19

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003341547 BY
VINOD CHOPRA
TO REGISTER THE FOLLOWING TRADE MARKS (SERIES OF 2):

fivepoundworld

and

5poundworld

IN CLASS 35

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 415056 BY
POUNDLAND LIMITED

BACKGROUND AND PLEADINGS

1. On 27 September 2018, Vinod Chopra (“the applicant”) applied to register the trade marks **fivepoundworld** and **5poundworld** in the UK. The application was published for opposition purposes on 12 October 2018 and registration is sought for the services listed in paragraph **14** below.

2. The application is opposed by Poundland Limited (“the opponent”) based upon sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon the following marks for the purposes of its opposition:

POUNDLAND

EUTM registration no. 8860157

Filing date 4 February 2010; registration date 27 July 2010

(“the First Earlier Mark”)

POUNDLAND

UK registration no. 2279236

Filing date 29 August 2001; registration date 17 December 2004

(“the Second Earlier Mark”)

3. Under section 5(2)(b) the opponent relies upon all goods and services for which the earlier marks are registered (as set out in paragraph **14** below) and claims that there is a likelihood of confusion because the respective goods and services are identical or similar and the marks are similar.

4. Under section 5(3) the opponent claims that it has a reputation in respect of all goods and services for which the earlier marks are registered. The opponent claims that use of the applicant’s mark would, without due cause, take unfair advantage of, or be detrimental to, the distinctive character and/or reputation of the earlier marks.

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

6. The applicant is unrepresented, and the opponent is represented by Freeths LLP. The opponent filed evidence in the form of the witness statement of Mark Duncan Pym dated 26 March 2019. This was accompanied by written submissions dated 27 March 2019. No evidence was filed by the applicant. Neither party requested a hearing and only the opponent filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

EVIDENCE

7. As noted above, the opponent filed evidence in the form of the witness statement of Mr Pym dated 26 March 2019, which was accompanied by 13 exhibits. Mr Pym is the Trading Controller of the opponent; a role he has held since January 2017. I have read the evidence in its entirety, and in particular, I note the following:

a) The opponent has been using its mark since 1990 and now has 764 'Poundland' branded individual shops in the UK¹ which are located across the country;

b) The opponent is known for selling goods for just £1 (which is the case for 90% of its goods) although it also sells goods for £2 and £5²;

c) The marks have been used on the opponent's website between 1998 and 2016³. I note that the website print outs show no examples of the opponent selling its own goods under the marks, but rather, is selling third party branded goods;

d) Copies of adverts that Mr Pym states were placed in the Daily Mirror and OK Magazine between 2014 and 2018 have been provided⁴;

¹ Witness statement of Mark Duncan Pym, para. 5

² Witness statement of Mark Duncan Pym, para. 6

³ Exhibit MDP 6

⁴ Exhibit MDP 7

- e) A print out from the website “Insightdiy” dated April 2015 states that “Poundland is the largest single price value retailer in the UK” and states that “with over 500 stores nationwide, Poundland serves over 4.5million customers every week.⁵” The article notes that in 2015, the opponent’s total revenue was over £1billion;
- f) There are references in the evidence to Poundland’s own brands but these do not appear to be sold under the earlier marks, but rather the opponent’s other brands such as #6, Bling Ring and Twin Peakes;
- g) The opponent promotes its services on social media including its Facebook account (which has 395,000 followers) and its Twitter account (which has 119,000 followers⁶;
- h) The opponent released its first TV advert in 2017 which was aired on a number of channels and a television programme about its stores was aired on ITV in June 2017;
- i) Turnover for goods sold under the services in the UK was £880million until March 2013, £997million until March 2014, £1.1billion until March 2015, £1.2billion until March 2016 and £2.2billion until October 2017⁷;
- j) The opponent’s advertising expenditure was approximately £500,000 per year in 2015, 2017 and 2018⁸; and
- k) The opponent won Discount Retailer of the Year in 2011, 2012 and 2013⁹.

8. As noted above, the opponent’s evidence was accompanied by written submissions. The opponent also filed written submissions in lieu. Whilst I do not propose to

⁵ Exhibit MDP 7

⁶ Witness statement of Mark Duncan Pym, para. 14 and Exhibit MDP 8

⁷ Witness statement of Mark Duncan Pym, para. 17

⁸ Witness statement of Mark Duncan Pym, para. 18

⁹ Witness statement of Mark Duncan Pym, para. 19 and Exhibit MDP 11

summarise these here, I have taken them into consideration and will refer to them below where necessary.

DECISION

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

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

(a)...

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

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

10. Section 5(3) of the Act states:

“5(3) A trade mark which -

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.”

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

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

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

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

12. The trade marks upon which the opponent relies qualify as earlier trade marks under the above provisions. As the opponent’s marks completed their registration processes more than five years before the publication date of the application in issue in these proceedings, they are subject to proof of use pursuant to section 6A of the Act. However, the applicant did not request that the opponent provide proof of use of its marks and the opponent is, therefore, entitled to rely upon all goods and services for which its marks are registered.

Section 5(2)(b)

13. 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 greater degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings to mind the earlier mark, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

14. The competing goods and services are as follows:

Opponent's goods and services	Applicant's services
<p>The First Earlier Mark</p> <p><u>Class 35</u></p> <p>Retail services connected with the sale of stationery, printed matter, printed publications, diaries and personal organisers, greeting cards, gift wrap, party ware, disposable tableware, travel goods, household containers, crockery and tableware, cooking pans and implements, ornaments, household or kitchen utensils, porcelain, glassware, earthenware, furniture, mirrors, photograph and picture frames, furnishings, textile goods, bed linen, towels, floor coverings, rugs, wallpaper and wall coverings, clothing, footwear, headgear, haberdashery, hair accessories, toys, games, playthings, sporting goods, sporting apparatus and equipment, fitness equipment, Christmas and seasonal decorations,</p>	<p><u>Class 35</u></p> <p>Retail services connected with stationery; Retail services connected with the sale of clothing and clothing accessories; Retail services connected with the sale of furniture; Retail services connected with the sale of pre-paid encoded cards (for others); Retail services connected with the sale of subscription boxes containing chocolates; Retail services connected with the sale of subscription boxes containing cosmetics; Retail services connected with the sale of subscription boxes containing food; Retail services for computer software; Retail services for pharmaceutical, veterinary and sanitary preparations and medical supplies; Retail services for works of art provided by art galleries; Retail services in relation to agricultural equipment; Retail services</p>

confectionery, fresh fruit and vegetables, foodstuffs' non-alcoholic and alcoholic beverages, tobacco and tobacco goods, smokers' goods, smokers' requisites, weed killer, pet food and pet accessories, car accessories, nappies, perfume, toiletries, cosmetics, candles, non prescription medicines, optical goods, sunglasses, audio tapes, CDs, videos & DVDs, mobile phone top up cards, domestic lighting and parts and accessories therefor, clocks, watches, hand tools and implements, leather goods, bags, purses, wallets, luggage, umbrellas, jewellery, garden tools and DIY equipment.

The Second Earlier Mark

Class 3

Bleaching preparations; cleaning, polishing, scouring and abrasive preparations; laundry products; soaps; perfumery cosmetics; hair care products; dentifrices.

Class 8

Hand tools and implements; cutlery; razors.

Class 9

Instructional, teaching and measuring apparatus and instruments; adding machines; calculators; amusement

in relation to alcoholic beverages (except beer);Retail services in relation to animal grooming preparations; Retail services in relation to art materials; Retail services in relation to articles for use with tobacco; Retail services in relation to audio-visual equipment; Retail services in relation to bags; Retail services in relation to baked goods; Retail services in relation to bakery products; Retail services in relation to beauty implements for animals; Retail services in relation to bedding for animals; Retail services in relation to beer; Retail services in relation to bicycle accessories; Retail services in relation to building materials; Retail services in relation to car accessories; Retail services in relation to chemicals for use in agriculture; Retail services in relation to chemicals for use in forestry; Retail services in relation to chemicals for use in horticulture; Retail services in relation to chocolate; Retail services in relation to cleaning articles; Retail services in relation to cleaning preparations; Retail services in relation to clothing; Retail services in relation to clothing accessories; Retail services in relation to cocoa; Retail services in relation to coffee; Retail services in relation to computer hardware; Retail services in relation to computer software; Retail services in relation to

machines; batteries; computers; computer hardware, software and firmware; lamps; scientific apparatus and instruments; apparatus and instruments all for the recordal, storage transmission and reproduction of audio, visual and audio visual data; viewers and projectors; buoyancy aids; parts and fittings for the aforesaid goods.

Class 16

Papers; cardboard; articles of paper or of cardboard; portable printing sets, modelling materials; chalk; books; printed matter; greetings cards; printed publications; photographs, pictures and posters; charts; stationery; artists and writing implements and materials; instructional and teaching materials; glues and adhesives; paint brushes; playing cards; albums; babies and childrens' napkins of paper; blackboards, drawing boards and easels; transfers; plans, maps and globes; erasers; alphabetic letters and numeral symbols; stencils; cases and holders for the aforesaid goods; parts and fittings for all the aforesaid goods.

Class 21

Household and kitchen utensils and containers, glassware, porcelain and earthenware.

confectionery; Retail services in relation to construction equipment; Retail services in relation to cookware; Retail services in relation to cooling equipment; Retail services in relation to cutlery; Retail services in relation to dairy products; Retail services in relation to desserts; Retail services in relation to dietary supplements; Retail services in relation to dietetic preparations; Retail services in relation to disposable paper products; Retail services in relation to diving equipment; Retail services in relation to domestic electrical equipment; Retail services in relation to domestic electronic equipment; Retail services in relation to downloadable electronic publications; Retail services in relation to downloadable music files; Retail services in relation to earthmoving equipment; Retail services in relation to educational supplies; Retail services in relation to fabrics; Retail services in relation to fashion accessories; Retail services in relation to festive decorations; Retail services in relation to floor coverings; Retail services in relation to fodder for animals; Retail services in relation to food cooking equipment; Retail services in relation to food preparation implements; Retail services in relation to foodstuffs; Retail services in relation to footwear; Retail services in

Class 28

Toys, games and playthings.

Class 29

Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, fruit sauces; eggs, milk and milk products; edible oils and fats; frozen foods; chilled foodstuffs; frozen vegetables, potato and fruit products; potato crisps; potato chips; potato products in the form of snack foods; preparations consisting principally of dehydrated meat, dehydrated poultry and/or dehydrated vegetables for making instant meals and for making instant snack foods; instant meals; prepared meals; desserts and preparations for making desserts; nuts and mixtures of nuts and dried fruits; sea foods; meat products; extracts of fruit and/or vegetables; fruit preserves, vegetable preserves; dairy products; cheese; cheese spreads; cheese dips; yoghurt, frozen yoghurt; vegetable oils and fats; nut butter; pickles; food spreads; soups; fruit snack bars; snack foods.

Class 30

Frozen foods; chilled foodstuffs; prepared meals; instant meals; snack

relation to fragrancings preparations; Retail services in relation to freezing equipment; Retail services in relation to frozen yogurts; Retail services in relation to fuels; Retail services in relation to furnishings; Retail services in relation to furniture; Retail services in relation to games; Retail services in relation to gardening articles; Retail services in relation to gardening products; Retail services in relation to hair products; Retail services in relation to hand-operated implements for construction; Retail services in relation to hand-operated tools for construction; Retail services in relation to headgear; Retail services in relation to hearing protection devices; Retail services in relation to heaters; Retail services in relation to heating equipment; Retail services in relation to horticulture equipment; Retail services in relation to horticulture products; Retail services in relation to hygienic implements for animals; Retail services in relation to hygienic implements for humans; Retail services in relation to ice creams; Retail services in relation to information technology equipment; Retail services in relation to jewellery; Retail services in relation to kitchen appliances; Retail services in relation to kitchen knives; Retail services in relation to lighting; Retail services in

<p>foods; snack foods made from flour, cereals and/or farinaceous substances; preparations for making instant meals and instant snack foods; preparations consisting principally of noodles, rice, spaghetti or pasta for making instant meals and for making instant snack foods; chutneys, sauces and ketchup's; desserts; preparations for making desserts; popcorn; coated nuts; coffee, coffee essences and coffee extracts; mixtures of coffee and chicory; chicory and chicory mixtures, all for use as substitutes for coffee; tea; cocoa; preparations made principally of cocoa; chocolate; chocolate products; confectionery; candy; sugar; flour; breakfast cereals; pizzas; pasta and pasta products; bread; biscuits; pastries; cakes; pastry; ice, ice cream, water ices, frozen confections; preparations for making ice cream and/or water ices and/or frozen confections; honey; preparations consisting wholly or substantially wholly of sugar, for use as substitutes for honey; syrup, treacle, molasses; preparations for making sauces; spices; vinegars; custard powders; salad dressings; mousses; puddings.</p> <p><u>Class 35</u></p>	<p>relation to litter for animals; Retail services in relation to lubricants; Retail services in relation to luggage; Retail services in relation to meats; Retail services in relation to medical apparatus; Retail services in relation to medical instruments; Retail services in relation to metal hardware; Retail services in relation to mobile phones; Retail services in relation to musical instruments; Retail services in relation to navigation devices; Retail services in relation to non-alcoholic beverages; Retail services in relation to paints; Retail services in relation to pet products; Retail services in relation to pharmaceutical preparations; Retail services in relation to physical therapy equipment; Retail services in relation to pre-paid encoded cards (for others); Retail services in relation to preparations for making alcoholic beverages; Retail services in relation to preparations for making beverages; Retail services in relation to printed matter; Retail services in relation to pushchairs; Retail services in relation to recorded content; Retail services in relation to refrigerating equipment; Retail services in relation to saddlery; Retail services in relation to safes; Retail services in relation to sanitary installations; Retail services in relation to sanitation equipment; Retail services in</p>
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<p>The bringing together for the benefit of others of a variety of goods, enabling customers to conveniently view and purchase those goods from a supermarket; the bringing together, for the benefit of others, of a variety of goods through a home shopping channel to enable customers to conveniently view and purchase those goods by means of telecommunications or the Internet; the bringing together, for the benefit of others, of a variety of goods found in a home shopping catalogue, enabling customers to conveniently view and purchase those goods by mail order or telecommunications or the Internet; the bringing together, for the benefit of others, of a variety of goods enabling customers to conveniently view and purchase those goods from a general merchandise Internet website.</p>	<p>relation to seafood; Retail services in relation to sewing articles; Retail services in relation to sex aids; Retail services in relation to smartphones; Retail services in relation to smartwatches; Retail services in relation to sorbets; Retail services in relation to sporting articles; Retail services in relation to sporting equipment; Retail services in relation to stationery supplies; Retail services in relation to sun tanning appliances; Retail services in relation to tableware; Retail services in relation to teas; Retail services in relation to threads; Retail services in relation to time instruments; Retail services in relation to tobacco; Retail services in relation to toiletries; Retail services in relation to toys; Retail services in relation to umbrellas; Retail services in relation to vehicles; Retail services in relation to veterinary apparatus; Retail services in relation to veterinary articles; Retail services in relation to veterinary instruments; Retail services in relation to veterinary preparations; Retail services in relation to wall coverings; Retail services in relation to water supply equipment; Retail services in relation to weapons; Retail services in relation to wearable computers; Retail services in relation to works of art; Retail services in relation to yarns; Retail services relating</p>
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	<p>to alcoholic beverages; Retail services relating to audiovisual equipment; Retail services relating to automobile accessories; Retail services relating to automobile parts; Retail services relating to candy; Retail services relating to clothing; Retail services relating to delicatessen products; Retail services relating to fake furs; Retail services relating to flowers; Retail services relating to food; Retail services relating to food preparation implements; Retail services relating to fragrancings preparations; Retail services relating to fruit; Retail services relating to furniture; Retail services relating to furs; Retail services relating to horticultural equipment; Retail services relating to horticultural products; Retail services relating to jewelry; Retail services relating to kitchen knives; Retail services relating to live animals; Retail services relating to sporting goods; Retail services via catalogues related to alcoholic beverages (except beer);Retail services via catalogues related to beer; Retail services via catalogues related to foodstuffs; Retail services via catalogues related to non-alcoholic drinks; Retail services via global computer networks related to alcoholic beverages (except beer);Retail services via global computer networks related to beer; Retail services</p>
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	via global computer networks related to foodstuffs; Retail services via global computer networks related to non-alcoholic beverages; Retail shop window display arrangement services; Retail store services in the field of clothing.
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15. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union (“CJEU”) 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.”

16. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (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. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of ‘dessert sauce’ did not include jam, or because the ordinary and natural description of jam was not ‘a dessert sauce’. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

18. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

“I should add that I see no reason to give the word “cosmetics” and “toilet preparations”... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context.”

19. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as the then was) stated that:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

20. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) stated that:

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

21. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that “complementary” means:

“... there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think the responsibility for those goods lies with the same undertaking.”

22. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted, as the Appointed Person, in *Sandra Amelia Mary Elliot v LRC Holdings Limited*, BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense – but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“... it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

23. “Retail services connected with stationery”, “retail services connected with the sale of clothing”, “Retail services in relation to clothing”, “Retail services relating to clothing”, “Retail store services in the field of clothing”, “retail services connected with the sale of furniture”, “Retail services relating to furniture”, “Retail services in relation to bags”, “Retail services in relation to car accessories”, “Retail services relating to automobile accessories”, “Retail services in relation to confectionery”, “Retail services in relation to floor coverings”, “Retail services in relation to foodstuffs”, “Retail services relating to food”, “Retail services in relation to footwear”, “Retail services in relation to fragrancings preparations”, “Retail services relating to fragrancings preparations”, “Retail services in relation to furnishings”, “Retail services in relation to furniture”, “Retail services in relation to games”, “Retail services in relation to headgear”, “Retail services in relation to jewellery”, “Retail services relating to jewelry”, “Retail services in relation to luggage”, “Retail services in relation to printed matter”, “Retail services in relation to stationery supplies”, “Retail services in relation to tableware”, “Retail services in relation to toiletries”, “Retail services in relation to toys”, “Retail services in relation to wall coverings” and “Retail services in relation to umbrellas” in the applicant’s specification are self-evidently identical to “Retail services connected with the sale of stationery, printed matter, [...] tableware, [...] furniture, [...] furnishings, [...] floor coverings, [...] wall coverings, clothing, footwear, headgear, [...] toys, games, [...] confectionery, [...] foodstuffs, [...] car accessories, [...] perfume, toiletries, [...] bags, [...] luggage, umbrellas, jewellery [...]” in the opponent’s specification.

24. “Retail services connected with the sale of subscription boxes containing chocolates”, “Retail services in relation to chocolate” and “Retail services relating to

candy” in the applicant’s specification fall within the broader category of “Retail services connected with the sale of [...] confectionery” in the opponent’s specification. These services can be considered identical on the principle outlined in *Meric*.

25. “Retail services connected with the sale of subscription boxes containing cosmetics” in the applicant’s specification falls within the broader category of “Retail services connected with the sale of [...] cosmetics” in the opponent’s specification. These services can be considered identical on the principle outlined in *Meric*.

26. “Retail services connected with the sale of subscription boxes containing food”, “Retail services in relation to baked goods”, “Retail services in relation to bakery products”, “Retail services in relation to dairy products”, “Retail services in relation to desserts”, “Retail services in relation to frozen yogurts”, “Retail services in relation to ice creams”, “Retail services in relation to meats”, “Retail services in relation to seafood”, “Retail services in relation to sorbets”, “Retail services relating to delicatessen products”, “Retail services relating to fruit”, “Retail services via catalogues related to foodstuffs” and “Retail services via global computer networks related to foodstuffs” in the applicant’s specification fall within the broader category of “Retail services connected with the sale of [...] foodstuffs” in the opponent’s specification. These services can, therefore, be considered identical on the principle outlined in *Meric*.

27. “Retail services in relation to alcoholic beverages (except beer)”, “Retail services in relation to beer”, “Retail services in relation to cocoa”, “Retail services in relation to coffee”, “Retail services in relation to non-alcoholic beverages”, “Retail services in relation to teas”, “Retail services relating to alcoholic beverages”, “Retail services via catalogues related to alcoholic beverages (except beer)”, “Retail services via catalogues related to beer”, “Retail services via catalogues related to non-alcoholic drinks”, “Retail services via global computer networks related to alcoholic beverages (except beer)”, “Retail services via global computer networks related to beer” and “Retail services via global computer networks related to non-alcoholic beverages” in the applicant’s specification fall within the broader category of “Retail services connected with the sale of [...] non-alcoholic and alcoholic beverages” in the

opponent's specification. These services can, therefore, be considered identical on the principle outlined in *Meric*.

28. "Retail services in relation to articles for use with tobacco" and "Retail services in relation to tobacco" in the applicant's specification fall within the broader category of "retail services connected with the sale of [...] tobacco and tobacco goods" in the opponent's specification. These services can, therefore, be considered identical on the principle outlined in *Meric*.

29. "Retail services in relation to diving equipment", "Retail services in relation to sporting articles", "Retail services in relation to sporting equipment" and "Retail services relating to sporting goods" in the applicant's specification fall within the broader category of "Retail services connected with the sale of [...] sporting apparatus and equipment" in the opponent's specification. These services can, therefore, be considered identical on the principle outlined in *Meric*.

30. "Retail services connected with the sale of [...] domestic lighting and parts and accessories therefor" in the opponent's specification falls within the broader categories of "Retail services in relation to domestic electrical equipment" and "Retail services in relation to domestic electronic equipment" in the applicant's specification. These services can, therefore, be considered identical on the principle outlined in *Meric*.

31. "Retail services connected with the sale of [...] cooking pans and implements" in the opponent's specification falls within the broader categories of "retail services in relation to cookware", "Retail services in relation to food cooking equipment", "Retail services in relation to food preparation implements" and "Retail services relating to food preparation implements" in the applicant's specification. These services can be considered identical on the principle outlined in *Meric*.

32. "Retail services in relation to festive decorations" in the applicant's specification falls within the broader category of "Retail services connected with the sale of [...] Christmas and seasonal decorations" in the opponent's specification. These services can, therefore, be considered identical on the principle outlined in *Meric*.

33. 'Fodder' is food given to farm animals. Some such animals may also be kept as pets (such as horses). "Retail services connected with the sale of [...] pet food" in the opponent's specification would, therefore, fall within the broader category of "Retail services in relation to fodder for animals" in the applicant's specification. These services can, therefore, be considered identical on the principle outlined in *Meric*. If I am wrong in this finding then they will overlap in user, use, method of use and trade channels and will be highly similar.

34. "Retail services connected with the sale of [...] garden tools" in the opponent's specification falls within the broader categories of "Retail services in relation to gardening articles", "Retail services in relation to gardening products", "Retail services in relation to horticulture equipment", "Retail services in relation to horticulture products", "Retail services relating to horticultural equipment" and "Retail services relating to horticultural products" in the applicant's specification. These services can, therefore, be considered identical on the principle outlined in *Meric*.

35. "Retail services connected with the sale of [...] hand tools and implements" in the opponent's specification falls within the broader categories of "Retail services in relation to hand-operated implements for construction", "Retail services in relation to construction equipment" and "Retail services in relation to hand-operated tools for construction" in the applicant's specification. These services can, therefore, be considered identical on the principle outlined in *Meric*.

36. "Retail services connected with the sale of [...] pet food and pet accessories" in the opponent's specification falls within the broader category of "Retail services in relation to pet products" in the applicant's specification. These services can, therefore, be considered identical on the principle outlined in *Meric*.

37. The Cambridge English Dictionary defines haberdashery as:

"Cloth, pins, threads, etc. used for sewing, or a shop or a department of a large store that sells these."¹⁰

¹⁰ <https://dictionary.cambridge.org/dictionary/english/haberdashery>

38. I therefore consider that “Retail services in relation to fabrics”, “Retail services in relation to sewing articles”, “Retail services in relation to threads” and “Retail services in relation to yarns” in the applicant’s specification all fall within the broader category of “Retail services connected with the sale of [...] textile goods, [...] haberdashery” in the opponent’s specification. These services can, therefore, be considered identical on the principle outlined in *Meric*.

39. “Retail services connected with the sale of [...] clocks, watches” in the opponent’s specification falls within the broader category of “retail services in relation to time instruments” in the applicant’s specification. These services can, therefore, be considered identical on the principle outlined in *Meric*.

40. “Retail services connected with the sale of [...] weed killer” in the opponent’s specification falls within the broader categories of “Retail services in relation to chemicals for use in agriculture”, “Retail services in relation to chemicals for use in forestry” and “Retail services in relation to chemicals for use in horticulture” in the applicant’s specification. These services can, therefore, be considered identical on the principle outlined in *Meric*.

41. “Retail services connected with the sale of [...] non prescription medicines” in the opponent’s specification falls within the broader categories of “Retail services in relation to pharmaceutical preparations” and “Retail services for pharmaceutical [...] preparations and medical supplies” in the applicant’s specification. These services can, therefore, be considered identical on the principle outlined in *Meric*.

42. “Retail services connected with the sale of [...] domestic lighting” in the opponent’s specification falls within the broader category of “Retail services in relation to lighting” in the applicant’s specification. These services can, therefore, be considered identical on the principle outlined in *Meric*.

43. “Retail services in relation to cutlery” in the applicant’s specification falls within the broader category of “retail services connected with the sale of [...] crockery and

tableware” in the opponent’s specification. These services can, therefore, be considered identical on the principle outlined in *Meric*.

44. Dietary supplements can be recommended for the treatment of medical conditions (such as iron supplements for anemia) and may also take the form of food products (such as nutrient enriched cereal bars). Consequently, I consider that “Retail services in relation to dietary supplements” and “Retail services in relation to dietetic preparations” in the applicant’s specification will fall into the broader categories of “Retail services connected with the sale of [...] non prescription medicines” and “Retail services connected with the sale of [...] foodstuffs” in the opponent’s specification. These services can, therefore, be considered identical on the principle outlined in *Meric*.

45. “Retail services connected with the sale of clothing accessories”, “Retail services in relation to clothing accessories” and “Retail services in relation to fashion accessories” in the applicant’s specification will overlap in nature, user, method of use and trade channels with “Retail services connected with the sale of [...] clothing” in the opponent’s specification. These services are highly similar.

46. “Retail services in relation to physical therapy equipment” in the applicant’s specification will cover retail services for goods which are the same or similar as those covered by “Retail services connected with the sale of [...] sporting apparatus and equipment” in the opponent’s specification. There will be overlap in user, trade channels and method of use. I consider the services to be similar to at least a medium degree.

47. “Retail services in relation to animal grooming preparations”, “Retail services in relation to beauty implements for animals”, “Retail services in relation to bedding for animals” and “Retail services in relation to litter for animals” in the applicant’s specification will overlap in user and trade channels with “Retail services connected with the sale of [...] pet accessories” in the opponent’s specification. The services will clearly overlap in nature. I consider there to be at least a medium degree of similarity between these services.

48. “Artists and writing implements and materials” in the opponent’s specification will overlap in trade channels and user with “Retail services in relation to art materials” and “Retail services in relation to paints” in the applicant’s specification. They will clearly differ in nature but there will be a degree of complementarity. I consider the goods and services to be similar to at least a medium degree.

49. “Cleaning, polishing, scouring and abrasive preparations” in the opponent’s specification will overlap in trade channels and user with “Retail services in relation to cleaning articles” and “Retail services in relation to cleaning preparations” in the applicant’s specification. They will clearly differ in nature but there will be a degree of complementarity. I consider the goods and services to be similar to at least a medium degree.

50. The Cambridge English Dictionary defines a computer as:

“An electronic machine that is used for storing, organizing, and finding words, numbers, and pictures, for doing calculations, and for controlling other machines.¹¹”

51. “Computers” and “computer hardware, software and firmware” in the opponent’s specification will overlap in user and trade channels with “Retail services for computer software”, “Retail services in relation to computer hardware”, “Retail services in relation to computer software”, “Retail services in relation to information technology equipment”, “Retail services in relation to smartwatches”, “Retail services in relation to smartphones”, “Retail services in relation to mobile phones” and “Retail services in relation to wearable computers” in the applicant’s specification. The goods and services will differ in nature, but there will be a degree of complementarity between them. I consider the goods and services to be similar to at least a medium degree.

52. “Retail services in relation to educational supplies” in the applicant’s specification will overlap in user and trade channels with “Instructional, teaching and measuring apparatus and instruments” in the opponent’s specification. The goods and services

¹¹ <https://dictionary.cambridge.org/dictionary/english/computer>

will clearly differ in nature but there will be a degree of complementarity between them. I consider the goods and services to be similar to at least a medium degree.

53. “Apparatus and instruments all for the recordal, storage transmission and reproduction of audio, visual and audio visual data” in the opponent’s specification will overlap in user and trade channels with “Retail services in relation to audio-visual equipment”, “Retail services in relation to downloadable music files”, “Retail services in relation to recorded content” and “Retail services relating to audiovisual equipment” in the applicant’s specification. They will clearly differ in nature but there will be a degree of complementarity between them. I consider the goods and services to be similar to at least a medium degree.

54. “Hair care products” in the opponent’s specification will overlap in user and trade channels with “Retail services in relation to hair products” in the applicant’s specification. The goods and services will clearly differ in nature but there will be a degree of complementarity between them. I consider the goods and services to be similar to at least a medium degree.

55. “Retail services connected with the sale of [...] printed publications” in the opponent’s specification will overlap in user and trade channels with “Retail services in relation to downloadable electronic publications” in the applicant’s specification. For example, it is not uncommon for magazines or newspapers to offer both printed and online equivalents of a publication. The services will be in competition. I consider the services to be similar to at least a medium degree.

56. “Retail services in relation to kitchen knives” and “Retail services relating to kitchen knives” in the applicant’s specification will overlap in user and trade channels with “Retail services connected with the sale of [...] kitchen utensils” in the opponent’s specification. The nature of the services is the same. I consider the services to be similar to a medium degree.

57. “Retail services in relation to disposable paper products” in the applicant’s specification will include items such as disposable table cloths and napkins. There will, therefore, be overlap in user and trade channels with “Retail services connected with

the sale of [...] disposable tableware” in the opponent’s specification. The nature of the services is the same. I consider the services to be similar to a medium degree.

58. The opponent states that “Retail services in relation to hygienic implements for humans” in the applicant’s specification is similar to “Retail services connected with the sale of [...] perfumes, toiletries, cosmetics” in its own specification. I consider that “hygienic implements” in the applicant’s specification would cover those goods that are used for the purposes of personal hygiene (such as sponges or shower brushes). There would, therefore, be overlap in user and trade channels with the opponent’s retail services. I consider the services to be similar to a medium degree. The same will also apply to “retail services for [...] sanitary preparations” in the applicant’s specification.

59. I also, therefore, consider that there will be a medium degree of similarity between “retail services in relation to hygienic implements for animals” in the applicant’s specification and “Retail services connected with the sale of [...] pet accessories” in the opponent’s specification for the reasons set out above.

60. “Retail services in relation to bicycle accessories” in the applicant’s specification may overlap in trade channels with “Retail services connected with the sale of [...] car accessories” in the opponent’s specification. Retail outlets are known to sell both bicycle accessories (such as bells or repair kits) and car accessories (such as replacement wiper blades). I consider the services to be similar to a medium degree.

61. It is not uncommon for the same retailers to provide services for the purchase of vehicles as well as their parts and accessories. I therefore consider that there will be an overlap in trade channels and user between “Retail services in relation to vehicles” and “Retail services relating to automobile parts” in the applicant’s specification and “Retail services connected with the sale of [...] car accessories” in the opponent’s specification. I consider the services to be similar to a medium degree.

62. The opponent submits that “Retail services in relation to kitchen appliances” in the applicant’s specification is similar to “Retail services connected with the sale of [...] household containers, crockery and tableware, cooking pans and implements,

household or kitchen utensils, porcelain, glassware, earthenware” in its own specification. However, kitchen appliances would cover items such as hobs, ovens and refrigerators which are not typically provided through the same trade channels as the goods to which the opponent’s retail services relate. There will be overlap in user in that they are all used by members of the public but this is not sufficient for a finding of similarity. There is no overlap in method of use, nature or uses. There is no competition or complementarity between them. I consider the services to be dissimilar. If I am wrong in this finding, then they will be similar to only a low degree.

63. “Retail services for [...] veterinary preparations”, “Retail services in relation to veterinary apparatus”, “Retail services in relation to veterinary articles”, “Retail services in relation to veterinary instruments” and “Retail services in relation to veterinary preparations” in the applicant’s specification are, to my mind, further removed from “retail services connected with the sale of [...] pet accessories” because they cover specifically medical type products for animals which would not be covered by the term “pet accessories”. If I am correct in this, then there will be no overlap in trade channels. The nature and user of the services will overlap, but this is not sufficient on its own for a finding of similarity. I consider the services to be dissimilar. If I am wrong, then they will be similar to only a low degree.

64. “Retail services in relation to preparations for making alcoholic beverages” and “Retail services in relation to preparations for making beverages” in the applicant’s specification is, in the absence of any submissions to assist me, unlikely to overlap in trade channels with the opponent’s beverage retail services because the opponent’s services relate to the sale of the final product and the applicant’s services relate to the sale of an ingredient for that product. There may also be different users with members of the general public using the opponent’s services and manufacturers of beverages using the applicant’s services. In my view, the services are dissimilar. However, if I am wrong in this finding then they will be similar to only a low degree.

65. I note that the opponent relies on the class 35 services in the Second Earlier Mark. However, this term is too broad for me to properly consider it. It refers to retail services generally and does not specify to what goods those retail services relate. In the

absence of any submissions to assist me, I can see no point of similarity between the applicant's specification and the following services:

Retail services connected with the sale of pre-paid encoded cards (for others); Retail services for works of art provided by art galleries; Retail services in relation to agricultural equipment; Retail services in relation to building materials; Retail services in relation to cooling equipment; Retail services in relation to earthmoving equipment; Retail services in relation to freezing equipment; Retail services in relation to fuels; Retail services in relation to hearing protection devices; Retail services in relation to heaters; Retail services in relation to heating equipment; Retail services in relation to lubricants; Retail services in relation to medical apparatus; Retail services in relation to medical instruments; Retail services in relation to metal hardware; Retail services in relation to musical instruments; Retail services in relation to navigation devices; Retail services in relation to pre-paid encoded cards (for others); Retail services in relation to pushchairs; Retail services in relation to refrigerating equipment; Retail services in relation to saddlery; Retail services in relation to safes; Retail services in relation to sanitary installations; Retail services in relation to sanitation equipment; Retail services in relation to sex aids; Retail services in relation to sun tanning appliances; Retail services in relation to water supply equipment; Retail services in relation to weapons; Retail services in relation to works of art; Retail services relating to fake furs; Retail services relating to flowers; Retail services relating to furs; Retail services relating to live animals; Retail shop window display arrangement services.

66. As some degree of similarity is required for there to be a likelihood of confusion under section 5(2)(b), the opposition must fail in respect of these services.

The average consumer and the nature of the purchasing act

67. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then determine the manner in which the goods are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem*

Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median”.

68. The average consumer for the goods and services is likely to be either a member of the general public or a professional. Some of the services relate to goods which are particularly low cost and may be an impulse buy (such as a chocolate bar). For some of the goods and services, even where the purchases are of low value, there will still be certain factors taken into account by the consumer (such as suitability for the customer’s specific requirements and the experience provided by the service provider). For some of the services (such as where medical items are being purchased) a higher degree of attention will be paid due to the impact upon the user’s health and the responsibilities placed upon the medical professional. I, therefore, consider that the degree of attention paid during the purchasing process for the goods and services will vary from low to at least medium.

69. The goods are likely to be obtained by self-selection from a retail outlet or online or catalogue equivalent. The services are likely to be purchased from retail or specialist shops (or their online equivalents) following inspection of the premises’ frontage, websites or advertisements (such as flyers, posters or online adverts). Generally, the purchasing process is likely to be dominated by visual considerations. However, given that word-of-mouth recommendations may also play a part and consumers may seek advice from sales assistants, I do not discount that there will be an aural component to the selection of the goods and services.

Comparison of trade marks

70. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in 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.”

71. 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.

72. The respective trade marks are shown below:

Opponent's trade marks	Applicant's trade marks
POUNDLAND	fivepoundworld and 5poundworld

73. The opponent's marks consist of the conjoined words POUNDLAND. Although conjoined, the average consumer will recognise the two individual words. There are no other elements to contribute to the overall impression which lies in the words themselves. The applicant's marks consist of the conjoined words FIVEPOUNDWORLD and conjoined letters and numbers 5POUNDWORLD. Again, although conjoined the consumer will dissect the marks into their three separate words/numbers. There are no other elements to contribute to the overall impression of the marks which lies in the words and numbers themselves.

74. Visually, the marks coincide in the presence of the word POUND in all of the marks. However, in the applicant's marks this word is preceded by the number 5 or word FIVE and followed by the word WORLD. In the opponent's marks, this word is followed by the word LAND. These are clear points of visual differences between the marks. I consider the marks to be visually similar to a low degree.

75. Aurally, although the words in all of the marks are conjoined, they will be pronounced individually by the average consumer. The word POUND will be pronounced identically in all three marks. The word LAND in the opponent's marks will be given its ordinary English pronunciation. The number 5 will, clearly, be pronounced the same as the word FIVE in the applicant's marks, but these have no counterpart in the opponent's marks. These are all points of aural differences between the marks. I consider them to be aurally similar to a low degree.

76. Conceptually, the words LAND and WORLD in the marks will be conceptually similar to the extent that they both refer to places or areas. The word POUND is likely to be recognised as a reference to the currency of the UK in the context of retail services. I consider the marks to be conceptually similar to a medium degree.

Distinctive character of the earlier trade marks

77. 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-2779, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested 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).”

78. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. A mark’s distinctive character may be enhanced by virtue of the use made of it.

79. The opponent’s marks consist of the conjoined words POUNDLAND. In the context of retail services, it alludes to the characteristics of the services provided. I consider that the marks are inherently distinctive to a low to medium degree.

80. The opponent has filed evidence to show that its marks have acquired enhanced distinctiveness through use. The opponent has hundreds of shops across the UK. It has advertised in national newspapers and magazines and has spent £500,000 per year on advertising in 2015, 2017 and 2018. The opponent has also promoted its

brand through TV advertising, a television program and social media platforms. Its turnover reached over £1billion in 2015 and over £2billion in 2017. It won Discount Retailer of the Year in 2011, 2012 and 2013 and serves millions of customers in the UK each week. I am satisfied that the distinctive character of the opponent's mark has been enhanced through use to a high degree.

Likelihood of confusion

81. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's marks, the average consumer for the goods and services in issue and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

82. I have found the marks to be visually and aurally similar to a low to medium degree and conceptually similar to a medium degree. I have found the opponent's mark to be inherently distinctive to a low to medium degree, but this has been enhanced through use to a high degree. I have found the average consumer to be a member of the general public or a professional who will select the goods and services primarily through visual means (although I do not discount an aural component). I have concluded that the degree of attention paid during the purchasing process for the goods and services will vary from low to at least medium depending on the particular goods and services. I have found the goods and services to vary from being identical to similar to a low degree (except for those that I have found to be dissimilar).

83. Taking all of these factors into account, I do not consider that the marks will be mistakenly recalled or misremembered as each other. Notwithstanding the fact that the opponent's mark has a high degree of distinctiveness, the visual, aural and conceptual differences between the marks are sufficient to counteract this. I am satisfied that there is no likelihood of direct confusion.

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

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”

85. Having recognised the differences between the marks, I can see no reason why the average consumer would consider the marks to belong to the same or economically linked undertakings. I recognise that the distinctiveness of the opponent's marks have been enhanced to a high degree through use, however, that distinctiveness lies in the words POUNDLAND and, whilst consumers may see the addition of 5 or FIVE as a reference to a shop which sells goods at a higher price, the change from the word LAND to WORLD would not be a natural brand variant for the opponent. A finding of confusion should not be made merely because two marks share

a common element; it is not sufficient that one mark merely calls to mind the other¹². I am satisfied that there is no likelihood of indirect confusion.

Section 5(3)

86. I now turn to the opposition based upon section 5(3) of the Act. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Addidas-Salomon*, Case C-487/07, *L'Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows:

(a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel*, paragraph 42

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph

¹² *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure*).

87. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that the earlier marks have achieved a level of knowledge/reputation amongst a significant part of the public. Secondly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier mark being brought to mind by the later mark. Thirdly, assuming that the first and second conditions have been met, section 5(3) requires that one or more of the types of damage claimed will occur and/or that the contested mark will, without due cause, take unfair advantage of the reputation and/or distinctive character of the reputed mark. It is unnecessary for the purposes of section 5(3) that the goods or services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks. The relevant date for the assessment under section 5(3) is the date of the application - 27 September 2018.

Reputation

88. In determining whether the opponent has demonstrated a reputation for the goods and services in issue, it is necessary for me to consider whether its mark will be known by a significant part of the public concerned with the services. In reaching this decision, I must take all of the evidence into account including “the market share held by the trade mark, the intensity, geographical extent and duration of use, and the size of the investment made by the undertakings in promoting it.”¹³

89. Given the extent of the use made of the opponent’s marks, the extent of the advertising undertaken, the number of customers served, consequent turnover and the awards won, I am satisfied that the opponent has a strong reputation for retail services in relation to a variety of household goods from cleaning products, to food, to cosmetics.

90. Although the opponent’s evidence shows that it uses its mark for retail services in relation to a variety of goods, this is not sufficient to demonstrate a reputation in respect of the goods themselves. There is no evidence of the goods themselves being

¹³ *General Motors*, Case C-375/97

branded with the earlier marks. Rather, the evidence shows that the opponent sells third party goods and, where its own goods are sold, they are sold under alternative brands (such as Twin Peakes). I am not satisfied that the opponent has demonstrated a reputation in respect of any of the goods in issue.

Link

91. As I noted above, my assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* are:

The degree of similarity between the conflicting marks

For the reasons set out earlier, I consider that there is a low degree of visual and aural similarity and a medium degree of conceptual similarity between the marks.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

The goods and services vary from being dissimilar to identical.

The strength of the earlier mark's reputation

The opponent's marks have a strong reputation in the UK.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use

The opponent's marks have a low to medium degree of inherent distinctive character which has been enhanced to a high degree through use.

Whether there is a likelihood of confusion

I have found there to be no likelihood of confusion.

92. I find that a significant section of the relevant public will perceive a link between the earlier marks and the application. Even where the applicant's specification covers retail services in relation to broader categories of goods which are dissimilar to the opponent's services, the strength of the opponent's reputation is such that the requisite link will still be made. In respect of "retail shop window display arrangement services" these are more niche services that would be provided to retail businesses. They are further removed from those services for which the opponent has demonstrated a reputation and are entirely differ in nature. I do not, therefore, consider that the requisite link will be made in respect of these services.

Damage

93. I must now assess whether any of the three pleaded types of damage will arise.

Unfair Advantage

94. Unfair advantage has no effect on the consumers of the earlier marks' goods and services. Instead, the taking of unfair advantage of the distinctive character or reputation of an earlier mark means that consumers are more likely to buy the goods and services of the later mark than they would otherwise have been if they had not been reminded of the earlier mark.

95. In *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch) Arnold J. considered the earlier case law and concluded that:

"80. The arguments in the present case give rise to two questions with regard to taking unfair advantage. The first concerns the relevance of the defendant's intention. It is clear both from the wording of Article 5(2) of the Directive and Article 9(1)(c) of the Regulation and from the case law of the Court of Justice interpreting these provisions that this aspect of the legislation is directed at a

particular form of unfair competition. It is also clear from the case law both of the Court of Justice and of the Court of Appeal that the defendant's conduct is most likely to be regarded as unfair where he intends to benefit from the reputation and goodwill of the trade mark. In my judgment, however, there is nothing in the case law to preclude the court from concluding in an appropriate case that the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation and goodwill of the trade mark amounts to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation and goodwill.”

96. The opponent claims that the applicant “will ‘ride on the coat-tails’ of the reputation” of its marks and will, therefore benefit from “the marketing effort expended by the Opponent in order to create and maintain the trade marks’ image and reputation”. In light of the strength of the reputation of the earlier marks, I find that there exists a non-hypothetical risk that use of the applicant’s marks in the UK could take unfair advantage of the reputation of the earlier marks. The applicant would secure a commercial advantage, benefitting from the opponent’s reputation without paying financial compensation and would, therefore, be likely to take unfair advantage of the earlier marks.

97. The marks in issue will be instantly more familiar to the relevant public than they otherwise would be. It will, therefore, be easier for the applicant to market its services and the applicant would benefit from the opponent’s reputation and take unfair advantage of the earlier marks.

CONCLUSION

98. The opposition is successful in respect of all services in the applicant’s specification save for “retail shop window display arrangement services”.

99. The application will proceed to registration in respect of the following services only:

Class 35 Retail shop window display arrangement services.

COSTS

100. As the opponent has been mostly successful, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the opponent the sum of **£1,550** as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Preparing a notice of opposition and considering the applicant's statement	£250
Preparing evidence and written submissions	£800
Preparing written submissions in lieu	£300
Official fee	£200
Total	£1,550

101. I therefore order Vinod Chopra to pay Poundland Limited the sum of £1,550. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 12th day of September 2019

S WILSON

For the Registrar