

BLO/241/20

TRADE MARKS ACT 1994

**IN THE MATTER OF
TRADE MARK APPLICATION NO. 3358710
BY GUBA ENTERPRISE LTD
TO REGISTER AS A TRADE MARK:**

GUBA Heritage

IN CLASSES 20, 25 & 35

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 415240
BY HAQ TRADING LTD**

BACKGROUND AND PLEADINGS

1. On 5 December 2018, GUBA ENTERPRISE LTD (“the applicant”) applied to register the trade mark **GUBA Heritage**, under number 3358710 (“the application”). It was accepted and published in the Trade Marks Journal on 21 December 2018 in respect of the following goods and services:

Class 20: Display stands for selling goods.

Class 25: Clothes; Shoes; Head wear.

Class 35: 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 subscription boxes containing food; Retail services in relation to bags; Retail services in relation to clothing; Retail services in relation to clothing accessories; Retail services in relation to confectionery; Retail services in relation to cutlery; Retail services in relation to fabrics; Retail services in relation to fashion accessories; Retail services in relation to jewellery; Retail services relating to clothing.

2. On 24 January 2019, Haq Trading Ltd (“the opponent”) filed a notice of opposition. The partial opposition is brought under Section 5(1), Section 5(2)(a) and Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and is directed against ‘*clothes*’ in class 25 of the application.

3. The opponent relies upon its United Kingdom trade mark number 3174505, **GUBA** (“the earlier mark”). The earlier mark was filed on 13 July 2016 and was registered on 14 October 2016 in respect of ‘*clothing for men, women and children*’ in class 25.

4. The opponent’s mark is an earlier mark, in accordance with Section 6 of the Act. However, as it had not been registered for five years or more at the filing date of the application, it is not subject to the proof of use requirements specified within Section 6A of the Act.

5. The opponent claims that, due to the competing trade marks sharing the common element “GUBA”, the marks are identical and/or similar resulting in a likelihood of confusion. As these are the only comments I have from the opponent, they are reproduced in full, and as written, below:

Both Trade Marks have got the same name starting GUBA and the one i am oposing (GUBA HERITAGE) has got Heritage as a second word.

If Heritage is written smaller then both Trade Marks GUBA and GUBA Heritage would look identical or/and similar to each other.

If Heritage is written undeneath GUBA then again both Trade Marks GUBA and GUBA Heritage would look identical or/and similar to each other.

If even both are wrtitten same as normal there is a likelihood of confusion.

6. The applicant filed a counterstatement denying the grounds of opposition.¹ The applicant argues that it is the owner of another registered trade mark which predates the earlier mark; on this basis, the applicant denies that the application infringes upon the opponent’s rights but is, rather, an extension of their prior rights. Moreover, the applicant denies any likelihood of confusion and contends that its business is well established and reputable, rendering confusion between its mark and the earlier mark unlikely. The applicant maintains that those that are familiar with its brand, predominantly those of the Ghanaian diaspora, will not be confused by the registration of both competing trade marks.

7. The opponent is unrepresented, while the applicant has been represented by Eugenia Frimpomaa-Wiafe throughout these proceedings. Only the applicant filed evidence and neither party filed written submissions in lieu of an oral hearing. Both parties were offered the choice of a hearing but neither requested to be heard on this matter. Therefore, this decision is taken following a careful perusal of the papers, keeping all submissions in mind.

¹ In the Tribunal’s correspondence dated 20 February 2019 in which the applicant was notified of the opposition, the applicant was informed that the deadline for filing a notice of defence and counterstatement was 23 April 2019, as per Rule 18(1) and 18(3) of the Trade Mark Rules 2008. Form TM8 was not filed by the applicant until 01:00 on 24 April 2019. Nevertheless, the Tribunal’s preliminary view was that there were, on balance, sufficient extenuating circumstances to admit the applicant’s defence. The opponent was given the opportunity to challenge the Tribunal on this view. However, no challenge from the opponent was forthcoming and the defence was subsequently admitted into these proceedings.

EVIDENCE

8. The applicant's evidence consists of a witness statement of Eugenia Frimpomaa-Wiafe, recorded representative of the applicant, together with Exhibits A to C.²

9. Exhibit A consists of a print from the 'Intellectual Property Office' website <https://trademarks.ipo.gov.uk/ipo-tmcase/page/Results/1/UK00002601199>. The exhibit displays information from the Register regarding United Kingdom trade mark number 2601199. The applicant highlights that the filing date of this mark, namely 14 November 2011, is before that of the earlier mark. The recorded owner of the mark is Speak to Dentaa, though it is explained in the witness statement that ownership has now been transferred to the applicant.

10. Exhibit B comprises prints from seven social media accounts: 'gubaawards', 'gubacareers', 'gubaenterprise', 'gubadiaspora', 'gubausa', 'gubafoundation', and 'gubaexpo'. These accounts have a combined total of 27,468 followers. The witness statement asserts that the accounts can be attributed to the applicant; however, the exhibit shows no indication as to if and how these social media accounts are connected to the applicant. The exhibit is undated.

11. Exhibit C contains copies of previous correspondence and forms related to the present proceedings, including the opponent's Form TM7 and letters to both parties from the Tribunal. Other than demonstrating when the applicant became aware of this opposition, the intended purpose of the exhibit is unclear.

PRELIMINARY ISSUES

12. In its counterstatement and evidence, the applicant provides the following arguments which it claims will avoid any likelihood of confusion:

² The same exhibits were filed with the applicant's witness statement regarding the admission of its late filed Form TM8.

- i. The application cannot amount to infringement of the opponent's rights because it is the owner of another trade mark which predates the earlier mark;
- ii. The applicant business has been established for the past decade and is well known in the Ghanaian diaspora, members of which are unlikely to be confused;

13. Before going any further into the merits of this opposition, it is necessary to explain why, as a matter of law, these points will have no bearing on the outcome of my decision.

14. Section 72 of the Act provides that registration shall be taken as prima facie evidence of the validity of a registered mark. The applicant contends that it was not made aware of the opponent's application for the earlier mark, intimating that it would not have allowed the mark to proceed to registration had it been. To the contrary, the owner of trade mark 2601199 was notified of the publication of the opponent's mark on 29 July 2016. Thereafter, the owner had the opportunity to challenge the registration of the mark. This notwithstanding, the applicant has not sought to cancel (or 'invalidate', to use the language of Section 47 of the Act) the earlier mark on the basis of its claim to an earlier still trade mark. Consequently, the opponent's trade mark must be regarded as a validly registered mark. In this situation, the law requires priority to be determined according to the filing dates of the applications for registration. The applicant's prior mark is a separate property right which is not linked to the present application. This means that, for the purposes of this opposition, the opponent's mark has priority and the applicant cannot rely upon the filing date of its prior mark. The likelihood of confusion between the marks in suit only, based on their notional use throughout the UK, will be enough to justify the refusal of the applicant's later filed trade mark.

15. Sections 5(1) and 5(2) of the Act turn upon whether the 'attacker' has an earlier trade mark compared to the mark under 'attack', as defined by Section 6 of the Act. Whether the applicant for registration/registered proprietor has another registered trade mark (or trade mark application) that predates the earlier mark upon which the

'attacker' relies cannot affect the outcome of the case in relation to these grounds. The position was explained by the Court of First Instance in *PepsiCo, Inc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) T-269/02*:

"24 Nor did the applicant claim, and even less prove, that it had used its earlier German mark to obtain cancellation of the intervener's mark before the competent national authorities, or even that it had commenced proceedings for that purpose.

25 In those circumstances, the Court notes that, quite irrespective of the question whether the applicant had adduced evidence of the existence of its earlier German mark before OHIM, the existence of that mark alone would not in any event have been sufficient reason for rejecting the opposition. The applicant would still have had to prove that it had been successful in having the intervener's mark cancelled by the competent national authorities.

26 The validity of a national trade mark, in this case the intervener's, may not be called in question in proceedings for registration of a Community trade mark, but only in cancellation proceedings brought in the Member State concerned (Case T 6/01 *Matratzen Concord v OHIM - Hukla Germany (MATRATZEN)* [2002] ECR II 4335, paragraph 55). Moreover, although it is for OHIM to ascertain, on the basis of evidence which it is up to the opponent to produce, the existence of the national mark relied on in support of the opposition, it is not for it to rule on a conflict between that mark and another mark at national level, such a conflict falling within the competence of the national authorities."

16. The viability of a defence including claims that the applicant for registration has a registered trade mark that predates the trade mark upon which the 'attacker' relies for grounds under Sections 5(1) and 5(2) of the Act was considered by Ms Anna Carboni, sitting as the appointed person, in *Ion Associates Ltd v Philip Stainton and Another*, BL O/211/09. Ms Carboni rejected the defence as being wrong in law. Therefore, if the owner or applicant of the mark under 'attack' has an earlier mark which could be used to oppose or invalidate the trade mark relied upon by the 'attacker', and the applicant

for registration/registered proprietor wishes to invoke that earlier mark, the proper course is to oppose or apply to invalidate the 'attacker's' mark.³

17. Furthermore, although the applicant feels that its mark is reputable and well-known among members of the Ghanaian diaspora in the UK, I must, at this early stage, clarify that this argument will not be significant in ascertaining whether there exists a likelihood of confusion. While I note the applicant has not filed any evidence to support its assertion that members of this community will not be confused by the presence of both competing marks in the marketplace, it would not be persuasive if such evidence was forthcoming. While evidence of actual confusion may be persuasive where it exists, the absence of confusion on the marketplace is rarely significant. In *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchen L.J. stated that:

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

³ Tribunal Practice Notice 4/2009 refers.

18. In *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283 Millett L.J. stated that:

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

19. The provisions in the Act are not merely a reflection of what is happening in the market. As the owner of the earlier mark is not required to prove proof of use, I must consider notional use of the registered mark. It may be the case that there is an absence of confusion due to the way in which the registered mark has been used or due to reasons extraneous to the mark. In cases where there is no confusion in practice, it remains possible for there to be a finding of a likelihood of confusion.

20. Moreover, my assessment later in this decision must take into account only the applied for mark – and its specification – and any potential conflict with the opponent's earlier mark, through the eyes of the average consumer in the UK; a trade mark is a national property right and the test for whether or not there exists a likelihood of confusion will not be based upon a particular section of society or the specific consumers of the applicant's goods. Rather, my assessment will be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The average consumer is a legal construct and the likelihood of confusion test is to be applied objectively from the point of view of that constructed person. The average consumer will be discussed in more detail later in this decision.

DECISION

Section 5(1) and Section 5(2)(a)

21. Section 5(1) of the Act reads as follows:

"(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are

identical with the goods or services for which the earlier trade mark is protected.”

22. Section 5(2)(a) of the Act reads as follows:

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

(a) it is identical with an earlier trade mark and is to be registered for goods or services 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.”

23. In order for claims under Section 5(1) and Section 5(2)(a) of the Act to succeed, the competing trade marks are required to be identical. The question of when a mark may be considered identical to another was addressed in *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, where the Court of Justice of the European Union (“CJEU”) held that:

“54... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

24. While both marks are in word-only format and share the common element “GUBA”, the application also includes the word “Heritage”. The word is not wholly descriptive of clothing and cannot be considered entirely non-distinctive. The application does not reproduce the earlier mark without any modification or addition. Moreover, when viewed as a whole, I do not consider the addition of the word “Heritage” in the application so insignificant that it would go unnoticed by the average consumer. **Therefore, I find that the marks are not identical and the claims under Section 5(1) and 5(2)(a) of the Act must inevitably fail.**

Section 5(2)(b)

25. Section 5(2)(b) of the Act reads 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.”

26. Determination of a Section 5(2)(b) claim must be made in light of the following principles, which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

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

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

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

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

Comparison of goods

27. The General Court (“GC”) confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, that, even if goods are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

“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”.

28. The goods to be compared are:

Opponent’s goods	Applicant’s goods
Class 25: Clothing for men, women and children.	Class 25: Clothes.

29. The words ‘clothing’ and ‘clothes’ are both commonly understood to mean articles of dress and can be used interchangeably.⁴ Moreover, ‘clothes’ is a broad term, worded in such a manner whereby it could reasonably encompass those for men, women and children. The respective goods of the competing trade marks are considered identical, either self-evidently or under the principle in *Merica*.

The average consumer and the nature of 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

⁴ <https://www.collinsdictionary.com/dictionary/english/clothes>
<https://www.collinsdictionary.com/dictionary/english/clothing>

according to the category of goods or services in question (see *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 contested goods in class 25 are available to the general public and are ordinary purchases consisting of items of attire. Due to their nature, these goods are likely to be frequent purchases for the purposes of functionally clothing one’s self or as a form of self-expression. The cost of such goods may vary between cheaper items of limited quality at one end of the spectrum, to more expensive fashion pieces at the other. However, on average they would not typically require a significant outlay. The purchasing of these goods is likely to be more casual than careful, factoring upon personal taste, particular style or superficial preference. For this reason, choice for the consumer is not considered to be dramatically important. In my view, the purchasing process for items of clothing would overwhelmingly be visual in nature; the goods are likely to be purchased after they are viewed in physical retail establishments or their online equivalents, brochures, window displays or visual advertising. Nevertheless, I cannot discount aural considerations such as word of mouth recommendations completely. I find that the level of attention of the general public in respect of these goods would be average.

Comparison of trade marks

33. 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 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.”

34. 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.

35. The competing trade marks are shown below:

Earlier trade mark	Applicant's mark
GUBA	GUBA Heritage

36. The opponent has submitted that the marks are similar as they both begin with the word “GUBA”. Moreover, the opponent has contended that, if the words in the applicant's mark are presented or arranged in particular ways (such as the word “Heritage” appearing in a smaller font than, or below, the word “GUBA”), the competing

trade marks “would look identical and/or similar to each other”. Even in the absence of these hypothetical scenarios, the opponent has maintained that there is a likelihood of confusion between the competing marks. The applicant has not disputed similarity between the marks, though, I have no explicit submissions from the applicant on this issue.

37. The earlier mark is a plain word mark consisting of the word “GUBA”. As this is the only element of the mark, the overall impression is dominated by the word itself.

38. The applicant’s mark is a plain word mark comprising the words “GUBA Heritage”. The word “GUBA” is likely to be perceived as an invented term, while the word “Heritage” is an ordinary dictionary word in the English language. The word “Heritage” could be perceived by consumers of clothing as an allusive reference to a traditional brand or product which is regarded as emblematic of fine craftsmanship. For these reasons, although the word “Heritage” is not entirely non-distinctive, it will play a lesser role in the overall impression of the mark. In my view, “GUBA” has more impact, is more dominant and contributes more to the overall impression of the mark.

39. Visually, the competing marks are similar because they have a common four-letter string “G-U-B-A”, in the same order, at the beginning of the marks. As outlined above, this word is the dominant element of both marks. The marks are visually different insofar as the application contains the word “Heritage”, which has no counterpart in the earlier mark. The respective endings are therefore visually dissimilar, though it is established that the attention of the consumer is usually directed to the beginning of words. Furthermore, this diverging element plays a lesser role in the application. Bearing in mind my assessment of the overall impressions, I consider there to be a medium degree of similarity between the marks.

40. Aurally, the earlier mark consists of a two-syllable word, i.e. (“GOO-BER”), while the application comprises a two-syllable word followed by a three-syllable word, i.e. (“GOO-BER-HE-RI-TAGE”). The first two syllables of the competing marks are indistinguishable in the way in which they will be articulated. The subsequent three syllables in the application are not replicated in the earlier mark. Taking into account

the overall impressions, I consider that the marks are aurally similar to a medium degree.

41. Conceptually, the earlier mark does not have an obvious meaning per se and, as such, would likely be understood by the average consumer as an invented term. The application begins with the same word, which would also be understood by the average consumer as an invented term. However, the application also includes the word “Heritage”. In relation to goods such as clothing, this could be understood by consumers as meaning a traditional brand or product which is regarded as emblematic of fine craftsmanship, thereby alluding to a clothing collection which has been finely crafted. The word introduces a new conceptual aspect which is not replicated in the earlier mark. On this basis, and in consideration of my assessment of the overall impressions, I consider the marks somewhat conceptually dissimilar.

Distinctive character of the earlier mark

42. 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).”

43. 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.”

44. 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.

45. I have no submissions from the opponent nor the applicant regarding the distinctiveness of the earlier mark. The registration process for the earlier mark was not completed more than five years before the filing date of the application and, as such, the opponent has not been required to provide proof of use. The opponent has not filed evidence in this matter and, therefore, has not demonstrated that the earlier mark enjoys an enhanced level of distinctive character. Consequently, I have only the inherent position to consider.

46. Registered trade marks possess varying degrees of inherent distinctive character. These range from the very low, such as those which are suggestive or allusive of the goods or services, to those with high inherent distinctive character, such as invented words. Dictionary words which do not allude to the goods or services will be somewhere in the middle.

47. As the earlier mark consists of one plain word, the distinctive character lies indivisibly in the word itself. The word "GUBA" is neither descriptive nor allusive of the goods at issue but, rather, appears to be an invented word. In light of this, I find that the earlier mark has a high degree of inherent distinctive character.

Likelihood of confusion

48. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods, and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier trade mark, the average consumer for the services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

49. 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 or services down to the responsible undertakings being the same or related.

50. In *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, the General Court noted that the beginnings of word tend to have more visual and aural impact than the ends. The court stated:

“81. It is clear that visually the similarities between the word marks MUNDICOLOR and the mark applied for, MUNDICOR, are very pronounced. As was pointed out by the Board of Appeal, the only visual difference between the signs is in the additional letters ‘lo’ which characterise the earlier marks and which are, however, preceded in those marks by six letters placed in the same position as in the mark MUNDICOR and followed by the letter ‘r’, which is also the final letter of the mark applied for. Given that, as the Opposition Division and the Board of Appeal rightly held, the consumer normally attaches more importance to the first part of words, the presence of the same root ‘mundico’ in the opposing signs gives rise to a strong visual similarity, which is, moreover, reinforced by the presence of the letter ‘r’ at the end of the two signs. Given those similarities, the applicant’s argument based on the difference in length of the opposing signs is insufficient to dispel the existence of a strong visual similarity.

82. As regards aural characteristics, it should be noted first that all eight letters of the mark MUNDICOR are included in the MUNDICOLOR marks.

83. Second, the first two syllables of the opposing signs forming the prefix ‘mundi’ are the same. In that respect, it should again be emphasised that the attention of the consumer is usually directed to the beginning of the word. Those features make the sound very similar.”

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

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

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

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

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

52. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the

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

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).”

53. Earlier in this decision I concluded that:

- The goods of the competing trade marks are identical, either self-evidently or under the principle in *Meric*;

- Average consumers of the goods at issue are members of the general public, whom would demonstrate an average level of attention during the purchasing act;
- The purchasing process for the contested goods would be overwhelmingly visual in nature, though I have not discounted aural considerations;
- The overall impression of the earlier mark would be dominated by the word “GUBA”, being the only element of the mark;
- The invented word “GUBA” would provide a larger contribution to the overall impression conveyed to consumers by the applicant’s mark, while the word “Heritage” would play a lesser role;
- The competing trade marks are visually and aurally similar to a medium degree, and somewhat conceptually dissimilar;
- The earlier mark possesses a high level of inherent distinctive character.

54. I appreciate that the competing marks both contain the invented word “GUBA” and I accept that I have found the word “Heritage” to play a lesser role in the applicant’s mark due to its allusive meaning in respect of the goods at issue. However, the difference between the marks would not simply be overlooked. Although it appears at the end of the contested mark, and it is established that the attention of the consumer is usually directed at the beginning of marks, I do not consider the word “Heritage” non-distinctive to the extent that it would be entirely overlooked by the average consumer. In my view, consumers would still notice the word in the mark. Despite the word being lower in distinctiveness than the word “GUBA”, it has no counterpart in the earlier mark and does provide a contribution to the overall impression of the contested mark. It is considered that the presence of the word “Heritage” in the contested mark will sufficiently enable the average consumer to avoid mistaking one trade mark for the other. Even when factoring in the imperfect recollection principle, it follows that there will be no direct confusion.

55. Nevertheless, I have found the respective goods of the competing trade marks to be identical and the attention level of the average consumer to be no more than average. As explained above, I feel that the average consumer will recognise that there is a difference between the marks in the word “Heritage”. However, consumers will also recognise the common element “GUBA”, which has a high level of inherent distinctive character and dominates both marks. Whether consciously or subconsciously, this will lead the average consumer through the mental process described in case law by Mr Purvis, namely, that there is a difference between the marks, but there is also something in common. As an invented word, the common element is strikingly distinctive. Therefore, particularly when applied to identical goods, the average consumer is likely to assume that no other undertaking but the brand owner would be using it in a trade mark. The word “Heritage”, although not entirely non-distinctive, would be perceived by consumers as an allusive reference to a clothing collection by the opponent which has been finely crafted; added to the highly distinctive common element “GUBA”, the word “Heritage” readily lends itself to a sub-brand or logical brand extension. It is entirely plausible for a producer of clothing to have a specific collection of goods which are of higher quality or more prestigious than the ‘classic’, ‘standard’ or ‘basic’ lines. To my mind, the difference between the marks is conducive to a logical brand extension and I am satisfied that the average consumer would assume a commercial association between the parties, or sponsorship on the part of the opponent, due to the shared dominant element “GUBA”. Consequently, I consider there to be a likelihood of indirect confusion.

CONCLUSION

56. The partial opposition under Section 5(2)(b) of the Act has succeeded. Subject to any successful appeal, the application will be refused in respect of ‘clothes’ in class 25.

57. The mark will become registered in relation to the following goods which were not opposed:

Class 20: Display stands for selling goods.

Class 25: Shoes; Head wear.

Class 35: 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 subscription boxes containing food; Retail services in relation to bags; Retail services in relation to clothing; Retail services in relation to clothing accessories; Retail services in relation to confectionery; Retail services in relation to cutlery; Retail services in relation to fabrics; Retail services in relation to fashion accessories; Retail services in relation to jewellery; Retail services relating to clothing.

COSTS

58. As the opposition has been successful, ordinarily the opponent would be entitled to an award of costs. However, as it has not instructed solicitors it was invited by the Tribunal to indicate whether it intended to make a request for an award of costs, including accurate estimates of the number of hours spent on a range of given activities relating to the proceedings. It was made clear by letter dated 8 January 2020 that if the pro-forma was not completed, costs may not be awarded.⁵ The opponent did not return a completed pro-forma to the Tribunal. On this basis, I award the opponent the sum of **£100** as a contribution towards official fees only.

59. I therefore order GUBA ENTERPRISE LTD to pay Haq Trading Ltd the sum of **£100**. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

⁵ Other than official fees arising from the action

Dated this 17th day of April 2020

**James Hopkins
For the Registrar,
The Comptroller General**