

O/470/20

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO. 3446216

BY

ICEBREAKER LIMITED

TO REGISTER THE FOLLOWING TRADEMARK IN CLASS 25

THE MAKERS AND CREATORS

AND OPPOSITION THERETO NO. 600001307

BY

THE MAKERS B.V.

Background and Pleadings

1. Icebreaker Limited (“The Applicant”) applied to register the trade mark “THE MAKERS AND CREATORS” on 22 November 2019. It was accepted and published on the 29 November 2019 for goods in class 25.

2. The Makers B.V. (“the Opponent”) opposes the application by way of the Fast Track opposition procedure under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). It relies on its earlier EU trade mark numbered 018021753 “THE MAKERS” filed on 12 February 2019 and registered on 3 August 2019 for goods and services in classes 25 and 35.

3. The Opponent claims that there is a likelihood of confusion because the trade marks are similar and are to be registered for goods identical with or similar to which the earlier mark is protected.

4. The Applicant filed a defence and counterstatement denying the claims made that there is any likelihood of confusion arguing that “the respective marks are not similar much less confusingly similar and that the visual and phonetic dissimilarity are sufficient for the contested marks to be considered dissimilar overall”.

5. Both parties are professionally represented; the Applicant by Morgan, Lewis & Bockius UK Ltd¹, the Opponent by Novagraaf UK.

6. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of the Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

¹ Although originally represented by Cooley Ltd, the Applicant notified the Registry by way of form TM33 filed on 7 July 2020, that it had changed its representation to Morgan, Lewis & Bockius UK Ltd.

7. The net effect of these changes is to require parties to seek leave in order to file evidence in Fast Track oppositions. No leave was sought in respect of these proceedings. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken.

8. By way of letter dated 25 June 2020 the parties were given until 30 July 2020 to request a hearing. Neither party made such a request and therefore the matter has proceeded by way of the Fast Track procedure with only the Applicant filing submissions in lieu of hearing. Whilst I do not propose to summarise those submissions, I have taken them into account and shall refer to them where necessary in my decision. This decision is taken following a careful perusal of all papers filed.

Decision

9. The opposition is based on section 5(2)(b) of the Act which states:

“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”.

10. An earlier trade mark is defined in section 6 of the Act, which states:

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

(a) a registered trade mark, international trade mark (UK), a European Union 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.”

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

11. In these proceedings, the Opponent is relying upon its EU trade mark registration, shown above, which qualifies as an earlier mark under section 6 of the Act. As the earlier mark had not been registered for five years at the date the application was filed it is not subject to the proof of use provisions contained in section 6A of the Act. Consequently, the Opponent is entitled to rely upon all its class 25 goods and class 35 services, as registered, without having to establish genuine use.

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

The principles:

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

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

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

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

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

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a 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 the goods and services

13. When conducting a goods and services comparison, all relevant factors should be considered as per the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon Kabushiki Kaisha v Metro Goldwyn Mayer Inc.* Case C-39/97, where 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”.

14. 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 für Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or Applicant relies on those goods as listed in paragraph where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

15. The Applicant acknowledges that there is some overlap between the Applicant’s goods in Class 25 and the Opponent’s goods and services but goes no further to specify which particular goods. It is still necessary therefore for me to consider whether and to what extent the respective goods and services are identical or similar.

16. The competing goods and services are set out as follows:

Applicant's goods	Opponent's goods and services
<p>Class 25: Clothing, namely, pullovers, scarves, shirts, sweatshirts, singlets, socks, sweaters, tee shirts, underclothes, boxer shorts, jockey shorts, underpants, underwear, camisoles, shorts, pants, jackets, coats, jerseys, jumpers, vests, leggings, neck warmers, and gloves; cyclist clothing, namely, shirts, shorts, leggings, and pullovers; headgear, namely, caps, hats, balaclavas; and footwear.</p>	<p>Class 25: Clothing for men, women, children and babies, namely shirts, golf shirts, T-shirts, polo shirts, knitted tops, woven tops, fleece tops, vest tops, sweaters, blouses, knitwear, turtlenecks, shorts, tracksuit bottoms, tracksuits, blazers, sports coats, trousers, jeans, skirts, dresses, wedding dresses, suits, overalls, jerseys (clothing), vests, jackets, coats, waterproof coats, parkas, ponchos; Clothing for swimming, Bikinis, Bathing drawers, Topcoats; Rainwear, Cagoules; Dance clothing, namely leotards and outfits for classical dance; Nightwear, pyjamas; Bathwraps, Shower caps, Chasubles; Underwear, lingerie, Boxer's shorts boxer shorts; Leather belts [clothing], Neckties; headgear namely, hats, wool hats, caps, visors, headbands, ear muffs; scarves, shawls, , wristbands, cloth bibs; Footwear, gym shoes, sneakers, socks, stockings, hosiery, shoes, boots, beach shoes, sandals, slippers, gloves, suspenders; Layette; Sashes for wear.</p>
	<p>Class 35: Retailing and business assistance for the trading of clothing,</p>

	footwear and headwear; Including all the aforesaid services in the context of franchising; Retailing by companies for mail-order sale in the field of clothing, footwear and headwear; Administrative services relating to the conclusion of franchise contracts for clothing, footwear and headwear; Business management assistance for franchise organisations; Advertising; Office functions; Demonstration of goods on communication media, for sales purposes; Office functions in connection with issuing licences for the rights to goods and services of others; Sales promotion for others; Sales promotion (to third parties); personnel advisory services; Relocation services for businesses; Clerical services; Accounting; The aforesaid services via the internet.
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17. The Applicant seeks registration inter alia for *clothing, headgear and footwear* in class 25, however, the terms *clothing* and *headgear* are followed by the word “namely” and then followed by a list of items. The effect of the term “namely” is to restrict the specification only to those individual items as listed. The Opponent’s goods within class 25 are drafted in similar terms and include a comparable limitation. Notwithstanding this, however, the respective parties’ goods either include the identical wording or the Applicant’s items are encompassed within the Opponent’s broader category of goods or vice versa. On this basis the contested goods are thus identical or identical according to the principles set out under *Meric*. As a result of this assessment I need not consider further the Opponent’s services in class 35, as it does not place it in any better position.

Average Consumer and the Purchasing Process

18. When considering the opposing marks, I must determine first of all who the average consumer is for the goods and the purchasing process. The average consumer is deemed reasonably informed and reasonably observant and circumspect. For the purposes of assessing the likelihood of confusion the average consumer's level of attention is likely to vary according to the category of goods in question.²

19. 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.”

20. Whilst generally the goods in class 25 are likely to vary in price from the inexpensive mass-produced items to designer pieces with a higher price ticket, I must consider the respective goods across the whole breadth of the registered specification especially in light of the absence of evidence from both parties. The Applicant concedes that overall the respective goods are directed at the general public at large and I agree.

² *Lloyd Schuhfabrik Meyer*, case c- 342/97.

21. In relation to the purchasing process, in *New Look Limited v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (“OHIM”), joined cases T-117/03 to T-119/03 and T-171/03, the GC stated that:

“49. However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (*BUDMEN*, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumer choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs.”

And

“50..... Generally in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly the visual aspect plays a greater role in the global assessment of the likelihood of confusion.”

22. Taking into account this decision and the nature of the goods I accept that the purchasing process will be primarily visual with the goods selected from retail outlets or their online equivalents. I do not discount aural considerations however in the form of advice sought from or requests made to sales assistants or queries over the telephone. The respective goods will be purchased on a fairly frequent basis but notwithstanding this, considerations such as fashion trends, price, quality and

suitability will still be taken into account. For these reasons I consider that at least an average degree of attention will be undertaken in the purchasing process i.e.no higher or lower than the norm for such goods.

Comparison of the marks

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

24. It would be wrong to artificially dissect the trade marks, although, it is necessary to consider the distinctive and dominant components and give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

25. The respective trade marks are as follows:

Applicant's Mark	Opponent's Mark
THE MAKERS AND CREATORS	THE MAKERS

26. The Opponent submits that:

“20. The marks under comparison are visually, aurally and conceptually similar to a higher than average degree due to their coincidence in the words THE MAKERS, which is the initial part of the contested mark and the whole of the earlier mark.

21. Considering that consumers generally tend to focus on the beginning of a sign when they encounter a trade mark, because the public reads from left to right, which makes the part placed at the left of the sign (the initial part) the one that first catches the attention of the reader, it is expected that the element THE MAKERS of the contested mark will be the one, which will first attract the consumer's attention and will have more weight in the overall perception of the sign THE MAKERS AND CREATORS. The presence of the words AND CREATORS at the right (the end) of the contested mark is not sufficient in our view to counteract the visual, aural and the conceptual coincidences between the marks under comparison, and as such do not allow consumers to distinguish between them safely.

22. It is common today for companies to make small variations of their brands, for example, by altering their font or color, or by adding terms or elements, or to create a modernized version of the brand. Indeed, in the case at hand it is very likely that consumers perceive the contested sign as a version or a brand variation of the opponent's mark, or vice versa, given the fact that both signs contain/consist of, and indeed start with, the verbal element THE MAKERS.”

27. The Applicant submits that:

“15. Visually the Applicant's Mark differs from the Opponent's mark given the additional AND CREATORS elements. The Opponent's Mark consists of nine

letters, whilst the Applicant's Mark consists of twenty letters. Accordingly, the marks are visually dissimilar."³

and in its counterstatement that:

"8. The Applicant submits that the Opponent's Marks and the Applicant's Mark are not similar, much less, confusingly similar.

9. Visually, the Applicant's Mark and the Opponent's Mark differ given the additional AND CREATORS elements of the Applicant's Mark.

10. From a phonetic point of view, the marks are also dissimilar because, while the marks coincide in the THE MAKERS elements, the marks differ in the AND CREATORS elements of the Applicant's Mark. Accordingly, the Applicant's Mark includes four additional syllables, namely 'THE'-'CREE'-'ATE'-'ORS'. These differences therefore offset any similarity between the marks, and the Opponent's Mark and the Applicant's Mark are therefore phonetically dissimilar.

11. The Applicant submits that the marks are not similar overall, given the clear visual and phonetic differences detailed above."

28. The Opponent's mark consists of the words THE MAKERS presented in conventional black font, in capitals. I consider that the overall impression resides in the totality of these words although weighted in favour of the MAKERS element since the word "THE" will have little trade mark significance acting as it does as a definitive article.

29. The Applicant's mark consists of the words THE MAKERS AND CREATORS and the overall impression resides in the totality of the mark again weighted in favour of the elements MAKERS and CREATORS since again little trade mark significance will be attributed to the words "THE" and "AND".

³ Submissions dated 27 August 2020.

Visual, Aural and Conceptual comparison

30. The marks are visually and aurally similar in so far as they each contain the words THE MAKERS and differ to the extent that the Applicant's mark also contains the words AND CREATORS, there being no counterpart in the Opponent's mark. Since beginnings of marks tend to have more visual and aural impact than their ends,⁴ I consider that the marks are visually and aurally similar to a medium degree.

31. Neither party has made submissions regarding the meaning attributed to their respective marks. The ordinary dictionary meaning will be attributed to the dominant and distinctive elements in both marks. The element THE MAKERS in both marks will be understood to refer to a group of individuals called THE MAKERS who design or produce something. The CREATORS element in the Applicant's mark is a synonym of the word MAKERS again referring to a specific group of individuals who are the designers or producers of the goods. I do not discount the possibility that consumers may attribute a religious meaning to the words MAKERS and CREATORS however since the words are in the plural format, I do not consider this likely as ordinarily any reference to god as the creator/maker would be in the singular. The addition of the word THE in each mark, has little distinctive conceptual significance other than acting as a definitive article to define the group of MAKERS/CREATORS as a specific group of people. Overall the marks are highly conceptually similar as they each give rise to the perception of a specific group responsible for the goods provided under the respective marks.

Distinctive character of the earlier mark

32. 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

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

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).”

33. Registered trade marks possess varying degrees of inherent distinctive character, some being suggestive or allusive of a characteristic of the goods and services on offer, others being highly inherently distinctive, such as invented words.

34. The Opponent has not filed any evidence as this is a Fast Track opposition and therefore, I am only able to consider the position based on inherent characteristics.

35. The earlier mark consists of the words THE MAKERS which as I have outlined will be regarded as a reference a specified group of people who produce or make the products in question. The inclusion of the definitive article “THE” evokes something definitive or specific about the group, namely being the one and only. In so far as the distinctive characteristic of the mark, this rests in the MAKERS element, being a dictionary word with no apparent connection to the goods other than a general allusion that the goods are produced by an undertaking called the MAKERS. Although in its submissions the Applicant argues that the Opponent’s mark is not one that possesses any great degree of distinctive character stating in particular that:

“22. ..the words ‘The Makers’ are not distinctive for the goods and services covered by the Opponent’s mark, namely clothing and associated retail services. The Applicant submits that ‘the Makers’ would be considered descriptive and non-distinctive as the relevant public would understand the term to mean “*a person or thing that makes or produces something*”. It is therefore submitted that the Opponent’s Mark has a very low degree of distinctiveness.”

36. The Applicant, however, has not filed evidence to explain why this is the case. Nonetheless, I do not accept that the Opponent’s mark is descriptive and non-distinctive in light of the decision in *Formula One*.⁵ The CJEU determined that I must assess the matter on the basis that every registerable mark must be assumed to possess at least a minimum level of distinctive character and therefore it is not permissible for me to find that the earlier mark is not distinctive per se. In the context of the goods at issue, I see no reason why the earlier mark is not capable of distinguishing its goods and services from those of other undertakings and therefore it is in my view that the earlier mark is possessed of at least an average degree of distinctive character.

Likelihood of Confusion

37. When considering whether there is a likelihood of confusion between the two marks I must consider whether there is direct confusion, where one mark is mistaken for the other or whether there is indirect confusion where the similarities between the marks lead the consumer to believe that the respective goods or services originate from the same or related source.

38. A number of factors must also be borne in mind when undertaking the assessment of confusion. 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 or services and vice versa. As I mentioned above, it is also necessary for me to keep in mind a global assessment of all relevant factors when

⁵ *Formula One Licensing BV v OHIM*, Case C-196/11P

undertaking the comparison. In doing so, I must consider 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.

39. I remind myself that I have found the marks to be visually and aurally similar to a medium degree and that the marks share a high degree of conceptual similarity. I have found the earlier mark to possess at least an average degree of inherent distinctiveness. I have identified the average consumer to be a member of the general public, selecting the goods primarily through visual means but with aural considerations not being discounted. I have found that the level of attention paid by the average consumer is at least average.

40. The Applicant submits that:

““the Makers” element will not be perceived as a distinctive element. The inclusion of the words AND CREATORS creates a different visual and phonetic impression in the dominant part[sic] of the sign. This difference is sufficient for the relevant public to distinguish between the marks and that the goods come from different undertakings.”

41. In addition, the Applicant refers me to the decision of *Promedia GCV v DeTeMedien Deutsche Telekom Medien GmbH* (17 December 2003) No. B369779 where the Opposition Division held that there was no likelihood of confusion between the marks “YELLOW PAGES” and “Yellow Pages der DeTeMedien” on the basis that the clear visual, phonetic and conceptual differences of the dominant elements of the marks were sufficient to give a different overall impression of the application. However, decisions of the EUIPO are not binding upon me and I am obliged to consider the matter before me on the basis of the global assessment of the marks at issue, taking into account the relevant authorities.

42. In terms of direct confusion, in light of the additional elements present in the Applicant’s mark, I consider that it is unlikely that the average consumer will mistake or misremember one mark for the other. The addition of the CREATORS element (which I found to play an equally dominant role in the overall impression of the applied

for mark) is such that this element will not go unnoticed and will be sufficient for the average consumer not to directly confuse the two marks.

43. Moving on to indirect confusion, in *L.A. Sugar Limited v By Back Beat Inc*, Mr Iain Purvis Q.C., as the Appointed Person, explained that: ⁶

“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.

44. The question arises as to whether the inclusion of the additional words AND CREATORS would be sufficient for consumers to distinguish between the marks and regard them as separate entities, or whether as a result of the identical first two elements that they would regard the goods as originating from or being provided by one and the same undertaking. I remind myself that I found the degree of attention in the purchasing process to be at least average and that the purchase of clothing is predominantly a visual process with greater emphasis being given to the beginning of marks. In my view consumers may acknowledge the difference with the additional elements in the Applicant’s mark but focus on the element “MAKERS” and consider that the inclusion of the second element AND CREATORS to be a different range of clothing or a brand extension from the same undertaking.

⁶ BL O/375/10

45. I have considered the possibility as set out by Mr James Mellor Q.C., as the Appointed Person, in *Duebros Limited v Heirler Cenovis GmbH*,⁷ where he stressed that a finding of indirect confusion should not be made merely because two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark; this is mere association not indirect confusion. However, I discount this argument in the case before me. The additional elements AND CREATORS in the Opponent's mark are in my view an example of a logical sub brand as envisaged in *LA Sugar*. The identical use of the words THE MAKERS would lead consumers to conclude that the Opponent was the enterprise responsible for the contested goods and that the goods provided bearing the applied for mark were being provided by either the Opponent or a connected undertaking. I consider consumers would perceive the addition of the AND CREATORS elements to be, for example, a differing range of clothing from the Opponent. The fact that the element CREATORS shares the same conceptual thread as the element MAKERS merely reinforces the view that there is a connection between the respective marks. For these reasons, I consider this would lead to a likelihood of indirect confusion.

Outcome

46. The opposition under section 5(2)(b) of the Act succeeds in full. Subject to any successful appeal the application is refused for all its goods in class 25.

Costs

47. As the Opponent has been successful it is entitled to an award of costs. For Fast Track opposition proceedings costs are capped at £500 according to Tribunal Practice Notice 2/2015. The Opponent however did not file any evidence or additional submissions and I therefore award costs on the following basis:

⁷ BL O/547/17

Preparing a notice of opposition and considering the defence and counterstatement	£200
Official fee	£100
Total	£300

48. I order Icebreaker Ltd to pay The Makers B.V. the sum of £300. The sum to be paid within twenty one days of the expiry of the appeal or within twenty one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 24th day of September 2020

Leisa Davies
For the Registrar