

**O-555-21**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3539575 BY  
GLOBE IMPORTS AND SOURCING LTD**

**TO REGISTER:**



**AS A TRADE MARK IN CLASSES 8 AND 21**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 600001697 BY  
TALKING TABLES LTD**

## Background & pleadings

1. On 1 October 2020, Globe Imports and Sourcing Ltd (“the applicant”) applied to register the trade mark shown on the cover page of this decision for the goods in classes 8 and 21 shown in paragraph 16 below.

2. On 26 April 2021, the application was opposed in full under the fast track opposition procedure by Talking Tables Ltd (“the opponent”). The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), with the opponent relying upon all the goods (also shown in paragraph 16 below) in United Kingdom registration no. 3474866, for the trade mark shown in paragraph 29 below. This trade mark has a filing date of 13 March 2020 and was entered in the register on 9 August 2020.

3. As the only comments I have from the opponent are contained in its Notice of opposition, they are reproduced below in full:

“From a visual perspective the two signs share the majority of the same elements. They are both circular devices, contain leaf elements and two out of the three words of [the applicant’s] device are identical to the words used in our earlier device, namely “Planet Friendly.” The additional third word of [the applicant’s] mark is wholly descriptive of the goods it represents and may not be considered to add significantly to the distinctive character of the device. Visually, we consider the marks to be similar/very similar to one another.

The aural elements of [the applicant’s] mark only contains a single differing element. Two out of the three words used in [the applicant’s] mark are identical to the words used in our PLANET FRIENDLY device. The additional third word of [the applicant’s] mark, which may be read first by a member of the public and is therefore considered to be more dominant in the mind of the average consumer, is entirely descriptive of the goods it represents. PLANET FRIENDLY is the dominant aural aspects of the mark, as such, aurally, the marks are almost identical.

When taken conceptually, both marks are clearly indicating that the goods to which they are applied are “good for the planet” i.e. they are recyclable, compostable, reusable, etc. They use identical imagery (circle devices representing the world/world map and leaves) and words to signpost to the consumer that these products will not damage the planet. Conceptually, the marks are considered very similar/identical.”

4. The applicant filed a counterstatement. Once again as these are the only comments I have from the applicant, they are reproduced below in full:

“There is no confusion between the [trade marks at issue]...

To illuminate this opinion, please see the link in the email, which demonstrates the search results for “planet friendly” conducted via the Google search engine. As can be seen from these results, and as you will appreciate, the term “planet friendly” is a common and generic way to refer to products/services which are not environmentally harmful (e.g. eco-friendly, environment friendly etc. are synonyms for “planet friendly”). For this reason, there is no single exclusive proprietorship of this term and this term is free to use by all to refer to products/services which are not environmentally harmful or, indeed, to phrase this another way, “planet friendly”. We are NOT seeking to obtain a monopoly in the terms “planet friendly”, but, instead, in the overall get-up of its brand...

Our trade mark includes the additional word “compostable”, which is also a generic and common term free to use by all.

The distinctiveness of our trade mark is the wrapping of the word elements around the planet symbol, which reinforces the generic “planet friendly” message and the graphic leaf elements which are alongside those words and are of a non-identical shape, colour, design and set at a unassociated angle. Also, notably compared to [the opponent’s trade mark], the term “planet friendly” is presented in our mark in a different font and size. Our terms curve around the earth, whereas [the opponent’s] term goes through a circle which

makes [the opponent's] logo look more like an apple/fruit as opposed to representing the earth/planet. The distinctiveness in [the opponent's trade mark] is the overall get-up of the figurative mark [it has] registered, which includes a different leaf design (and is absent a planet logo or the word "compostable"). None of [the applicant's] distinctive elements are present in [the opponent's] trade mark."

5. I note that the Form TM8 contains references to "Please see attached word documents..." and "please see the link in the email". However, a review of the official file indicates that the Tribunal discussed these issues with the applicant, who confirmed that: (i) the reference to a link in the email was erroneous, and (ii) the single page of the counterstatement (the text of which I have reproduced above) was all that it intended to file.

6. That is somewhat odd, as it appears from the inclusion of the words "which demonstrates the search results for "planet friendly" conducted via the Google search engine. As can be seen from these results...", that it was the applicant's intention to file information to demonstrate that the term "planet friendly" was widely used to indicate, as the applicant puts it, "products/services which are not environmentally harmful...". Had such search results been provided, the applicant would have been advised that in order to rely upon such information, it would have been necessary for it to seek leave to file evidence at the appropriate time. In an official letter dated 28 May 2021, the Tribunal advised the parties:

"Any request for leave to file evidence should be submitted within 14 days of the date of this letter, that is on or before **11 June 2021**. Further guidance is provided at paragraph 7 of the Tribunal Practice Notice 2/2013."

7. As the applicant specifically confirmed that its Form TM8 and counterstatement was as it intended, and as it did not seek leave to file the information referred to by it in its Notice of defence when it was afforded the opportunity to do so, I must proceed on the basis of the pleadings as indicated above.

8. In these proceedings both parties represent themselves.

9. Rule 6 of the Trade Marks (Fast Track Opposition)(Amendment) Rules 2013, S.I. 2013 2235, disappplies paragraphs 1-3 of 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.”

10. The net effect of these changes is to require parties to seek leave in order to file evidence in fast track oppositions. 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.

11. In the official letter dated 28 May 2021, the parties were allowed until 11 June to seek leave to file evidence and/or request a hearing and until 25 June 2021 to provide written submissions. Neither party sought leave to file evidence, requested a hearing or filed written submissions.

## **DECISION**

12. The opposition is based upon section 5(2)(b) of the Act, which 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.

5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the

trade mark is applied for, the application is to be refused in relation to those goods and services only.”

13. The trade mark upon which the opponent relies qualifies as an earlier trade mark under section 6 of the Act. As this earlier trade mark had not been registered for more than 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. The opponent is, as a consequence, entitled to rely upon it in relation to all of the goods indicated without having to prove that it has made genuine use of it.

14. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

### **Case law**

15. The following principles are gleaned from the decisions of the courts of the European Union 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 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 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

16. The competing goods are as follows:

The opponent's goods	The applicants' goods
<p><b>Class 16</b> - Disposable party paper napkins, disposable paper table covers, bags of paper for use at parties (loot bags), streamers, birthday banners, paper decorations for festive use.</p> <p><b>Class 21</b> - Paper cups, paper plates.</p> <p><b>Class 28</b> - Party twisters (confetti launchers), table confetti, wedding confetti, streamers (party novelties), party poppers, party hats, party novelties, toy tiaras, party blowers, all being party toys or novelties.</p>	<p><b>Class 8</b> - Biodegradable cutlery; Biodegradable forks; Biodegradable knives; Biodegradable spoons.</p> <p><b>Class 21</b> - Biodegradable bowls; Biodegradable cups; Biodegradable plates; Biodegradable trays; Biodegradable trays for domestic purposes; Compostable bowls; Compostable cups; Compostable plates; Compostable trays; Compostable trays for domestic purposes.</p>

17. 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:

“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”.

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

- (a) The respective 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.

19. 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.”

20. 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 General Court (“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 that the responsibility for those goods lies with the same undertaking”.

21. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the GC stated:

“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 where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

22. As neither party has commented on the similarity (or otherwise) in the competing goods, I must reach my own conclusions.

## **Class 8**

23. The opponent’s trade mark is not registered in class 8. It is, however, registered in class 16 for, inter alia, “disposable party paper napkins” and “disposable paper table covers” and in class 21 for “paper cups” and “paper plates”, all of which could,

of course, be biodegradable or compostable. Although the nature of the competing goods is likely to differ, when one considers the likely overlap in the users, intended purpose, method of use and trade channels, the applicant's goods in this class are, in my view, similar to the opponent's named goods to at least a medium degree.

## **Class 21**

24. The opponent's specification in this class consists of "paper cups" and "paper plates". As such terms are broad enough to include "Biodegradable cups", "Biodegradable plates", "Compostable cups" and "Compostable plates" in the application, the goods are to be regarded as identical on the principles outlined in *Meric*. That leaves "Biodegradable bowls", "Biodegradable trays", "Biodegradable trays for domestic purposes", "Compostable bowls", "Compostable trays" and "Compostable trays for domestic purposes". Once again, if one considers the likely overlap in the nature, intended purpose, method of use, users and trade channels of these remaining goods with those of the opponent in the same class, it results in what I consider to be a high degree of similarity.

## **The average consumer and the nature of the purchasing process**

25. As the case law above indicates, it is necessary for me to determine who the average consumer is for the goods at issue; I must then determine the manner in which such goods are likely to be selected by the average consumer in the course of trade. 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."

26. The average consumer of the goods at issue is a member of the general public. As a member of the general public will, for the most part, self-select such goods from the shelves of a bricks-and-mortar retail outlet or from the equivalent pages of a website or catalogue, visual considerations are likely to dominate the selection process. That said, as such goods may also be the subject of, for example, word-of-mouth recommendations or oral requests to sales assistants (both in person and by telephone), aural considerations must not be forgotten.

27. Although the goods at issue are likely to be inexpensive, they are also likely to be selected fairly infrequently. When selecting such goods, the average consumer is likely to be alive to factors such as cost, size, colour, material etc. Consequently, they can, in my view, be expected to pay a between low and medium degree of attention to their selection.



### **Comparison of trade marks**

28. 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 them, 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*:

“.....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.”

29. It would be wrong, therefore, artificially to dissect the trade marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore

contribute to the overall impressions they create. The competing trade marks are as follows:

The opponent's trade mark	The applicant's trade mark
	

### Overall impression

30. The opponent's trade mark consists of a number of components. The first is the words "PLANET FRIENDLY" presented at an angle in a conventional typeface in upper case letters. These words form a unit, in which the first word qualifies the second. Given the size of these words and their positioning in the context of the trade mark as a whole, they will make by far the most important contribution to the overall impression it conveys. The second component consists of what both parties agree is a device of a leaf. Given its size and positioning it will make a modest contribution to the overall impression conveyed as will the third component i.e. a circular device upon which the first and second components are placed. I shall return to the distinctiveness of these various components later in this decision.

31. The applicants' trade mark also consists of a number of components. The first is the word "Compostable" presented in title case in a conventional bold typeface. Although this word appears at the top of the trade mark and will contribute to the overall impression it conveys, as I agree with the opponent that it will be regarded as descriptive in nature, any contribution it may make to the overall impression conveyed will not be a distinctive one. The second component consists of a circular device which the applicant refers to as the "planet symbol". I am satisfied that is how the average consumer will construe the second component. Although given its size and positioning this component will make an important contribution to the overall impression conveyed, as such devices are, in my experience both as a Trade Marks

Hearing Officer and as a member of the general public, commonly used by undertakings in all areas of trade to indicate, for example, their environmental credentials, any contribution this component may make to the trade mark's distinctiveness will be, at best, low. The third component consists of devices (which appear to the left and right of the circular device) which the parties agree will be construed as leaves. The impact of these devices on the overall impression conveyed will be modest, at best. The fourth and final component consists of the words "Planet Friendly" presented in title case in a conventional bold typeface. As I found in relation to the opponent's trade mark, these words form a unit. Despite their positioning at the bottom of the trade mark, they will make an important contribution to the overall impression conveyed. I will return to the distinctiveness of the third and fourth components below.

### **Visual similarity**

32. The competing trade marks share the words "PLANET FRIENDLY"/"Planet Friendly", a circular device and differing representations of leaves. Weighing the similarities and differences, in particular the differences in the circular devices, results in what I regard as at least a medium degree of visual similarity between them.

### **Aural similarity**

33. It is well established that when a trade mark consists of a combination of words and figurative components, it is by the word components that the trade mark is most likely to be referred to. Proceeding on that basis, the opponent's trade mark will be referred to by the four syllable combination "PLAN-ET FRIEND-LY". As the word "Compostable" in the applicant's trade mark is descriptive, it is most unlikely to be verbalised by the average consumer when referring to the applicant's trade mark. In that scenario, the competing trade marks are aurally identical. However, if the word "Compostable" were to be verbalised, as it is likely to be verbalised first, the degree of aural similarity would reduce to medium.

## **Conceptual similarity**

34. The words “PLANET FRIENDLY”/“Planet Friendly” in the competing trade marks will, the parties appear to agree, send the same conceptual message i.e. that the goods to which they are to be applied are, to use the opponent’s words, “good for the planet”. Insofar as the circular device in the applicant’s trade mark is concerned this will convey the concept of the world. While for some average consumers the same may be true of the circular component in the opponent’s trade mark, others may, as the applicant suggests, see it as a device of an “apple/fruit.” Finally, to the extent that the devices of leaves will create any concrete concept in the mind of the average consumer, the concept will be identical. Considered overall, even if the average consumer construes the circular device in the opponent’s trade mark as an apple/fruit, the fact that both parties’ trade marks contains a component which will convey the identical concept of products which are “good for the planet”, results in at least a medium degree of conceptual similarity between them. Of course if the average consumer construes the device in the opponent’s trade mark as a planet/globe, the degree of conceptual similarity will be even higher.

## **Distinctive character of the earlier trade mark**

35. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

36. As these are fast track proceedings in which the opponent has filed no evidence of any use it may have made of its earlier trade mark, I have only its inherent characteristics to consider. In its counterstatement, the applicant argues that:

“...”planet friendly” is a common and generic way to refer to products/services which are not environmentally harmful (e.g. eco-friendly, environment friendly etc. are synonyms for “planet friendly”). For this reason, there is no single exclusive proprietorship of this term and this term is free to use by all to refer to products/services which are not environmentally harmful or, indeed, to phrase this another way, “planet friendly”.

37. Although the applicant did not seek leave to file evidence in support of that assertion, the opponent appears to accept that the words “PLANET FRIENDLY” will be understood by the average consumer as relating to, inter alia, goods which are “good for the planet.” That is how I construed these words and, more importantly is, I am satisfied, how the average consumer will construe them. Consequently, even though there is no evidence which establishes that these words are, as the applicant suggests, “generic”, they are highly likely to be regarded by the average consumer as descriptive of and non-distinctive for goods which are, for example, environmentally friendly. Having already concluded that these words will make by far the most important contribution to the overall impression the opponent’s trade mark conveys, even if: (i) the device of a leaf is considered to be distinctive (which is doubtful), and (ii) the circular device is construed as an apple/fruit, when considered as a whole, the opponent’s trade mark enjoys at best a low degree of inherent distinctive character.

### **Likelihood of confusion**

38. In determining whether there is a likelihood of confusion, 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 also necessary for me to keep in mind the distinctive character of the opponent’s trade mark as the more distinctive it is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and 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 he has retained in his mind.



39. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods down to the responsible undertakings being the same or related. 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.”

40. Earlier in this decision I concluded that:

- where not identical, the applicant’s goods are similar to named goods in the opponent’s specification in classes 16 and 21 to at least a medium degree;
- the average consumer is a member of the general public who, whilst not ignoring aural considerations, will select the goods at issue by primarily visual means whilst paying a between low and medium degree of attention during that process;
- the competing trade marks are visually similar to at least a medium degree, aurally similar to at least a medium degree (and much more likely aurally identical) and conceptually similar to at least a medium degree;

- although the words “PLANET FRIENDLY” in the opponent’s trade mark are highly likely to be regarded as descriptive/non-distinctive by the average consumer, when considered as a whole, the opponent’s trade mark enjoys at best a low degree of inherent distinctive character.

41. In reaching a conclusion, I begin by reminding myself that in *Nicoventures Holdings Limited v The London Vape Company Ltd* [2017] EWHC 3393 (Ch), Mr Justice Birss stated:

31. The nature of the common elements needs to be considered and in a case like this, in which the common elements are elements which themselves are descriptive and non-distinctive (as the Hearing Officer found in paragraph 34), it is necessary somewhere to focus on the impact of this aspect on the likelihood of confusion. As has been said already it does not preclude a likelihood of confusion but it does weigh against it. There may still be a likelihood of confusion having regard to the distinctiveness and visual impact of the other components and the overall impression but the matter needs to be addressed.

32. The Hearing Officer found that the element in the opponent's mark which is the common element (i.e. VAPE and CO) is itself more distinctive than other features of that mark (i.e. the stylised features). That is a decision he was entitled to reach but it does not mean that once that decision has been reached, the low distinctiveness of what is the common element ceases to be relevant to a likelihood of confusion. Far from it. That is not what the CJEU in *L'Oreal v OHIM* was saying at all.

33. Given that the Hearing Officer has erred in this way, the matter needs to be considered again bearing in mind the *White and Mackay's* principle. Given the clarity of the Hearing Officer's decision there is no need to go over this at length.

34. Each mark includes as important elements the terms VAPE and CO. There is more to each mark than that because they each include stylised features which are unremarkable but are different from one another (decision paragraphs 27 and 28). The point is that the marks do have a high degree of visual, aural and conceptual similarity (paragraphs 29-31) but that similarity arises from the common elements of the terms VAPE and CO and the combination of those two words. Bearing in mind the goods and services for which these marks are registered or applied for respectively, those words individually are both descriptive and non-distinctive. Put together the combination is also descriptive and non-distinctive.

35. As the Hearing Officer held in paragraph 31 they connote an undertaking in the vaping market. The average consumer, who is a member of the general public over 18 years old, will pay a relatively high degree of attention to the selection of goods and a reasonable level of attention to the selection of services.

36. Bearing all this in mind but in particular having regard to the low degree of distinctiveness about the features these two marks have in common, even taking into account imperfect recollection the differences in the two marks will take on a greater significance for the average consumer than they might otherwise. Although the stylised aspects of each mark are not very remarkable, the fact remains that these aspects are entirely different. From the point of view of visual similarity, the likelihood of confusion is low. Considering conceptual similarity, the concept the two marks share is entirely down to their non-distinctive elements. It is the common concept which is non-distinctive. That does not lead to a likelihood of confusion. In some ways the respondent's best case could be thought to come from considering the aural similarity. From that point of view of course the visual stylised elements will not be present, and hearing "Vape dot co" or "THE Vape dot co" is not so far away from hearing "Vape and co" but the fact is again that they are not the same and what they share is entirely non-distinctive when one bears in mind this is all in the context of electronic cigarettes.

37. Accordingly I do not consider that there is a likelihood of confusion in this case.”

42. The competing goods are either identical or similar to at least a medium degree and the average consumer will pay a between low and medium degree of attention to the selection of such goods (thus making him/her more prone to the effects of imperfect recollection). These are points in the opponent’s favour.

43. However, I also concluded that the words “PLANET FRIENDLY” are descriptive of and non-distinctive for goods which are, for example, environmentally friendly. Although the competing trade marks share a circular device, these devices are visually quite different and, for some average consumers, are likely to send differing conceptual messages. However, even if the average consumer construes the circular device in the opponent’s trade mark as representing the world, when considered in the context of products that are “good for the planet”, that device also lacks distinctiveness.

44. Having weighed the various factors and notwithstanding the points in the opponent’s favour, the lack of distinctiveness the opponent’s trade mark possesses both as a whole and, in particular, in the words “PLANET FRIENDLY” is, in my view, unlikely to result in either direct or indirect confusion. Far more likely, in my view, is that the average consumer will simply assume that completely unrelated undertakings wishing to trade in relation to the same and related goods (and who wish to inform the consumer that their goods are environmentally friendly), have coincidentally and, in my view, unsurprisingly, combined in different ways a number of descriptive/non-distinctive words and figurative components designed to convey that message.

### **Overall conclusion**

**45. The opposition has failed and, subject to any successful appeal, the application will proceed to registration.**

## Costs

46. As the applicant has been successful, it is, in principle, entitled to an award of costs. Awards of costs in fast track opposition proceedings are governed by Tribunal Practice Notice (“TPN”) 2 of 2015.

47. A review of the official record indicates that Withers & Rogers LLP (“WR”) were appointed as the applicant’s agent on 25 March 2021 and, on 18 May 2021, the Form TM7F was served upon them. However, inter alia, I note that: (i) the official record shows that WR are no longer representing the applicant, (ii) the Form TM8 was filed by the applicant itself (signed by Mr Harbinson), and (iii) the official record indicates that WR forwarded all relevant correspondence to the applicant for its consideration (an example of which is WR’s mail to the applicant timed at 12.13 on 1 June 2021). As a consequence, the applicant ought to have been fully aware that in the official letter of 28 May 2021, the Tribunal stated:

“If you intend to make a request for an award of costs you must complete and return the attached pro-forma and send a copy to the other party. Please send these by e-mail to [tribunalhearings@ipo.gov.uk](mailto:tribunalhearings@ipo.gov.uk) on or before **25 June 2021**.

If the pro-forma is not completed and returned, costs, other than official fees arising from the action (excluding extensions of time), may not be awarded. You must include a breakdown of the actual costs, including accurate estimates of the number of hours spent on each of the activities listed and any travel costs. Please note that The Litigants in Person (Costs and Expenses) Act 1975 (as amended) sets the minimum level of compensation for litigants in person in Court proceedings at £19.00 an hour.”

48. As the applicant elected not to complete a costs proforma and as it has incurred no official fees in the defence of its application, I make no order as to costs.

Dated this 26th day of July 2021

**C J BOWEN**

**For the Registrar**