

O/0093/23

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NUMBER 3556454

BY AHMED SYED

TO REGISTER THE FOLLOWING TRADE MARK:

LISTEN BEYOND YOUR LIMITS

IN CLASS 9

AND

AN OPPOSITION THERETO UNDER NUMBER 425137

BY FOCAL JMLAB

BACKGROUND AND PLEADINGS

1. On 16 November 2020, Ahmed Syed (“the applicant”) applied to register “**LISTEN BEYOND YOUR LIMITS**” as a trade mark in the UK (“the contested mark”). The application was published for opposition purposes on 26 March 2021 and registration is sought for the following goods:

Class 9 *Headphones; Apparatus for the reproduction of sound; Audio accessories; Speakers; Loudspeakers; Headphone accessories; Wireless Earbuds.*¹

2. On 24 June 2021, FOCAL JMLAB (“the opponent”) opposed the application in full, based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). Under sections 5(2)(b) and 5(3) the opponent relies upon international trade mark number WO0000001364947: “**LISTEN BEYOND**” (“the earlier mark”). The trade mark has a filing date of 19 June 2017, a registration date of 3 November 2017, a priority date of 28 February 2017 and is registered for goods in Class 9.² In accordance with section 6 of the Act, the mark is considered an earlier mark. The mark had not been registered for five years at the date of the application for the contested mark and so, in accordance with section 6A of the Act, the mark is not subject to proof of use; the opponent may rely upon all the goods for which the mark is registered.

3. Under section 5(2)(b), the opponent claims that there is a likelihood of confusion on the basis that the marks are similar and the goods are identical or similar.

4. Under section 5(3), the opponent claims to have a strong reputation for all the goods relied upon and claims that use of the contested mark would, without due cause, take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier mark.

¹ The specification listed takes account of a request by the applicant via a Form TM21B to amend the specification applied for. The opponent confirmed that it would be maintaining its opposition.

² These will be listed in the goods comparison.

5. Under section 5(4)(a), the opponent relies upon the unregistered sign “**LISTEN BEYOND**” which it claims to have used throughout the UK since 2017 in relation to *high fidelity speakers, home theatre systems, multimedia systems, car audio systems and professional audio products and general electronic products*. The opponent claims to have generated a significant goodwill in the sign and that use of the contested mark would constitute a misrepresentation to the public that would damage the opponent’s goodwill. Therefore, use of the contested mark would be contrary to the law of passing off.

6. The applicant filed a defence and counterstatement denying a likelihood of confusion on the basis that, whilst the marks at issue are similar, they are clearly distinguishable from one another. The applicant further submits that whilst both parties’ goods are in the audio category, the products actually manufactured and sold are dissimilar. It is important to note here that it is not the goods available on the market that is relevant to the likelihood of confusion under section 5(2)(b), but the goods as registered in each mark’s specification.

7. In relation to section 5(3), the applicant argues that the contested mark would not take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier mark. The applicant claims that consumers will not confuse the brands on the basis that the marketing material, website and product packaging are significantly different. The applicant accepts that the opponent “is known for manufacturing high fidelity speakers, home theatre systems, multimedia and wireless systems, headphones, car audio systems and professional audio products” but that the applicant is in the process of establishing a company involved in “wireless speakers, wireless headphones, true wireless earbuds and related accessories”.

8. In regard to section 5(4)(a), the applicant simply states that the contested mark “does not offend against [the relevant] provisions”.

9. The opponent is represented by Mathys & Squire LLP; the applicant is unrepresented. Only the opponent filed evidence (accompanied by written submissions) in these proceedings. Neither party requested a hearing, nor did they file

written submissions in lieu. The evidence will be summarised to the extent that it is considered necessary. This decision is taken following a careful perusal of the papers.

EVIDENCE

10. The opponent filed evidence in the form of the witness statement of Cédric Boutonet dated 28 January 2022 and its corresponding 12 exhibits (CB01-CB12). Mr Boutonet is Chief Executive Officer of the opponent company. Written submissions and three associated annexes accompanied the witness statement.

11. Mr Boutonet's witness statement explains that the LISTEN BEYOND mark has been used in the UK since 2017 and that the opponent company specialises in audio equipment, audio speakers, car audio systems, headphones and monitoring loudspeakers.

12. Some of the exhibits are intended to show use of the mark on the opponent's goods including the packaging.³ Screenshots of the opponent's UK website, taken from the web archive 'wayback machine', are shown below.⁴ Whilst the earlier mark is visible, it is not clear which goods are actually branded with LISTEN BEYOND; I can simply see categories of goods, with no obvious connection to the earlier mark as opposed to the main FOCAL brand.

³ CB02-03, CB06-08 and CB10-11.

⁴ CB02.

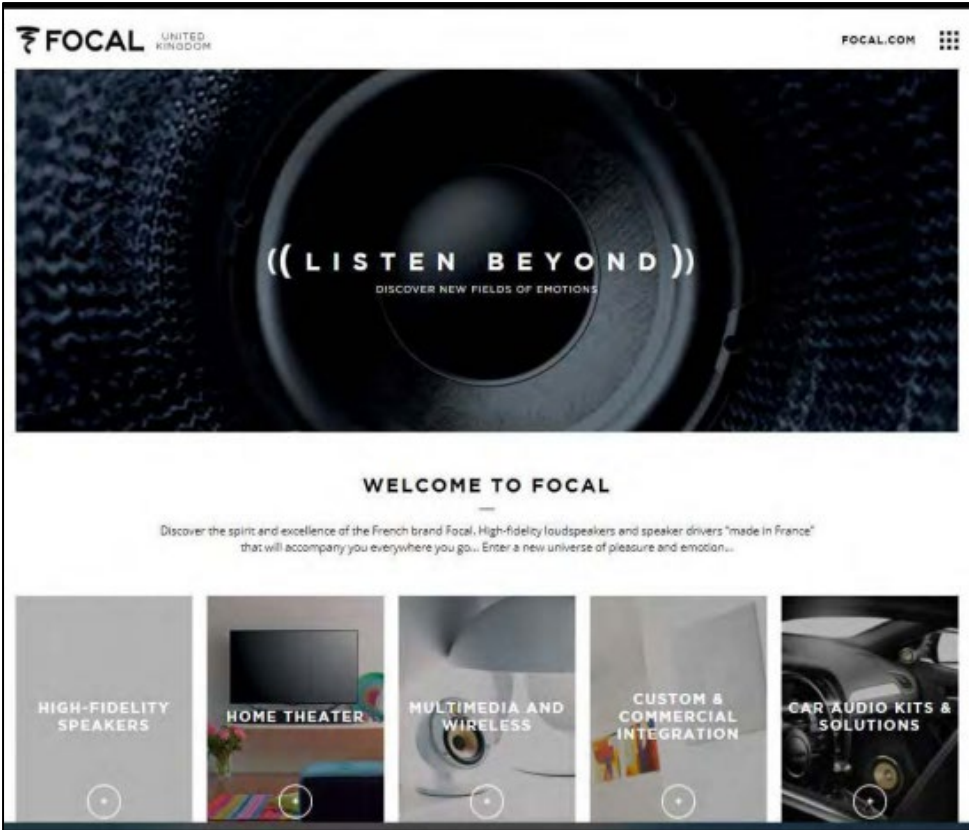


Figure 1

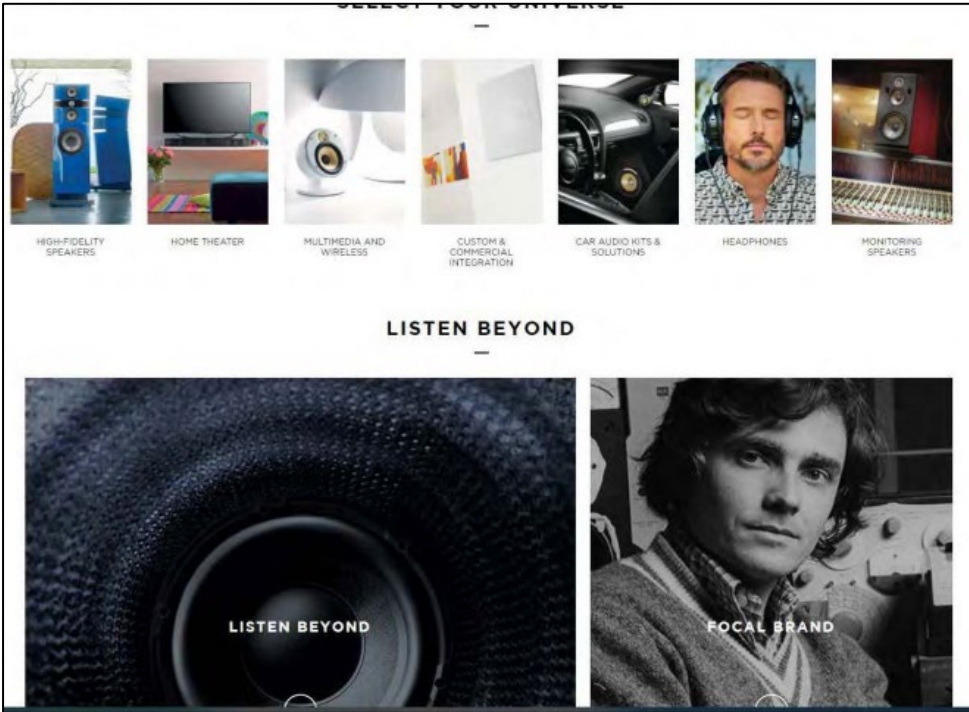


Figure 2

13. None of the goods shown in Exhibit CB03, which include headphones, audio-visual receivers, amplifiers and speakers, are referred to as LISTEN BEYOND goods. The goods do, however, mostly display the mark on the goods themselves or the packaging, as per the images below. The same applies to the product referred to in Exhibit CB06: it is described as 'Focal 40th Anniversary Full Active System – Drivers – Tweeters – Sub – Amplifier – DSP' but displays the LISTEN BEYOND mark as per Figure 7, below.



Figure 3



Figure 4



Figure 5



Figure 6



Figure 7



Figure 8

14. The product catalogues within Exhibit CB07, dated 2019 and 2020, amount to 44 pages, of which the mark is clearly visible once on only five pages and not in relation to any particular goods.

15. Exhibit CB08 contains a review of a product described as 'Focal Astral 16 AV Processor/Amplifier Review' on the website www.avforums.com dated 22 December 2019. The earlier mark is visible in a small font on the product itself, below the larger FOCAL mark, but LISTEN BEYOND is not used in reference to the product or anywhere else throughout the 16-page review.

16. Images taken from, and online articles relating to, trade shows and exhibitions attended by the opponent are contained within Exhibit CB10, one of which took place in the UK – Bristol, England – in 2019. Two of the opponent's goods, Focal Elegia and Focal Stellia headphones, feature in the online article related to the Bristol event but the earlier mark is not visible. Pictures of the opponent's stands at other events outside the UK, however, display the mark as shown below.

1) High End Show- Munich 2017



Figure 9

2) Integrated Systems Europe 2018- Amsterdam



Figure 10



Figure 11

17. Mr Boutonet explains that the opponent invested over 150,000 euros in the production of a film to launch the LISTEN BEYOND mark in 2016. Exhibit CB11 is a screenshot taken from the film on YouTube, shown below. The video was uploaded in June 2016 and had 32,823 views at the point the screenshot was taken in January 2022. The exhibit shows no reference to any particular goods and so it is impossible for me to know what the launch of the mark related to.

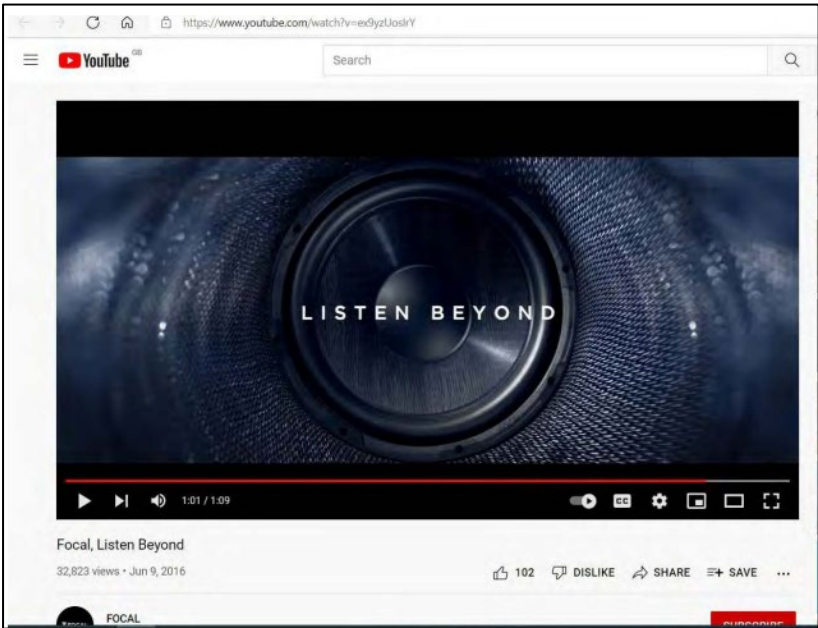


Figure 12

18. Exhibit CB04 contains website traffic analysis for the years 2017 to 2021. The opponent's UK website figures are shown in the table below. There is no mention of the earlier mark.

Year	Users	Session	Page Views
2017	11,652	4,638	34,761
2018	59,790	56,747	186,946
2019	51,892	56,200	140,763
2020	51,504	56,670	149,780
2021	58,877	65,831	165,986
Total	194,655	240,086	678,236

19. Exhibit CB05, a screenshot of the opponent's website taken from the web archive 'wayback machine' in July 2020, is explained by Mr Boutonet as showing there were over 250 dealers and distributors in the UK at that date. Again, the earlier mark is not visible.

20. Exhibit CB09 is described as a list of awards the opponent has won in the UK between 2018 and 2021, but I note that there are awards from countries other than the UK also listed. The table contains, inter alia, the date of the award, the relevant magazine, the product the award related to and the brand of the product. None of the product names or brands are LISTEN BEYOND; the majority of the brands listed are FOCAL or NAIM, the latter not having been explained.

21. Finally, Exhibit CB12 contains invoices dated between August 2016 and August 2020 and the delivery addresses contained therein include Bristol, Lancashire, Salisbury, Avonmouth, Welwyn Garden City and Peterborough. The mark on the top of each invoice is FOCAL JMLAB. None of the invoices make any reference to the LISTEN BEYOND mark.

DECISION

Relevance of EU law

22. 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 upon 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.

Section 5(2)(b)

23. Section 5(2)(b) of the Act states that:

“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.”

Relevant law

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

The principles

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

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

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

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

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

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

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

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

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

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

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

Comparison of goods

25. The competing goods are shown in the table below:

The earlier mark	The contested mark
Class 9: Software; interfaces (software); apparatus for recording, transmission, reproduction or processing of sound or images; loudspeaker cabinets; amplifiers, loudspeakers, radios, mixing decks, sound processors and converters of sound data, electroacoustic apparatus, microphones, home cinemas, car radios; telecommunication apparatus, magnetic data carriers, acoustic or optical discs; cd drives, dvd drives, high-fidelity sound systems, televisions, video projectors; connection stations for digital players; audio and	Class 9: Headphones; Apparatus for the reproduction of sound; Audio accessories; Speakers; Loudspeakers; Headphone accessories; Wireless Earbuds.

video equipment (apparatus), apparatus, components and accessories (namely microprocessors and electronic power supply) used for the production, processing, measuring, analyzing, recording, amplification, improvement, production, reproduction, transmission, storage, checking, testing, receiving and playing of audio signals, files and sounds and visual signals, files and images; sound cards; motherboard; apparatus and software for the improvement of analog and digital sound for the processing, recording, reproduction, streaming, transmission and reception of electronic or digital signals; computer programs, software, computer hardware and computer components and other digital devices used for the creation, processing, measuring, analysis, recording, amplification, improvement, reproduction, transmission, control, testing, reception and playing of signals, audio and sound files, and signals, visual files and images; computer programs and software for encoding and decoding voice and audio signals; computer hardware and software for the processing, recording, reproduction, distribution, streaming, transmission and reception of electronic or digital signals; video processors and sound processors; equipment (apparatus) for alignment and

testing for audio and video equipment for the processing, recording, reproduction, diffusion, streaming, transmission and reception of electronic or digital signals; digital signal processing chips; printed circuit boards; graphics cards; graphic processors; magnetic, optical and digital recording media.	
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26. In *Gérard Meric v OHIM*, the General Court (“GC”) confirmed 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):⁵

“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.”

27. The opponent provided a table comparing the respective specifications,⁶ which I have taken into account in my assessment.

28. The applicant, in its defence and counterstatement, made submissions in relation to the comparison of goods, including references to, inter alia, its plans in relation to product launches in 2023, the goods currently sold by the opponent and the packaging of the goods. As explained at paragraph 6, above, these factors are not relevant to the likelihood of confusion under section 5(2)(b) and so the goods I will compare in this section are those listed in the table at paragraph 25, i.e. the goods for which the earlier mark is registered and the goods for which the applicant is seeking registration.

⁵ Case T-133/05

⁶ The opponent’s written submissions dated 31 January 2022 at [28].

29. I consider the applicant's *headphones; speakers; loudspeakers and wireless earbuds* to be apparatus for reproducing sound. As such, these fall within the scope of the opponent's *apparatus for recording, transmission, reproduction or processing of sound or images*; these are identical in line with the principle in *Meric*.

30. It is self-evident that the applicant's *apparatus for the reproduction of sound* are encompassed by the opponent's *apparatus for recording, transmission, reproduction or processing of sound or images*. These goods are identical.

31. I consider the applicant's *audio accessories* to fall within the scope of the opponent's *audio and video equipment*. These goods are identical in line with *Meric*. Since headphones are considered audio equipment, I also find the applicant's *headphone accessories* identical to the opponent's *audio and video equipment*.

32. To conclude, I consider the entirety of the applicant's specification identical to one or more of the opponent's goods.

The average consumer and the purchasing act

33. It is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

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

34. I consider the parties' goods to be aimed at the general public at large. The cost of the goods will vary: some audio accessories will be fairly inexpensive and purchased more often than more expensive audio equipment, such as headphones and speakers, for example. The purchase will be considered by consumers taking into account aesthetic preferences, product specifications and suitability for their needs. Consumers will most likely select the goods visually, by choosing them from the shelves of physical retail stores or from their catalogue or online equivalents. However, I do not ignore the potential for an aural aspect to the purchasing process, owing to conversation with retail assistants. In those circumstances however, consumers are still likely to visually encounter the goods. On the whole, a slightly higher than average degree of attention will be paid to the purchase of the parties' goods, regardless of the cost.

Comparison of marks

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

36. It would be wrong, therefore, to dissect the trade marks artificially, although it is necessary to take into account the distinctive and dominant components of the trade 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.

37. The trade marks to be compared are as follows:

The earlier mark	The contested mark
LISTEN BEYOND	LISTEN BEYOND YOUR LIMITS

38. The applicant's counterstatement contains the following submissions:

"The "Listen Beyond Your Limits" trademark is similar but is clearly distinguishable from the "Listen Beyond" trademark. Despite containing the words "Listen Beyond" it is felt that the trade mark is distinct given the addition of the words "Your Limits". [...] The Applicant argues that the marks are visually, aurally and conceptually different. Conceptually, the addition of the words "Your Limits" infers that [the applicant's] products provide an elevated audio experience beyond the listening capacity of the individual."

39. In its written submission, the opponent contends that the marks at issue are highly similar and makes detailed submissions,⁷ which I have taken into account in my assessment and will refer to where necessary.

Overall impression

40. The earlier mark consists of the two words LISTEN and BEYOND, with neither word dominating. There are no other elements to add the overall impression of the marks which rests in the mark as a whole.

41. The contested mark consists of the four words LISTEN, BEYOND, YOUR and LIMITS, with none of the words dominating. Again, there are no other elements and the overall impression of the mark rests in the words LISTEN BEYOND YOUR LIMITS.

⁷ At [10] to [26].

Visual comparison

42. Both marks begin with the identical words LISTEN BEYOND, creating visual similarity. The point of visual difference is the addition of the words YOUR LIMITS in the contested mark, resulting in a mark almost twice as long as the earlier mark. I consider the marks to be visually similar to between a medium and high degree.

Aural comparison

43. The marks share the element LISTEN BEYOND, at the beginning of the marks, which will be pronounced identically. The additional words YOUR LIMITS in the contested mark act as a point of aural difference and result in a seven-syllable mark compared to the earlier four-syllable mark. There is a medium to high degree of aural similarity between the marks.

Conceptual comparison

44. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM*.⁸ The assessment must be made from the point of view of the average consumer.

45. The opponent makes the following submissions:⁹

“21. [...] the consumer, when presented with the mark “LISTEN BEYOND” would actually see an invented phrase with no particular meaning. It is therefore the Opponent’s submission that no conceptual assessment should be necessary.

22. However, in the alternative [...] it would be the Opponent’s position that the marks are conceptually identical due to the identical impression created by the

⁸ [2006] e.c.r.-I-643; [2006] E.T.M.R. 29

⁹ The opponent’s written submissions dated 31 January 2022.

marks due to the incorporation of the identical elements LISTEN and BEYOND.”

46. I agree somewhat with the opponent’s submission to the extent that the two ordinary dictionary words LISTEN BEYOND create an unusual combination, but I would not describe the phrase as invented since both words have clear meanings. In my view, consumers are likely to either see LISTEN BEYOND as an alternative way of saying ‘listen carefully’ or, when considering the nature of the relevant goods, as a reference to enjoying an enhanced listening experience.

47. In the contested mark, the addition of the words YOUR LIMITS to LISTEN BEYOND make the meaning slightly less ambiguous. Whilst the phrase is also unusual, I agree with the applicant that it may infer that the goods “provide an elevated audio experience beyond the listening capacity of the individual”.

48. Despite the marks being somewhat vague in their meaning, I do not consider either mark to be devoid of any conceptual message. The words YOUR LIMITS add a point of conceptual difference, but given the shared element LISTEN BEYOND, there is a clear conceptual overlap between the marks. Taking everything into account, I find the marks to be conceptually highly similar.

Distinctive character of the earlier mark

49. In *Lloyd Schuhfabrik Meyer* 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 *WindsurfingChiemsee 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).”

50. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

51. I will begin by assessing the inherent distinctive character of the earlier mark, which consists of the two ordinary dictionary words LISTEN BEYOND. For some of the goods in the earlier mark’s specification, LISTEN has an allusive nature but as explained in my comparison of the marks, the words hang together to create an unusual – though not *invented* – combination. Overall, I consider the mark to be inherently distinctive to a medium degree.

52. Turning now to consider whether the distinctiveness of the earlier mark has been enhanced through use, I refer to the opponent’s evidence of use, summarised above. I bear in mind that the relevant territory for this purpose is the UK.

53. I have not been provided with the market share or the amount spent on advertising the LISTEN BEYOND mark, other than 150,000 euros used to produce a film launching the mark in 2016, which evidences no link with any particular goods. Neither have I been provided with sales figures for the opponent company at all, let alone for the UK specifically or for goods bearing the earlier mark. Whilst there are invoices in

evidence, none of those refer to the earlier mark and so it is unclear what relevance LISTEN BEYOND has to the goods listed on each invoice.

54. The opponent has provided a few examples of the earlier mark visible on goods or their packaging, but taking the evidence as a whole, this does not satisfy me that each product sold by the opponent bears the earlier mark. There is evidence of the opponent attending one trade show in the UK, but the related article makes no mention of LISTEN BEYOND. Further, the opponent has clearly won numerous awards in the UK, but again, the brand and description of the relevant goods does not refer to LISTEN BEYOND. Overall, it is not clear which goods, if any, consumers would associate the earlier mark with, since it is not used as the product name; the relationship between the mark and any particular goods is not clear. Based on the evidence before me, I am not satisfied that the opponent has demonstrated that the distinctiveness of the earlier mark has been enhanced through use.

Likelihood of confusion

55. In determining whether there is a likelihood of confusion, all of the above factors need to be borne in mind. They must be considered globally (*Sabel*) from the perspective of the average consumer. In making my assessment, I must keep in mind 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 (*Lloyd Schuhfabrik*). The factors considered above have a degree of interdependency (*Canon*): for example, 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.

56. I have found the marks to be visually and aurally similar to a medium to high degree and conceptually highly similar. I have found the earlier mark to have a medium degree of inherent distinctive character. I have identified the average consumer to be a member of the general public who, paying a slightly higher than average degree of attention, selects the goods predominantly by visual means, though there may be an aural element to the purchase. I have found the goods at issue to be identical.

57. Confusion can be direct or indirect. The difference between these two types of confusion was explained in *L.A. Sugar Limited v By Back Beat Inc.*, BL O/375/10, where Iain Purvis QC (as he then was), sitting 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 recognised that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: ‘The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark’.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI”, etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

58. I bear in mind that the contested mark contains the entirety of the earlier mark and that this shared element is at the beginning of the marks. I also remind myself that the beginnings of marks tend to have more visual and aural impact than the ends.¹⁰ However, the contested mark contains two additional words – YOUR LIMITS – which have no counterpart in the earlier mark and render the marks very different in length. Despite consumers focusing on the beginning of the marks, I do not find it likely that consumers would entirely forget two out of four words in the contested mark. Given that direct confusion involves no process of reasoning, I find it highly unlikely that the average consumer would mistake one mark for the other. Even for identical goods, I do not consider there to be a likelihood of direct confusion.

59. I turn now to indirect confusion. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

60. During the comparison of the marks, I explained that whilst LISTEN BEYOND comprises two ordinary dictionary words, they create an unusual combination. I also found that the marks are conceptually highly similar given this shared unusual element and that YOUR LIMITS somewhat expands upon the meaning of LISTEN BEYOND. Whilst this is not a clear example of any of the categories identified by Mr Purvis KC at [57], I bear in mind that the three categories are not exhaustive.¹¹ In my view, consumers will not see LISTEN BEYOND in two different marks used on identical

¹⁰ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02.

¹¹ *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207.

goods and put it down to mere coincidence; they are far more likely to assume a connection between the two undertakings, whether that is LISTEN BEYOND YOUR LIMITS being a sub-brand of LISTEN BEYOND, or as a result of a merger between the two undertakings, for example. I find there to be a likelihood of indirect confusion.

61. The opposition under section 5(2)(b) succeeds.

62. Since the opposition has succeeded and the application will be refused in full, it is not necessary to deal, in full, with the remaining grounds of opposition. I will, however, give an indication as to my findings for each.

Section 5(3)

63. Section 5(3) states:

“(3) A trade mark which-

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

64. The conditions of section 5(3) are cumulative. First, the opponent must show that the earlier mark is similar to the contested mark. Secondly, it must satisfy me that the earlier mark has achieved a level of knowledge/reputation amongst a significant part of the relevant public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier mark being brought to mind by the contested mark. Fourthly, assuming that the first three conditions have been met, section 5(3) requires that one or more of the three types of damage claimed will occur. It is unnecessary for the purposes of section 5(3) that the goods be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

65. Under section 5(2)(b), I found that the contested mark was similar to the earlier mark.

Reputation

66. In *General Motors*, Case C-375/97, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation ‘in the Member State’. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation ‘throughout’ the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

67. I recall that I found the evidence insufficient to establish that the distinctive character of the earlier mark had been enhanced. The factors that were relevant in that assessment are also the ones that I must consider when deciding whether the mark has a reputation. In particular there are no sales figures and limited marketing expenditure in the UK or examples of advertising the LISTEN BEYOND mark in particular. Similar to my reasoning in paragraphs 53-54, the evidence is insufficient for me to find that the mark is known by a significant proportion of the general public. For

this reason, this ground of opposition falls at the first hurdle and it is not necessary to consider the matter further.

68. The section 5(3) ground fails.

Section 5(4)(a)

69. Section 5(4)(a) states:

“(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(aa) [...]

(b) [...]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

70. Subsection (4A) of Section 5 states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

Relevant law

71. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “*a substantial number*” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

Relevant date

72. In *Advanced Perimeter System Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC (as he then was), as the Appointed Person, endorsed the registrar’s assessment of the relevant date for the purposes of section 5(4)(a) of the Act, as follows:

“43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of

the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.”

73. The applicant has not filed evidence that it has used the contested mark prior to the application date. Consequently, the relevant date for this opposition is the date of the application, i.e. 16 November 2020.

Goodwill

74. The concept of goodwill was considered by the House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

75. I again note that no sales figures have been adduced in evidence and, as per my findings at paragraphs 53-54, the relationship between the earlier mark and any particular goods of the opponent is not clear. The evidence before me is insufficient for me to find goodwill associated with the sign LISTEN BEYOND.

76. The section 5(4)(a) ground has failed.

OUTCOME

77. The opposition has succeeded under section 5(2)(b) and registration is refused.

COSTS

78. The opponent has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. My

calculation of the award is shown below. I have allowed £100 to cover official fees for the successful ground.

Preparing a statement and considering the other side's statement	£300
Preparing evidence and submissions	£500
Official fees	£100
Total	£900

79. I therefore order Ahmed Syed to pay FOCAL JMLAB the sum of £900. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the final determination of the appeal proceedings.

Dated this 1st day of February 2023

E FISHER (née VENABLES)

For the Registrar