

O-046-18

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3188970 BY
SPIFF TECHNOLOGIES LIMITED
TO REGISTER:**

SPIFF

AS A TRADE MARK IN CLASSES 14 & 26

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 408890 BY SPIFFING LIMITED**

BACKGROUND & PLEADINGS

1. On 3 October 2016, Spiff Technologies Limited (“the applicant”) applied to register the trade mark **SPIFF** for goods in classes 14 and 26, full details of which can be found later in this decision. The application was published for opposition purposes on 23 December 2016.

2. On 23 March 2017, the application was opposed in full by Spiffing Limited (“the opponent”). The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), in relation to which the opponent relies upon three registrations of the word **SPIFFING**, full details of which are shown in the Annex to this decision.

3. The applicant filed a counterstatement which consists, in essence, of a denial of the ground upon which the opposition is based.

4. In these proceedings, the opponent is represented by Urquhart-Dykes & Lord LLP; the applicant represents itself. Although only the opponent filed evidence, both parties filed written submissions during the course of the evidence rounds. Neither party asked to be heard nor did they elect to file written submission in lieu of attendance at a hearing. I shall refer to the submissions filed, as necessary, later in this decision.

The opponent’s evidence

5. This consists of a witness statement and seven exhibits from Anthony Pawlyn, a trade mark attorney at Urquhart-Dykes & Lord LLP. I will return to this evidence later in this decision.

DECISION

6. 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.”

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

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

8. In these proceedings, the opponent is relying upon the UK and EUTM registrations shown in the Annex to this decision, all of which qualify as earlier trade marks under the above provisions. As the opponent’s earlier trade marks had not been registered for more than five years at the date the application was published, they are not subject to the proof of use provisions.

Section 5(2)(b) – case law

9. 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 and services

Class 14

10. The applicant seeks registration for the following goods:

Precious metals; jewellery; precious stones; chronometric instruments.

11. In its counterstatement, the applicant admits that:

“11...the goods listed in class 14 (of its application) are encompassed by the earlier mark.”

12. As the opponent’s earlier trade marks nos. (2) and (3) contain identical terms to those contained in the application in class 14, I agree the competing goods are identical.

Class 26

13. Although in its Notice of Opposition the opponent relies upon all the goods and services in its earlier trade marks, in its submissions, it restricts its comparison to its goods and services in classes 24, 25 and 35. Proceeding on that basis and as trade mark no. 3 contains all of the goods and services upon which the opponent relies, it is this trade mark I shall use to conduct the comparison.

Opponent – EUTM No. 14966865	Applicant
<p>Class 24 - Fabrics; textiles and textile goods, not included in other classes; filtering materials of textiles; duvets, lap blankets, lap robes, lap rugs; bed covers; table covers; draperies.</p> <p>Class 25 - Clothing; footwear; headgear.</p> <p>Class 35 - The bringing together for the benefit of others of a variety of...fabrics, textiles, filtering materials of textiles, duvets, lap blankets, lap robes, lap rugs, bed covers, table covers, draperies enabling customers to conveniently view</p>	<p>Class 26 - Lace; embroidery; ribbons; braid; buttons; hooks and eyes; pins; needles; artificial flowers.</p>

<p>and purchase these goods in retail stores, department retail stores, online retail stores, wholesale stores, by means of telecommunications or from a website or from a catalogue or by means of mail order; The bringing together for the benefit of others, of a variety of clothing, footwear, headgear, enabling customers to conveniently view and purchase these goods in retail stores, department retail stores, online retail stores, wholesale stores, by means of telecommunications or from a website or from a catalogue or by means of mail order.</p>	
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14. In reaching a conclusion, I have taken into account (but do not intend to record here) all of the parties' competing submissions/evidence on this aspect of the case. In approaching the matter, I am guided by the case law which follows. Firstly, in the judgment of the Court of Justice of the European Union ("CJEU") in *Canon*, Case C-39/97, the Court stated at paragraph 23 of its judgment:

“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”.

15. 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 users of the respective goods or services;
- b) The physical nature of the goods or acts of services;
- c) The respective trade channels through which the goods or services reach the market;
- d) 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;
- e) The extent to which the respective goods or services are competitive. This enquiry 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.

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

"... 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."

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

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

18. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criteria 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”.

19. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* 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 the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

20. In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the GC held that although retail services are different in nature, purpose and method of use to goods,

retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

21. In *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services v goods. He stated (at paragraph 9 of his judgment):

“9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent’s earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are ‘*similar*’ to goods are not clear cut.”

22. However, on the basis of the European courts’ judgments in *Sanco SA v OHIM*¹, and *Assembled Investments (Proprietary) Ltd v. OHIM*², upheld on appeal in *Waterford Wedgewood Plc v. Assembled Investments (Proprietary) Ltd*³, Mr Hobbs concluded:

i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer’s point of view, they are unlikely to be offered by one and the same undertaking;

¹ Case C-411/13P

² Case T-105/05, at paragraphs [30] to [35] of the judgment

ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent's goods and then to compare the opponent's goods with the retail services covered by the applicant's trade mark;

iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;

iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

23. In *Les Éditions Albert René v OHIM*, Case T-336/03, the GC found:

"61... The mere fact that a particular good is used as a part, element or component of another does not suffice in itself to show that the finished goods containing those components are similar since, in particular, their nature, intended purpose and the customers for those goods may be completely different."

24. Although the opponent bases its case on the similarity between the applicant's goods and its own goods and services in classes 24, 25 and 35, in my view, its best case lies with its goods in class 24 and its retail services in relation to such goods in class 35. In its submissions, the opponent identifies what it considers to be, inter alia, the similarity in the nature, intended purpose and method of use of the competing goods. I think it is fair to say that the main thrust of the opponent's argument is that its goods in class 24 are "frequently combined with" or "frequently assembled" using the applicant's goods in this class.

³ Case C-398/07P

25. The opponent also identifies what it considers to be the complementary nature/trade channels of the applicant's goods and its goods in class 24 by reference to exhibits ANP1, 2 and 3 of Mr Pawlyn's statement. This consists of extracts obtained on 25 July 2017 from abakhan.co.uk, libertylondon.com/uk and sewessential.co.uk. The opponent concludes, inter alia, that its class 24 goods and the applicant's goods are "highly similar to one another". In relation to class 35, it states that its services:

"8...include the retail of all these goods in class 24 and class 25 and that this retail will often occur directly alongside and in the same outlet as the class 26 goods..."

26. The exhibits referred to above indicate that the undertakings mentioned conduct (at least) a retail trade in both fabrics and items of haberdashery (for example, dress trimmings, ribbons, buttons, lace, zips, eyelets and fastenings, scissors, pins, needles and cushions, flowers and "occasion accessories"). Although from after the material date in these proceedings, this evidence reflects my own experience and, I am satisfied, will also represent the average consumer's understanding of the position both at the material date in October 2016 and for many years prior to it.

27. As the case law explains, for goods to be regarded as complementary, there must be "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". I am satisfied, on the basis of my own experience and the evidence provided, that there is a complementary relationship between, for example, the opponent's "fabrics, textile and textile goods" in class 24 and the applicant's "lace, embroidery, ribbons, braid, buttons, hooks and eyes and artificial flowers" and a further complementary relationship between the opponent's retail services in class 35 in relation to named goods which are proper to class 24 and all of the applicant's goods in class 26, both of which result in a medium degree of similarity overall.

The average consumer and the nature of the purchasing act

28. As the case law above indicates, it is necessary for me to determine who the average consumer is for the goods and services at issue. I must then determine the manner in which these goods and services 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.”

29. The average consumer of the goods and services at issue is a member of the general public. As a member of the general public will, for the most part, self-select the goods in classes 14, 24 and 26 from the shelves of a bricks and mortar retail outlet or, as the evidence shows, from the equivalent pages of a website or catalogue and the services in class 35 from, inter alia, websites, advertisements and signage on the high street, visual considerations are likely to dominate the selection process. That said, as such goods and services 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.

30. I must now consider the degree of care the average consumer will display when selecting the goods and services at issue. The cost of the goods in class 14 can vary considerably as will the degree of care involved. Compare, for example, the care likely

to be taken when selecting costume jewellery (costing just a few pounds) with that of a designer chronograph (costing many thousands of pounds). However, as the goods at issue are likely to be worn on the average consumer's person and will contribute to the consumer's appearance, even when selecting, for example, an inexpensive watch, the consumer will be alive to factors such as size, weight, colour, strap type, cost etc. resulting in an average degree of attention being deployed. That degree of attention is likely to increase when selecting more expensive variants of the goods at issue.

31. Whilst the cost of the goods in class 24 will also vary, it is, I think, likely to be to a much lesser degree than the goods in class 14. However, whether the goods in this class are used to create other goods or are finished goods in their own right, as the average consumer will, in my experience, be conscious of factors such as material, size, colour, cost, compatibility with other items etc. they are, once again likely to pay an average degree of attention during the selection process.

32. The cost of the goods in class 26 is, perhaps with the exception of lace, likely to be low. I would expect the average consumer to pay a low degree of attention to the selection of functional items with a low degree of sophistication (such as pins and needles) and an average degree of attention to those goods with a decorative purpose (lace, embroidery, ribbons, braid and artificial flowers) or higher degree of functional sophistication such as buttons, hooks and eyes. As to the degree of care with which the services may be selected, in my experience, the average consumer is likely to be mindful of a range of considerations such as the breadth of goods/brands stocked, customer reviews, delivery times/costs and, in relation to a bricks and mortar outlet, proximity to their home, opening times, parking etc. all of which suggests an average degree of attention being paid during the selection process.

Comparison of trade marks

33. 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*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

34. It would be wrong, therefore, 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 trade marks to be compared are:

Opponent's trade mark	Applicant's trade mark
SPIFFING	SPIFF

35. In reaching the conclusions which follow, I have once again taken into account (but do not intend to record here) all the competing submissions on this aspect of the case.

36. The competing trade marks consist of the words SPIFFING and SPIFF presented in block capital letters. As no part of either word is highlighted or emphasised in any way, there are no distinctive and dominant components. The overall impressions they will convey and their distinctiveness lie in the single words of which they are composed. Having reached those conclusions, I will now compare the competing trade marks from the visual, aural and conceptual standpoints.

37. The competing trade marks are five and eight letters long respectively. The first five letters of the opponent's trade mark are identical to the five letters of which the applicant's trade mark is composed. The last three letters of the opponent's trade mark i.e. ING have no counterpart in the applicant's trade mark. Bearing in mind the similarities and differences, but reminding myself that as a general rule the beginnings of trade marks tend to have more visual and aural impact than their endings (*El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02), I find the competing trade marks to be visually similar to an above average degree.

38. In relation to aural similarity, the opponent's trade mark is most likely to be pronounced as the two syllable word SPIF-FING, whereas the applicant's trade mark will be pronounced as the one syllable word SPIFF. As the first syllables will be articulated in an identical fashion but bearing in mind that the final syllable in the opponent's trade mark will be verbalised and is alien to the applicant's trade mark, I find this results, once again, in an above average degree of aural similarity.

39. Finally, the conceptual comparison. In its counterstatement, the applicant, first by reference to the Oxford Dictionary, states that SPIFF means "to make someone or something attractive, smart or stylish". It also refers to an entry in collinsdictionary.com in which SPIFF is defined as being slang for "a commission for the selling of dated merchandise". It further states (again by reference to collinsdictionary.com), that the opponent's trade mark is an adjective meaning "excellent, splendid". The applicant adds:

"It must be noted that the subject mark SPIFF is a North American word, and although used informally, it is not common or prevalent in the relevant territory of the United Kingdom. In contrast, SPIFFING is a British word and as such, this adjective will be recognised in the United Kingdom..."

40. Attached to Mr Pawlyn's statement as exhibits are extracts obtained from oxforddictionaries.com and macmillandictionary.com which describes SPIFFING thus:

“Adjective, British, dated, informal, Excellent; splendid...” and “Adjective, British, informal, old fashioned very good, or enjoyable” (ANP4) and from oxforddictionaries.com, SPIFF as “Verb (with object), (spiff someone/something up), North American, Informal, Make someone or something attractive, smart, or stylish...” (ANP5).

41. The mere presence of a word in a dictionary is, of course, no guarantee of how the average consumer will understand that word. Absent evidence as to how the average consumer would approach these words, I must reach my own conclusions. That said, I am satisfied that a not insubstantial number of average consumers will understand the word SPIFFING in the manner suggested by the parties i.e. as meaning, broadly speaking, excellent. I am far less convinced that despite its appearance in the dictionaries mentioned, the average consumer will understand the word SPIFF as meaning “to make someone or something attractive, smart or stylish” and even less convinced it will be understood as “a commission for the selling of dated merchandise”. Consequently, while the opponent’s trade mark is likely to convey a clear conceptual message, it is, in my view, highly likely that the applicant’s trade mark will convey no concrete message. That said, it is not, I think, unreasonable to conclude that the not insubstantial number of average consumers who are familiar with the word SPIFFING and its meaning, are likely to recognise that the applicant’s trade mark consists of the first five letters of the word SPIFFING and, as consequence, to conclude that the meaning of the word SPIFF is in some way connected to the meaning of that word.

Distinctive character of the earlier trade mark

42. The distinctive character of a trade mark can be appraised only, first, by reference to the goods and services 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 and services for which it has been registered as coming from a particular undertaking and thus to distinguish those goods and services from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

43. As the opponent has not filed any evidence of the use it may have made of its earlier trade mark, I have only its inherent characteristics to consider. I have already commented upon the meaning of the word SPIFFING above. In its submissions, the opponent states:

“13...the opponent’s mark would be understood to allude to the goods [or services] being excellent or splendid as the word is an unusual and rarely encountered one with that connotation...”

44. Although the word SPIFFING has laudatory connotations, it is an informal word which, in my experience (and as the dictionary definition suggests), is somewhat old-fashioned. Absent use, it is possessed of a moderate i.e. between low and medium degree of inherent distinctive character.

Likelihood of confusion

45. 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 services 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 and services, 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.

46. Earlier in this decision I concluded that the respective goods in class 14 are identical. I also concluded that the applicant's goods in class 26 are similar to the opponent's goods in class 24 and services in class 35 to a medium degree. I found that the average consumer of the goods and services was a member of the general public who (whilst not discounting aural considerations) is most likely to select the goods and services at issue by predominantly visual means paying a degree of attention ranging from low to higher than average during that process. Having assessed the competing trade marks distinctive and dominant components, I found them to be visually and aurally similar to an above average degree and concluded that whilst the opponent's trade mark will convey a clear conceptual message it was likely that the applicant's trade mark would not. Finally, I assessed the opponent's trade mark to be inherently distinctive to a moderate degree.

47. 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/services down to the responsible undertakings being the same or related.

48. Proceeding on the basis most favourable to the applicant i.e. that the opponent's trade mark sends a clear conceptual message whereas it does not, the comments of the CJEU in *The Picasso Estate v OHIM*, Case C-361/04 P, are relevant. In that case, the CJEU found:

“20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law.”

49. However, as the GC explained in *Nokia Oyj v OHIM*, Case T-460/07:

“Furthermore, it must be recalled that, in this case, although there is a real conceptual difference between the signs, it cannot be regarded as making it possible to neutralise the visual and aural similarities previously established (see, to that effect, Case C-16/06 P *Éditions Albert René* [2008] ECR I-0000, paragraph 98).”

50. Even if the applicant’s trade mark conveys no conceptual message to the average consumer, it is not, in my view, sufficient to “neutralise” the above average degree of visual and aural similarity between the competing trade marks. Thus notwithstanding the only moderate degree of distinctive character the opponent’s earlier trade mark enjoys, even when considered from the perspective of an average consumer paying an above average degree of attention during the selection process (but who remains susceptible to the effects of imperfect recollection), those similarities are likely to lead to direct confusion i.e. there is a likelihood the competing trade marks will be mistaken for one another.

51. However, even if I am found to be wrong in that regard, the fact that the competing trade marks coincide in a feature i.e. the letters SPIFF and the positioning of these letters in the opponent’s trade mark will, at the very least, lead the consumer to assume that the identical/similar goods and services at issue come from the same or economically linked undertakings i.e. there will be indirect confusion. Those conclusions result in the opposition to the application succeeding. Of course, the outcome is even more clear-cut if one considers the position from the perspective of an average consumer paying only a low or average degree of attention during the selection process (making them more even more prone to the effects of imperfect recollection) or if the visual and aural similarities between the competing trade marks were to lead the average consumer to conclude that the meaning of the word SPIFF is in some way connected to the meaning of the word SPIFFING, resulting in at least a medium degree of conceptual similarity.

Overall conclusion

52. The opposition has succeeded in full and, subject to any successful appeal, the application will be refused.

Costs

53. As the opponent has been successful, it is entitled to a contribution to its costs. Awards of costs in proceedings commenced after 1 July 2016 are governed by Annex A of Tribunal Practice Notice (“TPN”) 2 of 2016. Applying the guidance in that TPN, I award costs to the opponent on the following basis:

Preparing a Notice of Opposition and reviewing the counterstatement:	£200
Preparing evidence:	£500
Written submissions:	£300
Official fee:	£100
Total:	£1100

54. I order Spiff Technologies Limited to pay to Spiffing Limited the sum of **£1100**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 22nd day of January 2018

C J BOWEN

For the Registrar

The opponent's earlier rights

(1) UK No. 3104141 which was applied for on 15 April 2015 and entered in the register on 17 July 2015. The opponent relies upon all the goods and services in its registration i.e.

Class 25 - Clothing; footwear; headgear.

Class 35 - The bringing together for the benefit of others, of a variety of clothing, footwear, headgear, enabling customers to conveniently view and purchase these goods in retail clothing stores, by means of telecommunications or from a website or from a catalogue by mail order.

(2) UK No. 3131773 which was applied for on 15 October 2015 and entered in the register on 11 March 2016. The opponent relies upon all the goods and services in its registration i.e.

Class 8 - Hand tool and implements (hand operated); hand-operated tools and implements for treatment of materials, for construction, repair and maintenance; cutlery; food preparation implements and kitchen knives; side arms, edged and blunt weapons; razors; hygienic and beauty implements for humans and animals; lifting tools.

Class 12 - Vehicles; parts and fittings for vehicles; apparatus for locomotion by land, space, air or water.

Class 13 - Pyrotechnics and fireworks; explosives and explosive substances; weapons, firearms, ammunition and projectiles.

Class 14 - Precious metals and their alloys, not included in other classes; jewellery, jewellery boxes; precious stones, gemstones and pearls and imitations of those goods; time instruments, horological instruments, chronometric instruments, timepieces, watch boxes.

Class 24 - Fabrics; textiles and textile goods, not included in other classes; filtering materials of textiles; duvets, lap blankets, lap robes, lap rugs; bed covers; table covers; draperies.

Class 27 - Carpets; floor coverings and artificial ground coverings; coverings for existing floors; floor coverings in mat, tiles and sheet form; wall and ceiling coverings.

Class 35 - The bringing together for the benefit of others, of a variety of hand tool and implements (hand operated), hand-operated tools and implements for treatment of materials, for construction, for repair, for maintenance, cutlery, food preparation implements, kitchen knives, side arms, edged weapons, blunt

weapons, razors, hygienic implements and beauty implements for humans and animals, lifting tools, vehicles, parts and fittings for vehicles, apparatus for locomotion by land, by space, by air, by water, pyrotechnics, fireworks, explosives, explosive substances, weapons, firearms, ammunition, projectiles, precious metals and their alloys, jewellery, jewellery boxes, precious stones, gemstones, pearls, imitations of precious stones, gemstones and pearls, time instruments, horological instruments, chronometric instruments, timepieces, watch boxes, fabrics, textiles, filtering materials of textiles, duvets, lap blankets, lap robes, lap rugs, bed covers, table covers, draperies, carpets, floor coverings, artificial ground coverings, coverings for existing floors, floor coverings in mat, tiles and sheet form, wall coverings, ceiling coverings, enabling customers to conveniently view and purchase these goods in retail stores, department retail stores, online retail stores, wholesale stores, by means of telecommunications or from a website or from a catalogue or by means of mail order; product demonstration and product display services; collection and systematization of business data.

Class 42 - Science and technology services; testing, authentication and quality control services; design services; IT services; design and development of computer hardware and software; develop, maintenance and updating of a telecommunications network search engine; providing an online website for creating and hosting micro websites for businesses.

(3) EUTM No. 14966865 which was applied for on 29 December 2015 (claiming priority from an earlier filing in the United Kingdom on 15 October 2015) and entered in the register on 9 September 2016. The opponent indicates that it relies upon all the goods and services in its registration i.e.

Class 8 - Hand tool and implements (hand operated); hand-operated tools and implements for treatment of materials, for construction, repair and maintenance; cutlery; food preparation implements and kitchen knives; side arms, edged and blunt weapons; razors; hygienic and beauty implements for humans and animals; lifting tools.

Class 12 - Vehicles; parts and fittings for vehicles; apparatus for locomotion by land, space, air or water.

Class 13 - Pyrotechnics and fireworks; explosives and explosive substances; weapons, firearms, ammunition and projectiles.

Class 14 - Precious metals and their alloys, not included in other classes; jewellery, jewellery boxes; precious stones, gemstones and pearls and imitations of those goods; time instruments, horological instruments, chronometric instruments, timepieces, watch boxes.

Class 20 - Furniture; mirrors; picture frames; fittings for furniture; upholstered furniture; beds; headboards; mattresses; ottomans; sofas; chairs; reclining sofas

and reclining chairs; armchairs; foot rests, footstools; dining furniture, dining tables and dining chairs; sideboards; occasional tables; coffee tables; display cabinets; TV cabinets; cushions, seat pads; bedding, except linen; pillows; casters, supports, feet, slidable supports, slidable feet, silicone pads, slidable pads for furniture and for sofas; garden furniture.

Class 24 - Fabrics; textiles and textile goods, not included in other classes; filtering materials of textiles; duvets, lap blankets, lap robes, lap rugs; bed covers; table covers; draperies.

Class 25 - Clothing; footwear; headgear.

Class 27 - Carpets; floor coverings and artificial ground coverings; coverings for existing floors; floor coverings in mat, tiles and sheet form; wall and ceiling coverings.

Class 35 - The bringing together for the benefit of others, of a variety of hand tool and implements (hand operated), hand-operated tools and implements for treatment of materials, for construction, for repair, for maintenance, cutlery, food preparation implements, kitchen knives, side arms, edged weapons, blunt weapons, razors, hygienic implements and beauty implements for humans and animals, lifting tools, vehicles, parts and fittings for vehicles, apparatus for locomotion by land, by space, by air, by water, pyrotechnics, fireworks, explosives, explosive substances, weapons, firearms, ammunition, projectiles, precious metals and their alloys, jewellery, jewellery boxes, precious stones, gemstones, pearls, imitations of precious stones, gemstones and pearls, time instruments, horological instruments, chronometric instruments, timepieces, watch boxes, fabrics, textiles, filtering materials of textiles, duvets, lap blankets, lap robes, lap rugs, bed covers, table covers, draperies, carpets, floor coverings, artificial ground coverings, coverings for existing floors, floor coverings in mat, tiles and sheet form, wall coverings, ceiling coverings, enabling customers to conveniently view and purchase these goods in retail stores, department retail stores, online retail stores, wholesale stores, by means of telecommunications or from a website or from a catalogue or by means of mail order; product demonstration and product display services; collection and systematization of business data.; The bringing together for the benefit of others, of a variety of furniture, mirrors, picture frames, fittings for furniture, upholstered furniture, beds, headboards, mattresses, ottomans, sofas, chairs, reclining sofas, reclining chairs, armchairs, enabling customers to conveniently view and purchase these goods in retail stores, department retail stores, online retail stores, wholesale stores, by means of telecommunications or from a website or from a catalogue or by means of mail order; The bringing together for the benefit of others, of a variety of foot rests, footstools, dining furniture, dining tables, dining chairs, sideboards, occasional tables, coffee tables, enabling customers to conveniently view and purchase these goods in retail stores, department retail stores, online retail stores, wholesale stores, by means of telecommunications or from a website or from a catalogue or by means of mail order; The bringing together for the benefit of others, of a variety of display cabinets, TV cabinets, cushions, seat

pads, bedding (except linen), pillows, enabling customers to conveniently view and purchase these goods in retail stores, department retail stores, online retail stores, wholesale stores, by means of telecommunications or from a website or from a catalogue or by means of mail order; The bringing together for the benefit of others, of a variety of casters, supports, feet, slidable supports, slidable feet, silicone pads, slidable pads for furniture and for sofas, garden furniture, enabling customers to conveniently view and purchase these goods in retail stores, department retail stores, online retail stores, wholesale stores, by means of telecommunications or from a website or from a catalogue or by means of mail order; The bringing together for the benefit of others, of a variety of clothing, footwear, headgear, enabling customers to conveniently view and purchase these goods in retail stores, department retail stores, online retail stores, wholesale stores, by means of telecommunications or from a website or from a catalogue or by means of mail order.

Class 38 - Telecommunication and communication services; television and radio broadcasting services; provision of telephone and mobile telephone telecommunications; providing user access to the Internet (service providers) and the World Wide Web; providing telecommunications access and links to computer databases and the Internet; facsimile, telex, telephone and telegram services; mobile telephone services; telecommunication services, namely reception, recordal, networking and transmission of data and information by means of electronics, computer, cable, optical fibre, radio, radio paging, teleprinter, teleletter, electronic mail, television, facsimile, microwave, laserbeam, infra red or communication satellite; message sending services; transmission of information from a database; telecommunication services in relation to reception, recordal, networking and display of information from a database; transmission of messages and images.

Class 42 - Science and technology services; testing, authentication and quality control services; design services; IT services; design and development of computer hardware and software; develop, maintenance and updating of a telecommunications network search engine; providing an online website for creating and hosting micro websites for businesses; electronic storage services for information from a database.