

**O-187-18**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF**

**TRADE MARK APPLICATION 3225685  
IN THE NAME OF KINDRED LIVING LIMITED  
FOR THE TRADE MARK:**

**ORIGIN**

**AND**

**OPPOSITION THERETO (UNDER No 600000666)  
BY AN ORIGIN LTD**

**Background and pleadings**

1. These opposition proceedings were launched under the fast track provisions and are based on a single ground of opposition under section 5(2)(b) of the Trade Marks Act 1994 (“the Act) with the opponent relying on a single trade mark. Consequently, the conflict boils down to whether there is a likelihood of confusion between the following marks:

| Applicant’s mark  | Opponent’s mark   |
|---|---|
| <p>UK trade mark application 3225685 which was filed by Kindred Living Limited (“the applicant”) on 19 April 2017 and published on 12 May 2017:</p> <p><b>ORIGIN</b></p> <p><b>Class 20:</b> Furniture; wardrobes; non-metallic chests; chests of drawers; beds; dressing tables; desks; bedside cabinets; shelves; shelving; fitted bedroom furniture; furniture fittings, not of metal; storage furniture; storage drawers [furniture]; storage racks; storage boxes [furniture]; storage cases [furniture]; storage cabinets [furniture]; storage units [furniture]; storage cupboards [furniture]; hanging storage racks [furniture]; mobile storage racks [furniture]; shelves for storage; storage modules [furniture]; metal storage cabinets; furniture for storage; non-metallic storage racks [furniture]; storage units for cupboard conversions; display shelves; benches with shelves.</p> | <p>UK registration 3018002 which was filed by An Origin Ltd (“the opponent”) on 13 August 2013 and was registered on 22 November 2013:</p>  <p><b>Class 35:</b> Retail shop window display arrangement services; Business management consulting with relation to strategy, marketing, production, personnel and retail sale matters; Presentation of goods on communications media, for retail purposes; Presentation of goods on communication media for retail purposes; Administration of the business affairs of retail stores; Department store retail services connected with the sale of beauty products, toiletries, machines for household use, hand tools, optical goods, domestic electrical and electronic equipment; Mail order retail services connected with clothing accessories; Management of a retail enterprise for others; Retail services connected with stationery; Retail services connected with the sale of clothing and clothing accessories; Retail services connected</p> |

with the sale of furniture; Retail store services in the field of clothing; Shop retail services connected with carpets; Stationery shop retail services connected with the sale of stationery, printed matter, computer equipment and peripherals and home entertainment products; Presentation of goods on communication media, for retail purposes; Communication media (Presentation of goods on -), for retail purposes; Retail purposes (Presentation of goods on communication media, for -);Restaurant management for others; Retail purposes (Presentation of goods on communication media, for -);Retail services connected with stationery ;Retail services connected with the sale of clothing and clothing accessories; Retail services connected with the sale of furniture; Retail shop window display arrangement services; Retail store services in the field of clothing; Risk management consultancy [business];Account auditing; Accountancy; Accountancy services; Accounting; Accounting services; Arranging the buying of goods for others; Assistance (business management-);Auction sales (arranging of -);Auction sales (conducting of - );Auctioneering; Auctioneering provided on the internet; Auctioneering services; Auctioneering services related to real estate; Business auditing; Business consultancy; Computerised business research; Computerized file management; Consumer research; Corporate planning; Direct marketing; Hotel management for others; Hotel management service [for others];Hotels (business management of- );Hotels (Business management of -);Online advertisements; On-line advertising on a computer

network; Outdoor advertising; Outdoor advertising services; Recruitment advertising; Recruitment (Personnel -);Sales demonstration [for others];Sales promotion; Sales promotion for others.

**Class 43:** Cafe services; Arranging of accommodation for tourists; Arranging of banquets; Banqueting services ;Bar services; Bars; Bistro services; Booking services for hotels; Buildings (Rental of transportable -) ;Cafe services; Cafés; Cafeteria services; Cafeterias; Camp services (Holiday -) [lodging];Canteen services; Canteens; Carvery restaurant services; Catering (Food and drink -);Catering for the provision of food and beverages; Catering of food and drinks; Catering services; Catering services for the provision of food; Catering services for the provision of food and drink; Cattery services; Club services for the provision of food and drink; Cocktail lounge services; Coffee shop services; Coffee shops; Consultancy services relating to baking techniques; Consultancy services relating to food; Consultancy services relating to food preparation; Consultancy services relating to hotel facilities; Consulting services in the field of culinary arts; Cookery advice; Fast food restaurant services; Fast-food restaurants; Food cooking services; Food preparation; Food preparation services; food takeaway service; Night club services [provision of food];Public house services; Pubs; Restaurant services; Restaurants; Restaurants (self-service-);Restaurants (Self-service -);Snack bar services; Snackbars.

2. The opponent's mark was filed before that of the applicant and, so, constitutes an earlier trade mark in accordance with section 6 of the Act. Furthermore, the opponent's mark was registered within 5 years of the publication of the applicant's mark, so meaning that it may be relied upon without the mark having to meet the use conditions set out in section 6A of the Act. The opponent states that it plans to open a retail shop related to furniture and that there cannot be two very similar trade marks in the same market without causing damage to each other.

3. The applicant filed a counterstatement denying the grounds of opposition. It states that the opponent has relied on all of its very broad list of services without explaining why there is similarity with the applied for goods. It accepts that within the opponent's services the specification covers retail of furniture, but, again, notes that no reasoning has been put forward to explain why such a term is similar to furniture per se. The opponent further argues that any similarity between the marks, on a visual, aural and conceptual basis, is low.

4. Rules 20(1)-(3) of the Trade Marks Rules 2008 ("TMR") (the provisions which provide for the filing of evidence) do not apply to fast track oppositions, but Rule 20(4) does; it reads:

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

5. The net effect of the above is to require parties to seek leave in order to file evidence (other than the proof of use evidence which is filed with the notice of opposition) in fast track oppositions. Neither party sought leave.

6. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if 1) the Office requests it or 2) 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. A hearing was neither requested nor considered necessary. Neither party filed written submissions.

7. In these proceedings, the applicant has been represented by Mohun Intellectual Property Limited. The opponent initially represented itself, but subsequently appointed London IP Ltd to represent it.

### **Preliminary issue**

8. The opponent's notice of opposition contained a number of irregularities. Even when some of those irregularities were rectified, further irregularities were introduced. The most serious related to the name of the opponent. The opposition was first filed in the name of the sole director of the opponent company, however, it was the opponent company that owned the mark. When this was rectified, it was then noticed that the name of the opponent company had been incorrectly registered as a result of a clerical error ("Ltd" was missing from its name) which then had to be rectified by the filing of a form TM26 and accompanying witness statement. Whilst the earlier mark now stands in the correct name and the notice of opposition has been amended to reflect this, I set out this procedural aspect of the case here because it is something that the applicant considers should be taken into account when the costs of these proceedings are considered. I will return to the matter of costs later.

### **Section 5(2)(b)**

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

"5.-(2) A trade mark shall not be registered if because – ..

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

10. The following principles are gleaned from the judgments of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer*

*Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

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

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

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

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

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

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

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

11. When making a comparison of goods/services, all relevant factors relating to them should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the Court of Justice of the European Union (“the CJEU”) 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.”

12. Guidance on this issue has also come from Jacob J where, in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, the following factors were highlighted as being relevant:



- “(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.”

13. In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v OHIM* Case T- 325/06 it was stated:

“It is true that goods are complementary if 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 (see, to that effect, Case T-169/03 Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI) [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P Rossi v OHIM [2006] ECR I-7057; Case T-364/05 Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL) [2007] ECR II-757, paragraph 94; and Case T-443/05 El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños) [2007] ECR I-0000, paragraph 48).”

14. In relation to complementarity, I also bear in mind the guidance given by Mr Daniel Alexander QC, sitting as the Appointed Person, in case BL O/255/13 *LOVE*, where he warned against applying too rigid a test:

“20. In my judgment, the reference to “legal definition” suggests almost that the guidance in Boston is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to Boston.”

15. In relation to understanding what terms used in specifications mean/cover, the case-law informs me that “in construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of the trade”<sup>1</sup> and that I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning<sup>2</sup>. I also note the judgment of Mr Justice Floyd (as he then was) in *YouView TV Limited v Total Limited* where he 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) (IPTRANSLATOR)* [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

---

<sup>1</sup> See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

<sup>2</sup> See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

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.”

16. In its counterstatement, the applicant highlights that the opponent has sought to rely on all of its services despite many of them being completely dissimilar to the applied for goods and without any supporting arguments. I accept this criticism, although, when one considers what the opponent did say in its statement of case (that it intends to open a shop related to furniture) it is clear that the most relevant conflict was between the applied for furniture (of various types) and the opponent’s “retail services connected with the sale of furniture”. I will proceed on the basis of this term only, the other terms putting the opponent in no better position.

17. Whilst noting the presence of the opponent’s retail services connected with furniture, the applicant argues that it does not follow that such a service is similar to furniture goods. Reference is made to the decision of Ms Anna Carboni, sitting as the Appointed Person, in *Giant* (BL O-264-14):

“27. I pause here to insert my own observation that, in short, the General Court held that the nature, purpose and method of use of, for example, “the retail of clothing” on the one hand and “clothing” on the other, were different in each case, and thus any finding of similarity would have to rest on different factors.

28. The hearing officer did not expressly apply those aspects of the *Canon v MGM* similarity test. As Mr Onslow submitted, he did seem to recognise that there was a degree of difference between the goods/services under comparison in *Oakley* and those under comparison here, because of the lack of identity between the goods concerned in each case, but he did not explain his approach. I re-visit this below.

29. Returning to Mr Onslow’s submissions, he continued to take me through the comparison undertaken by the General Court in *Oakley*, where it

considered the distribution channels of the services and goods in issue, as follows:

49 With regard, second, to the distribution channels of the services and the goods in question, it is correct, as rightly pointed out by the Board of Appeal in paragraph 22 of the contested decision, that retail services can be offered in the same places as those in which the goods in question are sold, as the applicant has also recognised. The Board of Appeal's finding that retail services are rarely offered in places other than those where the goods are retailed and that consumers need not go to different places to obtain the retail service and the product they buy, must therefore be upheld.

49 Contrary to what is claimed by the applicant, the fact that the retail services are provided at the same sales points as the goods is a relevant criterion for the purposes of the examination of the similarity between the services and goods concerned. In that regard, it should be pointed out that the Court has held, in paragraph 23 of Canon, paragraph 16 above, that, in assessing the similarity of the goods and services in question, all the relevant factors characterising the relationship between the goods or services should be taken into account. It stated that those factors include their nature, purpose, method of use, and whether they are in competition with each other or are complementary, meaning that it did not in any way regard those factors are the only ones which may be taken into account, their enumeration being merely illustrative. The Court of First Instance therefore concluded from this that other factors relevant to the characterisation of the relationship which may exist between the goods or services in question may also be taken into account, such as the channels of distribution of the goods concerned (Case T-443/05 *El Corte Inglés v OHIM– Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR II-0000, paragraph 37; see also, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 65, upheld on appeal in Case C-214/05 *P Rossi v OHIM* [2006] ECR I-7057; and Case T-364/05

Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL) [2007] ECR II-757, paragraph 95).

50 Furthermore, contrary to the applicant's assertion, which is moreover unsubstantiated, that, as the majority of the goods are sold in supermarkets, consumers do not attach too much importance to the point of sale when making up their mind whether goods share a common origin, it must be held that, as contended by OHIM, the manufacturers of the goods in question often have their own sales outlets for their goods or resort to distribution agreements which authorise the provider of the retail services to use the same mark as that affixed to the goods sold.

51 It was therefore correct, in paragraph 22 of the contested decision, to take into account, when comparing the goods and the services covered by the trade marks in dispute, the fact that those goods and services are generally sold in the same sales outlets (see, in that regard, *SISSI ROSSI*, paragraph 49 above, paragraph 68, and *PiraÑAM diseño original Juan Bolaños*, paragraph 49 above, paragraph 37).

30. Mr Onslow submitted that these paragraphs were predicated on identity between the goods of the earlier mark and the goods covered by the retail services of the later mark and that paragraph 49, in particular, is *obiter* and wrong, or is limited to cases of identical goods. While it is true that this was the scenario facing the General Court, there is nothing in the *Oakley* decision that persuades me that it is wrong to consider the channels of distribution and sales outlets through which the relevant goods and services are provided in the absence of identity. Indeed, the authorities cited in paragraph 49 of *Oakley* do not all involve identity. Further, as Mr Gymer pointed out, and as set out in *Oakley* itself, the CJEU in *Canon* and subsequent cases has made it clear that, in assessing the similarity of the goods and services in question, all the relevant factors characterising the relationship between the goods or services should be taken into account.

31. Having said this, in the modern age of retail stores, particularly on-line retailers, that sell almost anything one can envisage wanting to buy, trade mark tribunals have to be careful not to give undue weight to the existence of an overlap in the channels of distribution and sales outlets, particularly in the absence of any specific evidence on the point.”

18. In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the General Court 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. In *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, reviewed the law concerning retail services v goods; he stated:

“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.”

19. However, on the basis of the European courts’ judgments in *Sanco SA v OHIM*<sup>3</sup>, and *Assembled Investments (Proprietary) Ltd v. OHIM*<sup>4</sup>, upheld on appeal in

---

<sup>3</sup> Case C-411/13P

<sup>4</sup> Case T-105/05, at paragraphs [30] to [35] of the judgment

*Waterford Wedgewood Plc v. Assembled Investments (Proprietary) Ltd*<sup>5</sup>, Mr Hobbs concluded that:

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;

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

20. Further points made in the applicant's counterstatement include:

- That undue weight should not be given to any potential overlap in trade channels (as per the *Giant* case).
- That trade marks specifications should not be interpreted too broadly, with reliance placed on the *You View* case (see paragraph 15 above).

---

<sup>5</sup> Case C-398/07P

- That the Trade Marks Work manual states that retail service specifications do not cover the goods retailed, and that if protection for goods is required then an application should be made accordingly.
- That the owner of the earlier mark could have applied for the goods but choose not to, which demonstrates its intention of operating a retail outlet and, therefore, that the commercial interests of the parties differ.
- That an average consumer encountering the applied for mark in relation to furniture in a retail setting other than in the opponent's store, would not believe that those goods were the responsibility of the retailer operating under the earlier mark.

21. In terms of not interpreting specifications too broadly, this has little significance in the case before me. This is because the terms are clear and unambiguous. I, of course, accept (as noted above) that the retail service specification should not be treated as if it were a specification covering the retailed goods. Further, whilst I accept that the opponent could have elected to register its marks for the goods in addition to its retailing, this does not prevent it from opposing a mark for similar goods if confusion would result. To do otherwise would result in section 5(2)(b) applying only to goods/services that are identical – this is clearly not what the statute says.

22. I note the caution expressed in *Giant* regarding the overlap in channels of trade. However, in this case, it seems to me obvious, and matches my own experience, that taking account of the normal ways in which furniture is retailed, consumers are accustomed to seeing furniture retailers selling their own brand of furniture, often exclusively, sometimes alongside other brands. This means that the nature of the relationship is sufficiently pronounced from the consumer's point of view that a complementary relationship is in play. I consider there to be a medium degree of similarity between the applied for goods (which I consider to all be items of furniture, or so close to furniture that any distinction does not matter) and the retail services connected with the sale of furniture.



## **Average consumer and the purchasing act**

23. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. 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.”

24. Whether selecting furniture, or choosing which retailer of furniture to visit, the average consumer will be a member of the general public. The goods are not everyday purchases/choices, although, with many items of furniture, there perusal will be more frequent than, say, buying a new car. Some furniture is reasonably expensive, but this does not apply to everything and, further, lower cost alternatives are available. I consider there will be a slightly higher than normal level of care and attention in the purchasing process, but not of the highest degree. The same applies to the choice of retailer, although, it is likely that slightly more consideration will be applied to the goods themselves as compared to the retailer of the goods.

25. The goods will normally be selected by looking at them in a specialist store, including online retail outlets. They may also be encountered in brochures or advertisements. Whilst this suggests a skew towards the visual impression of the marks taking on more significance, this is the type of purchase where sales advisors may be consulted, so the aural impacts of the marks should not be ignored. The choice

of retailer to visit will be largely focused on signage (including online), advertising and brochures.

### Comparison of marks

26. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

27. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks. The marks to be compared are:

## ORIGIN

v



28. In terms of the overall impression, the applied for mark consists solely of the word ORIGIN, so that is the only thing that contributes to its overall impression. The earlier mark comprises the word "origin", with its letter "g" in a contrasting colour and with lines or spikes emanating from the top, together with the word "an" in much smaller font positioned at the upper left of the letter "o" in origin. It is, in my view, clearly the case that the word origin has by far the greatest relative weight in the overall impression of the mark. Whilst the word "an" is not wholly negligible, it is so small in size that I consider the contribution it makes to the overall impression to be minimal. The stylisation of the letter "g" plays a greater role (than "an"). Even though it is not the element which has greatest relative weight, it still makes a reasonable contribution to the overall impression.

29. The sharing of the word ORIGIN/origin, a word which comprises the whole of one mark and the element with the greatest relative weight in the overall impression of the other mark, creates an inevitable degree of similarity. The difference in casing of the words does not create a difference because notional use of the plain word ORIGIN would include use in lower case lettering. The applicant points to the visual impact created by the stylisation of the mark and the presence of the word "an". In my view, the presence of "an" does little to reduce the visual similarity between the marks on account of the minimal weight it plays in the overall impression. The stylisation creates more of a difference, however, given my assessment of the overall impression of the marks I still conclude, notwithstanding this difference, that the marks still have a reasonably high (but not the highest) level of visual similarity.

30. Aurally, the applicant submits that there is a difference due to the sound an- at the start of the earlier mark, which is absent from the applicant's mark. It submits that this is important because it is the first sound. Whilst this is noted, I take the view that due to the overall impression of the mark, some average consumers would not articulate "an" at all given it is so lacking in significance. Even if were to be articulated, the aural comparison is between AN-O-RI-GIN and O-RI-GIN. Notwithstanding that the difference is at the beginnings of the marks, I still consider that there is a high degree of aural similarity.

31. Conceptually, the applicant argues that the addition of the word “an” creates a different concept to the word ORIGIN alone given that “an origin” relates to a certain source of something, as opposed to a more general appreciation of the word. I doubt the average consumer would think in that way and they would, instead, conceptualise both marks purely on the basis of the known meaning of the word ORIGIN. The concepts are identical. However, even if the applicant is right on its assessment, I still consider that there would be a high degree of conceptual similarity between the marks, not low as the applicant puts forward.

### **Distinctiveness of the earlier mark**

32. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, based either on inherent qualities or because of use made, the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *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).”

33. I have only the inherent character of the mark to consider. Neither party have really commented on this aspect. I note that in *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of “distinctive character” is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

34. The component of the earlier mark which is common to the applied for mark is the word ORIGIN. In *Whyte & MacKay Ltd v Origin Wine UK Ltd and Dolce Co Invest Inc* [2015] EWHC 1271 (Ch) Arnold J stated:

“In my judgment there is an error of principle in the hearing officer's approach. The root problem with his analysis is that he failed at the outset to consider how the average consumer would understand the word ORIGIN in the context of the relevant goods. For this purpose, it makes no difference whether one is considering the Respondents' goods (wine in the case of the Word Mark) or the Appellant's goods (Scotch whisky and whisky-based liqueurs). Either way, in my judgment the average consumer would understand the word ORIGIN as

referring to the origin of the goods, whether their geographical origin or their trade origin. This would be true in relation to most goods and services, but it is particularly true of both wine and Scotch whisky, where geographical origin is both an important factor in quality and frequently intimately associated with trade origin. It follows that the word ORIGIN is inherently descriptive, or at least non-distinctive, for the goods in issue. As counsel for the Appellant rightly conceded, *Formula One* establishes that, since its validity has not been challenged, the Word Mark must nevertheless be deemed to have the minimum degree of distinctive character for it to be validly registered; but no more than that.”

35. I bear in mind that the above represents a factual finding not a finding of law. I also bear in mind that the services of the earlier mark which are being considered are quite different to goods such as wine. It is difficult to fully pin down what role the word ORIGIN (beyond the trade origin message it contributes to) is playing. It could be said that there is a mild allusion to the furniture being sold having a clear explanation of where it was made, or where the material (such as wood) was sourced from. I find that as whole the mark has a medium degree of inherent distinctive character, but even when one considers just the word ORIGIN within the earlier mark, it still has a moderate (between low and medium) level of distinctiveness.

### **Likelihood of confusion**

36. The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused. Confusion can be direct (which effectively occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same, but puts the similarity that exists between the marks/goods and services down to the responsible undertakings being the same or related). In terms of indirect

confusion, this was dealt with by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10 where he noted 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.

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).”

37. In considering whether there exists a likelihood of confusion, imperfect recollection must be borne in mind. Even though the level of care and attention may mitigate, to a certain extent, against imperfect recollection, it still plays a role. In this case, the absence/presence of the word “an” in the earlier mark may be something that is overlooked through the effects of imperfect recollection, particularly bearing in mind the minimal role it plays in the overall impression. The same can also be said about the stylised letter g. Although it gives the earlier mark a particular visual impact, the focus will still be placed on the “origin” element with the stylisation susceptible to being misremembered or misrecalled. If this were the case, and bearing in mind the medium degree of similarity between the goods and the services, the competing marks would be directly confused with each other. Even if the marks were more perfectly recalled (although the “an” element will always be susceptible to imperfect recollection), the stylistic differences will be put down to the responsible undertaking simply presenting the word ORIGIN, which has at least moderate distinctiveness for the opponent’s services (and which is the only thing that contributes to the overall impression and distinctiveness of the applied for mark), in a stylised manner as opposed to in plain font. That difference is insufficient to signify that the responsible undertakings differ. The average consumer will believe that the goods sold under the ORIGIN mark are from the same or economically linked undertaking as the retail (of furniture) offered under the earlier mark. The claim under section 5(2)(b) succeeds.

### **Conclusion**

38. The opposition succeeds. Subject to appeal, the application for registration is refused in its entirety.

### **Costs**

39. The opponent has been successful and would, ordinarily, be entitled to an award of costs. In relation to costs, the applicant has pointed to the broad claims of similarity that have been made and, also, the number of attempts it took the opponent to get its statement of case in order, on which the applicant had to engage.



40. Any costs award in favour of the opponent would have been limited given that it has only participated to a limited extent by way of filing the notice of opposition and then dealing with the inadequacies mentioned earlier. Given what I said earlier about this, I do not consider it appropriate to make an award in favour of the opponent to reflect this work. In fact, the only costs I think it reasonable to award relate to the opposition fee itself, a sum of £100. No further costs shall be awarded.

41. I order Kindred Living Limited to pay An Origin Ltd the sum of £100 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 23<sup>rd</sup> day of March 2018**

**Oliver Morris**  
**For the Registrar**  
**the Comptroller-General**