

**O-470-19**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3285960**

**BY GREENS OF HIGHGATE LIMITED**

**TO REGISTER THE FOLLOWING TRADE MARK:**

**Greens of Highgate**

**IN CLASS 31**

**AND**

**OPPOSITION THERETO UNDER NO. 413245**

**BY RAZA REHMAN**

## **BACKGROUND AND PLEADINGS**

1. On 29 January 2018, Greens of Highgate Limited (“the applicant”) filed trade mark application number UK00003285960 for the mark **Greens of Highgate**. The application was accepted and published for opposition purposes on 27 April 2018, in respect of the following goods:

Class 31      Fresh fruits and vegetables; Fresh flowers.

2. Raza Rehman (“the opponent”) opposes the application in full under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), relying upon United Kingdom trade mark (“UKTM”) no. 3115881, the pertinent details of which are as follows:

**Representation:** Greens

**Filing date:** 01 July 2015

**Registration date:** 05 February 2016

**Services:** Class 35<sup>1</sup>

3. For the purposes of these proceedings, the opponent relies upon all the services in class 35 for which its mark is registered. The mark qualifies as an earlier mark in accordance with section 6 of the Act. Given its registration date, it is not subject to the proof of use provisions contained in section 6A of the Act.

4. The opponent’s case under section 5(2)(b) is that the applied-for mark is “closely similar” to its earlier mark and that the respective goods and services are similar, resulting in a likelihood of confusion. The opponent originally relied upon sections 5(2)(b) and 5(3) of the Act for its opposition but has since notified the Tribunal of its decision not to pursue the 5(3) ground.

5. The applicant filed a counterstatement in which it denies a likelihood of confusion due to the marks at issue not being similar and the goods and services not being similar.

---

<sup>1</sup> I will list these when I come to the goods and services comparison

6. Neither party filed evidence. Neither party requested a hearing. Neither party filed written submissions in lieu of a hearing. The opponent and the applicant represent themselves.

## **DECISION**

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

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

“A trade mark shall not be registered if because –

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

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

### **Relevant law**

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

#### The principles

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

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

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

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

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

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

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

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

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

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

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

### Comparison of goods and services

9. The competing goods and services are shown in the table below:

Earlier mark	Applied-for mark
Class 35: The bringing together, for the benefit of others, of a variety of grocery products, namely: non medicated toiletries; cosmetic preparations; skin care preparations; antiperspirants; perfumes; body sprays and eau de cologne; essential oils; toilet articles; shampoos; soaps; essential oils; after-shave and sticks for cosmetic purposes; non-medicated talcum powder for toilet purposes; emery colorants; dyes, lotions, waving, styling preparations and spray for hair; tissues impregnated with cosmetic lotions; cosmetic preparations for slimming purposes; cosmetic preparations for slimming purposes; cosmetic preparations for the care of babies and infants bodies; charcoal, coke, coal, wood for burning, briquettes; food for babies; plasters, materials for dressings; disinfectants; analgesics;	Class 31: Fresh fruits and vegetables; Fresh flowers.

antiseptics; napkins and pants for incontinence; tissues impregnated with pharmaceutical lotions; sanitary preparations; menstruation pads and tampons; sunburn ointment and preparations for pharmaceutical purposes; contraceptive preparations; vitamins; vitamin preparations; patches incorporating a pharmaceutical preparation; metallic foil; cutlery, razors and razor blades; hand operated tools and implements; non-electric can openers; irons; hair-removing tweezers; pedicure sets; nail files; needle threaders; scissors: batteries; calculators; compact discs; tights; torches; paper; greeting cards; printed matter; periodical publications; books; pens and nibs; table linen of paper; plastic cling film; toilet paper; paper towels; wrapping paper; household or kitchen utensils combs; brushes articles for cleaning purposes; glass; glassware; porcelain and earthenware not included in other classes; gloves for household purposes; paper and plastic and mixtures of paper and plastic plates and cups; sewing cottons; decorations and artificial snow for Christmas trees; Christmas crackers; pasta and pasta products; bread; biscuits; cookies; cakes; ice, ice cream, water ices, frozen confections; preparations for making ice

cream and/or water ices and/or frozen confections; honey; preparations consisting wholly or substantially wholly of sugar, for use as substitutes for honey; syrup, treacle, molasses; ketchup; sauces and preparations for making sauces; custard powder; prepared meals; mousses; desserts; puddings; yeast, baking powder; salt, pepper, mustard; for household purposes: natural sweeteners; syrups; salad dressings; fresh fruits, herbs; flowers; beverages for animals, litter for animals; tobacco, cigars and cigarettes; smokers articles; matches; electrically operated lighters for smokers enabling customers to conveniently view and purchase those goods from a supermarket or mini-market; provision of information to customers and advice or assistance in the selection of goods brought together as above; business and management consultancy services; business and marketing research; providing services and advice on bookkeeping, auditing and accounting; secretarial and administrative services; the provision of services for typing, transcription and photocopying; business and management consultancy; business and marketing research; professional consultations and provision of information; business advice relating to

franchising; consultancy services relating to branding of goods.	
--	--

10. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, the court stated at paragraph 23 that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

11. The relevant factors for assessing similarity, identified by Jacob J. (as he then was) in the *Treat* case,<sup>2</sup> were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

---

<sup>2</sup> [1996] R.P.C. 281



(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.

12. In *Kurt Hesse v Office for Harmonization in the Internal Mark (OHIM)*,<sup>3</sup> the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*,<sup>4</sup> 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”.

13. *Oakley, Inc v OHIM*<sup>5</sup> is also relevant. 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.

14. In *Tony Van Gulck v Wasabi Frog Ltd*,<sup>6</sup> Mr Geoffrey Hobbs QC as the Appointed Person reviewed the law concerning retail services v goods. He said (at paragraph 9 of his judgment) that:

“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

---

<sup>3</sup> Case C-50/15 P

<sup>4</sup> Case T-325/06

<sup>5</sup> Case T-116/06, at paragraphs [46] to [57] of the judgment

<sup>6</sup> BL O/391/14

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."

15. The opponent has suggested similarity between the applicant's entire specification and its own 'the bringing together, for the benefit of others, of a variety of grocery products, namely: fresh fruits, herbs; flowers'. The opponent submits as follows:

"6.2 These services are associated with and therefore identical to the goods covered by the Application in Class 31."

16. Goods and services differ in nature since goods are tangible items whereas services are intangible, thus serving different needs. I do not find the goods and services at issue to be identical. However, bearing in mind the above case law, I do find similarity. The opponent's services are those that enable consumers to view and purchase goods (in this instance, the goods named within the specification). The opponent's registration therefore covers a service for purchasing, inter alia, fresh fruits and flowers. The application consists of identical goods: fresh fruits and fresh flowers; as well as fresh vegetables. I group the applicant's goods together for the purpose of assessment in accordance with *Separode Trade Mark*,<sup>7</sup> since the average consumer regularly does the same. The purpose, method of use and nature of the goods and the services differ. They are not in competition with one another as consumers do not choose between goods themselves and the services that offer them. However, the users may overlap since those who wish to purchase fresh fruits, vegetables and flowers are likely to use the services which offer those goods. The goods and services are also complementary in that they are important for one another, resulting in the consumer seeing a connection between the two and believing that the responsibility for both lies with the same undertaking. In addition, the goods and services may be

---

<sup>7</sup> BL O/399/10 (AP)

distributed through the same trade channels. Overall, I find there to be a medium degree of similarity between the applicant's 'fresh fruits and vegetables; fresh flowers' and the opponent's 'the bringing together, for the benefit of others, of a variety of grocery products, namely: fresh fruits; flowers'.

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

17. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purposes 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*.<sup>8</sup>

18. 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*,<sup>9</sup> 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."

19. The average consumer of the goods and services at issue will be a member of the general public. The consumer does not pay, as such, for the services provided by the opponent but pays for the goods offered by that service. The goods are relatively inexpensive and are purchased frequently. Overall, the level of care and consideration that will be adopted during the purchasing process would be average. The purchase of the goods and the selection of the services is likely to be predominantly visual: the goods will be self-selected from physical stores or websites and the services will be

---

<sup>8</sup> Case C-342/97

<sup>9</sup> [2014] EWHC 439 (Ch)

selected by eye, seeing the establishment's name displayed on the venue itself, on the internet, or on advertising material. However, I do not completely discount an aural element to the purchase.

### **Comparison of marks**

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

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

21. 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 trade marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the trade marks.

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

<b>Earlier mark</b>	<b>Applied-for mark</b>
<b>Greens</b>	<b>Greens of Highgate</b>

23. The parties have made submissions on the similarities and differences of the marks. I have considered them all in reaching my decision and will refer below to some

of the arguments raised (although I do not propose to reproduce the submissions in full).

### Overall impression

24. The applied-for mark consists solely of the plain words 'Greens of Highgate', with no stylisation or figurative elements. The average consumer might see the word 'Highgate' as indicative of the geographical origin of the goods (which I discuss later). The word 'of' will be seen as indicating an association between 'Greens' and 'Highgate'. Whilst this may mean that the word 'Greens' plays a slightly greater role in the overall impression of the mark, the words 'of Highgate' still contribute to the overall look and feel of the mark when considered as a whole.

25. The earlier mark consists solely of the word 'Greens', with no stylisation or figurative elements. The overall impression of the mark rests in the word itself.

### Visual comparison

26. The similarity between the marks rests in the first word 'Greens', meaning the entirety of the earlier mark is visible within the applied-for mark. The differences are in the addition of the two words 'of Highgate' in the applied-for mark. Overall, I find a medium degree of visual similarity between the marks.

### Aural comparison

27. Both marks will be articulated in their entirety: the earlier mark as the one-syllable 'Greens' and the applied-for mark as the four-syllable 'Greens of Highgate'. Overall, I find a medium degree of aural similarity between the marks.

### Conceptual comparison

28. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC and

the CJEU including *Ruiz Picasso v OHIM*.<sup>10</sup> The assessment must be made from the point of view of the average consumer.

29. Consumers who would purchase the goods and services at issue will recognise the relevance of the word 'Greens' in relation to fresh fruits and vegetables, since the word is often used informally to refer to green vegetables.<sup>11</sup> This will be the concept grasped by the consumer for the earlier mark. The applied-for mark will conjure the same concept in the mind of the consumers, with the additional indication of the geographical origin presented by the words 'of Highgate'. Overall, I find a high degree of conceptual similarity between the marks.

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

30. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, the greater the likelihood of confusion (see *Sabel*). In *Lloyd Schuhfabrik Meyer* the CJEU stated that:

"22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *WindsurfingChiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested

---

<sup>10</sup> [2006] e.c.r.-I-643; [2006] E.T.M.R. 29

<sup>11</sup> Oxford English Dictionary

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).”

31. The opponent has not claimed to have used its earlier mark to the extent that it has an enhanced degree of distinctive character. However, even if it had, I have not been provided with any evidence to make a finding on the matter. Accordingly, I have only the inherent distinctiveness of the earlier mark to consider.

32. I have found that the average consumer will notice the relevance of the word ‘Greens’ in relation to fruits and vegetables. ‘Greens’ is descriptive of some of the goods sold under the opponent’s services: those which I have found similar to the applicant’s specification (namely, ‘the bringing together, for the benefit of others, of a variety of grocery products, namely: fresh fruits; flowers’). The purpose of a trade mark is to distinguish the services of one undertaking from those of another trader. This cannot be achieved if the average consumer cannot see past the descriptive message that the mark gives. It seems to me that the word ‘Greens’ (alone, without more) would not serve as an indication of trade origin of any one individual trader in relation to the goods applied for.<sup>12</sup> With this in mind, and that since an existing registered trade mark must be afforded some distinctive character,<sup>13</sup> I find the earlier mark to have a very low degree of distinctive character.

### **Likelihood of confusion**

33. Firstly, I am minded to deal with the following submissions made by the opponent:

---

<sup>12</sup> See *Henkel v OHIM*, paragraph 34, Case C-304/06 P; *Eurohypo v OHIM* [2008] ECR I-3297, paragraph 66, Case C-398/08 P; *Audi v OHIM* [2010] ECR I-0000, paragraph 33; *Storck v OHIM*, paragraph 25; *Henkel v OHIM*, paragraph 35; and *Eurohypo v OHIM*, paragraph 67.

<sup>13</sup> *Formula One Licensing BV v OHIM*, Case C-196/11P

“2. The Applicant argues that the word ‘Green’ is also contained in at least twenty six other registered Trademarks in the UK. These 26 earlier Marks are listed at the end of this document.

3. The Applicant submits that within the above mentioned earlier marks (for which there are at least 26), 6 of these earlier marks cover the same products as the Applicant in Class 31 and the Opponent in Class 35. These 6 earlier marks are listed at the end of this document, they are written in bold and underlined.

4. The Applicant argues that if twenty one other trademarks can co-exist without the public being confused with association, then the Applicant’s mark should also be allowed to co-exist.”

34. In relation to the registered trade marks referred to by the applicant, I bear in mind *Zero Industry Srl v OHIM*.<sup>14</sup> The GC stated that:

“73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word ‘zero’, it should be pointed out that the Opposition Division found, in that regard, that ‘... there are no indications as to how many of such trade marks are effectively used in the market’. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word ‘zero’ is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T-135/04 GfK v OHIM – BUS(Online Bus) [2005] ECR II-4865, paragraph 68, and Case T-29/04 Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH) [2005] ECR II-5309, paragraph 71).”

---

<sup>14</sup> Case T-400/06



35. Accordingly, the state of the register is not evidence of how many of such trade marks are effectively used in the market.

36. In relation to the claimed absence of confusion in the marketplace, I refer to *Roger Maier and Another v ASOS*.<sup>15</sup> Kitchen LJ stated that:

“80. ...the likelihood of confusion must be assessed globally taking into account all relevant factors and having regard to the matters set out in *Specsavers* at paragraph [52] and repeated above. If the mark and the sign have both been used and there has been actual confusion between them, this may be powerful evidence that their similarity is such that there exists a likelihood of confusion. But conversely, the absence of actual confusion despite side by side use may be powerful evidence that they are not sufficiently similar to give rise to a likelihood of confusion. This may not always be so, however. The reason for the absence of confusion may be that the mark has only been used to a limited extent or in relation to only some of the goods or services for which it is registered, or in such a way that there has been no possibility of the one being taken for the other. So there may, in truth, have been limited opportunity for real confusion to occur.”

37. Since I have been provided with no evidence of the registered trade marks (referred to by the applicant) in use, I cannot determine whether there has or has not been any opportunity for confusion to occur. Even if I had been provided with such evidence, absence of confusion is rarely significant, since there could be numerous reasons for this.<sup>16</sup>

38. Having dealt with the necessary submissions made by the opponent, I move on to assessing the likelihood of confusion. The factors assessed so far have a degree of interdependency (*Canon*); a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel*). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the

---

<sup>15</sup> [2015] EWCA Civ 220

<sup>16</sup> *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283

viewpoint of the average consumer and determining whether they are likely to be confused.

39. Confusion can be direct (which 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 undertaking being the same or related).

40. The marks have been found to be visually similar to a medium degree, aurally similar to a medium degree and conceptually highly similar. The goods and services have been found to be similar to a medium degree.

41. Due to the visual and aural differences I have highlighted, particularly the fact that the applied-for mark contains two additional words which do not appear in the earlier mark, I do not find that the average consumer would mistake one mark for the other. Those additional words in the applied-for mark will not go unnoticed by the average consumer. Even bearing in mind the concept of imperfect recollection, there is no likelihood of direct confusion.

42. I go on now to consider 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*:<sup>17</sup>

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognised that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: ‘The later mark is different from the earlier mark, but also has something in common with it. Taking account of the

---

<sup>17</sup> BL O/375/10

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).”

43. I have borne in mind that the examples given by Mr Purvis are not exhaustive. Rather, they were intended to be illustrative of the general approach.<sup>18</sup>

44. I also bear in mind the guidance of Mr James Mellor QC, sitting as the Appointed Person in *Duebros Limited v Heirler Cenovis GmbH*:<sup>19</sup>

“81.4. Fourth, I think it is important to stress that a finding of indirect confusion should not be made merely because the two marks share a common element. When Mr Purvis was explaining in more formal terms the sort of mental process

---

<sup>18</sup> See *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17 at paragraphs [81] to [82]

<sup>19</sup> BL O/547/17

involved at the end of his [16], he made it clear that the mental process did not depend on the common element alone: ‘Taking account of the common element in the context of the later mark as a whole.’ (my emphasis).”

45. I go on now to consider whether the average consumer, having recognised that the marks are different, considers the common element of both marks and determines, through an instinctive mental process, that the marks are related and originate from the same, or an economically linked undertaking.

46. I have found that the earlier mark has only an inherently very low distinctive character in relation to the goods and services in common. I note the words of Lord Simonds in *Office Cleaning Services Limited v Westminster Window & General Cleaners Limited*:<sup>20</sup>

“Where a trader adopts words in common use for his trade name, some risk of confusion is inevitable. But that risk must be run unless the first user is allowed unfairly to monopolise the words. The court will accept comparatively small differences as sufficient to avert confusion. A greater degree of discrimination may fairly be expected from the public where a trade name consists wholly or in part of words descriptive of the articles to be sold or the services to be rendered.”

47. His Honour Judge Hacon recently considered the applicability of the *Office Cleaning Services* case to the law of registered trade marks, in *Burgerista Operations GmbH v Burgista Bros Limited*,<sup>21</sup> where he said:

“40... The court will be careful to discount confusion which...has arisen solely because of the purely descriptive elements common to both the claimant’s and the defendant’s marks – for instance, where some people have muddled the identity of two companies just because they both have ‘office cleaning’ in their

---

<sup>20</sup> [1946] 63 RPC 39. *Office Cleaning* was a passing off case, but is applicable in a 5(2)(b) case – see Mr Daniel Alexander QC (sitting as the Appointed Person) in Case BL O/255/13 (Sandra Amalia Mary Elliott) at paragraphs [56] and [57].

<sup>21</sup> [2018] EWHC 35 (IPEC)

names. This is not a matter of policy; it is simply that such confusion is irrelevant to the claimant's case.”

48. The only point of similarity between the marks is the word ‘Greens’, which is either directly descriptive of the goods provided or the goods being sold through the services provided. I believe the average consumer will recognise the commonality as a coincidental (and unsurprising) use of descriptive language within the context of two different trade marks. Considering the addition of the words ‘of Highgate’ in the applied-for mark, which do not form an element that one would expect to find in a sub-brand or brand extension, I can see no logical step which would induce the consumer to be indirectly confused. This is so even despite the words being indicative of the geographical origin of the goods. I find that the average consumer, being well informed and reasonably observant and circumspect, would not assume that the goods and services were provided by the same or a related undertaking. I do not consider indirect confusion to be likely.

## **CONCLUSION**

49. There is no likelihood of confusion. The opposition has failed, and the applicant's mark may continue to registration.

## **COSTS**

50. As the applicant has been successful, it would, ordinarily, be entitled to an award of costs in its favour. As the applicant is unrepresented, at the conclusion of the evidence rounds the tribunal invited it to indicate whether it intended to make a request for an award of costs and, if so, to complete a pro-forma indicating a breakdown of its actual costs. Since the applicant did not respond to that invitation within the timescale allowed (nor has any response been received from the applicant prior to the date of the issuing of this decision), each party will bear its own costs.

**Dated this 12th day of August 2019**

**Emily Venables  
For the Registrar,  
The Comptroller-General**