

BL O-234-20

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3394870

BY SYED MOHSIN ZULFIQAR BUKHARI

TO REGISTER:

A stylized logo consisting of the letters 'M' and 'B' intertwined in a bold, serif font. The 'M' is on the left and the 'B' is on the right, with their vertical strokes overlapping.

AS A TRADE MARK IN CLASSES 3, 9, 14, 18 & 25

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NO. 416895

BY ZIA MARIA HOLDING B.V.

BACKGROUND & PLEADINGS

1. On 26 April 2019, Syed Mohsin Zulfiqar Bukhari (“the applicant”) applied to register the trade mark shown on the cover page of this decision for the goods shown in paragraph 9 below. The application was published for opposition purposes on 10 May 2019.

2. On 9 July 2019, the application was opposed in full by Zia Maria Holding B.V. (“the opponent”). The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). In its Notice of opposition, the opponent indicates that it relies upon all the goods and services (shown in paragraph 9 below) in the following European Union Trade Mark (“EUTM”) registration:

No. 13710256 for the trade mark shown below, which was applied for on 5 February 2015 and entered in the register on 24 September 2019:



3. In its Notice of opposition, the opponent stated:

“The respective parties marks both contain or comprise the identical term 'MB' with the phrase 'MY BRAND' in the mark of the opponent being largely non-distinctive in the context of the goods applied for. Despite the visual differences between them, because of the identity of the phrase 'MB' within each mark, they are both visually and phonetically similar to one another, especially when one allows for imperfect recollection amongst consumers.

Although both marks contain logo elements (thus allowing for a degree of visual difference between them) this does not assist overall in distinguishing them from one another when one acknowledges their phonetic similarity. This phonetic similarity is the more important element when one takes into account the fact that the marks are usually known by customers by their dominant words or phrases rather than their visual elements.

The goods applied for are either identical or highly similar to the opponent's earlier goods which can be sold alongside or in close proximity to one another which would be considered to come from the same source by consumers. For example, it is quite common in the marketplace for class 14 and 18 goods to come from the same source and to be sold under the same brand as class 3 and/or class 25 goods. The class 35..."

There is no more text after the words "The class 35"; I shall return to this point below.

4. The applicant filed a counterstatement, subsequently amended. In the amended counterstatement, he stated:

"They are not identical

My logo or mark is "MB" only abbreviation of my name "Mohsin Bukhari"

Whereas, their logo is "MB" in a circle around together with two words "My Brand" underneath. So how could they be identical or similar with each other?

Just put both logos side to side and have a look

If I put a circle around my logo and write some thing underneath then it would be a kind of similar but in current case it isn't like that, so my logo is "MB" and their logo is "MB MY MRAND"

It looks a silly opposition."

5. In these proceedings, the opponent is represented by Novagraaf UK, the applicant represents himself. Although no evidence has been filed, the opponent filed written submissions during the evidence rounds. Neither party requested a hearing nor did

they elect to file written submissions in lieu of attendance. I shall keep the written submissions in mind, referring to them to the extent I consider it necessary.

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.

5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

7. The trade mark being relied upon by the opponent qualifies as an earlier trade mark under the provisions of section 6 of the Act. As this earlier trade mark had not been registered for more than five years at the date the application was filed, it is not subject to the proof of use provisions. As a consequence, the opponent can rely upon all the goods and services claimed without having to demonstrate that its trade mark has been used in relation to such goods and services.

Case law

8. 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

9. The competing goods and services are as follows:

Opponent's goods & services	Applicant's goods
Class 3 - Soaps; perfumery, colognes, toilet water, perfumes, fragrances for personal use, body and beauty care preparations, toilet water, essential oils; cosmetics; make-up products namely lip sticks, lip glosses, mascaras, eye shadows, eyeliners, blushes, pressed powders, loose powders, foundations; nail care products namely nail polish and nail polish remover; toiletries; non-medicated skin care products namely	Class 3 - Soaps for personal use; Perfumery, essential oils; Cosmetics, namely hair, face and body creams and lotions; Bath and shower gels and preparations, shampoos; Make-up preparations, namely foundations, lipsticks, eye shadows, mascara, make-up powder and nail varnish. Class 9 - Sunglasses; Spectacles; Optical lenses; Eyewear cases;

<p>cosmetic creams and lotions for skin care, moisturizing creams, facial masks and skin firming creams and lotions; non-medicated bath preparations, soaps and perfumery; cosmetic preparations for baths and showers namely, bath oil, bath salts, bath beads and bath crystals, talcum powders, hair lotions, shampoos; dentifrices; antiperspirants, deodorants for personal use; shaving articles namely shaving soaps, shaving gel and shaving cream, after-shave, after-shave lotions and gels.</p> <p>Class 25 - Clothing for men, women and children and infants namely, shirts, golf shirts, t-shirts, polo shirts, knit tops, woven tops, sweatshirts, tank tops, sweaters, blouses, jerseys, turtle-necks, shorts, sweatpants, warm-up suits, blazers, sport coats, trousers, jeans, skirts, dresses, wedding dresses, suits, overalls, jumpers, vests, jackets, coats, raincoats, parkas, ponchos, swimwear, bikinis, swim trunks, overcoats, rainwear, wind resistant jackets; clothing for dancing namely leotards and ballet suits, sleepwear, pajamas, bathrobes, shower caps, chasubles, underwear, lingerie, boxer shorts, belts made of leather, ties; headgear namely, hats, wool hats, caps, visors,</p>	<p>Telephones; Mobile phones; Smartphones; tablets; Electronic personal assistants; MP3 players; Telephone accessories, mobile telephones, smartphones, tablet devices, PDAs and MP3 players, in particular hands-free kits for telephones, batteries, back covers, covers, faceplates, chargers, neck straps or cords.</p> <p>Class 14 -Jewelry (including costume jewelry), in particular rings; Earrings; Cuff links; Bracelets; Trinkets; Brooches; Chains; Necklaces; Pendants; Key rings; Tie pins; Medallions; Jewelry cases; Watches; Wrist watches; Watch straps; Alarm clocks; Cases for watches.</p> <p>Class 18 - Boxes of leather or imitations of leather; Travelling bags, travelling sets (leather ware), trunks and travelling bags, garment bags for travel; Vanity cases, toiletry cases; Backpacks, handbags; Attaché cases and briefcases of leather; Pocket wallets, purses, key rings (leather ware); Umbrellas.</p> <p>Class 25 -Clothing, footwear, headgear.</p>
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headbands, ear muffs; scarves, shawls, wristbands, cloth bibs; footwear, gym shoes, sneakers, socks, stockings, hosiery, shoes, boots, beach shoes, sandals, slippers, gloves, suspenders; layettes [clothing]; sashes for wear.

Class 35 - Retail department store services, online retail department store services, online retail outlet services featuring perfumery, cosmetics, clothing, footwear, headgear, textile goods, bags, eyewear, jewellery, watches and horological and chronometric instruments, household or kitchen utensils and tableware; mail order catalog services featuring apparel, perfumery, products for home furnishing, namely decorative fabrics, utensils and tableware, cosmetics, watches, jewellery, eyewear, records, compact discs, cassettes, videos, books, art pictures, photos, cards, calendars, posters, prints, stickers and cartoon prints.

10. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the Court stated at paragraph 23:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their

intended purpose and their method of use and whether they are in competition with each other or are complementary”.

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

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

12. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court (“GC”) stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

13. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....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.”

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

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

15. 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.

16. 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 said (at paragraph 9 of his judgment) that:

“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.”

17. 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 Wedgwood Plc v. Assembled Investments (Proprietary) Ltd*³, 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 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

¹ Case C-411/13P

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

³ Case C-398/07P

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).

18. As I mentioned above, the text in the Notice of opposition was incomplete insofar as the opponent commented upon its services in class 35. However, as the opponent has provided written submissions in relation to this class, I need comment no further on the incomplete nature of its Notice of opposition. Both parties' specifications include the word "namely". The Trade Mark Registry's Classification Guide explains that this word should be approached on the following basis:

"Note that specifications including "namely" should be interpreted as only covering the named Goods, that is, the specification is limited to those goods. Thus, in the above "dairy products namely cheese and butter" would only be interpreted as meaning "cheese and butter" and not "dairy products" at large. This is consistent with the definitions provided in Collins English Dictionary which states "namely" to mean "that is to say" and the Cambridge International Dictionary of English which states "which is or are"."

I have borne all of the above case law etc. in mind in reaching the conclusions which follow.

Class 3

19. All of the terms in the applicant's specification either appear in the opponent's specification using the same words, as synonyms or are included in a broader term which appears in the opponent's specification. Where not literally identical, the goods

in the applicant's specification are to be regarded as such on the principles outlined in *Meric*.

Class 9

20. In relation to the applicant's goods in class 9, in its written submissions, the opponent states:

"The goods sunglasses; spectacles, optical lenses; eyewear cases; in the class 09 goods of the applicant are similar to the following retail services of the opponent in class 35 namely "retail department store services, online retail department store services, online retail outlet services featuring eyewear". The retailing of eyewear is similar to the above named products in class 09 per se because they are complementary to one another and share similar trade channels. The remaining electrical goods in class 9 of the application are similar to the following services namely 'mail order catalog services featuring apparel, perfumery, products for home furnishing, namely records, compact discs, cassettes, videos'."

21. Having applied the case law mentioned above and my own experience as an average consumer of such goods and services which, I am satisfied is not atypical, I agree with the opponent that there is a complementary relationship between its "online retail outlet services featuring eyewear" and the applicant's "Sunglasses; Spectacles; Optical lenses; Eyewear cases" which, in my view, results in a medium degree of similarity between them.

22. Although the opponent claims that the remaining goods in this class i.e.

"Telephones; Mobile phones; Smartphones; tablets; Electronic personal assistants; MP3 players; Telephone accessories, mobile telephones, smartphones, tablet devices, PDAs and MP3 players, in particular hands-free kits for telephones, batteries, back covers, covers, faceplates, chargers, neck straps or cords",

are similar to its named services, it provides no explanation for this conclusion. Without any submissions to assist me, having considered the opponent's named services and the goods the subject of those services, I am unable to discern, for example, any meaningful complementary relationship that may exist between the opponent's named services and the applicant's goods listed above, and, as a consequence, no meaningful degree of similarity. I shall return to this point later in this decision.

Class 14

23. In relation to the applicant's goods in class 14, in its written submissions, the opponent states:

“The goods of class 14 of the application are similar to the following retail services of the opponent in class 35 namely "retail department store services, online retail department store services online retail outlet services featuring Jewellery, watches and horological and chronometric Instruments". The retailing of these products is similar to the class 14 products of the application per se because they are complementary and share similar trade channels to one another.”

24. For the same reasons I explained in relation to the applicant's “Sunglasses; Spectacles; Optical lenses; Eyewear cases” in class 9, I agree with the opponent that its “online retail outlet services featuring Jewellery, watches and horological and chronometric Instruments” in class 35 are complementary to all of the applicant's goods in class 14 and are, as a consequence, similar to a medium degree.

Class 18

25. In relation to the applicant's goods in class 18, in its written submissions, the opponent states:

“The goods of class 18 of the application are similar to the following retail services of the opponent in class 35 namely "retail department store services,

online retail department store services, online retail outlet services featuring bags". The retailing of these products is similar to class 18 products of the application per se because they are complementary and share similar trade channels to one another."

26. As the vast majority of the applicant's goods are, broadly speaking, bags of one sort or another, for the reasons I have already explained, I agree with the opponent that there is a complementary relationship between such goods and the opponent's "online retail outlet services featuring bags" which, once again, results in a medium degree of similarity between them. Given what in my experience is the manner in which such goods are retailed, I reach the same conclusion in relation to "Boxes of leather or imitations of leather", "Pocket wallets", "purses", "key rings (leather ware)"; "Umbrellas."

Class 25

27. The applicant's specification reads "clothing, footwear, headgear". As the opponent's specification includes "Clothing for men, women and children and infants namely..." "headgear namely..." and "footwear", where not literally identical, the competing goods are to be treated as such on the *Meric* principle.

28. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated:

"49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity."

29. Having found no meaningful degree of similarity between the opponent's named services and the goods in the application shown in paragraph 22, there can be no likelihood of confusion and the opposition to such goods fails accordingly.

The average consumer and the nature of the purchasing act

30. As the case law above indicates, it is necessary for me to determine who the average consumer is for those goods and services I have found to be identical or similar. I must then determine the manner in which such 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.”

31. As the opponent suggests, the average consumer of the goods and services at issue is a member of the general public. As such goods and services are most likely to be the subject of self-selection either on the high street or on-line, visual considerations are likely to dominate the selection process. However, as aural considerations in the form of, for example, requests to sales assistants or word-of-mouth recommendations from one consumer to another will also form part of the process, such considerations must also be kept in mind.

32. In its submissions, the opponent suggests the degree of attention paid to the selection of such goods and services will be “at most, average”. The cost of the goods at issue in each goods class can vary considerably. Some may be fairly inexpensive and bought fairly frequently (shampoo for example) whereas others will



be bought less often and may be considerably more expensive, designer fragrances spectacles, jewellery, briefcases and many articles of clothing for example. As a consequence, the degree of attention paid to the selection of the various goods and their associated retail service is likely to vary. I will return to this point when I consider the likelihood of confusion.

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 as follows:

Opponent’s trade mark	Applicant’s trade mark
	

35. The applicant's trade mark consists of the letters "M" and "B" presented in upper case in a heavy bold font and in which the letters are coalesced. It is in that two letter combination the overall impression and distinctiveness lies.

36. The opponent's trade mark consists of a number of components. The first, is a circular device. Although significant in the context of the trade mark as a whole and the overall impression it conveys, such devices have very little, if any, distinctive character. The second component consists of what, despite its slight stylisation, I am satisfied the average consumer will interpret as the letters "M" and "B" presented in upper case and in which the letters are coalesced. These stylised letters occupy almost all of the circular device in which they appear and will have a high relative weight in both the overall impression the opponent's trade mark conveys and its distinctiveness. The third component consists of the words "MY BRAND", once again, presented in upper case letters in a very slightly stylised script. The words form a unit. In his original counterstatement, the applicant stated:

"4 "MY BRAND" IS A GENERIC WORD CANNOT BE REGISTERED AS TRADE MARK, I MAY OPPOSE IT."

37. Although as one can see in paragraph 4 above that did not appear in the applicant's amended counterstatement (which was amended at the tribunal's request for entirely different reasons), the original counterstatement was sent to the opponent when the applicant was asked to amend it. As a consequence, I see no reason why it should not be taken into account. Given their size and positioning within the trade mark, the words "MY BRAND" will have a much lower relative weight in the overall impression the opponent's trade mark conveys and, if the applicant is correct (which in my view he is), will add very little if anything to its distinctive character. I will bear the above conclusions in mind in the comparison which follows.

Visual similarity

38. The competing trade marks consist of or contain the stylised letters "MB" which although stylised in differing ways, are coalesced in a very similar manner. Although the opponent's trade mark also contains the circular device and the words "MY

BRAND”, given my comments above about the relative importance of those components, the competing trade marks are visually similar to a fairly high degree.

Aural similarity

39. Despite its stylisation, I have no doubt the average consumer will pronounce the applicant’s trade mark as “EM-BEE”. It is well established that when a trade mark consists of a combination of words and figurative components it is by the word(s) that it is most likely to be referred to. In my view, the opponent’s trade mark may very likely be referred to as simply “EM-BEE”, in which case the competing trade marks will be aurally identical. However, even if it is referred to as “EM-BEE MY- BRAND”, as “EM-BEE” will be articulated first, it still results in a fairly high degree of aural similarity between the trade marks at issue.

Conceptual similarity

40. Given their presentation, the letters “MB” in the applicant’s trade mark may be seen as indicating the initials (i.e. forename and surname) of a person which, the applicant explains, is his intention. Equally, they may be seen as simply letters and accorded no conceptual significance. As for the opponent’s trade mark, the presence of the circular device will have no bearing on any conceptual message the other components in its trade mark are likely to convey. It is likely that some consumers will notice that the letters “MB” are the first letters of the words “MY BRAND” which appear below them. Equally some consumers will not make this connection and will either accord the letters “MB” no conceptual meaning at all, or may, despite the presence of the words “MY BRAND”, treat them as initials. The concept created by the presence of the words “MY BRAND” in the opponent’s trade mark is, of course, completely alien to the applicant’s trade mark. As the conceptual position is likely to be mixed, I shall return to this point below.

Distinctive character of the earlier trade mark

41. 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.

42. As the opponent has filed no evidence of any use it may have made of its earlier trade mark, I have only its inherent characteristics to consider. Trade marks consisting of two letters are a very common form of indicating trade origin and the letters “M” and “B” are not unusual. Notwithstanding the degree of stylisation in the letters “MB” and the fact that the average consumer is likely to regard the words “MY BRAND” as being devoid of any distinctive character, when considered as a totality, the opponent’s earlier trade mark is possessed of a lower than medium (but not low) degree of distinctiveness, with the vast majority of that distinctiveness lying in the presence of the stylised letters “MB” within the trade mark.

Likelihood of confusion

43. 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.

44. 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 and services down to the responsible undertakings being the same or related. Earlier in this decision I concluded:

- The remaining goods in the application are either identical to the opponent's goods (classes 3 and 25) or similar to the opponent's named services in class 35 to a medium degree (classes 9, 14 and 18);
- The average consumer is a member of the general public who, whilst not forgetting aural considerations, will select the goods and services using predominantly visual means whilst paying a varying degree of attention during that process;
- The competing trade marks are visually similar to a fairly high degree and aurally similar to at least a fairly high degree;
- The conceptual messages likely to be conveyed by the competing trade marks is mixed;
- The opponent's earlier trade mark is, absent use, possessed of a lower than medium (but not low) degree of inherent distinctive character with the vast majority of this distinctiveness lying in the presence of the stylised letters "MB" within the trade mark.

45. 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 trade 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.”

46. In other words, simply considering the level of distinctive character possessed by the earlier trade mark is not enough. It is important to ask “in what does the distinctive character of the earlier trade mark lie?”. Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

47. Earlier I concluded that although the earlier trade mark possesses only a below medium (but not low) degree of inherent distinctiveness, the vast majority of the distinctive character the opponent’s trade mark possesses resides in the stylised letters “MB”. I also concluded that the degree of attention the average consumer is likely to pay during the selection process will vary. However, even if the average consumer pays only a low degree of attention during the selection process (thus making him/her more prone to the effects of imperfect recollection) and even when considered in relation to identical goods, in particular, the various visual differences between the competing trade marks (including the differing presentation of the letters “MB”) are, when considered in the context of what will be a predominantly visual purchasing process, likely to be sufficient to avoid direction confusion.

48. That leaves indirect confusion to be considered. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it

is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: "The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark."

49. As I mentioned above, the conceptual position is mixed. However, in my view, a significant proportion of average consumers are likely to accord the letters "MB" no conceptual meaning (even when they appear with the words "MY BRAND"). Approached on that basis, the average consumer is likely, to use Mr Purvis' analysis, to notice that the applicant's trade mark is different from the opponent's trade mark but will also notice that it has something in common with it i.e. the stylised letters "MB" which although stylised in different ways are coalesced in a very similar manner.

50. Notwithstanding the below medium (but not low) degree of inherent distinctiveness the opponent's trade mark possesses, I must also keep in mind, *inter alia*, the identity or medium degree of similarity in the competing goods and services and the fairly high degree of visual and, at least, fairly high degree of aural similarity between the competing trade marks. Those combination of factors are, in my view, likely to lead even a consumer paying a high degree of attention during the selection process to conclude that the applicant's trade mark is, for example, a variant brand of the opponent or of an undertaking linked to the opponent. That error on the part of the average consumer leads to a likelihood of indirect confusion and, as a consequence, the opposition to those goods and services I have found to be identical or similar succeeds accordingly.

Overall conclusion

51. Subject to any successful appeal, the application will be refused in relation to all of the goods for which registration has been sought, with the exception of the following goods in class 9:

Telephones; Mobile phones; Smartphones; tablets; Electronic personal assistants; MP3 players; Telephone accessories, mobile telephones, smartphones, tablet devices, PDAs and MP3 players, in particular hands-free kits for telephones, batteries, back covers, covers, faceplates, chargers, neck straps or cords.

Costs

52. As the opponent has been largely successful it is entitled to a contribution towards its costs. Awards of costs in proceedings are governed by Annex A of Tribunal Practice Notice (“TPN”) 2 of 2016. Applying the above guidance but making a “rough and ready” reduction to what I would have otherwise awarded to the opponent to reflect the measure of the applicant’s success, I award costs to the opponent on the following basis:

Filing the Notice of opposition and reviewing the counterstatement:	£170
Official fee:	£100
Written submissions:	£260
Total:	£530

53. I order Syed Mohsin Zulfiqar Bukhari to pay to Zia Maria Holding B.V. the sum of **£530**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 17th day of April 2020

C J BOWEN

For the Registrar