

O/428/20

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003393740 BY
RAINBOW MODERN HOUSEWARES LTD
TO REGISTER:

Rainbow Original
The logo features the word 'Rainbow' in a serif font, followed by 'Original' in a smaller serif font. A decorative banner is positioned below 'Rainbow', containing the word 'Original' in a cursive script.

AS A TRADE MARK IN CLASS 21

AND

IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 417486 BY
THE GUIDE ASSOCIATION

BACKGROUND AND PLEADINGS

1. On 21 April 2019, Rainbow Modern Housewares Ltd (“the applicant”) applied to register the following trade mark in the UK:

 Rainbow Original

2. The application was published for opposition purposes on 10 May 2019 and registration is sought for the following goods:

Class 21: Thermos flasks; Thermally insulated containers for food; Heat-insulated containers for beverages; Insulating flasks; Vacuum bottles; Beer mugs; Jugs; Pitchers; Bottles; Cups; Drinking bottles for sports.

3. On 29 August 2019, the application was opposed by The Guide Association (“the opponent”). The opposition is based on section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent initially relied on the following series’ of trade marks:



UK registration no. 3035732

Filing date 19 December 2013; registration date 19 September 2014.

Relying on some goods namely:

Class 21: Household or kitchen utensils or containers (not of precious metals or coated therewith); glassware; porcelain and earthenware not included in other classes; chinaware; plates; bowls; cups; egg cups; insulated mugs; water bottles.

("the earlier registration");

and

RAINBOWS

RAINBOW

Rainbows

Rainbow

UK registration no. 2033809

Filing dated 14 September 1995; registration date 13 December 1996.

Relying on some goods namely:

Class 21: Household, kitchen or camping utensils and containers; mugs; cups and saucers; glassware, porcelain and earthenware.

("the 809 registration").

4. In its counterstatement, the applicant initially put the opponent to proof of use of the 809 registration. However, on 20 January 2020 the opponent wrote to this Office and stated the following:

"The opponent hereby requests amendment to the grounds of opposition, namely for the claim under Section 5(2)(b) in respect of UK Registration No. 2033809 RAINBOW/RAINBOWS (series of 4) to be removed in its entirety. This is with a view to the opposition proceedings going ahead in respect of the grounds claimed under Section 5(2)(b) in relation to the Opponent's earlier UK Registration No. 3035732 RAINBOWS logo (series of 2) only.

5. In response to this, this Office wrote to the opponent on 22 January 2020 stating that:

“Your request to remove the earlier mark UK00002033809 has been noted and this mark has been removed from the opposition. As the opposition is based on Section 5(2)(b) only and proof of use is no longer required, the opposition will hereby proceed.”

6. On the same date, this Office also wrote to the applicant on similar terms, stating:

“The opponent’s request to remove the earlier mark UK00002033809 has been noted and this mark has been removed from the opposition. As the opposition is based on Section 5(2)(b) only and proof of use is no longer required, the opposition will hereby proceed.”

7. As a result of the above, the opponent no longer relies on the 809 registration in its opposition. This means that the opponent is no longer required to provide evidence regarding proof of use of the 809 registration. The opponent relies on the earlier registration only on the basis of section 5(2)(b) of the Act.

8. In its amended Notice of Opposition, the opponent states that the applicant’s mark should be refused registration on the basis that it is visually and aurally highly similar to the earlier registration. Further, the opponent argues that there exists a likelihood of confusion, including a likelihood of association, on the part of the UK public between the earlier registration and the applicant’s mark.

9. The applicant filed a counterstatement denying the claims made.

10. The opponent is represented by Isabelle Bertaux and the applicant is represented by Bates Wells & Braithwaite London LLP. Neither party has filed evidence. No hearing was requested and both parties have filed written submissions in lieu of a hearing. I have taken the written submissions into consideration and will refer to them below where necessary. This decision is taken following a careful perusal of the papers.

DECISION

Section 5(2)(b): legislation and case law

11. Section 5(2)(b) of the Act reads as follows:

“(2) A trade mark shall not be registered if because-

(a) ...

(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 or association with the earlier trade mark.”

12. Section 5A of the Act states as follows:

“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.”

13. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“(6)(1) In this Act an “earlier trade mark” means –

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

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

14. The earlier registration qualifies as an earlier trade mark under the above provisions. As the earlier registration had not completed its registration process more than 5 years before the date of the application in issue, it is not subject to proof of use pursuant to section 6A of the Act. The opponent can, therefore, rely upon all of the goods for which the marks are registered.

15. 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 Office for Harmonization in the Internal Market (Trade Marks and Designs) (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 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

16. The competing goods are set out as follows:

The earlier registration's goods	The applicant's mark's goods
<p data-bbox="252 472 379 506"><u>Class 21</u></p> <p data-bbox="252 580 810 943">Household or kitchen utensils or containers (not of precious metals or coated therewith); glassware; porcelain and earthenware not included in other classes; chinaware; plates; bowls; cups; egg cups; insulated mugs; water bottles.</p>	<p data-bbox="831 472 959 506"><u>Class 21</u></p> <p data-bbox="831 580 1385 891">Thermos flasks; Thermally insulated containers for food; Heat-insulated containers for beverages; Insulating flasks; Vacuum bottles; Beer mugs; Jugs; Pitchers; Bottles; Cups; Drinking bottles for sports.</p>

17. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. 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 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”.

18. 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.

19. The General Court (“GC”) confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, that, even if goods or services are not worded identically, they can still be considered identical if one term falls within the scope of another or (vice versa):

“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”.

20. In its counterstatement, the applicant admitted that “some of the goods are similar and relate to same category of products as for example the term “cups” or “bottles”.” The applicant, however, did dispute the identity or similarity of the remaining goods.

21. In its written submissions, the opponent submits that:

"The Applicant submits that aside from the goods "Bottles" and "Cups" that are admitted to be similar, the remaining goods covered by the Application are dissimilar as they have a different nature, purpose and method of use to the goods covered by the Opponent's earlier Rainbows Marks.

The Opponent submits that the Applicant's assessment of the goods is wholly incorrect as it is based on broad assumptions regarding the nature and intended purpose of the goods at issue that are clearly wrong. The Applicant's arguments should therefore be dismissed in their entirety.

The Opponent submits the Contested Goods should be found identical or highly similar to the goods covered by the Rainbows Marks. The goods in both cases are essentially receptacles for enabling the consumption or transportation of food or drink. The Opponent believes it is also important to address the Applicant's following two specific points raised regarding the similarity of the goods.

Whilst the Contested Goods may include those which may be 'thermally insulated' or 'vacuum', it does not alter the fact the goods have the same intended nature and purpose of transporting or aiding consumption of food and drink. The goods are therefore likely to be sold through the same trade channels or be found in the same section within a shop. The end consumer would also be the same, i.e. a person looking to buy items which will aid the transport or consumption of food or drink. In line with this the Opponent's goods should be found identical or highly similar. Further, the Applicant appears to have overlooked that the Opponent's goods include "insulated mugs", which have the same specific function of maintaining the temperature of the food or drink contents, and are therefore identical or closely similar to "Thermos flasks: Thermally insulated containers for food; Heat-insulated containers for beverages: Insulating flasks: Vacuum bottles" contained under the Application;

The Applicant also submits that "Vacuum bottles" and "Bottles for sports" should be found dissimilar to "Water bottles" covered by the Opponent's earlier

rights based on a misconception that the Opponent's goods are somewhat limited to 'porcelain and earthenware products'. The Opponent's specification clearly provides protection for "water bottles" without any such limitation to these goods being made from porcelain or earthenware. In any event the material base of the products would not alter the fact that "Water bottles" encompasses bottles used for sports purposes intended to contain water or vacuum based bottles that could be used to keep water cool. Therefore "Vacuum bottles" and "Bottles for sports" should be found identical to the Opponent's goods.

Considering the above points, it is clear that the Rainbows Marks relied on in these proceedings cover goods which are identical to, or at the very least highly similar to, the Contested Goods. It is submitted that in view of the close similarity between the trade marks and the identity or close similarity of the goods at issue, a likelihood of confusion is clear and inevitable. The Opponent's opposition under Section 5(2) should therefore be successful."

21. In its written submissions, the applicant states:

"The Applicant can admit that some of the goods are similar and relate to same category of products as for example the term "cups" or "bottles".

However, the Applicant disputes that the other goods covered by the Applicant's trademark application are similar.

As mentioned above, goods are not regarded as being similar from each other only on the ground that they appear in the same class.

[...]

Those goods in question have a different nature, purpose and method of use which provide difference between the covered goods.

Hence, the function and the destination of these goods are different.

The Opponent argues that the Contested Goods should be found identical or highly similar to the goods covered by the Opponent's Marks as the goods in both cases are essentially receptacles for enabling the consumption or transportation of food or drink.

However, as mentioned previously, the Applicant considers that the goods in the earlier trademarks cannot be confused with the goods "*Thermos flasks; Thermally insulated containers for food; Heat-insulated containers for beverages, vacuum bottles*" as they have the specific function of heating or maintain the temperature of the beverage or the food.

Also, the destination of the "vacuum bottles" or "bottles for sports" covered by the Applicant's mark is different to the "water bottles" covered by the Opponent's trademark, being specified that the goods covered by the Opponent's marks are related to precious metal, *porcelain and earthenware's* products.

In conclusion, most of the goods covered by the Applicant's trademark cannot be confused with the goods covered by the Opponent's trademarks.

And even if a similarity can be found between the goods or some of the goods, this similarity is not sufficient to offset the differences between the signs and to establish a likelihood of confusion in the present case."

22. I note that the applicant admits that there is a level of similarity between "bottles" and "cups" in its specification with "cups" and "water bottles" in the earlier registration's specification, however, it has not clarified to what level they consider them to be similar. I must therefore carry out my own assessment in respect of these goods.

23. "Cups" in the applicant's mark's specification has a direct counterpart in the earlier registration. These goods are identical.

24. “Thermos flasks” and “insulating flasks” in the applicant’s mark’s specification describe a specific type of container that will hold a liquid and also maintain its temperature for a prolonged period of time. Flasks are not considered types of mugs and, therefore, these goods do not fall within the category of “insulated mugs” in the earlier registration’s specification. However, these goods will share user, nature and purpose in that they describe different types of insulated containers for transporting and maintaining the temperature of all kinds of beverages. These goods will also have a competitive relationship in that a consumer may choose to purchase an insulated flask over an insulated mug and vice versa. These goods will also be found in the same sections of shops and their online equivalents. Further, the same undertaking is likely to sell insulated flasks and mugs. These goods are, therefore, similar to a high degree.
25. “Insulated mugs” in the earlier registration describes a container that is used to hold various types of beverages. These goods are insulated so as to maintain the beverages’ temperature. Given that an insulated mug is a type of heat-insulated container, these goods fall within the category of “heat-insulated containers for beverages” in the applicant’s marks specification and are therefore identical under the principle outlined in *Meric*. Even where the term covered by the applicant’s specification includes goods that are not insulated mugs, there will still be overlap in user, use, method of use, nature and trade channels and the goods will be highly similar.
26. “Beer mugs” in the applicant’s mark’s specification commonly refers to a type of large glass that is shaped like a mug and has a glass handle. As the term specifies, it is used for drinking beer. Given that these goods are commonly made of glass, they fall within the category of “glassware” in the earlier registration’s specification. These goods will therefore be identical under the principle outlined in *Meric*. Even where they are not made of glass, they will overlap in user, method of use, purpose and trade channels with the equivalent goods covered by the term “glassware” in the earlier registration’s specification. There may be a degree of competition between them. Consequently, they will be highly similar.

27. “Household or kitchen utensils or containers (not of precious metals or coated therewith)” in the earlier registration’s specification describes a wide range of goods that includes (but is not limited to) spatulas, ladles, jugs and various types of plastic food containers. Given that “jugs” and “pitchers” describe large containers for holding liquids that are commonly made of plastic or glass, they will fall within the category of “household or kitchen utensils or containers (not of precious metals or coated therewith)” in the earlier registration’s specification. These goods will therefore be identical under the principle outlined in *Meric*.
28. “Bottles” in the applicant’s mark’s specification covers a wide range of types of bottles. Bottles are commonly sold as plastic or glass bottles. Insofar as the applicant’s mark’s specification describes glass bottles, these goods will fall within the category of “glassware” in the earlier registration’s specification. They will therefore be identical under the principle outline in *Meric*. However, bottles sold in plastic form (or other materials) will commonly be used to consume water or other types of cold drinks. “Water bottles” in the earlier registration’s specification will fall within this broader category. These goods will also therefore be identical under the principle outlined in *Meric*.
29. “Drinking bottles for sports” in the applicant’s mark’s specification describes a type of bottle that is commonly (although not always) made of plastic and is designed in a way so that it is easy to transport or carry when the user is participating in sports. These goods will be used to consume water and other types of cold drinks. “Water bottles” in the earlier registration’s mark will also be used to consume water and, despite having water in its name, will be used to consume other types of cold drinks. Therefore, these goods will fall within the category of “water bottles” in the earlier registration’s mark. These goods will therefore be identical under the principle outlined in *Meric*.
30. “Vacuum bottles” in the applicant’s mark’s specification describes a type of bottle that is lined with two separate walls. Between these walls, there is a vacuum, hence the name vacuum bottles. The purpose of the vacuum is to prevent heat moving between the walls and as a result, the liquid within the bottle maintains its temperature. Vacuum bottles are, therefore, insulated bottles. A bottle is not

considered a type of mug meaning that these goods do not fall within the category of “insulated mugs” in the earlier registration’s specification. However, these goods will share user, method of use, nature and purpose in that they describe different types of insulated containers for transporting and maintaining the temperature of all kinds of beverages. These goods will also have a competitive relationship in that a consumer may choose to purchase a vacuum bottle over an insulated mug and vice versa. These goods will also be found in the same sections of shops and their online equivalents. Further, the same undertaking is likely to sell insulated mugs and vacuum bottles. These goods are, therefore, similar to a high degree.

31. “Thermally insulated containers for food” can describe a number of different types of thermal containers that are used to store food and maintain its temperature. Given that these goods are containers for food, they will fall within the broader category of “household or kitchen utensils or containers (not of precious metals or coated therewith)” in the earlier registration’s specification. These goods will therefore be identical under the principle outlined in *Meric*. However, if I am wrong in my finding that these goods are identical, then they will overlap in user, nature and purpose with “insulated mugs”. The main purpose of these goods will be to keep their contents at a certain temperature. Their nature will be the same in that they are both insulated containers. Further, they will overlap in trade channels as an undertaking that produces insulated mugs is also likely to produce insulated food containers. These goods will therefore be similar to at least a medium degree.

The average consumer and the nature of the purchasing act

32. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods. I must then decide the manner in which these goods 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.”

33. The opponent submits that “The relevant consumer in this case is the general public at large and average consumer within the UK.” I do not have any submissions from the applicant regarding the average consumer. I agree with the opponent in that the average consumer for the goods at issue will be a member of the general public in the UK.

34. The goods at issue cover a wide range of kitchen and homeware together with other forms of receptacles used for consuming food and/or drink. The goods will be found in various types of shops such as supermarkets and kitchen/homeware specialists and their online equivalents. The goods at issue will be displayed on shelves, where they will be viewed and self-selected by the consumer. A similar process will apply to websites, where the consumer will select the goods having viewed an image displayed on a webpage. While the visual aspect plays a greater role in the selection process, I do not discount aural consideration in the form of word of mouth recommendations and advice sought from shop assistants.

35. The purchase of the goods at issue will range in price but are likely to be fairly low in cost. The purchase of the goods at issue are likely to be fairly infrequent. When selecting the goods, the average consumer is likely to consider such things as design, materials used, form of insulation and colour. The consumer is, therefore, likely to pay a medium degree of attention during the selection process.

Distinctive character of the earlier registration

36. 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 Windsurfing Chiemsee 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).”

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

38. When making its submissions regarding the distinctive element of the marks, the opponent submits that “the dominant and distinctive element in each case is the identical word ‘Rainbow(s)’”. The applicant submits that:

“The distinctiveness of the earlier marks is one of the factors to be taken into account in the global assessment of likelihood of confusion.

No evidence is submitted by the Opponent to prove any distinctive character of the Opponent's trademarks.

Therefore, the distinctiveness of the earlier mark must be seen as average.”

39. I note the comment from the applicant that the opponent has filed no evidence to suggest that the distinctiveness of the earlier registration has been enhanced through use. I have, therefore, only the inherent position to consider. I must make an assessment on the inherent distinctiveness of the earlier registration as a whole.

40. The earlier registration consists of a series of two marks. Both of which contain two elements, being a word and a device element. The word element consists of the word ‘Rainbows’ in a slightly stylised font. The device element sits above the letter ‘i’ where, instead of a typical dot, there begins a three-tiered stripe device that arches to the left and finishes to the left of the letter ‘R’ at the start of the mark. The first in the series of marks is in black and white, whereas the second in the series of marks consists of red font and the three-tiered stripe device consists of three colours, which are, from top to bottom, red, yellow and blue.

41. The word ‘Rainbows’ is plural of the word ‘rainbow’. A rainbow is a bow-shaped display in the sky of the colours of the spectrum that is caused by the refraction and reflection of the sun’s ray through rain or mist.¹ When viewed on the opponent’s goods, the word ‘Rainbows’ will be taken to have its ordinary dictionary meaning by average consumers. It has no connection to the goods for which the earlier registration is registered so will be neither allusive nor descriptive. The word ‘Rainbows’ will, therefore, have a medium degree of distinctiveness.

¹ <https://www.collinsdictionary.com/dictionary/english/rainbow>

42. As above, the device element is a three-tiered striped device. In my view, when used alongside the word RAINBOW, this will be viewed as a stylised image of a rainbow. I note that in the first mark of the series, it does not contain any colour, however, I am of the view that it will still be viewed as a rainbow by average consumers. As with the word 'Rainbows' above, the rainbow device will have no connection to the goods for which the earlier registration is registered. The rainbow device further connects the earlier registration to the word 'Rainbows' and will contribute to the distinctiveness of the marks, as will the stylisation used. Overall, I find that the earlier registration has a higher than medium degree of inherent distinctive character.

Comparison of marks



43. It is clear from *Sabel 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 the trade marks, bearing in mind their distinctive and dominant components.

44. 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.”

45. 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.

46. The respective trade marks are shown below:

Opponent's trade marks (series of 2)	Applicant's trade mark
 <p data-bbox="349 792 700 831">('the earlier registration')</p>	 <p data-bbox="940 804 1262 842">('the applicant's mark')</p>

47. I have lengthy submissions regarding the comparison of the marks from both parties that I do not intend to reproduce here, however, I will refer to them below if necessary.

Overall Impression

The applicant's mark

48. The applicant's mark consists of a word and a device element. The word element consists of the words 'Rainbow Original' and the word 'Original' repeated. The word 'Rainbow' will be seen by the average consumer as a reference to a rainbow but will not be viewed as either allusive or descriptive of the goods for which the applicant seeks protection. The word 'Original' will be seen to indicate that the products offered by the applicant are original products, in the sense of being early or first versions of something. As a result, I am of the view that the word 'Original' will play a lesser role in the overall impression of the applicant's mark.

49. The words 'Rainbow Original' are displayed in a large, slightly stylised font with the repeated 'Original' displayed in a smaller, slightly stylised font below the letters 'B-O-W'. The device element is a small white ribbon or banner device with

a black border that sits below the letters 'R' and 'a' in the word Rainbow. The repeated word 'Original' sits within the device element. While the device element is noticeable, I am of the view that the eye is naturally drawn to the elements of the mark that can be read. I, therefore, consider the word 'Rainbow' plays a greater role in the overall impression of the mark, with the words 'Original', the stylisation and the device (and repeated word 'Original') element playing a lesser role.

The earlier registration

50. The earlier registration consists of the word 'Rainbows' and a device element, which is likely to be seen as a rainbow. The fact that one of the series of the mark is in colour and the other is not does not affect the overall impression of the registration. While the device element is noticeable and reinforces the reference to a rainbow, I am of the view that the eye is naturally drawn to the elements of the mark that can be read. I, therefore, consider the word 'Rainbows' to play a greater role in the overall impression of the mark, with the device element and stylisation playing a lesser role.

Visual Comparison

51. The opponent submits that:

"The contested Application consists of the words "Rainbow" and "Original" in a larger font, along with the word "Original" in a smaller font set within a banner device presented in an arch like formation beneath. A standard font is used for all verbal elements. The word "Original" is set apart from the initial element "Rainbow", which serves to further distinguish its secondary role played in the mark. Whilst the Application is a figurative mark the stylisation is minimal to the extent the visual appeal of the mark rests with the verbal elements. The word "Original" is considered non-distinctive as it is commonly used in marketing to refer to the authenticity of a product, or the fact it is the initial product in a range of products. This additional verbal element would therefore not serve to differentiate or reduce the similarity between the marks.

Therefore, the dominant and distinctive element in the Application is clearly the word "Rainbow" presented in title case.

By comparison, the Opponent's earlier rights relied on commonly consist of the word "Rainbows" in a broadly standard font presented in title case. Whilst the marks are figurative, both have minimal stylisation as they presented along with a simple arch device. Whilst the second mark in the series is presented in colour it is predominantly shown in a dark shade of red. The addition of the end letter "S" would most likely be seen to purely refer to a plural of the word and mostly go unnoticed. Further, it has been established where the only difference lies between the singular or plural version of a word this difference is not enough for the public to be able to distinguish between the marks (*Origins Natural Resources Inc. vs Origin Clothing Ltd [1995] FSR 280*). It is therefore apparent that both sets of marks contain the identical word "Rainbow(s)" presented in title case, a non-fanciful font and similar dark hue of colour, along with an arch shaped device.

Considering the dominant and distinctive element in each case is the identical word "Rainbow(s)", conceptually both marks are identical and would be understood to refer to "an arch of colours visible in the sky". The arch shape devices in both marks would serve to further establish this conceptual notion."

52. The applicant submits that:

"the trademarks at issue are somewhat a little bit similar, only to the extent that they use the same common word "Rainbow", albeit used in the composed sentence "Rainbow Original" for the Applicant's trademark and used on its own for the Opponent's trademarks. This being reminded, the word "Rainbow" has to be taken in consideration in the Applicant's trademark in its entirety and is not any way dominant in the Applicant's trademark.

Clearly, what will distinguish the signs for the relevant public is the trademark in its entirety with all the words included in both trademarks,

namely "Rainbow Original (repeated twice)" for the Applicant's Trademark and "Rainbow(s)" (only) for the Opponent's Trademarks. And contrary to what the Opponent argues the word "Rainbow" and the word "Original" are at the same level in the Applicant's trademark, the typeface is the same, same size, and the word "Original" is used twice which shows that this word as its great importance in the Applicant's trademark.

Indeed, the fact that the word "Original" is repeated twice in the Applicant's trademark shows that this word has a dominant place in the disputed trademark and should not be considered as playing a secondary role in the mark as wrongly argued by the Opponent."

53. Visually, the marks coincide in that they both contain the word 'Rainbow'. The marks differ in that the earlier registration has the letter 's' at the end of the word 'Rainbow', indicating that it is a reference to rainbow in the plural. The applicant's mark has the word 'Original', repeated twice, that is not present in the earlier registration. The word elements of the marks are presented in different fonts. The earlier registration features a rainbow device (in either black and white or in colour) that is not present in the applicant's mark. Further, the applicant's mark contains a ribbon device that is not present in the earlier registration. While I have found that the device elements in the marks and the word 'Original' in the applicant's mark play a lesser role in the respective marks, they still constitute visual differences between the marks. Taking all of this into account, I find that the marks are visually similar to a medium degree.

Aural Comparison

54. The applicant submits that:

"the earlier marks will be pronounced as [RAIN-BOWS] and the Applicant's sign as [RAIN-BOW O-RI-GI-NAL].

The marks at stake are therefore phonetically different since the Applicant's mark uses the other word "Original".

The earlier marks are composed of one word with two syllables when the Applicant's trademark is composed of two words with six syllables.

The Opponent's trademarks "Rainbows" will therefore be pronounced rapidly, straight away contrary to the Applicant's trademark which will be pronounced in two parts "Rainbow" and "Original" with a pause between "Rainbow" and "Original" and with the possibility to pronounce twice the word "Original".

55. Aurally, the earlier registration will consist of two syllables that will be pronounced 'RAIN-BOWS'. The device element will not be pronounced. The applicant's mark consists of six syllables that will be pronounced 'RAIN-BOW-ORR-IDG-INN-UHL'. The device element will not be pronounced. I am of the view that the word 'Original' will not be pronounced twice. I do not agree with the applicant's submissions that the earlier registration will be pronounced rapidly and find that the shared element, being the word 'RAIN-BOW' will be pronounced identically, save for the inclusion of the letter 's' in the earlier registration.

56. As noted above, I have found that the word 'Original' plays a lesser role in the applicant's mark. I conclude that if the word 'Original' in the applicant's mark is not pronounced (given its allusive significance) then the marks will be aurally similar to a very high degree. If the word 'Original' is pronounced, then the marks will be aurally similar to a medium degree.

Conceptual Comparison

57. The opponent submits that:

"Considering the dominant and distinctive element in each case is the identical word "Rainbow(s)", conceptually both marks are identical and would be understood to refer to "an arch of colours visible in the sky". The arch shape devices in both marks would serve to further establish this conceptual notion."

58. The applicant submits that:

“Rainbow' will be understood as the *"an arch of colors visible in the sky, caused by the refraction and dispersion of the sun's light by rain or other water droplets in the atmosphere"* and 'Original' will be understood as *'created personally'*.

Therefore, the Applicant's trademark "Rainbow Original" has a semantic content, namely as meaning "an original rainbow".

The Opponent's trademarks are only composed by the word 'Rainbow' so it means only the arch of colors but not associated to any adjective as the one used in the Applicant's trademark and which gives a specific meaning to the Applicant's sign.

It is concluded from the explanations above that the Applicant mark will be perceived as having a specific concept describing the rainbow as being original.

Therefore, the signs have conceptual differences.”

59. In assessing the distinctive character of the earlier registration and the overall impression of the applicant's mark, I have found that average consumers would view the word 'Rainbows' and 'Rainbow' on their respective marks to have their ordinary dictionary meaning. The device element in the earlier registration provides a further connection to a rainbow. The device element in the applicant's mark conveys no conceptual meaning. The words 'Rainbows' and 'Rainbow' on their respective marks will be conceptually at least highly similar.

60. I disagree with the applicant's submissions that the word 'Original' on the goods covered by the applicant's specification will be taken to mean 'created personally'. Instead, I find that it will convey to the average consumer that the goods offered under the mark are early or first versions of the goods. While I have found it plays a lesser role in the overall impression of the applicant's mark, it will act as a point of conceptual difference between the marks. Overall, I find that the conceptual meaning conveyed by the marks as a whole is similar to a higher than medium degree.

Likelihood of confusion

61. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where 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 necessary for me to keep in mind the distinctive character of the earlier registration, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to 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 that he has retained in his mind.

62. I have found the goods at issue to range from being identical to being similar to at least a medium degree. I have found the average consumer for the goods at issue to be a member of the general public. The goods will be purchased by primarily visual means, although I do not discount an aural component. I have concluded that a medium degree of attention is likely to be paid in the purchasing process. I have taken these factors into account in my assessment of likelihood of confusion between the marks.

Direct Confusion

63. I have found the marks to be visually similar to a medium degree, aurally similar to a very high degree or a medium degree (depending on whether the word 'Original' is pronounced) and conceptually similar to a higher than medium degree. The earlier registration has a higher than medium degree of inherent distinctive character. Notwithstanding the principle of imperfect recollection and taking all of the above factors into account, I consider that the visual differences

between the marks and the presence of the word 'Original' twice in the applicant's mark will be sufficient to enable the consumer to differentiate between the marks. This will particularly be the case given the importance of the visual component in the selection of the goods at issue and in circumstances in which the consumer will be paying a medium degree of attention. Consequently, I do not consider there to be a likelihood of direct confusion between the marks, even when they are used on goods that are identical.

Indirect Confusion

64. I will now consider whether there is a likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C., sitting as the Appointed Person in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10.

“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.”

65. I must now consider the possibility of indirect confusion and whether average consumers would believe that there is an economic connection between the marks or that they are variant marks from the same undertaking as a result of the shared common elements of the marks.

66. Even if the word 'Original' in the applicant's mark is noticed by the average consumer, I have found that it is likely to be seen as allusive to the fact that the

brand offers original goods i.e. goods that are early or first versions. In my view, the difference between the words 'Rainbows' in the earlier registration and 'Rainbow' in the applicant's mark, being the inclusion of the letter 's', will be overlooked by the average consumers. I consider that the presence of the word 'Original' in the applicant's mark and the difference in presentation styles between the marks (such as the typeface used and the device elements) will likely be seen as indicating a sub-brand (such as retro style products or the original product range offered by the undertaking). The differences in stylisation and presentation of the marks will simply be seen as an alternative mark being used by the same or economically linked undertakings. Taking all of the above into account, I consider there to be a likelihood of indirect confusion for all goods against which the opposition is directed.

CONCLUSION

67. The opposition succeeds in its entirety and the application is refused.

COSTS

68. The opponent has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the opponent the sum of **£600** as a contribution towards the costs of proceedings. The sum is calculated as follows:

Filing a notice of opposition and considering the applicant's counterstatement:	£200
Preparing written submissions in lieu:	£300
Official fee:	£100
Total:	£600

69. I therefore order Rainbow Modern Housewares Ltd to pay the Guide Association the sum of £600. 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 8th day of September 2020

**A COOPER
For the Registrar**