

BL O/895/21

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION 3586661

BY

MINED LONDON LTD

TO REGISTER THE FOLLOWING TRADE MARK:



AND

OPPOSITION NO. 60001758 THERETO

BY

MYNE LONDON LTD

Background and pleadings

1. On 28 January 2021, MINED LONDON LTD (the “applicant”) applied to register the trade mark shown on the cover of this decision. The contested trade mark application was accepted and published for opposition purposes in the Trade Marks Journal on 28 May 2021. Registration of the mark is sought in respect of the following goods:

Class 14 *Jewellery*

2. On 3 June 2021, Myne London Ltd (the “opponent”) filed a Fast Track opposition. The opponent opposed the application under Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), on the basis of its earlier United Kingdom Trade Mark (UKTM):

MYNE
LONDON

Applied for on 9 March 2019, and registered on 22 June 2018

3. In this opposition, the opponent chose to rely only on the Class 14 goods for which the mark is registered, i.e.:

Class 14 *Jewellery (Paste -); Jewellery articles; Jewellery being articles of precious metals; Jewellery being articles of precious stones; Jewellery boxes; Jewellery boxes [fitted]; Jewellery boxes and watch boxes; Jewellery boxes of precious metal; Jewellery boxes of precious metals; Jewellery brooches; Jewellery cases; Jewellery cases [caskets or boxes]; Jewellery cases [caskets]; Jewellery cases [caskets] of precious metal; Jewellery cases [fitted]; Jewellery cases of precious metal; Jewellery caskets; Jewellery caskets of precious metal; Jewellery chain; Jewellery chain of precious metal for anklets; Jewellery chain of precious metal for bracelets; Jewellery chain of precious metal for necklaces; Jewellery chains; Jewellery charms; Jewellery coated with precious metal alloys; Jewellery coated with precious metals; Jewellery*

containing gold; Jewellery fashioned from bronze; Jewellery fashioned from non-precious metals; Jewellery fashioned of cultured pearls; Jewellery fashioned of precious metals; Jewellery fashioned of semi-precious stones; Jewellery findings; Jewellery foot chains; Jewellery for personal adornment; Jewellery for personal wear; Jewellery in non-precious metals; Jewellery in precious metals; Jewellery in semi-precious metals; Jewellery in the form of beads; Jewellery incorporating diamonds; Jewellery incorporating pearls; Jewellery incorporating precious stones; Jewellery items; Jewellery made from gold; Jewellery made from silver; Jewellery made of bronze; Jewellery made of crystal; Jewellery made of crystal coated with precious metals; Agate as jewellery; Amber pendants being jewellery; Amberoid pendants being jewellery; Amulets [jewellery, jewelry (Am.)]; Amulets [jewellery]; Amulets being jewellery; Articles of imitation jewellery; Articles of jewellery; Articles of jewellery coated with precious metals; Articles of jewellery made from rope chain; Articles of jewellery made of precious metal alloys; Articles of jewellery made of precious metals; Articles of jewellery with ornamental stones; Articles of jewellery with precious stones; Artificial jewellery; Beads for making jewellery; Body costume jewellery; Body jewellery; Bracelets [jewellery, jewelry (Am.)]; Bracelets [jewellery]; Bracelets made of embroidered textile [jewellery]; Brooches [jewellery, jewelry (Am.)]; Brooches [jewellery]; Cabochons for making jewellery; Cases adapted to contain items of jewellery; Chain mesh of precious metals [jewellery]; Chains [jewellery, jewelry (Am.)]; Chains [jewellery]; Chains made of precious metals [jewellery]; Charms [jewellery, jewelry (Am.)]; Charms [jewellery]; Charms [jewellery] of common metals; Charms for jewellery; Clasps for jewellery; Clips of silver [jewellery]; Cloisonne jewellery; Cloisonné jewellery; Cloisonné jewellery [jewelry (Am.)]; Collets being parts of jewellery; Costume jewellery; Crosses [jewellery]; Crucifixes as jewellery; Crucifixes of precious metal, other than jewellery; Decorative articles [trinkets or jewellery] for personal use; Decorative brooches [jewellery]; Decorative pins [jewellery]; Dress ornaments in the nature of jewellery; Ear ornaments in the nature of jewellery; Enamelled jewellery; Facial

jewellery; Fake jewellery; Fashion jewellery; Gold jewellery; Gold plated brooches [jewellery]; Gold thread [jewellery, jewelry (Am.)]; Gold thread [jewellery]; Hat jewellery; Imitation jewellery; Imitation jewellery ornaments; Items of jewellery; Ivory [jewellery, jewelry (Am.)]; Ivory jewellery; Jade [jewellery]; Key chains as jewellery [trinkets or fobs]; Key chains for use as jewellery; Lapel pins [jewellery]; Lapel pins of precious metals [jewellery]; Lockets [jewellery, jewelry (Am.)]; Lockets [jewellery]; Medallions [jewellery, jewelry (Am.)]; Necklaces [jewellery, jewelry (Am.)]; Necklaces [jewellery]; Ornaments [jewellery, jewelry (Am.)]; Ornaments [jewellery]; Parts and fittings for jewellery; Paste jewellery; Paste jewellery [costume jewelry (Am.)]; Paste jewellery [costume jewelry (Am.)]; Pearls [jewellery, jewelry (Am.)]; Pearls [jewellery]; Pendants [jewellery]; Personal jewellery; Pewter jewellery; Pins [jewellery, jewelry (Am.)]; Pins [jewellery]; Pins being jewellery; Plastic costume jewellery; Jewellery; Jewellery made of glass; Jewellery made of non-precious metal; Jewellery made of plastics; Jewellery made of plated precious metals; Jewellery made of precious metals; Jewellery made of precious stones; Jewellery made of semi-precious materials; Jewellery of precious metals; Jewellery of yellow amber; Jewellery plated with precious metals; Jewellery products; Jewellery rolls; Jewellery rope chain for anklets; Jewellery rope chain for bracelets; Jewellery rope chain for necklaces; Jewellery stones; Jewellery watches; Jewellery, clocks and watches; Jewellery, including imitation jewellery and plastic jewellery; Precious jewellery; Presentation boxes for jewellery; Ring bands [jewellery]; Rings [jewellery, jewelry (Am.)]; Rings [jewellery]; Rings [jewellery] made of non-precious metal; Rings [jewellery] made of precious metal; Rings being jewellery; Rope chain [jewellery] made of common metal; Semi-finished articles of precious metals for use in the manufacture of jewellery; Semi-finished articles of precious stones for use in the manufacture of jewellery; Shoe jewellery; Silver thread [jewellery, jewelry (Am.)]; Silver thread [jewellery]; Small jewellery boxes of precious metals; Sterling silver jewellery; Synthetic stones [jewellery]; Threads of precious metal [jewellery, jewelry (Am.)]; Threads of precious metal [jewellery]; Trinkets [jewellery, jewelry (Am.)];

*Trinkets [jewellery]; Wire of precious metal [jewellery, jewelry (Am.)];
Wire of precious metal [jewellery]; Wooden jewellery boxes; Wristlets
[jewellery].*

4. Since its filing date predates that of the contested application, the opponent's mark is an "earlier mark" in accordance with section 6 of the Act. However, as it had not been registered for five years or more before the filing date of the application, it is not subject to the use requirements specified within section 6A of the Act. As a consequence, the opponent may rely upon any or all of the goods for which the earlier mark is registered without having to show that it has used the mark at all.

5. The claim is based on the parties' goods being identical or similar, and a similarity between the respective marks. The notice of opposition expressed the claim in the following terms:

"We believe that it is too similar to our brand name and particularly using the word London. We are a London brand but this company is based in Nottingham."

6. On 29 July 2021, the applicant filed a counterstatement denying the grounds of opposition in the following terms:

"We have a brand that I believe is completely different from the opponent. Our jewellery is specific styling, a completely different price bracket and [are] marketed to a completely different audience.

Also, the branding and wording is completely different! The only similarity is that the word London is under the word. I just cant see how [anybody] is going to get these mixed up!! Our brand is bold and clean."

7. Neither side filed evidence, nor did either side file written submissions.

8. Neither party is professionally represented.

9. No hearing was requested and so this decision is taken following a careful perusal of the papers.

Decision

Section 5(2)(b)

10. Section 5(2)(b) of the Act is as follows:

5(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 of association with the earlier trade mark”.

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

(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.

12. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

Comparison of goods

13. The parties' respective specifications are:

Earlier mark	Application
Class 14: <i>as set out in paragraph 3.</i>	Class 14: <i>Jewellery.</i>

14. It has been established by the General Court (GC) in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, that:

“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. The general category term *Jewellery* under the contested mark clearly encompasses goods under the earlier mark – for instance *Jewellery (Paste -)*; *Jewellery articles*; *Jewellery for personal wear*. I therefore find the goods at issue to be identical.

Comparison of marks



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

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight

in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

17. It would be wrong, therefore, to dissect the trade marks artificially, 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.

18. The respective trade marks are shown below:

Earlier trade mark	Contested trade mark
	

19. The overall impression of the opponent’s earlier mark derives from two elements. The first element is the term ‘MYNE’. The letter ‘M’ has a degree more stylisation than the other letters in the term, insofar as it deviates from the standard typeface, with the second peak being lower than the first. The lettering of the term is in bold font, and the term is stacked above the second element, which is the word ‘LONDON’. The word ‘LONDON’ is noticeably smaller than the term ‘MYNE’, and occupies a centralised position in the space below it. Due to the term ‘MYNE’ being larger and stacked above the word ‘LONDON’, I consider it to be both the more eye-catching and dominant element. I also find the term ‘MYNE’ to be the distinctive aspect of the mark. This is because the word ‘LONDON’ is primarily recognised as the name of the capital city of England, and will therefore be perceived by the consumer as referencing the geographical location of the production/manufacture/provision of the contested goods, rather than being perceived as an element which indicates trade origin.

20. The contested mark contains two word elements. The first is the word 'MINED'. The word 'MINED' is in bold font, and is stacked above the second word element 'LONDON'. The term 'MINED' is somewhat allusive in respect of the contested goods. This is because the contested goods may contain precious stones and metals etc., which could have been '*mined*' from the ground. Still, the word is a fanciful word in respect of jewellery as such. The word 'LONDON' is again noticeably smaller than the word 'MINED', and again occupies a centralised position in the space below it. The considerations of descriptiveness that applied to the element 'LONDON' in the earlier mark also apply to the same element in the contested mark.

21. Above the letters 'N' and 'E' of the word 'MINED' is a figurative element, consisting of two pick axes that cross over one another, surrounded by a circle. The concept of a pick axe is also somewhat allusive in relation to the contested goods, as they are tools that can be used to dig out those precious stones and metals etc., which could then be used in the production of the contested goods. The word and figurative elements are imposed on a white strip in the middle of a black, elongated background. The black background is certainly noticeable as it occupies more space than the remaining elements. As such it must be considered to contribute to the overall impression. However, the black background is essentially banal, and therefore cannot be considered to be the dominant element of the trade mark despite its size. Due to the colour contrast caused by the white strip on the black background, the eye will naturally be drawn to the central word and figurative elements of the contested mark. The central section is therefore considered to be the more eye-catching. I find the figurative element and word 'MINED' that occupy the central section to jointly be the dominant elements of the contested mark. This is not only because they are the most visually and conceptually intriguing elements, but also because the remaining element 'LONDON' would primarily be perceived to be descriptive, which would effectively relegate its overall impact. I therefore consider the figurative element of the crossed pick axes and the word 'MINED' to be the (equally) most distinctive aspects.

Visual similarity

22. Visually, the respective marks both include the term 'LONDON', which is similarly positioned in each case. However, not only is 'LONDON' the much smaller word element in each of the two marks, thus diminishing its visual impact, but as I have

already commented on it has a secondary/“relegated” role in relation to the distinctive word elements ‘MYNE’ and ‘MINED’ respectively. Despite the stylisation differences, the marks also share the same 1st, 3rd and 4th letters of their respective elements ‘MYNE’ and ‘MINED’.

23. The marks differ as to the 2nd letter in each of the respective elements ‘MYNE’ and ‘MINED’. In addition, the contested mark has a 5th letter (that being a ‘D’), whilst the earlier mark only has 4 letters. The marks further differ insofar as the contested mark has the figurative element of two pick axes surrounded by a circle, as well as having the noticeable use of the colour contrast of white between the two larger blocks of black. The earlier mark’s figurative elements have no counterpart in the contested sign.

24. In my opinion, the marks are visually similar to a degree that is somewhere between low and medium.

Aural similarity

25. Aurally, there is a significant phonetic similarity between ‘MINED’ and ‘MYNE’. The word ‘MINED’ will be pronounced in the usual way for the recognised English language term that it is. The term ‘MYNE’ will likely to be pronounced as ‘M-EYE-N’, which is phonetically identical to the way the English language word ‘MINE’ is pronounced, which happens to occupy a significant part of the contested mark’s ‘MINED’.

26. The respective marks both contain the word element ‘LONDON’. As previously identified, the word ‘LONDON’ will likely be perceived descriptively, and therefore has low or no level of distinctiveness. Because of this, and also by factoring in the size and position of the word, it is possible that the average consumer may not voice the word at all. If they do, it will of course be spoken identically in each mark in the usual way for the recognised English language word that it is. The figurative elements of the contested mark will not be articulated, and therefore have no aural impact from a comparison point of view.

27. In my opinion, the marks are aurally similar to a high degree.

Conceptual similarity

28. The element 'MYNE' in the earlier mark is not a standard dictionary word, and the opponent has not proffered a meaning for the term. The conceptual impact of the opponent's earlier mark therefore lies in the word element 'LONDON', being the capital city of England, which would likely be perceived as describing the geographical location of the production/manufacture/provision of the goods for which the earlier mark is registered.

29. The conceptual impact of the word 'MINED' in the contested sign is that it is the past participle of the verb to mine (i.e. to dig for minerals etc).¹ This concept is reinforced by the figurative device of two crossed pick axes, which are tools used in the process of mining. There is no comparable counterpart in the earlier mark, and so there is a clear conceptual difference between the respective marks.

30. The marks are found to be conceptually similar to the extent that they both convey the descriptive notion of the city of 'LONDON, however, this is the limit of the conceptual similarity. Since it is not uncommon for trade marks to include a city such as London to indicate the location of the respective goods/services, the significance of the conceptual overlap between the two trade marks in these proceedings is considered minimal.

31. In my opinion, the marks are conceptually similar to a very low degree at most, with actually some notable conceptual difference.

Average consumer and the purchasing act

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

¹ <https://www.collinsdictionary.com/dictionary/english/mine> - 2. VERB *When a mineral such as coal, diamonds, or gold is mined, it is obtained from the ground by digging deep holes and tunnels.*

33. 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.”

34. The goods at issue involve various forms of jewellery. Such an item can vary greatly in quality and in price. However, the fact that the cost of the item can fluctuate does not alter the identity of the average consumer for jewellery.² Jewellery is bought by the public at large and the average consumer will therefore be a member of the general public. In response to the applicant’s submission that the respective goods are marketed differently, it is established in case law that this is not a factor for consideration in assessing whether there is a likelihood of confusion. This is because marketing choices can change over time due to fashion and style, or the wishes of the trade mark owner, and therefore such an aspect should not be considered.³

35. The selection of the contested goods will be visual in the vast majority of instances, as the goods are tangible and can be examined in the store where they are sold under a label. They could also be purchased after having been viewed in a magazine, which is another form of visual purchase. The goods will also likely be sold online using websites, which again is very much a visual purchase. I do not discount the possibility that there may be an aural element such as the interaction between a consumer and sales representative, but items of jewellery are fundamentally aesthetic, and therefore a visual examination is central.

² See paragraph 31 of the decision of the General Court in *Bang & Olufsen A/S v OHIM*, Case T-460/05

³ See paragraph 59 of the decision of the General Court in *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P

36. Turning to the level of attention paid by the average consumer of jewellery, it is of course the case that jewellery ranges in price - for instance, goods involving precious stones or metals may be very expensive, such that a consumer's attention levels may be especially elevated. However, even where jewellery goods are inexpensive the average consumer will take a certain degree of care in their selection of jewellery to factor in aesthetic considerations and perhaps any allergy aspects. In general terms, a consumer is likely to pay at least a medium level of attention.

Distinctive character of the earlier trade mark

37. 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).”

38. The opponent has made no claim that its earlier mark has acquired an enhanced degree of distinctive character, nor filed any evidence of use that may indicate such an effect. My assessment of the degree of distinctive character of the earlier mark is therefore to be made only on the basis of its inherent features.

39. In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

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

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

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

40. In my opinion, the average consumer will most likely perceive the element 'LONDON' in the earlier trade mark as being directly descriptive in respect of the goods, or in the alternative at least not distinctive nor indicative of a particular undertaking.⁴

⁴ (It is perhaps worth noting that even if, as the opponent claimed, the applicant's goods are not in fact manufactured in, or otherwise associated with London, this is not relevant to the task of assessing matters in this decision, neither in terms of similarity nor distinctive character.)

41. I have previously identified at paragraph 20 of this decision that I consider the dominant element of the opponent's earlier right to be the term 'MYNE', and that it is in this aspect that the distinctive character of the earlier mark lies. Neither side has offered a meaning for the element 'MYNE', nor am I aware of it as a dictionary word. From the perspective of the average consumer, the word would appear to be invented and to have no clear meaning. Consequently, the element 'MYNE' may be considered to be inherently distinctive to a fairly high degree. The element 'MYNE' of the earlier mark has no counterpart in the contested sign. This will affect any prospect of a likelihood of confusion.

Likelihood of Confusion

42. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, whilst 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.

43. 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 (see *Sabel*, C-251/95, para 22). The factors include 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 (see *Canon*, C-39/97, para 17). It is necessary for me to keep in mind the distinctive character of the opponent's trade mark, the average consumer for the services 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.

44. I have found the marks to be conceptually similar to a very low degree at most. In fact, I have found the marks to possess conceptual difference. I have also found the marks to only be visually similar to a degree that is somewhere between low and medium. Although I have found the marks to be aurally similar to a high degree, I have

nevertheless also identified that visual considerations are of greater importance in the purchasing process of the contested goods.⁵ I have identified the most dominant and distinctive element of the earlier mark to be the term 'MYNE', which is not present in the contested mark. I have identified the relevant average consumer to be the general public, who is considered to be reasonably well informed and reasonably observant and circumspect.⁶

45. Despite the fact that I have found the respective goods to be identical, it is my opinion that the differences in the visual and conceptual comparisons of the marks prevent a finding of direct confusion. In *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03, the GC stated that:

“49. However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (*BUDMEN*, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumer choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs.”

46. Given that the aesthetic aspect is central to the nature of the contested goods, because their purchase will be based on a visual assessment which will most frequently occur in stores where a thorough examination can take place, it is the visual similarity between the signs (or lack thereof) which is the most important consideration for the assessment of likelihood of confusion.

⁵ *Quelle AG v OHIM*, Case T-88/05

⁶ See paragraph 60 of *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*.

47. 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.”

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

48. From a visual comparison standpoint, the similarity is somewhere between low and medium. Although both marks contain the term 'LONDON', and have in common a selection of 3 letters, I do not consider this to be sufficient to lead a consumer to mistake one mark for another, particularly as the contested sign contains additional elements which are dominant, which possess inherent distinctiveness, which have no counterpart in the earlier mark, which outnumber any visual similarities, and which lead to a conceptual difference.

49. The visual differences between the marks negate the fact that the signs are aurally similar to a high degree, due to the propensity of the purchasing process of the contested goods being visually focused.⁷ As a result, I do not consider it likely that there will be any direct confusion.

50. Having found that there is no direct confusion between the marks, I must now consider the possibility of indirect confusion. It should be borne in mind that a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion.⁸

51. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This would be mere association rather than indirect confusion. The fact that the only common element the marks share is the term 'LONDON' is therefore not enough, in and of itself, to find indirect confusion, especially when considering that the common element will primarily be perceived as having a descriptive purpose.

52. I do not disregard that fact that there is a degree of visual similarity between the marks attributed to the coinciding 1st, 3rd and 4th letters of the respective first elements 'MYNE' and MINED'. Nor do I overlook that the goods are identical. I am also aware of the interdependency principle. However, I do not find it likely that the average consumer of jewellery would proceed to carry out the mental process whereby they would either consciously or subconsciously notice a commonality of three letters

⁷ *Quelle AG v OHIM* paragraph 69.

⁸ See paragraph 16 of the decision of the Court of Appeal in *Liverpool Gin Distillery Limited v Sazerac Brands LLC [2021] EWCH Civ 2017*

amidst a number of additional elements, and subsequently conclude that the contested mark is another brand belonging to the owner of the earlier mark. The combination 'M_NE' is not sufficiently memorable or unique to lead a consumer to conclude that all such uses of the combination belong to either the same undertaking, or an economically linked undertaking.

53. I also do not consider it likely that the coincidence of the particular combination 'M_NE' in the contested mark would call to mind the earlier mark. If I am wrong in this, and an instance occurred where a consumer was faced with the contested mark and *did* proceed to recall the earlier mark, such a mental process is mere association and, is insufficient for finding of likelihood of indirect confusion.⁹

54. In my opinion, the overall impression of each mark is distinctive and different, one resting on the notion of pick axes and mining, and the other resting on an invented word. Any similarities are descriptive, or coincidental, and would not, I argue, cause a consumer to conclude that the owners of the marks are in any way related. I therefore find there to be no likelihood of indirect confusion.

COSTS

55. A successful party to proceedings before the tribunal (here the applicant) may generally be entitled to a contribution towards its costs. Since the parties are without professional representation, such cost would be based on £19 per hour¹⁰, reflecting the necessary tasks in the process. In its letter to the parties on 10 September 2021, the Registry informed the parties that if they intended to make a request for an award of costs they were required to complete and return the provided form before 8 October 2021, else costs may not be awarded. Neither party returned a costs form, so I make no award of costs in this case.

⁹ *Duebros*

¹⁰ The Litigants in Person (Costs and Expenses) Act 1975.

Dated this 10th day of December 2021

Dafydd Collins

For the Registrar