

O/831/22

TRADE MARKS ACT 1994

**IN THE MATTER OF THE UK DESIGNATION OF INTERNATIONAL TRADE
MARK REGISTRATION NO. 1579991
IN THE NAME OF OĞUZ EREL STİL DANIŞMANLIK LİMİTED ŞİRKETİ FOR THE
TRADE MARK**



IN CLASS 41

AND

**OPPOSITION THERETO UNDER NO. 425418
BY SILVIA MARIA MOTTA**

Background and pleadings

1. Oğuz Erel Stil Danışmanlık Limited Şirketi (“the holder”) applied to protect the International Trade Mark Registration (“IR”) shown on the cover page of this decision, with the IR number 1579991, in the UK. The IR holds the International Registration date and UK designation date of 4 December 2020. It also claims priority from 8 July 2020.¹ The IR was accepted and published in the Trade Marks Journal on 7 May 2021 in respect of the following services:

Class 41: Education and training; arranging and conducting of conferences, congresses and seminars; sporting and cultural activities; entertainment; ticket reservation and booking services for entertainment, sporting and cultural events, including ticket reservation and booking services for theatres, cinemas, museums and concerts; publication and editing of printed matter, including magazines, books, newspapers, other than publicity texts; electronic publication services; production of movie films, radio and television programmes; news reporters services; photographic reporting services; photography; translation.

2. Silvia Maria Motta (“the opponent”) opposes the trade mark on the basis of section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). This is on the basis of her two EU trade marks² as set out in the table below:

¹ The IR claims priority from Turkey from trade mark number 2020/76781.

² Although the UK has left the EU and the transition period has now expired, EUTMs, and International Marks which have designated the EU for protection, are still relevant in these proceedings given the impact of the transitional provisions of The Trade Marks (Amendment etc.) (EU Exit) Regulations 2019 – please see Tribunal Practice Notice 2/2020 for further information.

Registration number	Trade Mark	Filing/Registration date	Services relied upon
014229918 ("918 mark")	DRY	5 June 2015/3 December 2015	Class 41: Entertainment, Sporting and cultural activities, Organisation and production of shows and events, Organisation of conventions for cultural purposes, award ceremonies, organisation of parades for entertainment purposes, Congresses, Conducting of exhibitions for entertainment purposes, Arranging and conducting of colloquiums, Production of shows, Conferences, exhibitions and seminars; Publishing services, Online publishing.
15744683 ("683 mark")	DRY	11 August 2016/30 January 2017	Class 41: Entertainment, Sporting and cultural activities, Organisation and production of shows and events, Organisation of conventions for cultural purposes, award ceremonies, organisation of parades for entertainment purposes, Congresses, Conducting of exhibitions for entertainment purposes, Arranging and conducting of colloquiums, Production of shows, Conferences, exhibitions and seminars; Publishing services, Online publishing. ³

3. By virtue of their earlier filing dates, the marks constitute earlier rights in accordance with section 6 of the Act.

4. The opponent argues that the respective services are identical and that the marks are similar, and that as such there will be a likelihood of confusion between the marks. The holder filed a counterstatement denying the claims made and requesting that the opponent provides proof of use of its earlier '918 mark relied upon.

5. Only the opponent filed evidence in these proceedings. The opponent also filed written submissions during the evidence rounds. I do not intend to summarise the

³ The wording of the specification relied upon by the opponent under this mark differs slightly to the wording of the specification of services listed on the EU register. Most notably, the opponent's Form TM7 states the opponent relies upon this mark for *online publishing*, however, the opponent does not hold protection under this mark for these services specifically. However, the opponent does hold protection under this mark for *publishing services* at large which will encompass these services. Further, whilst the opponent states it relies upon *arranging and conducting of colloquiums* under this mark, these services appear on the register as *arranging and conducting of colloquia*. As the services relied upon as set out in the TM7 do not exceed the opponent's original registered protection and will therefore not impact the outcome of this decision, there is no need for the opponent to amend its pleadings based on these differences.

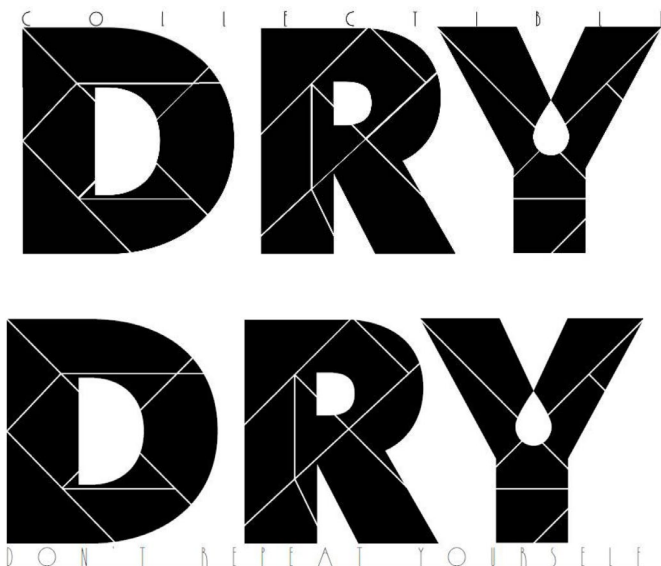
opponent's evidence or submissions at this time, but these have been considered in full and will be referred to where appropriate within this decision. No hearing was requested and neither party filed written submissions in lieu of a hearing. This decision is taken following a careful perusal of the papers.

6. The opponent is represented in these proceedings by Marco Mario Locatelli. The holder is represented by Forresters IP LLP.

7. 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.

Proof of use

8. The opponent relies upon two highly similar marks for identical services. There are slight differences in the marks, which are visible when these are enlarged as below:



9. Within its TM8, the holder requested that the opponent prove use of its earlier '918 mark only. The use provisions for opposition proceedings are set out under section 6A of the Act.

10. Section 6A of the Act reads as follows:

“(1) This section applies where

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

11. In this instance, the IR claims priority from 8 July 2020. The earlier ‘918 mark was registered on 3 December 2015. It had not been registered for a period of over five years at the priority date of the IR. It is therefore not necessary for the opponent to prove use of the earlier ‘918 mark within these proceedings, and the opponent may enforce its protection in relation to all of the services relied upon under both marks.

12. This discrepancy does not appear to have been picked up earlier in these proceedings by either party or by the Tribunal. However, with consideration to the details of this case, I do not find this will have a material impact on the decision I am to make in this instance, and as such I will proceed with the decision accordingly.

Decision

Section 5(2)(b)

13. Section 5(2)(b) of the Act is 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”.

14. Section 5A of the Act states:

Grounds for refusal relating to only some of the goods or services

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.

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 OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles

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

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

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

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

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

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

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

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

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

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

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

Comparison of services

16. The services for comparison are as follows:

Earlier services	Contested services
Class 41: Entertainment, Sporting and cultural activities, Organisation and production of shows and events, Organisation of conventions for cultural purposes, award ceremonies, organisation of parades for entertainment purposes, Congresses, Conducting of exhibitions for entertainment purposes, Arranging and conducting of colloquiums, Production of shows, Conferences, exhibitions and seminars; Publishing services, Online publishing.	Class 41: Education and training; arranging and conducting of conferences, congresses and seminars; sporting and cultural activities; entertainment; ticket reservation and booking services for entertainment, sporting and cultural events, including ticket reservation and booking services for theatres, cinemas, museums and concerts; publication and editing of printed matter, including magazines, books, newspapers, other than publicity texts; electronic publication services; production of movie films, radio and television programmes; news reporters services; photographic reporting services; photography; translation.

17. Some of the services, for example, *sporting and cultural activities* are included in both the earlier services and the contested services. These are self-evidently identical to one another. In this instance, I intend to proceed on the basis that all of the contested services are identical to the earlier services. If the opposition fails even in the case of identical services, then it follows it will also fail even where the services are only similar. However, if the opposition succeeds, I will return to this point to conduct a full analysis of the similarity of the services.

Comparison of marks

18. 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 Court of Justice of the European Union (“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.”

19. 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.

20. The respective trade marks are shown below:

Earlier trade marks	Contested trade mark
<p data-bbox="204 250 264 282">'918</p> 	
<p data-bbox="204 582 264 613">'683</p> 	

21. The earlier '918 mark includes two word elements, those being 'COLLECTIBLE' and 'DRY'. The word 'DRY' is written in large bold stylised letters, covered with a geometric pattern, and featuring what appears to be a water droplet dripping from the letter 'Y'. The word 'COLLECTIBLE' is written in very small thin letters that are only just visible. The dominant element of the mark is the word dry, with the stylisation of this element, including the pattern and water droplet playing a secondary but still significant role. Despite being a word element, the size and font used for the word COLLECTIBLE means it plays only a very small role in the overall impression of the mark itself.

22. The earlier '683 mark contains the same dominant elements as the '918 mark, with the word DRY being most dominant, the stylisation including the geometric pattern and water droplet playing a secondary but still significant role, and the small wording 'DON'T REPEAT YOURSELF' playing only a very small role in the overall impression of the mark itself.

23. The contested mark includes the wording DRY CLEAN ONLY. This element hangs together to make an instructive phrase which dominates the overall impression of the mark. The two squares on which the wording sits give the impression of a label and

play a lesser role in the overall impression of the mark, although this element is not negligible.

Visual comparison

24. Visually, the earlier '918 mark coincides with the contested mark due to the shared use of the word 'DRY'. It differs through the presentation of this element, with its geometric pattern and water droplet, in addition to the inclusion of the other elements of the mark. These comprise the small word 'COLLECTIBLES' in the earlier mark, and the wording 'CLEAN ONLY' and the label element in the contested mark. Overall I find the marks to be visually similar to between a low and medium degree.

25. The earlier '683 mark shares the same similarities with the contested mark as are outlined above, namely the shared use of the word DRY. The differences are also largely the same as above, however in this instance the earlier mark does not contain the word 'COLLECTIBLES' above the mark, and instead features the underlined wording DON'T REPEAT YOURSELF below the mark. Overall, with consideration to the similarities and differences, I also find this mark similar to the contested mark to between a low and medium degree.

Aural comparison

26. It is my view that given the dominance of the word DRY in both the earlier marks, and the very small font used for the additional wording, both earlier marks are likely to be pronounced as the single known English word DRY. It is my view that the contested mark will be pronounced in full as DRY CLEAN ONLY. Aurally, the marks all begin with the same syllable and word, but the contested mark is considerably longer being four syllables and three words in total. Overall, I find the marks to be aurally similar to a low to medium degree.

27. For completeness, I note here that if the earlier marks were to be pronounced in full as COLLECTIBLES DRY and DRY DON'T REPEAT YOURSELF (which I find unlikely), this will only reduce or maintain the level of aural similarity between the

marks, rendering the former aurally similar to a low degree, and the latter aurally similar to between a low and medium degree to the contested mark.

Conceptual comparison

28. The main element that will evoke a concept in the earlier '918 and '683 marks is the dominant word DRY. The word dry is defined in the Collins dictionary as follows: "[i]f something is dry, there is no water or moisture on it or in it."⁴ It is my view that the majority of consumers would understand it as meaning the absence of moisture, and that this concept would be evoked by the two earlier marks. This meaning is reinforced in both marks by the imagery of a water droplet.

29. I also note that the word DRY can be used to refer to uninteresting nature of particular material (be it a book or activity or otherwise).⁵ In the context of the services covered, it is my view that this meaning of dry will also be evoked for a significant portion of consumers in respect of both marks (although it is unlikely to be considered as a direct message about the opponent's own services), even if it is alongside the meaning of dry as a lack of moisture.

30. In the '683 mark the meaning of DRY as referring to uninteresting content is reinforced by the use of the phrase 'DON'T REPEAT YOURSELF' which will convey to the consumers the message of dry or uninteresting material where repetition is present. DRY may also be viewed as playful acronym for this message, although this will not prevent DRY from initially evoking a concept in and of itself.

31. In the earlier '918 mark, the word 'COLLECTIBLES' is present. This will evoke a second concept of items which may be rare or sought after and hold value, possibly above their original RRP. Collins dictionary states "a collectable object is one which is valued very highly by collectors because it is rare or beautiful."⁶

⁴ <https://www.collinsdictionary.com/dictionary/english/dry> [accessed on 31 August 2022]

⁵ "If you describe something such as a book, play, or activity as dry, you mean that it is dull and uninteresting." <https://www.collinsdictionary.com/dictionary/english/dry> [accessed on 31 August 2022]

⁶ <https://www.collinsdictionary.com/dictionary/english/collectable> [accessed on 31 August 2022]. Whilst this defines the word 'collectable' which is the spelling used in British English rather than

32. The contested mark is likely to be viewed by the majority of consumers as a dry clean only label that is often found within clothing or textiles. It will evoke the idea of particularly delicate or expensive items that may only be dry cleaned.

33. Whilst the concept of an absence of water is loosely shared between the marks, the concept of dry cleaning, and an item that is 'dry cleaning only' differs significantly from the concept of 'DRY' in and of itself. In addition, there are other concepts present in the earlier marks which do not feature in the contested mark. Overall, I find the marks to be conceptually similar at best to a low degree.

Average consumer and the purchasing act

34. 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.

35. 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.”

'collectible', which is more commonly used in American English and is used within the mark, it is my view the UK consumer will attribute the same meaning to the word.

36. In respect of services such as *education and training; sporting and cultural activities; entertainment; ticket reservation and booking services for entertainment, sporting and cultural events, including ticket reservation and booking services for theatres, cinemas, museums and concerts and photography*, the average consumer of the services will include both the general public and professional consumers. The degree of attention paid by the general public may vary significantly depending on the types of entertainment, education and activities being engaged with. For example, the level of attention paid when the consumer embarks on a one-off evening class will be considerably lower than the level attention paid when committing to a three or four year university degree.

37. In respect of the services such as *education, sporting and cultural activities and photography services*, considerations will be made as to quality, duration, location, reliability, and reputation of the services offered. With regards to the services such as those for ticket reservation and booking, factors such as the trustworthiness and convenience of the services will likely be considered. However, overall, I do not consider that these categories as a whole will warrant more than a medium level of attention from the general public.

38. Professional consumers will likely pay a higher degree of attention when engaging these types of services for staff or on behalf of client's, due to the increased liability and responsibility they will hold with their position. The level of attention paid by the professional consumers is likely to be at least above medium.

39. Services such as *arranging and conducting of conferences, congresses and seminars; publication and editing of printed matter, including magazines, books, newspapers, other than publicity texts; electronic publication services; production of movie films, radio and television programmes; news reporters services; photographic reporting services and translation* for example, are more likely to be engaged with by professional consumer only. These consumers are likely to pay at least an above medium level of attention or higher to these services on the basis that engaging the correct services will likely have a direct impact on their business or business goals.

Ensuring professional, reliable and quality services are obtained will therefore be of high importance.

40. The services offered are likely to be primarily engaged with visually, with consumers viewing an advertisement and consulting a website before engaging in the same. In respect of the services offered to professional consumers, visual presentations and pitches may also play a part in the decision-making process. In addition, I note that there may also be word of mouth recommendations and telephone bookings made, and so such I cannot completely discount the aural considerations.

Distinctive character of the earlier trade marks

41. 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).

42. The earlier ‘918 mark primarily comprises the English word ‘DRY’. Whilst to some this will allude to the concept of services such as those offered being uninteresting, I do not find this to significantly reduce the distinctive character of the mark in this instance, on the basis that it would be considered unusual to put out a negative promotional message about your own services. Where this element conveys this message to the consumer, they are therefore unlikely to consider that it alludes directly to the services offered, and it is more likely to be viewed as having a humorous intention. I find this word maintains a medium degree of distinctiveness in this instance, whether it is considered to refer to this meaning or to a lack of moisture. I note the word ‘COLLECTIBLES’ does not appear to be descriptive or allusive of the services.

In addition, the stylisation is bold and unusual and this adds slightly to the inherent distinctiveness of the earlier mark as a whole, which I find to sit at very slightly above a medium level when all of the elements are considered.

43. I find the reasoning above to also apply to the '683 mark in the most part, although I note that in this instance the word DRY will be viewed by some consumers as an acronym for the wording DON'T REPEAT YOURSELF which is displayed under the mark. In the context of some of the services, for example *conferences, exhibitions and seminars* this mildly alludes to the services including snappy or well thought out presentations in which repetition does not occur. However, with consideration to all of the elements of the marks, and with DRY being by far the most dominant element of the same and the first element the consumers view and will consider, I find that this mark maintains a medium level of inherent distinctiveness despite the allusive nature of the phrase in the context of some the services, and the apparent use of DRY as an acronym. I also find it will hold a slightly above a medium level of distinctive character for the services overall where this phrase will not be considered as an acronym.

44. The opponent has filed evidence in these proceedings, and as such I must also consider if the distinctiveness of the opponent's marks has been enhanced through the use made of the same. I remind myself that it is the perception of the UK consumer that is important when considering if the distinctive character of the earlier marks has been enhanced. Further, it is the position at the relevant date, which in this instance is 8 July 2020, that will be key.

45. The opponent's evidence is filed in the form of a statutory declaration made by Mrs Silvia Maria Motta, the owner of the earlier marks and the opponent in these proceedings. The statutory declaration introduces 9 exhibits, labelled Annex 1 to Annex 9. In her statement, Ms Motta describes the earlier '918 mark has been used in relation to the publication of a magazine as follows (footnotes omitted):

“...I hereby confirm that these have the purpose to prove that the aforesaid European trademark no. 14229918 (n. UK009142218) is used as title of a paper and digital magazine whose main object is fashion, luxury, art-design and

photography. I state also that the magazine “DRY” is advertised through the website <https://collectibledry.com/> at least since the beginning of the year 2016.

...

...the publication of the magazine “DRY” are distributed on the UK territory and World Wide, by the company Pineapple Media Limited, under the distribution and circulation agreement signed with the Collectible Media Limited on 6th November 2015 here attached below Annex 5.

To confirm the continued use of the sign over the years, the Opponent encloses below Annex 7, the covers of magazine “DRY” bearing the mark in question, published and distributed from the 2016 to 2021. This document shows that 2 to 4 issues of the magazine’s volumes are published each year, as shown by the volumes numbers on the top right of the cover, where the cost of the magazine in UK and Italy is also shown.”

46. Annex 5 is as described above. Annex 3 comprises license agreements between the opponent and the UK based entity Collectible Media Limited, licensing the use of both the earlier ‘683 and the ‘918 mark in relation to the magazine ‘Collectible DRY’. The territory of the licenses is stated as ‘world’. Annex 6 provides a number of invoices between Collectible Media Limited and Pineapple Media Limited, the first of which is dated 31 July 2016 and references that 2035 copies were sold to the UK. The rest of the invoices are spread out over the years up until the relevant date (and beyond), but they do not provide visible invoice amounts or reference units sold. Magazine covers are provided at Annex 7 dating from 2016 to 2021 as described by Ms Motta and show the price in GBP in addition to Euros. These feature the ‘918 mark.

47. Annex 1 shows the results of a google search for the term ‘Dry Collectables’ conducted from an Italian IP address on 17 December 2021. The hits show results for Collectible Dry magazine. However, even if this search had been conducted prior to the relevant date, it is my view it does little to show that the distinctiveness of the marks will have been enhanced amongst UK consumers. The results of a google search do

not assist in showing that the UK consumer will have been particularly exposed to the mark in relation to the services offered.

48. Annex 2 is an Instagram page showing the '918 mark for 'Collectible Dry Magazine'. The screenshot is dated 17 December 2021 after the relevant date, and although I note the number of followers is high, no detail is provided regarding the portion of the followers which are from the UK, or how many there were prior to the relevant date. Annex 4 shows archived pages from the website www.collectibledry.com. The pages are undated but I remind myself of Mrs Motta's statement that the magazine has been advertised through the website since at least 2016.

49. Annex 8 comprises a letter dated 19 November 2021 requesting permission to add to add Collectible Media Limited's print publications, in particular, the magazine titled "Collectible DRY", Vol.13 2021:Fall/Winter to the 'Legal deposit collections'. Annex 9 is a chain of email correspondence from 2018 showing what appears to be a promotional poster written in Italian. Mrs Motta confirms in her witness statement that this is (footnote omitted):

“...the poster of a presentation of the magazine DRY on the occasion of the Milano Photoweek edition 2018 is attached below Annex 9”

50. Mrs Motto states in a footnote that the magazine is referred to as “the most famous photography magazine in Europe”.

51. It is clear that no use of the earlier marks has been shown in respect of at least the majority of services relied upon. The opponent has evidenced use of the mark in respect of a photography magazine. It is my view that the use shown is use in relation to magazines, and not the services relied upon. If I am wrong, it is my view that at best there may have been some use of the mark in the UK in relation to *publishing services*. However, the extent of the services offered is far from clear, and the opponent has not provided me with turnover figures, promotional spend, or significant promotional material in relation to the offering of the services in the UK prior to the relevant date, or any other significant evidence that indicates that the distinctiveness of the earlier

marks has been enhanced amongst the UK consumer by virtue of the use made of the same. I therefore do not consider that the distinctiveness of the earlier marks to have been enhanced above the inherent level.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion

52. Prior to reaching a decision under Section 5(2)(b), I must first consider all relevant factors, including those as set out within the principles A-K at paragraph 15 of this decision. I must view the likelihood of confusion through the eyes of the average consumer, 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 they have kept in their mind. I must consider the level of attention paid by the relevant consumer, and consider the impact of the visual, aural and conceptual similarities of the marks by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. I must consider that the level of distinctive character held by the earlier marks will have an impact on the likelihood of confusion, and that the distinctiveness of the common elements is key.⁷ I must keep in mind that a lesser degree of similarity between the services may be offset by a greater degree of similarity between the marks, and vice versa. I must also consider that both the degree of attention paid by the average consumer and how the services are selected will have a bearing on how likely the average consumer is to be confused.

53. I consider at this point that there are two types of confusion that I may find. The first type of confusion is direct confusion. This occurs where the average consumer mistakenly confuses one trade mark for another. The second is indirect confusion. This occurs where the average consumer notices the differences between the marks, but due to the similarities between the common elements, they believe that both products derive from the same or economically linked undertakings.⁸

⁷ See *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, in which 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.

⁸ *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10

54. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C. (as he then was), 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 is mere association not indirect confusion.

55. In this instance I found that both earlier marks are aurally and visually similar to between a low and medium degree and are conceptually similar to a low degree. I have proceeded on the basis that the services are identical. I found the consumers will comprise both the general public and professionals, and that they will pay a medium degree of attention or above in respect of all of the services. I found the earlier '638 mark to hold a medium or slightly above medium degree of distinctive character in respect of the services. I found the '918 mark to hold and a slightly above medium degree of distinctive character in respect of the services, and I found the distinctiveness of the shared element, namely the word 'DRY' to be at a medium level. I found that it has not been evidenced that the distinctiveness of the earlier marks has been enhanced above their inherent level.

56. Considering all of the factors, it is my view that the differences between both earlier marks and the IR are sufficient to avoid a likelihood of direct confusion in respect of all of the services. I also note here that it is my view this would still be avoided even if the distinctiveness of the earlier mark had been shown to be enhanced to a high degree. I do not consider there will be a likelihood of direct confusion in this instance.

57. I move on to consider if there is a likelihood of indirect confusion. Three examples of when indirect confusion may occur were set out by Mr Iain Purvis Q.C. in *L.A. Sugar Limited v Back Beat Inc*, Case BL O/375/10. In this case, Mr Iain Purvis Q.C. set out at paragraph 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).”

58. Whilst I note the examples set out above are not an exhaustive list of instances in which indirect confusion may occur, I find in this instance, none of the above apply. I consider if there is another basis on which to find indirect confusion will occur. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. (as he then was) considered the impact of the CJEU’s judgment in *Bimbo*, Case C-591/12P, on the court’s earlier judgment in *Medion v Thomson*. The judge said:

“18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a

distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

59. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] 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”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

60. I note that the element that is shared between both earlier marks and the IR is the word dry, which in itself holds a medium degree of inherent distinctive character. However, it is my view that this element does not play an independent role in the IR, and that this element hangs together as part of the instructional phrase DRY CLEAN ONLY in the same. With consideration to the case law above, I can see no logical reason for the IR to be considered as a connected to the earlier marks through the shared use of the word dry. I find there to be no proper basis for a finding of indirect

confusion between the marks in this instance. If the consumer were to notice that both the earlier marks and the IR used the word DRY, it is my view that this would be put down to coincidence, and not to an economic connection between the marks.

Final Remarks

61. The opposition based on section 5(2)(b) fails even where the services are considered are identical. As it will make no material difference to the outcome of these proceedings, I will not return to consider the level of similarity shared by the services in this instance.

62. Subject to any successful appeal, the opposition fails in its entirety and the application will proceed to registration in respect of all of the services applied for.

COSTS

63. The holder has been successful and is entitled to a contribution towards its costs. Whilst the holder filed no evidence of its own, I consider it will have incurred costs for considering the opponent's evidence, and as such I have awarded an appropriate sum in respect of the same. In the circumstances I award the holder the sum of £450 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Considering the TM7 and statement of grounds and preparing and filing a counterstatement:	£250
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Considering the other sides evidence:	£200
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Total	£450
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64. I therefore order Silvia Maria Motta to pay Oğuz Erel Stil Danışmanlık Limited ŞİRKETİ the sum of £450. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 27th day of September 2022

**Rosie Le Breton
For the Registrar**