

BL O/837/22

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK3652837

BY ENSOI LTD

TO REGISTER THE SERIES OF TRADE MARKS:

Bodica

bodica

BODICA

IN CLASSES 16, 25, 26 & 35

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 428153

BY Petra Akinsiku

Background and pleadings

1. On 8 June 2021, Ensoi Ltd (“the applicant”) applied to register the series of trade marks shown on the cover page of this decision in the UK. The application was published for opposition purposes on 13 August 2021. Registration is sought for the following goods and services:

Class 16: Gift cards; Gift packaging; Gift vouchers; Gift wrap paper; Paper gift wrap.

Class 25: Silk Camisole; Jersey bras; lace bras; vegan silk; slips [clothing]; underwear; women's underwear; functional underwear; ladies' underwear; underwear for women; slips (undergarments); slips (underclothing); articles of under unclothing; underclothing; undergarments; bras; bra straps; brassieres; strapless brassieres; strapless bras; body linen (garments); linen (body-) (garments); linen clothing; bodies (underclothing); bodies (clothing); camisoles; lounge wear; evening wear; sleep wear; formal wear.

Class 26: Borders for hemming clothing; Reinforcing tapes for clothing; Twisted cords for clothing; Embroidered patches for clothing; Bindings for hemming clothing; Embroidery for garments; Lace; Lace trimmings; Picot [lace]; Embroidery laces; Lace for edgings; Frills [lacework]; Embroidery.

Class 35: Advertising; Online advertising; Online advertisements; Advertisements (Preparing of -); Publicity and advertising; Taxi top advertising; Direct market advertising; Direct mail advertising; Mail-order advertising; Creating advertising material; Advertisements (Placing of -); Advertising and publicity; On-line advertising; Advertising, including on-line advertising on a computer network; Advertising material (Updating of -); Dissemination of advertising matter; Publication of advertising texts; Radio advertising and commercials; Design of advertising logos; Advertising services of a radio and television advertising agency; Advertising services for the promotion of e-commerce.

2. The application was opposed by Petra Akinsiku (“the opponent”) on 12 November 2021. The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and concerns the goods and services in Classes 25, 26 and 35.

3. The opponent relies on the following series of trade marks:

UKTM 3310717

BOVDICCA

Bovdicca

Filing date: 15 May 2018

Registration date: 24 August 2018

Relying upon all goods for which the earlier marks are protected, namely:

Class 18: Ankle-mounted wallets; Articles of luggage; Backpacks; Baggage; Bags; Bags for travel; Beach bags; Beach umbrellas; Beach umbrellas [beach parasols]; Beachbags; Belt bags; Belt bags and hip bags; Belt pouches; Bumbags; Business card cases; Cabin bags; Calling card cases; Canvas bags; Carry-all bags; Carry-on bags; Chain mesh purses; Clutch bags; Clutch handbags; Clutch purses; Clutch purses [handbags]; Clutches [purses]; Cosmetic purses; Crossbody bags; Cross-body bags; Evening bags; Evening purses; Fanny packs; Fashion handbags; Fitted belts for luggage; Handbag straps; Handbags; Harness; Hip bags; Hipsacks; Holdalls; Makeup bags; Mesh shopping bags; Overnight bags; Pocketbooks; Pouches; Shoe bags; Shoulder bags; Small backpacks; Umbrellas and parasols; Waist bags; Wash bags for carrying toiletries; Waterproof bags; Weekend bags; Straps for handbags; Straps for luggage; Straps for suitcases; Tags for luggage; Toiletry bags; Tote bags; Travel baggage; Travel bags; Travel bags made of plastic materials; Trunks and traveling bags; Labels for luggage; Lockable luggage straps; Luggage; Luggage labels; Luggage straps; Luggage tags.

Class 24: Beach towels; Blankets for outdoor use; Hooded towels; Towels; Towels made of textile materials; Towels [textile] for the beach.

Class 25: Aqua shoes; Articles of sports clothing; Bath shoes; Bathing caps; Bathing costumes; Bathing costumes for women; Bathing suit cover-ups; Bathing suits; Bathwraps; Beach clothes; Beach clothing; Beach cover-ups; Beach footwear; Beach hats; Beach robes; Beach shoes; Beach wraps; Beachwear; Belts [clothing]; Belts made from imitation leather; Belts made out of cloth; Belts (Money -) [clothing]; Belts of textile; Bikinis; Bra straps; Bra straps [parts of clothing]; Caftans; Cap visors; Capes; Capes (clothing); Caps; Caps being headwear; Caps with visors; Cloaks; Clothes; Clothes for sport; Clothing; Clothing for leisure wear; Clothing for sports; Clothing made of imitation leather; Clothing of imitations of leather; Combinations [clothing]; Coverups; Cover-ups; Dry suits; Fabric belts [clothing]; Fitted swimming costumes with bra cups; Foundation garments; Functional underwear; Gussets for bathing suits [parts of clothing]; Gussets [parts of clothing]; Hats; Head wear; Headbands; Headbands [clothing]; Leisure clothing; Leisure footwear; Leisure wear; Monokinis; One-piece playsuits; One-piece suits; Pareos; Pareus; Ready-to-wear clothing; Sandals and beach shoes; Sarongs; Shoes for leisurewear; Shoulder straps for clothing; Shoulder wraps [clothing]; Suits (Bathing -); Sun visors; Sun visors [headwear]; Sundresses; Surf wear; Surfwear; Swim briefs; Swim caps; Swim shorts; Swim suits; Swim trunks; Swim wear for gentlemen and ladies; Swimming caps; Swimming caps [bathing caps]; Swimming costumes; Swimming suits; Swimming trunks; Swimsuits; Swimwear; Visors; Waist belts; Water socks; Wet suits; Wet suits for surfing; Wet suits for water-skiing and sub-aqua; Wet suits for windsurfing; Wetsuit gloves; Wetsuits; Wetsuits for surface watersports; Wetsuits for surfing; Wetsuits for water-skiing; Women's clothing; Wraps [clothing]; Articles of clothing.

4. The opponent claims that the marks are similar aurally and visually. It argues that the marks contain the identical letters 'B' 'O' 'D' 'I' 'C' 'A' with the only difference being the inclusion in the earlier series of marks of the letter 'V' and an additional 'C'. It further asserts that the phonetic differences between the marks are so insignificant as to go unnoticed by the average consumer. The opponent also claims that the applicant's

services are either identical or highly similar to their own services. It concludes that in the opinion of the opponent, the high degree of similarities and imperfect recollection mean that there is a likelihood of both direct and indirect confusion.

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

6. The applicant is represented by Buckworths and the opponent is represented by Briffa.

7. Both parties filed evidence during the evidence rounds. Neither party requested a hearing/provided submissions in lieu. This decision is therefore taken following careful perusal of the papers.

8. 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 on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

Evidence

9. The opponent's evidence consists of a witness statement by Petra Akinsiku, who is the registered proprietor of the earlier marks, together with three accompanying exhibits. The main purpose of the evidence is to rebut assertions of non-use made by the applicant within their counterstatement and provide information regarding the possibly conceptual meanings of the marks.

10. The applicant's evidence consists of a witness statement by Clare St John Lichfield, the owner of Ensoi Ltd, together with 12 accompanying exhibits. Her witness statement largely consists of submissions but also provides an explanation of the origin of the contested mark.

11. I have read and considered all of the evidence and will refer to the relevant parts at the appropriate points in the decision.

Decision

Section 5(2)(b)

12. Section 5(2)(b) reads 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.”

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 or international trade mark (UK) 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.

...”

14. The series of trade marks upon which the opponent relies qualify as earlier trade marks because they were applied for at an earlier date than the contested marks pursuant to section 6 of the Act. The earlier series of marks are not subject to the proof of use requirements pursuant to section 6A of the Act. This is because they had not completed their registration processes more than 5 years before the filing date of the

application in issue. The opponent can, therefore, rely upon all of the goods for which its series of marks are registered.

Section 5(2)(b) case law

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 Harmonisation 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 and Services

16. Section 60A of the Act provides:

“(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the "Nice Classification" means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975."

17. 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. In *Gérard Meric v OHIM* ('Meric'), Case T-133/05, the General Court ("the GC") stated 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".

20. For the purposes of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

21. The goods and services to be compared are shown in the table below:

Applicant's Goods & Services	Opponent's Goods
Class 25: Silk Camisole; Jersey bras; lace bras; vegan silk; slips [clothing]; underwear; women's underwear; functional underwear; ladies' underwear; underwear for women; slips (undergarments); slips (underclothing) ; articles of under unclothing; underclothing; undergarments; bras; bra	Class 18: Ankle-mounted wallets; Articles of luggage; Backpacks; Baggage; Bags; Bags for travel; Beach bags; Beach umbrellas; Beach umbrellas [beach parasols]; Beachbags; Belt bags; Belt bags and hip bags; Belt pouches; Bumbags; Business card cases; Cabin bags; Calling card cases;

<p>straps; brassieres; strapless brassieres; strapless bras; body linen (garments); linen (body-) (garments); linen clothing; bodies (underclothing); bodies (clothing); camisoles; lounge wear; evening wear; sleep wear; formal wear.</p>	
<p>Class 26: Borders for hemming clothing; Reinforcing tapes for clothing; Twisted cords for clothing; Embroidered patches for clothing; Bindings for hemming clothing; Embroidery for garments; Lace; Lace trimmings; Picot [lace]; Embroidery laces; Lace for edgings; Frills [lacework]; Embroidery.</p>	
<p>Class 35: Advertising; Online advertising; Online advertisements; Advertisements (Preparing of -); Publicity and advertising; Taxi top advertising; Direct market advertising; Direct mail advertising; Mail-order advertising; Creating advertising material; Advertisements (Placing of -); Advertising and publicity; On-line advertising; Advertising, including on-line advertising on a computer network; Advertising material (Updating of -); Dissemination of advertising matter; Publication of advertising texts; Radio advertising and commercials; Design of advertising logos; Advertising services of a radio and television advertising</p>	<p>Canvas bags; Carry-all bags; Carry-on bags; Chain mesh purses; Clutch bags; Clutch handbags; Clutch purses; Clutch purses [handbags]; Clutches [purses]; Cosmetic purses; Crossbody bags; Cross-body bags; Evening bags; Evening purses; Fanny packs; Fashion handbags; Fitted belts for luggage; Handbag straps; Handbags; Harness; Hip bags; Hipsacks; Holdalls; Makeup bags; Mesh shopping bags; Overnight bags; Pocketbooks; Pouches; Shoe bags; Shoulder bags; Small backpacks; Umbrellas and parasols; Waist bags; Wash bags for carrying toiletries; Waterproof bags; Weekend bags; Straps for handbags; Straps for luggage; Straps for suitcases; Tags for luggage; Toiletry bags; Tote bags; Travel baggage; Travel bags; Travel bags made of plastic materials; Trunks and traveling bags; Labels for luggage; Lockable luggage straps; Luggage; Luggage labels; Luggage straps; Luggage tags.</p> <p>Class 24: Beach towels; Blankets for outdoor use; Hooded towels; Towels; Towels made of textile materials; Towels [textile] for the beach.</p> <p>Class 25: Aqua shoes; Articles of sports clothing; Bath shoes; Bathing caps; Bathing costumes; Bathing costumes for</p>

<p>agency; Advertising services for the promotion of e-commerce.</p>	<p>women; Bathing suit cover-ups; Bathing suits; Bathwraps; Beach clothes; Beach clothing; Beach cover-ups; Beach footwear; Beach hats; Beach robes; Beach shoes; Beach wraps; Beachwear; Belts [clothing]; Belts made from imitation leather; Belts made out of cloth; Belts (Money -) [clothing]; Belts of textile; Bikinis; Bra straps; Bra straps [parts of clothing]; Caftans; Cap visors; Capes; Capes (clothing); Caps; Caps being headwear; Caps with visors; Cloaks; Clothes; Clothes for sport; Clothing; Clothing for leisure wear; Clothing for sports; Clothing made of imitation leather; Clothing of imitations of leather; Combinations [clothing]; Coverups; Cover-ups; Dry suits; Fabric belts [clothing]; Fitted swimming costumes with bra cups; Foundation garments; Functional underwear; Gussets for bathing suits [parts of clothing]; Gussets [parts of clothing]; Hats; Head wear; Headbands; Headbands [clothing]; Leisure clothing; Leisure footwear; Leisure wear; Monokinis; One-piece playsuits; One-piece suits; Pareos; Pareus; Ready-to-wear clothing; Sandals and beach shoes; Sarongs; Shoes for leisurewear; Shoulder straps for clothing; Shoulder wraps [clothing]; Suits (Bathing -); Sun visors; Sun visors [headwear]; Sundresses; Surf wear;</p>
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	<p>Surfwear; Swim briefs; Swim caps; Swim shorts; Swim suits; Swim trunks; Swim wear for gentlemen and ladies; Swimming caps; Swimming caps [bathing caps]; Swimming costumes; Swimming suits; Swimming trunks; Swimsuits; Swimwear; Visors; Waist belts; Water socks; Wet suits; Wet suits for surfing; Wet suits for water-skiing and sub-aqua; Wet suits for windsurfing; Wetsuit gloves; Wetsuits; Wetsuits for surface watersports; Wetsuits for surfing; Wetsuits for water-skiing; Women's clothing; Wraps [clothing]; Articles of clothing.</p>
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22. For the applicant's class 25 goods save for 'Vegan silk' and 'Bra straps' I find that these fall within the wider category of the opponent's 'clothing' and they are therefore identical under the *Meric* principles.

23. The applicant's 'bra straps' can be found identically within the opponent's class 25 specification.

24. Regarding the applicant's 'vegan silk', this would usually be included in class 24 of the Nice Classification but the High Court confirmed in *Multi-Access Limited v Guangzhou Wong Lo Kat Great Health Business Development Co Limited* [2019] EWCH 3357 (Ch) that the Registrar's decision as to the classification of goods and services is final. Consequently, a registered trade mark should not be treated as not covering clearly described goods or services simply because the trade mark may have been registered in a class in which those goods or services are not, or are no longer, usually classified.

25 ‘Vegan silk’ and the applicant’s class 26 goods are materials and constituent elements which could be intended to be used within the clothing manufacturing process. These goods are piece materials rather than the finished article.

26. The earlier good ‘clothing’ refers to the finished articles of clothing that may be constructed using the contested goods in class 26 and ‘Vegan silk’. These goods are intended for sale to the general public or as wholesale. I am reminded of the case of *Les Éditions Albert René v OHIM*, Case T-336/03, where the GC found that:

“61... The mere fact that a particular good is used as a part, element or component of another does not suffice in itself to show that the finished goods containing those components are similar since, in particular, their nature, intended purpose and the customers for those goods may be completely different.”

27. Although ‘vegan silk’ and the class 26 goods might be used in the production of the final garment, I do not find them similar as the respective uses, user and physical nature of the two items would be very different. The trade channels would also differ. These goods are far more likely to be purchased wholesale to be used in the production of a finished article, which would then be on sale to the general public. Even though the contested goods might be used in the production of the finished articles, I do not find there to be complementarity here as I believe the average consumer will believe the goods to come from differing entities. I therefore find these goods to be dissimilar to the opponent’s goods.

28. Next, I will consider the applicant’s class 35 services which all involve advertising. In comparing these services with the goods and services of the opponent’s marks, I rely on the guidance coming from the *Treat* decision. I conclude that although the proprietor’s services are fairly broad in terms of who the respective users may be, I find no overlaps in the respective uses of the services at issue, nor the nature of the services or trade channels. These services are therefore dissimilar.

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

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

30. Therefore, as I have found no similarity for the applicant’s ‘Vegan silk’, class 26 and class 35 goods and services, the opposition fails in relation to them. The opposition will continue in respect of the applicant’s class 25 goods save for ‘Vegan silk’.

Average consumer and the purchasing act

31. 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.

32. 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. (as he then was) 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 average consumer of the goods will predominantly be the general public.

34. The selection of such goods is largely a visual process, as the average consumer (general public) will wish to physically handle the goods to ensure the correct size has been selected, whilst simultaneously appraising the overall aesthetic impact. I do not, however, ignore the potential for the marks to be spoken, for example, by sales assistants in a retail establishment or when making a purchase from a catalogue, over the telephone. However, in those circumstances, the consumer will have had an opportunity to view the goods, perhaps electronically via an online catalogue or website, or on paper in the traditional sense of catalogue shopping. Therefore, when considering the aural impact of the marks, the visual impression of these goods will already have played a part in the consumer's mind.

35. Although the prices of individual items will vary greatly, I consider that the average consumer will pay at least a medium degree of attention (but not the highest level) during the purchase of the remaining class 25 goods.

Comparison of the marks

36. 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.”

37. 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.

38. The respective trade marks are shown below:

Earlier marks	Contested marks
<p data-bbox="368 779 624 824" style="text-align: center;">BOVDICCA</p> <p data-bbox="389 947 603 992" style="text-align: center;">Bovdicca</p>	<p data-bbox="1018 701 1177 745" style="text-align: center;">Bodica</p> <p data-bbox="1023 869 1173 913" style="text-align: center;">bodica</p> <p data-bbox="1007 1037 1189 1081" style="text-align: center;">BODICA</p>

39. The contested marks are a series of plain word marks which consist of one word. The overall impression lies in the word itself.

40. The earlier marks are also a series of plain word marks consisting of one word and once again, the overall impression lies in the word itself.

41. I will now consider the visual comparison of the marks. The applicant submitted in their counterstatement and within their evidence that the opponent uses a stylised version of their mark however, for the purposes of these proceedings, I must consider the marks as they are registered. I remind myself of the comments of Mr Iain Purvis QC, sitting as the Appointed Person in *Groupement Des Cartes Bancaires v China Construction Bank Corporation*, case BL O/281/14, who found that:

“It is well established that a ‘word mark’ protects the word itself, not simply the word presented in the particular font or capitalization which appears in the Register of Trade Marks.....A word may therefore be presented in a different way (for example a different font, capitals as opposed to small letters, or handwriting as opposed to print) from that which appears in the Register whilst remaining ‘identical’ to the registered mark.”

42. I therefore acknowledge that the marks at hand may be presented in any font, size, or combination of upper and lower-case fonts.

43. The earlier marks comprise a single word containing eight letters. The contested marks are single words containing six letters. Both marks contain the letters ‘B’ ‘O’ ‘D’ ‘I’ ‘C’ and ‘A’ presented in that order however, the earlier marks contain an extra two letters - ‘V’ and a further ‘C’ which come third and seventh respectively. Given the beginning and the ending of the marks are identical, i.e. they both begin with ‘BO’ and end with ‘CA’ I find that the marks are visually similar to a high degree.

44. I note that the opponent claims that the marks are phonetically identical. I agree that both marks would be pronounced with three syllables. However, I disagree that they would be pronounced identically. I do not believe the average consumer will overlook the ‘V’ in their pronunciation of the earlier marks and therefore, I believe they will be pronounced *BOV/DI/KAH*. I believe there are two likely pronunciations of the applicant marks. Firstly, there will be those who pronounce it *BOH/DI/KAH* and in this instance I believe the marks to be highly aurally similar as the only difference will be the ‘V’ sound in the first syllable. The second pronunciation would be *BOW/DI/KAH* and I believe this to be similar to no more than a medium degree with the opponent’s marks.

45. Conceptually, the opponent submitted that both marks would be understood to make reference to Boudica who was an Iceni Queen. The applicant argues that the average consumer would see the ‘V’ in their mark as a ‘U’ as per the classical Latin alphabet and gives the example of ‘BVLGARI’ being ‘BULGARI’ however, I have to consider the matter from the perspective of the average UK consumer. In that

instance, I find that the average consumer may not have knowledge of the Latin alphabet and given the 'V' is already next to another vowel, will give it its ordinary meaning. I note that there are multiple spellings of Boudica and that there may be some consumers who would perhaps consider these marks to be alternate spellings of her name and so in this instance, the marks would be conceptually identical. However, I consider that a significant proportion of the average consumers would believe these marks to be made up terms. In this instance, the marks would be conceptually neutral.

Distinctive Character of the Earlier Marks

46. 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).”

47. The opponent made no claim and put forward no evidence relating to an enhanced level of distinctiveness of their earlier marks. I will therefore consider the position based solely on its inherent distinctiveness.

48. The marks are comprised of one word which appears to be invented, although could be seen as referencing a female name/particular person. For the consumers who see the mark as invented, it will be distinctive to a high degree. For the consumers who see the marks as a female name, albeit not a common name, I find that the marks are inherently distinctive to an above average degree although not the highest degree.

Likelihood of Confusion

49. There are two types of confusion that I must consider. Firstly, direct confusion i.e. where one mark is mistaken for the other. The second is indirect confusion which is where the consumer appreciates that the marks are different, but the similarities between the marks lead the consumer to believe that the respective goods or services originate from the same or a related source.

50. In *L.A. Sugar Limited v 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.”

51. I have come to the conclusions above that the marks at issue are visually similar to a high degree; aurally similar to either a high degree or to no more than a medium degree; they are either conceptually identical or identically neutral and the average consumer would pay at least a medium degree of attention. The remaining goods at issue have been found to be identical. The earlier marks are inherently distinctive to either a high degree or an above average (but not the highest) degree depending on how the consumer view the mark. I found the overall impression of both series of marks was in the words themselves.

52. I keep in mind the settled case law that confirms the average consumer is unlikely to see the marks side-by-side and will therefore be reliant upon the imperfect picture of them they have kept in their mind. Given that the beginning and endings of the marks are identical, I believe that the average consumer will likely overlook the differences of the two letters, particularly as the letter 'C' already features within the word and is simply repeated immediately after. I believe that due to the imperfect recollection of the average consumer, they are likely to confuse one mark for the other. Therefore, I find that direct confusion will occur between the marks.

Conclusion

53. The opposition under section 5(2)(b) succeeds in respect of the applicant's class 25 goods save for 'Vegan silk'.

54. The opposition fails in respect of the applicant's 'Vegan silk', class 26 and class 35 specification.

55. Application No. 428153 will proceed to registration for the goods in Classes 16, 26 and 35 and 'Vegan silk' from class 25.

Costs

56. The guidance for awards of costs are set out in TPN 2/2016.

57. On reviewing the matters at hand, I consider that both parties have had some level of success and some failure which is roughly equal. It is therefore my view that on this occasion, the fairest basis to deal with costs is for each party to bear their own in this matter.

58. I therefore make no award of costs in this matter.

Dated this 28th day of September 2022

**L Nicholas
For the Registrar**