

O-993-22

TRADE MARKS ACT 1994
IN THE MATTER OF
INTERNATIONAL TRADE MARK NO. WO0000001491748
AND WO0000001491254
DESIGNATING THE UNITED KINGDOM
BY ALLBRIGHT LAW OFFICES
TO REGISTER

ALLBRIGHT

AND



AS TRADE MARKS
IN CLASS 45
AND OPPOSITIONS THERETO (UNDER NO. 419823 & 419824)
BY
ALBRIGHT IP LIMITED

Background and pleadings

1. ALLBRIGHT LAW OFFICES (“the holder”) is the holder of International Registrations (“IR”) nos. WO0000001491748 and WO0000001491254 (“the designations”) in respect of the trade marks set out on the title page. Protection in the UK was requested on 13 August 2019 in both cases in respect of class 45. The services will be set out later in this decision.

2. The IRs were published in the UK for opposition purposes on 10 January 2020. On 10 March 2020, Albright IP Limited (“the opponent”) opposed the designations in full under sections 5(1), 5(2)(a), 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”) on the basis of its earlier UK trade marks nos. 3079492, 3179637 and 2436697. In subsequent correspondence dated 9 March 2022 in the form of written submissions, the opponent reduced its grounds of opposition to 5(1), 5(2)(a) and 5(2)(b) on the basis of class 45 only in its earlier UK trade mark 3179637 and to 5(2)(b) for class 45 on the basis of 3079492. Moreover the opponent no longer relies on UK TM no. 2436697.

3. The details of the earlier registrations are set out below. The services relied on will be set out later in this decision.

| UK TM No. 3079492 | UK TM No. 3179637 |
|---|---|
| ALBRIGHT IP Albright IP (series of 2) Class 45 Filing date: 30 October 2014 Registration date: 20 March 2015 | ALBRIGHT Albright (series of 2) Class 45 Filing date: 10 August 2016 Registration date: 11 November 2016 |

4. The opponent’s registrations all have filing dates that are earlier than the designation date and, therefore they are earlier marks, in accordance with Section 6

of the Act. As the earlier registrations have not been registered for five years prior to the designation date, they are not subject to proof of use.

5. The holder filed counterstatements on 20 September 2021 in which it denied all grounds. The holder also put the opponent to proof of use for earlier registration no. 2436697, but for the reasons given above the opponent no longer relies on this earlier registration.

6. The cases were consolidated and this was confirmed by the Tribunal in a letter dated 27 January 2022.

6. Both parties have been professionally represented in these proceedings. The opponent represented themselves and the holder by Bird and Bird LLP.

7. Only the opponent filed evidence and written submissions in lieu of a hearing. I make this decision based on the material before me.

6. 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.

Opponent's evidence

8. The opponent supplied two witness statements and appended exhibits. The first witness statement was filed in the name of Katie Oliver dated 9 March 2022. Ms Oliver is a Chartered Trade Mark Attorney and director of the opponent. She appends two exhibits. Ms Oliver's witness statement describes the breadth of legal work undertaken by a Trade Mark Attorney and exhibit KAO1 illustrates this point. Her exhibit KAO2 is an example of a clients misspelling the name of the opponent, namely misspelled as ALLBRIGHT.

9. The second witness statement was filed in the name of Frederick Noble on the same date. Mr Noble is a Chartered Patent Attorney employed by the opponent.

His evidence is similar in scope to that of Ms Oliver in that it contains details of the breadth of legal work undertaken by a patent attorney and two exhibits illustrating a client misspelling of the ALBRIGHT name as ALLBRIGHT.

Section 5(1)

10. In its written submissions dated 24 August 2022 in relation to WO1491748, the opponent drew my attention to the following point,

In the counterstatement filed by the Applicant in UK (IR) No. WO0000001491748 ALLBRIGHT, the Applicant denied the grounds of Opposition asserted under Sections 5(2)(b) TMA 1994, 5(3) TMA1994 and 5(4)(a) TMA 1994 only. The Applicant has not denied the grounds of Opposition asserted under Sections 5(1) TMA 1994 and 5(2)(a) TMA 1994, in so far as the Opponent's earlier UK Trade Mark Registration No. 3179637. Accordingly, it must be assumed that the Applicant admits these grounds of Opposition.

11. I note the opponent's point, however I do not agree that an absence of a denial automatically equates to an admission. It is clear that the holder intended to defend its mark by dint of filing the TM8 to begin with and it is also clear that the holder was denying all other grounds. In particular with regard to the 5(2)(b) section of the counterstatement, viz

Section 5(2)(b)

2. The Applicant denies that the Applicant's Mark is closely similar to the marks which are the subject of the Opponent's Registrations. The Applicant also denies that the Contested Services are identical or similar to any of the Opponent's services. Therefore, the Applicant denies that there is any likelihood of confusion between the Application and the Opponent's Registrations. The Opponent is put to strict proof of this claim.

12. It would be illogical to deny that the respective marks are similar if one was simultaneously accepting they are identical. There is a denial in the extract above regarding the identity of the services. In my view this omission regarding the marks as they pertain to section 5(1) and 5(2)(a) was an administrative error on the part of the holder and for the purposes of this decision I will take the denial of 5(2)(b) as also being applicable to section 5(1) and 5(2)(a).

13. Section 5(1) of the Act reads as follows:

“5(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods and services for which the trade mark is applied for are identical with the goods and services for which the earlier trade mark is protected.

Identity of the marks

14. The marks to be compared are:

| Opponent's registration | Holder's mark |
|---|------------------|
| ALBRIGHT Albright (series of 2) | ALLBRIGHT |

15. I am guided on the matter of identity from *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, in which the Court of Justice of the European Union (CJEU) held that:

“54... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

16. Clearly the holder's mark is in a serif font, with differently sized letters and contains an additional letter L. As the guidance above states the differences must be 'so insignificant that they may go unnoticed'. I do not find the differences between the font used for the marks to be significant. However I find the sizing of the letters A and B and the additional letter L is significant which in my view denotes the mark as consisting of two conjoined words, i.e. ALL and BRIGHT, which in my view is not “so insignificant that they may go unnoticed”.

17. Having found that the holder's mark and the earlier mark relied on by the opponent are not identical, the opposition brought under section 5(1) and 5(2)(a) fail.

Section 5(2)(b)

18. 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”.

19. Section 5A of the Act reads:

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

20. The following principles are gleaned from the judgments 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 C3/03, *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 the mark as a whole and does not proceed to analyse its various details;

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

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

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

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

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

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

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

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

Comparison of services

21. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*,¹ the court stated at paragraph 23 of its judgment 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”.

22. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case², 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;

¹ Case C-39/97

² [1996] R.P.C. 281

(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.

23. The following case law is also applicable in relation to the contested services in these proceedings when in *Gérard Meric v Office for Harmonisation in the Internal Market*³, 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”.

24. The class 45 specifications of the two earlier marks are identical so it is reproduced just once below for ease of comparison. The services to be compared are:

| Opponent’s services | Holder’s services for WO1491748 | Holder’s services for WO1491254 |
|--|---|--|
| Legal services; legal services, including such services provided online from a computer network and/or via the Internet and/or extranets; intellectual property services; intellectual | Intellectual property consultancy; legal research; legal services; patent licensing [legal services]; licensing of trademarks [legal services]; registration of | Mediation; arbitration services; intellectual property consultancy; copyright management; licensing of intellectual property; monitoring |

³ Case T- 133/05

| | | |
|--|---|--|
| <p>property services, including such services provided online from a computer network and/or via the Internet and/or extranets; licensing; licensing of intellectual property; legal advice regarding franchising, licensing and intellectual property rights; exploitation of intellectual property rights; exploitation of inventions; exploitation of patents, Trade Marks, designs and copyright; intellectual property searching, drafting, filing, prosecution, registration, opposition, cancellation, revocation, invalidation, maintenance, renewal and enforcement services; intellectual property assignment services; copyright protection; management and exploitation of registered designs and unregistered design right; establishment, maintenance and management of domain name registrations and domain name protection; legal research; patent</p> | <p>domain names [legal services]; legal services relating to copyright licensing; licensing of databases [legal services]; licensing of patent applications [legal services]; legal services provided in relation to lawsuits; legal services relating to the exploitation of patents; legal services relating to the registration of trademarks; legal services for procedures relating to industrial property rights; licensing of computer software [legal services]; legal services in relation to the negotiation of contracts for others; licensing of patents and patent applications [legal services]; licensing of industrial property rights and copyright [legal services]; licensing of registered designs [legal services]; legal services relating to the exploitation of industrial property rights and copyright; legal</p> | <p>intellectual property rights for legal advisory purposes; legal research; litigation services; licensing of computer software [legal services]; registration of domain names [legal services]; alternative dispute resolution services.</p> |
|--|---|--|

| | | |
|---|---|--|
| <p>agency services; Trade Mark agency services; design, patent and Trade Mark searching; due diligence services (legal); title searching; arbitration, mediation, conciliation and alternative dispute resolution services; record keeping services in the field of intellectual property portfolio management and auditing; information, advisory and consultancy services relating to all of the aforementioned services.</p> | <p>services relating to the exploitation of broadcasting rights; legal services relating to the exploitation of intellectual property rights; licensing of rights relating to audio productions [legal services]; legal services relating to the negotiation and drafting of contracts relating to intellectual property rights; licensing of computer software and industrial property rights [legal services]; legal services relating to the management and exploitation of copyright and ancillary copyright; consultancy and legal services in the field of privacy and security laws, regulations, and requirements; legal services relating to the exploitation of ancillary rights relating to film, television, video and music productions; legal services relating to the protection and exploitation of copyright for film,</p> | |
|---|---|--|

| | | |
|--|---|--|
| | television, theater and music productions; licensing of rights relating to television, video and radio programs, productions and formats [legal services]; management and exploitation of industrial property rights and copyright by licensing for others [legal services]. | |
|--|---|--|

25. The respective services contain many literally identical terms or terms considered to be identical under the *Merix* principle which fall under the opponent's term *legal services* at large. As a result I will proceed on the basis that the services are identical.

Average Consumer

26. I next consider who the average consumer is for the contested services and how they are purchased. It is settled case law that the average consumer is deemed to be reasonably well informed and reasonably observant and circumspect.⁴ 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.⁵

27. The average consumers for the contested services are businesses which could encompass sole traders, SMEs or large multinational companies. Legal services relating to IP rights can range in price depending on the nature of the IP right or whether it concerns prosecution of a single application or the management of large

⁴ *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)

⁵ *Lloyd Schuhfabrik Meyer*, Case C-342/97.

IP portfolio. But even with such a price variation, legal services are generally expensive and the purchaser will be paying a high degree of attention. Services are likely to be accessed visually through a perusal of online materials or perhaps from a search of a professional membership association's website. I do not discount any aural aspect such as word of mouth recommendation.

Mark comparisons

28. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo SA v OHIM*⁶, 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.”

29. 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.

30. The respective trade marks to be compared are:

⁶ Case C-591/12P

| Opponent's registrations | Holder's marks |
|--|---|
| Mark ending '637 ALBRIGHT Albright | Mark ending '748  |
| Mark ending '492 ALBRIGHT IP Albright IP | Mark ending '254  |

31. The opponent's two earlier registrations consist of the same arrangement, namely both being a series of two word only marks, one mark being in capital letters and the other in sentence case. The single difference between the two registrations is the additional two letters **IP** in the registration ending '492. As the letters **IP** are well known as an initialism for Intellectual Property, and therefore wholly descriptive of the services, the dominant and distinctive element of the marks is **ALBRIGHT**.

32. The holder's word mark ending '748 is a slightly stylised word in capitals but with the first and fourth letters namely **A** and **B** being larger in size than the remaining letters which gives the overall impression of two words, **ALL** and **BRIGHT** being conjoined to form a single whole.

33. The holder's mark ending '254 is a composite arrangement of figurative and word elements in a vertical presentation. The figurative element is a diamond shape positioned above the word **ALLBRIGHT**, which itself sits above the words **LAW**

OFFICES. Below that element are three Chinese characters. The words **LAW OFFICES** are wholly descriptive of the services so it is the diamond device, the Chinese characters and the word **ALLBRIGHT** which all contribute to the overall impression but I find that, given words speak louder than devices, it is the word **ALLBRIGHT** which is the dominant element here.

34. Taking the visual comparison first, the respective marks all share the letters A-L-B-R-I-G-H-T. This is the entirety of the opponent's mark ending '637 and the distinctive element of its '492 mark. In terms of differences the holder's marks have some stylisation relating to letter sizing of the A and B and an additional letter L in its mark ending '748 and additional device and word elements in its '254 mark. Taking all this into account, I find there is a high degree of visual similarity between the opponent's marks and the holder's '748 mark and a medium level for the holder's '254 mark.

35. In an aural comparison, the device element and Chinese characters will play no part so I am only considering the word elements pronounceable by an English language consumer. Where only the words **ALBRIGHT** and **ALLBRIGHT** are pronounced, I find they will be pronounced identically. Where the other word elements are pronounced, namely **IP** and **LAW OFFICES** then I consider the aural similarity level to be high.

36. Finally turning to the conceptual comparison, I do not find that the element in common has any meaningful concept for a significant proportion of UK consumers although some might see it as a surname. Moreover the opponent contends in its written submissions that **ALLBRIGHT** is simply a variant spelling of **ALBRIGHT** and that the concepts are the same in both cases. I agree with this point about variant spelling. Although the holder's '748 mark has different sizing for the letters A and B making it appear as if two words have been conjoined the whole is still **ALLBRIGHT** as a concept. The remaining word elements namely **IP** and **LAW OFFICES** will bring to mind their usual meanings which in relation to the services, the opponent contends will overlap and "give rise to additional conceptual relevance". The device elements within the holder's '254 mark have no concept. The average consumer will likely recognise the characters in the mark as being Chinese from their appearance

but will not attribute any meaning to them. Taking all these factors into account I consider the conceptual similarity to be neutral as neither **ALBRIGHT** nor **ALLBRIGHT** has any meaningful concept. Or in the alternative whatever concept they do have will be the same in both cases.

Distinctive character of the earlier mark

37. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, based either on inherent qualities or because of use made, the greater the likelihood of confusion. In *Lloyd Schuhfabrik Meyer*⁷ 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).”

⁷ *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97

38. Registered trade marks possess varying degrees of inherent distinctive character starting from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, scaling up to those with high inherent distinctive character, such as invented words.

39. The opponent did not file any evidence showing that the distinctiveness of the earlier marks had been enhanced by use, so I will only consider the inherent distinctiveness.

40. The earlier marks **ALBRIGHT** and **ALBRIGHT IP** consist of an invented word and an initialism for Intellectual Property. The invented word element **ALBRIGHT** has no meaning in relation to the services for which the marks are registered whereas the **IP** element is clearly descriptive. Overall I consider the earlier marks to be distinctive to a high degree.

Likelihood of confusion

41. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them that they have kept in mind.⁸ I must also keep in mind the average consumer for the services, the nature of the purchasing process and have regard to 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 services and vice versa.

42. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related.

⁸ *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27

43. In *L.A. Sugar Limited*,⁹ Mr Iain Purvis K.C. (formerly Q.C.), sitting 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

44. In *Liverpool Gin Distillery Ltd*¹⁰, 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.

45. In *Kurt Geiger v A-List Corporate Limited*,¹¹ Mr Iain Purvis K.C. (formerly Q.C.), again sitting 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

⁹ *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10

¹⁰ *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207

¹¹ BL O-075-13

by use, the greater the likelihood of confusion'. This is indeed what was said in Sabel. However, it is a far from complete statement which can lead to error if applied simplistically.

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

46. In other words, simply considering the level of distinctive character possessed by the earlier 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.

47. So far in this decision I have found that,

- the services are identical
- The average consumer will pay a high level of attention during the primarily visual purchasing process
- There is a high degree of visual similarity between the opponent’s marks and the holder’s ‘748 mark.
- There is a medium degree of visual similarity between the opponent’s marks and the holder’s ‘254 mark.
- There is aural identity between the marks for the shared ALBRIGHT/ALLBRIGHT element.
- The level of overall aural similarity is high if the respective additional word elements are verbalised.
- There is conceptual neutrality.
- The earlier marks are inherently distinctive to a high degree

48. Based on the marks and the services before me and taking into account the assessments set out above, I find the nature of the **ALBRIGHT/ALLBRIGHT** element is the most pertinent factor to consider as per *Kurt Geiger*. As set out above a consumer rarely has the chance to make direct comparisons between marks but

instead relies on an imperfect recollection which could entail coming across the marks perhaps weeks or months apart. Whilst I did not find the opponent's mark and the holder's '748 mark to be identical under the test set out in the *SADAS* case, I nonetheless find these marks may be imperfectly recollected and therefore directly confusable.

49. In terms of the opponent's marks and the holder's '254 mark, notwithstanding the **ALBRIGHT/ALLBRIGHT** element, there are sufficient other differences between the marks with the device elements, such that I do not find that consumers will directly confuse these respective marks.

50. As I did not find direct confusion, I will go on to assess the likelihood of indirect confusion for the holder's '254 mark. I remind myself of the guidance given in *L.A. Sugar* that indirect confusion requires a consumer to undertake a thought process whereby they acknowledge the differences between the marks yet attribute the common element to the same or an economically connected undertaking, taking the later mark to be a possible brand extension or sub brand of the earlier mark. In this case consumers will note that the descriptive word element **LEGAL SERVICES** and the device elements and would likely draw the conclusion that the holder's '254 is simply a brand extension or sub-brand of the earlier marks, directed perhaps at legal services for the Chinese market. As such I find there is a likelihood of indirect confusion.

Conclusion

51. The oppositions under section 5(2)(b) have been successful. Subject to any appeal against this decision, the designations will be refused.

Costs

52. The opponent has been successful and is entitled to a contribution to its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 2/2016. Bearing in mind the guidance given in TPN 2/2016, I award costs to the opponent as follows but with regard to the official fees for the two oppositions I have taken into account that the grounds of opposition were reduced during proceedings and have

halved accordingly. I am also disinclined to award costs for the provision of evidence as it did not assist me in coming to my decision:

£200 Official fees for opposition

£400 Preparing Notice of Oppositions and considering the counterstatements

£400 Preparing written submissions

£1000 Total

53. I order ALLBRIGHT LAW OFFICES to pay Albright IP Limited the sum of £1000. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 14th day of November 2022

June Ralph

For the Registrar

The Comptroller-General