

O-0222-23

**TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK APPLICATION NO 3554827
BY HEATHER BOULTON
TO REGISTER**

BALLET
Contours

**AS A TRADE MARK IN CLASSES 25, 35 AND 41
AND
OPPOSITION THERETO (UNDER NO. 423989)
BY
DASHA STUDIOS LTD**

BACKGROUND

1) On 12 November 2020, Heather Boulton ('the applicant') applied to register the trade mark shown on the cover page of this decision in respect of the following goods and services:

Class 25: Clothing, footwear, headgear.

Class 35: Retail services in relation to clothing, footwear, headgear, books, cosmetics and stationery made either in store or online.

Class 41: Provision of physical training services to include classes as well as printed manuals for the purpose of instructor training, class plans and guidance books; Personal fitness training services; Personal trainer services [fitness training]; Personnel training; Coaching; Coaching services; Coaching [training]; Physical training services; Conducting training sessions on physical fitness online; Consultancy relating to physical fitness training; Physical fitness training services; Provision of information relating to physical training via an online web site; Arranging and conducting of classes; Arranging of classes; Ballet classes; Conducting classes in exercise; Conducting fitness classes; Conducting of classes; Exercise and fitness classes; Exercise classes; Provision of dance classes; Instruction in ballet; Personal coaching services in the field of ballet; Publication and editing of printed matter; Publication of audio books; Publication of booklets; Publication of books; Publication of calendars; Arranging and conducting of educational events; Arranging and conducting of entertainment events.

2) The application was published in the Trade Marks Journal on 15 January 2021 and notice of opposition was later filed by Dasha Studios Ltd ('the opponent'). The opponent claims that the trade mark application offends under section 5(2)(b) of the Trade Marks Act 1994 ('the Act'). It relies upon the following trade mark registration:

CONTOUR

Class 18: Baby carriers; slings for carrying babies; sling bags; travelling bags adapted for carrying toiletries for babies.

Class 21: Containers for drinks; bottles; water bottles; flasks; vacuum flasks; insulated containers; all for use in sports or exercise.

Class 25: Clothing; footwear; headgear; exercise wear; none being lingerie or swimwear.

Class 41: Providing of training; entertainment; fitness studio services; instruction in physical fitness; physical health education; physical training services; physical fitness instruction; physical health education; fitness classes; personal trainer services; providing fitness and exercise facilities; fitness and exercise programmes, clinics, clubs and salons; gymnasium services; ante-natal classes and courses; post-natal classes and courses; provision of instruction, training and educational assistance and educational counselling services in preparation for childbirth; post-natal support; information and advice relating to all these services.

Filing date: 25 October 2019

Date of entry in the register: 20 March 2020

3) The trade mark relied upon by the opponent is an earlier mark, in accordance with section 6 of the Act. As the earlier mark had not been registered for more than five years at the date the application was filed, the earlier mark is not subject to the proof of use conditions as per Section 6A of the Act.

4) At the time of filing the counterstatement, the applicant was without legal representation. Ms Boulton states, inter alia, the following:

- Proof of use of the earlier mark is requested. (However, for the reasons I have given in the preceding paragraph, the opponent is not required to provide any such proof.)

- The contested mark is neither identical, nor particularly similar, to the earlier mark, given both the prefix and the plural use of the word.
- Ms Boulton points out that the earlier mark does not cover any services in class 35 (whereas the contested application does).
- Ms Boulton denies that there is a likelihood of confusion in respect of all the classes covered by her application.

5) The opponent is represented by Bird & Bird LLP. As noted above, the applicant was unrepresented in these proceedings when the counterstatement was filed but has, thereafter, been represented by Elys IP Limited. The applicant filed evidence¹ which was also accompanied by submissions². I bear in mind the applicant's submissions and will refer to them if, and when, it is appropriate to do so. The opponent has filed nothing beyond the notice of opposition. Neither party requested a hearing and I have not received any submissions in lieu. I now make this decision after considering all the papers before me.

EVIDENCE

6) Ms Boulton's evidence provides information about her background as a ballet dancer and teacher, the nature of the goods and services actually provided by her business in the marketplace, related advertising thereof and information about another trade mark owned by her (which is not the subject of these proceedings). The purpose of this evidence appears to be to show that the contested mark is currently, and will continue to be, associated with the applicant and no other undertaking. However, none of this information is of assistance to Ms Boulton in the proceedings before me. This is because I must take account of all the circumstances in which the applied-for mark might be used if it were registered³. I must also make my assessment of the likelihood of confusion notionally and objectively based upon the marks before me and the goods and services which are covered by the terms listed in the respective specifications. The actual goods or services that are being

¹ Witness Statement of Heather Mae Boulton with Exhibits HMB1 – HMB4 and Witness Statement of Yvonne Onomor with Exhibits YO1 – YO4

² Dated 22 August 2022

³ See, for example, *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06

provided by the applicant or the opponent in the marketplace are irrelevant to that assessment (bearing in mind that the earlier mark is not subject to 'proof of use'). In this connection, the information provided in Ms Onomor's evidence at exhibits YO-1 and YO-2 showing the nature of use by the opponent on its website and on Instagram is also irrelevant. Furthermore, there is nothing before me to indicate that the respective marks have been used simultaneously and 'side -by-side' in the marketplace, and on such a scale, such as to satisfy me that confusion has not occurred or that it is unlikely to occur in the future. Finally, the information provided about another trade mark owned by the applicant is simply not relevant to the instant proceedings. For all of these reasons, I will make no further mention of the aforementioned evidence in this decision.

7) As regards the remainder of the applicant's evidence; specifically, Ms Onomor's evidence in exhibits YO-3 (consisting of dictionary definitions of the words 'contour' and 'ballet') and YO-4 (consisting of prints from a Google search, conducted on 22 August 2022, for 'contour' and 'fitness services' in the UK), I will refer to that evidence when it becomes relevant to do so.

DECISION

8) Section 5(2)(b) of the Act states:

"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.

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.”

Case law

9) The leading authorities which guide me are from the Court of Justice of the European Union ('CJEU'): *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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

10) 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.

Comparison of goods and services

11) All relevant factors relating to the goods and services should be taken into account when making the comparison. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU, Case C-39/97, stated at paragraph 23 of its judgment:

“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.”

12) Guidance on this issue has also come from Jacob J where, in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, the following factors were highlighted as being relevant:

- (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.

13) In relation to the retail services at issue, I note that in *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the General Court held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

14) Further, in *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning the comparison between retail services and goods. He said (at paragraph 9 of his judgment) that:

“9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent’s earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are ‘*similar*’ to goods are not clear cut.”

However, on the basis of the European courts’ judgments in *Sanco SA v OHIM*⁴, and *Assembled Investments (Proprietary) Ltd v. OHIM*⁵, upheld on appeal in *Waterford Wedgewood Plc v. Assembled Investments (Proprietary) Ltd*⁶, Mr Hobbs concluded that:

⁴ Case C-411/13P

⁵ Case T-105/05, at paragraphs [30] to [35] of the judgment

⁶ Case C-398/07P

- i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer's point of view, they are unlikely to be offered by one and the same undertaking;
- ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent's goods and then to compare the opponent's goods with the retail services covered by the applicant's trade mark;
- iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;
- iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

15) Further, in *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, ('*Avnet*') Jacob J. (as he then was) stated that:

"In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase."

16) I also note that in *Gérard Méric v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM Case T-133/05) ('*Méric*'), where the General Court held 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 the trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 Oberhauser v OHIM – Petit Liberto (Fifties) [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 Vedial v OHIM – France Distribution (HUBERT) [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 Koubi v OHIM – Flabesa (CONFORFLEX) [2004] ECR II-719, paragraphs 41 and 42).”

17) Finally, I bear in mind that, where it is not obvious to me that there is similarity between any of the respective goods and services, the onus is on the opponent to present evidence in support of its contentions that there is similarity (see, for example, Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc Case C-39/97, paragraph 22).

18) The goods and services to be compared are:

Opponent’s specification	Applicant’s specification
<p>Class 18: Baby carriers; slings for carrying babies; sling bags; travelling bags adapted for carrying toiletries for babies.</p> <p>Class 21: Containers for drinks; bottles; water bottles; flasks; vacuum flasks; insulated containers; all for use in sports or exercise.</p>	<p>Class 25: Clothing, footwear, headgear.</p> <p>Class 35: Retail services in relation to clothing, footwear, headgear, books, cosmetics and stationery made either in store or online.</p> <p>Class 41: Provision of physical training services to include classes as well as printed manuals for the purpose of instructor training, class plans and guidance books; Personal fitness</p>

<p>Class 25: Clothing; footwear; headgear; exercise wear; none being lingerie or swimwear.</p> <p>Class 41: Providing of training; entertainment; fitness studio services; instruction in physical fitness; physical health education; physical training services; physical fitness instruction; physical health education; fitness classes; personal trainer services; providing fitness and exercise facilities; fitness and exercise programmes, clinics, clubs and salons; gymnasium services; ante-natal classes and courses; post-natal classes and courses; provision of instruction, training and educational assistance and educational counselling services in preparation for childbirth; post-natal support; information and advice relating to all these services.</p>	<p>training services; Personal trainer services [fitness training]; Personnel training; Coaching; Coaching services; Coaching [training]; Physical training services; Conducting training sessions on physical fitness online; Consultancy relating to physical fitness training; Physical fitness training services; Provision of information relating to physical training via an online web site; Arranging and conducting of classes; Arranging of classes; Ballet classes; Conducting classes in exercise; Conducting fitness classes; Conducting of classes; Exercise and fitness classes; Exercise classes; Provision of dance classes; Instruction in ballet; Personal coaching services in the field of ballet; Publication and editing of printed matter; Publication of audio books; Publication of booklets; Publication of books; Publication of calendars; Arranging and conducting of educational events; Arranging and conducting of entertainment events.</p>
---	--

19) I will take each of the classes within the application in turn, grouping certain goods and services together where it is appropriate to do so⁷, beginning with class 25.

⁷ As per *Separode Trade Mark*, BL O-399-10

Class 25

20) All of the applicant's goods in class 25 are self-evidently identical to the goods covered by the opponent's specification in the same class.

Class 35

Retail services in relation to clothing, footwear, headgear, ...made either in store or online.

21) On the same basis as in the *Oakley* case referred to above, I find that the above retail services of the applicant are complementary to the opponent's 'clothing, footwear, headgear' in class 25. However, the respective nature, method of use and purpose differs and there is no real competitive relationship in play. Overall, I find a medium degree of similarity between the aforementioned goods and services.

Retail services in relation to ... books, cosmetics and stationery made either in store or online.

22) The above retail services relate to 'books, cosmetics and stationery'. The earlier mark does not cover any kind of retail service. Furthermore, none of the particular goods which are the subject of the applicant's retail services are covered by the earlier mark. I remind myself that, as the case law above indicates, the fact that the goods covered by the opponent's specification are not identical to the goods which are the subject of the applicant's retail services does not preclude a finding of similarity between them. However, there is nothing before me to indicate that any of the goods covered by the opponent's mark are commonly sold alongside 'books, cosmetics and stationery' such that the respective goods are typically subject to the same retail service. The applicant's retail services listed above are therefore unlikely to be important for the sale of any of the opponent's goods. The average consumer is unlikely to believe that an undertaking selling the opponent's goods is the same, or connected to, an undertaking that provides 'retail services in relation to books, cosmetics and stationery'. There is therefore no complementarity in play between

those goods and services. The respective nature, purpose and method of use also differs and there is no obvious competitive relationship. There is therefore no similarity between the above-listed retail services of the applicant and any of the opponent's goods in classes 18, 21 and 25. It is also not obvious to me that there is any similarity between any of the opponent's services in class 41 and the applicant's retail services listed above. I therefore find no similarity between the applicant's 'Retail services in relation to ... books, cosmetics and stationery made either in store or online' and the goods and services covered by the earlier mark.

Class 41

Provision of physical training services to include classes as well as printed manuals for the purpose of instructor training, class plans and guidance books; Personal fitness training services; Personal trainer services [fitness training]; Personnel training; Coaching; Coaching services; Coaching [training]; Physical training services; Conducting training sessions on physical fitness online; Physical fitness training services; Arranging and conducting of classes; Arranging of classes; Ballet classes; Conducting classes in exercise; Conducting fitness classes; Conducting of classes; Exercise and fitness classes; Exercise classes; Provision of dance classes; Instruction in ballet; Personal coaching services in the field of ballet.

23) I find that all of the above services of the applicant in class 41 fall within the opponent's broad term 'providing of training' and/or the term 'fitness classes'. The respective services are therefore identical as per *Meric*.

Provision of information relating to physical training via an online web site.

24) The opponent's specification includes 'information and advice relating to all these services'. That term relates back to all the preceding terms in the opponent's specification including 'providing of training'. The applicant's services listed above therefore fall within the opponent's services. They are identical as per *Meric*.

Consultancy relating to physical fitness training.

25) The applicant's services listed above involve the provision of professional advice and/or information to the average consumer about physical fitness training. There is overlap between the applicant's services and the opponent's 'providing of training' and 'information and advice relating to [those services]' because the users will be the same, the respective natures, methods of use and purpose is highly similar and trade channels are likely to be the same or overlap significantly. There is also a complementary relationship in play in the sense described in the case law. I find that the respective services are similar to a high degree.

Publication and editing of printed matter; Publication of audio books; Publication of booklets; Publication of books.

26) The opponent's specification includes 'providing of training', 'physical health education' and 'information and advice relating to all these services'. The applicant's services include the publication of printed matter, books and booklets, all of which may be for educational/training purposes. The respective nature and methods of use are not the same but the users may be the same, there is an overlap in purpose in the sense that both parties' services may be used to improve one's understanding of how to improve physical health and there may be a complementary relationship in play in the sense described in the case law. I find a medium degree of similarity between the applicant's services listed above and the opponent's 'providing of training', 'physical health education' and 'information and advice relating to [the aforementioned services]'.

Publication of calendars.

27) It is not obvious to me, bearing in mind the guidance in the *Avnet* case referred to above, and the 'core' meaning of 'publication of calendars' that those services share any real similarity with any of the opponent's goods or services. There is no obvious overlap in nature, methods of use, intended purpose, or trade channels. Neither is there any obvious competitive or complementary relationship in play of the kind described in the case law. I find no similarity between the opponent's goods and services and the applicant's 'publication of calendars'.

Arranging and conducting of educational events.

28) The opponent's specification includes 'physical health education'. I find that this falls within the applicant's services above; they are identical as per *Meric*.

Arranging and conducting of entertainment events.

29) The above services of the applicant fall within the opponent's broad term 'entertainment'; they are identical as per *Meric*.

30) As there cannot be a likelihood of confusion where there is no similarity between the respective goods and services⁸, the opposition must fail against the applicant's 'Retail services in relation to ... books, cosmetics and stationery made either in store or online' in class 35 and 'Publication of calendars' in class 41.

Average consumer and the purchasing process

31) It is necessary to determine who the average consumer is for the respective goods and services that have been to be either identical or similar and the manner in which they are likely to be selected. 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."

⁸ *Waterford Wedgewood v OHIM* Case C-398/07

32) The average consumer for the respective goods in class 25 is the general public. The purchasing act will be primarily visual for all of those goods as they will be selected after perusal of racks/shelves in high-street stores or from photographs/images on Internet websites or in catalogues. That is not to say though that the aural aspect should be ignored since the goods may sometimes be the subject of discussions with sales representatives, for example. The cost of those goods is likely to vary. However, factors such as size, material, comfort/fit, aesthetics and/or suitability for purpose are likely to be taken account of by the consumer. Generally speaking, I find that at least a medium degree of attention is likely to be paid during the purchase for the aforementioned goods. Similar considerations apply to the applicant's retail-type services in class 35. Those services are likely to be sought out primarily visually on the high street or on-line such that the visual aspect is of most importance. However, again I do not discount the potential for aural use of the marks for those services. The average consumer is likely to take into account factors such as the variety of goods offered under that retail service, returns policies etc. such that a medium degree of attention is likely to be paid to their selection.

33) In terms of the respective class 41 services, I note that the opponent has referred to the actual use that the opponent is carrying out in the marketplace⁹ which, it says, shows that the opponent's current target market is pregnant women or mothers who are 'extremely attentive to their physical wellbeing'. As I noted earlier, the opponent's mark is not subject to proof of use and the assessment I must make is a notional and objective one based upon the actual services listed in the opponent's specification. I have found that the opponent's specification includes broad terms such as 'providing of training'. Such services are not limited to those which would be appropriate only for pregnant women or mothers. The average consumer for the parties' services in class 41 is the general public at large. The cost of the services at issue is likely to vary but they are, generally speaking, unlikely to be very inexpensive or the subject of an impulse purchase. Rather, I would expect the purchase to be a reasonably considered one. On the whole, I would expect a medium to high degree of attention to be paid during the purchase. The services are

⁹ Exhibits YO1 and YO2

likely to be sought out primarily by eye using the internet or brochures. However, I do not discount that some may be the subject of aural recommendations.


Comparison of marks

34) 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.”

It would be wrong, therefore, artificially to dissect the marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

35) The marks to be compared are:

Opponent's mark	Applicant's mark
CONTOUR	

36) The overall impression of the opponent's mark rests solely in the single word CONTOUR. The applicant's mark consists of the two words BALLEET and Contours presented in a standard type of font. The former word is positioned in a curved position around the initial letter 'C' of 'Contours'. BALLEET is positioned at the beginning of the mark and is far from negligible. However, given its relative size and positioning to the word 'Contours', it takes up a much smaller proportion of the mark as a whole and has less visual impact than 'Contours'. Furthermore, BALLEET is entirely descriptive in relation to goods and services which relate to ballet. Bearing in mind all of these factors, I find that the word 'Contours' has the greatest weight in the overall impression of the applicant's mark.

37) Visually, both marks contain the word Contour (the difference between upper and lower case is not a distinguishing factor). However, in the applicant's mark that word has an additional letter, 's', at the end to form the plural which is absent from the earlier mark. The applicant's mark also has the word BALLEET curving around the initial letter 'C' of 'Contours' which is absent from the earlier mark. While I bear in mind that it is the beginnings of marks which tend to have the greatest impact upon the eye, that is not a hard and fast rule. Rather it is a general rule of thumb and I do not consider that it applies in this case given, in particular, the relatively small size of BALLEET as compared to Contours meaning the latter has the greater visual impact. The opponent refers to the 'graphic stylisation' of the applicant's mark being a point of visual difference. However, as I have already stated, I consider that the contested mark is presented in a standard type of font. I therefore do not consider that the contested mark bears any particular stylisation which is visually different to that used in the earlier mark. Overall, I find a high degree of visual similarity between the marks.

38) Aurally, the applicant contends that the marks are aurally dissimilar or, at best, similar to a low degree. Both marks consist of well-known words, the pronunciation of which requires no explanation. Clearly, the marks coincide in respect of the two-syllable words 'CONTOUR' and 'Contours', with the only aural difference between those words being the additional letter 's' at the end of the latter. The applicant's

mark also contains the two-syllable word BALLET which precedes the word 'Contours' and is entirely absent from the opponent's mark. Overall, I find a medium degree of aural similarity between the marks.

39) Turning to the conceptual comparison, the applicant provides dictionary definitions of the words 'ballet' and 'contour'¹⁰. 'Contour', as the dictionary definitions indicate, can have a number of slightly different meanings depending on the context of use. Of those meanings, I consider the most likely way in which the average consumer will perceive the opponent's mark will be either as: i) referring to the shape of something or ii) to change the shape of a surface (to 'shape' something). Turning to the applicant's mark, 'contours', of itself, has essentially the same meaning as 'contour' in the opponent's mark. Ballet will, of course, be immediately perceived as the well-known form of dance. As a whole, the applicant's mark evokes the concept of ballet shapes/shaping in the average consumer's mind. Both marks therefore share the concept of shapes/shaping albeit that those in the applicant's mark relate specifically to ballet. I find there to be a medium degree of conceptual similarity between the marks.

Distinctive character of the earlier mark

40) The distinctive character of the earlier mark must be considered. The more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). 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*

¹⁰ Exhibit YO 3

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).”

41) The opponent has filed no evidence and therefore I have only the inherent degree of distinctiveness of CONTOUR to consider. The mark will be perceived as referring to the shape of something or to changing the shape of something. In the context of the opponent’s earlier goods and services (the relevant ones being those which have been found to be identical or similar to the contested goods and services), I consider that the word CONTOUR has some allusive qualities. To my mind, for goods such as ‘clothing, footwear and headgear’ and services such as ‘providing of training’ and ‘fitness classes’ the mark alludes to the purpose of such goods and services. This is because the goods could be used to ‘shape’ the body (to improve the shape/contours of the body) or to closely follow/fit the contours of the body¹¹ and the services may be used to ‘shape’ the body through participation in physical fitness. I find that for those kinds of goods and services, the inherent distinctiveness of the mark is below-normal. For other goods and services such as ‘entertainment’ I can see no allusive message and the inherent distinctiveness is of a normal level.

¹¹ I make this finding despite the exclusion in the opponent’s specification of ‘none being lingerie or swimwear’ because the mark, in my view, remains allusive for other kinds of close-fitting clothing, footwear and headgear.

Likelihood of confusion

42) I must now feed all of my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors: i) the interdependency principle, whereby a lesser degree of similarity between the goods and services may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*); ii) the principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*), and; iii) the factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*).

43) In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: ‘The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark’.

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

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This

may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).

- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).
- (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)".

44) 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.

45) Furthermore, it is not sufficient that a mark merely calls to mind another mark: *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17. This is mere association not indirect confusion.

46) I bear in mind that the respective marks are visually highly similar and aurally and conceptually similar to a medium degree. I must also give due regard to the principle of imperfect recollection. In my view it is likely that CONTOUR in the earlier mark may be imperfectly recalled as CONTOURS (and vice-versa). With these factors in mind, I come to the view that the circumstances of the instant case are akin to the type of indirect confusion described by Mr Purvis in his category (b). I find that the average consumer, whether paying a medium or medium to high degree of attention during the mainly visual purchase is likely to perceive the applicant's mark as a sub-brand or brand extension of the earlier mark (owing to the likely imperfect recollection I have described) and the descriptiveness of the word BALLETT. I make this finding despite the earlier mark having a below-normal degree of distinctiveness for some of the

earlier services. In this connection, I have borne in mind that in *L'Oréal SA v OHIM*, Case C-235/05 P, the CJEU found that:

“45. The applicant’s approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders.”

There is a likelihood of indirect confusion in respect of all the goods and services which are identical or share some degree of similarity.

47) This conclusion is not disturbed by the opponent’s evidence of other traders using the word ‘CONTOUR’ in relation to fitness services in the UK¹². Firstly, I note that there is nothing to indicate that any of the sites shown in the evidence were in operation at the relevant date, which is the filing date of the contested mark, 12 November 2020. Secondly, there are only five different providers shown the evidence using the word ‘CONTOUR’. I am far from persuaded that this minimal evidence of use of the term ‘CONTOUR’ by other traders in relation to fitness services is sufficient to indicate that there is no likelihood of confusion between the marks at issue in the instant case.

OUTCOME

¹² Exhibit YO4

48) The opposition succeeds against all of the contested goods and services except for 'Retail services in relation to books, cosmetics and stationery made either in store or online' in class 35 and 'Publication of calendars' in class 41.

COSTS

49) As the opponent has been largely successful, it is entitled to a contribution towards its costs. I bear in mind that the opponent has filed nothing in these proceedings beyond the notice of opposition and that the information provided in the same was brief. Using the guidance in Annex A of Tribunal Practice Notice 2/2016, and allowing for the small degree of success of the applicant in classes 35 and 41, I award the opponent costs on the following basis:

Preparing a statement and considering the applicant's statement	£200
Official fee:	£100
Less £15 for applicant's degree of success	
Total:	£285

50) I order Heather Boulton to pay Dasha Studios Ltd the sum of **£285**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 1st day of March 2023

Beverley Hedley
For the Registrar,
the Comptroller-General