

O/0238/23

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3614229  
BY SUE PRIOR  
TO REGISTER THE FOLLOWING TRADE MARK:**



**IN CLASSES 16 & 41**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 428441  
BY LIVING STREETS (THE PEDESTRIANS ASSOCIATION)**

## **Background and pleadings**

1. On 22 March 2021, Sue Prior (“the applicant”) applied to register the trade mark displayed on the cover page of this decision in the UK, under number 3614229 (“the contested mark”). Details of the application were published for opposition purposes on 20 August 2021. Registration is sought for the following goods and services:

Class 16: Educational publications; educational and instructional material.

Class 41: Educational services; publication of educational materials.

2. On 22 November 2021, Living Streets (The Pedestrians Association) (“the opponent”) opposed the application in full under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon its UK trade mark number 3330208, **WOW** (“the earlier mark”). The earlier mark was filed on 8 August 2019 and became registered on 7 December 2018 in respect of a range of goods and services in classes 9, 16, 26, 39 and 41. For the purposes of the opposition, the opponent relies upon some of those goods and services, namely:

Class 16: Printed matter; printed matter for instructional purposes; printed teaching materials; printed teaching activity guides; instructional manuals for teaching purposes; none of the aforesaid goods relating to games or interactive entertainment.

Class 41: Education; provision of on-line electronic publications; none of the aforesaid services relating to games or interactive entertainment.

3. Given the respective filing dates, the opponent’s mark is an earlier mark in accordance with section 6 of the Act. As it had not completed its registration process more than five years before the filing date of the contested mark, it is not subject to the proof of use provisions specified in section 6A of the Act. Consequently, the opponent is entitled to rely upon all the goods and services identified, without having to demonstrate genuine use.

4. In its notice of opposition, the opponent contends that the contested mark is similar to its earlier mark. It also argues that the parties' goods and services are identical. Based upon these factors, it submits that there is a likelihood of confusion, including the likelihood of association.

5. The applicant filed a counterstatement, denying the ground of opposition.

6. The opponent is professionally represented by Stone King LLP, whereas the applicant is not professionally represented. Only the applicant filed evidence. Neither party requested an oral hearing, nor did they file written submissions in lieu of attendance. However, I note that the opponent filed written submissions during the evidence rounds. This decision is taken following careful consideration of the papers before me, keeping all submissions in mind.

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

### **Preliminary remarks**

8. Within its counterstatement, the applicant describes perceived differences between the actual services provided by the parties, intimating that this defeats any possibility of confusion. The applicant also filed evidence in the form of the witness statements of Carol Williams and Jane Edwards, together with nine exhibits. The purpose of their statements is to provide details of the applicant's business project, its use of the contested mark, marketing of the project and perceived differences between the actual goods and services provided by the parties. For reasons I will now explain, these points will, as a matter of law, have no bearing on the outcome of this opposition.

9. A trade mark registration is essentially a claim to a piece of legal property. Every registered trade mark is entitled to legal protection against the use, or registration, of the same or similar trade marks for the same or similar goods if there is a likelihood of

confusion. Once a trade mark has been registered for five years, section 6A of the Act is engaged and the opponent can be required to provide evidence of use of its mark. Until that point, however, the mark is entitled to protection in respect of the full range of goods and services for which it is registered.

10. As outlined above, the mark relied upon by the opponent had not been registered for five years at the date on which the application was filed. Consequently, the opponent is not required to prove its use of it. The earlier trade mark is entitled to protection against a likelihood of confusion with the contested mark based on the 'notional' use of that earlier mark for the goods listed in the register.

11. The concept of notional use was explained by Laddie J in *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 like this:

“22. [...] It must be borne in mind that the provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to be a finding of infringement. Similarly, even when the proprietor of a registered mark uses it, he may well not use it throughout the whole width of the registration or he may use it on a scale which is very small compared with the sector of trade in which the mark is registered and the alleged infringer's use may be very limited also. In the former situation, the court must consider notional use extended to the full width of the classification of goods or services. In the latter it must consider notional use on a scale where direct competition between the proprietor and the alleged infringer could take place”.

12. So far as the applicant's claimed use of the contested mark is concerned, in *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited* (Case C-533/06), the Court of Justice of the European Union (“CJEU”) stated at paragraph 66 of its judgment that, when assessing the likelihood of confusion in the context of registering a new trade mark, it is necessary to consider all the circumstances in which the mark might be used if it were registered. As a result, even though the applicant has suggested the

ways in which the mark will be used, and the goods and services for which it will be used, my assessment later in this decision must take into account only the contested mark – and its specification – and any potential conflict with the earlier mark. Any differences between the actual goods and services provided by the parties are not relevant unless those differences are apparent from the applied-for and registered marks. In *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P, the CJEU stated that:

“59. As regards the fact that the particular circumstances in which the goods in question were marketed were not taken into account, the Court of First Instance was fully entitled to hold that, since these may vary in time and depending on the wishes of the proprietors of the opposing marks, it is inappropriate to take those circumstances into account in the prospective analysis of the likelihood of confusion between those marks.”

13. Within its counterstatement, the applicant also argues that there has been no actual confusion by consumers. While I acknowledge the applicant’s comments, I must, at this early stage, clarify that an absence of confusion will not have any bearing on whether there exists a likelihood of confusion between the applied-for mark and the opponent’s earlier mark. While evidence of actual confusion may be persuasive where it exists, the absence of confusion in the marketplace is rarely significant. In *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchin LJ stated that:

“80. [...] the likelihood of confusion must be assessed globally taking into account all relevant factors and having regard to the matters set out in *Specsavers* at paragraph [52] and repeated above. If the mark and the sign have both been used and there has been actual confusion between them, this may be powerful evidence that their similarity is such that there exists a likelihood of confusion. But conversely, the absence of actual confusion despite side by side use may be powerful evidence that they are not sufficiently similar to give rise to a likelihood of confusion. This may not always be so, however. The reason for the absence of confusion may be that the mark has only been used to a limited extent or in relation to only some of the goods or services for which it is registered, or in such a way that there has

been no possibility of the one being taken for the other. So there may, in truth, have been limited opportunity for real confusion to occur.”

14. Furthermore, in *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283 Millett LJ stated that:

“Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff’s registered trade mark.”

15. Whilst the applicant has filed evidence of use of the competing marks, it is extremely limited. It is far from sufficient for the purpose of demonstrating that the marks have been used side by side. I am not satisfied, on the basis of the evidence provided, that there has been any real possibility for confusion between the marks to occur. As such, I do not consider the applicant’s arguments on the point to be persuasive.

16. Finally, I note that the applicant contends that the contested mark was designed a “long time before” the opponent registered the earlier mark. I must clarify that this line of argument will also have no bearing on the outcome of this opposition. Section 72 of the Act stipulates that registration shall be taken as *prima facie* evidence of the validity of a registered mark. Section 5(2) of the Act turns upon whether the ‘attacker’ has an earlier trade mark compared to the mark under ‘attack’, as defined by section 6 of the Act. As I understand it, the applicant has not sought to invalidate the registration relied upon by the opponent in these proceedings. Consequently, the opponent’s trade mark must be regarded as a validly registered mark. A likelihood of confusion between the marks in suit, based on their notional use throughout the UK, would be enough to justify the refusal of the contested mark. When the contested mark was designed is not relevant to that assessment.

## **Decision**

### **The law**

17. Sections 5(2)(b) and 5A of the Act read 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.”

“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.”

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

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

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

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

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

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

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

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

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

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



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

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

### **Comparison of goods and services**

19. In comparing the respective specifications, all relevant factors should be considered, as per *Canon*, where the CJEU stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, [...] 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”.

20. Additionally, the relevant factors for assessing similarity identified in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 include an assessment of the users and channels of trade of the respective goods and services.

21. Moreover, the law requires that goods be considered identical where one party’s description of its goods or services encompasses the specific goods or services covered by the other party’s description (and vice versa).<sup>1</sup>

22. The goods and services to be compared are outlined at paragraphs 1 and 2.

### Class 9

23. The opponent’s term ‘*printed matter*’ covers all material that has been printed or published, such as, for example, newspapers, magazines or books. The opponent has

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<sup>1</sup> *Gérard Meric v OHIM*, Case T-133/05

specifically excluded such goods relating to games and interactive entertainment. However, the opponent has not excluded such goods for educational or instructional purposes. As the applicant's '*educational publications; educational and instructional material*' fall within the opponent's broad term, they are to be regarded as identical.

#### Class 41

24. Although '*educational services*' in the applicant's specification and '*education*' in the opponent's specification are worded slightly differently, they describe the same services. Clearly, they are identical.

25. Publication refers to the act of making information available. The applicant's '*publication of educational materials*' covers the publication of such materials in physical and electronic formats. The opponent's '*provision of on-line electronic publications*' could relate to educational publications. Providing publications online is a means of electronic publication. Based upon these factors, it is my view that the applicant's service encompasses the opponent's service, rendering them identical.

#### **The average consumer and the nature of the purchasing act**

26. As the case law above indicates, it is necessary for me to determine who the average consumer is for the parties' goods and services. I must then determine the manner in which the goods and services are likely to be selected by the average consumer. 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. [...] 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.”

27. 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 in question.<sup>2</sup>

28. Due to the nature of the goods and services at issue in these proceedings, I agree with the opponent that it is necessary to identify two groups of relevant consumers, namely, the general public and business or professional users.

29. The general public are likely to purchase the goods and services relatively frequently for ongoing use to support their studies. The cost of the goods and services may vary, though, overall, they are relatively inexpensive purchases. As such, the purchasing of the goods and services is not likely to follow an overly considered thought process. Nevertheless, when selecting the goods, the general public will consider factors such as content, the author(s), and whether the materials are appropriate to their learning needs. When selecting the services, the general public will consider factors such as the quality of the service, ease of use/access as well as the outcomes of previous students. Taking all of this into account, I find that the general public will demonstrate a medium level of attention during the purchasing process, though I accept that it may be slightly higher in relation to educational services. The goods are likely to be purchased from retail outlets or their online equivalents after viewing information on physical displays or the internet. In light of this, the purchasing process will be predominantly visual in nature. However, I do not discount aural considerations entirely as it is possible that the general public may receive word-of-mouth recommendations or may wish to discuss the materials with a sales assistant prior to purchasing the goods. The services are likely to be obtained directly from the service provider after viewing information in brochures or on the internet. As such, the purchasing process will be largely visual in nature. However, I do not discount aural considerations in the form of, for example, receiving information verbally at an ‘open’ event or discussing the services with a representative prior to making a purchase.

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<sup>2</sup> *Lloyd Schuhfabrik Meyer*

30. As for business or professional users, the goods and services are likely to be purchased relatively frequently for the ongoing educational needs of a business or for the ongoing operation of an educational establishment. Again, the cost of the goods and services may vary. However, overall, they are not likely to be overly expensive. Therefore, the purchasing of the goods and services is not likely to follow an overly considered thought process. Nevertheless, I recognise that business or professional users will be conscious of similar factors when selecting the goods and services, though more aligned to the needs of their employees or students. In light of the above, I find that business or professional users will demonstrate a medium level of attention during the purchasing process. Again, I recognise that this may be slightly higher in respect of educational services. The goods are likely to be purchased from retailers, publishers and specialist suppliers, or their online equivalents, whereby they will be selected after viewing information on physical displays, in brochures or on the internet. Again, visual considerations will dominate. However, aural considerations are not dismissed completely, since business and professional users may engage in discussions with sales representatives prior to making a purchase. The services will be purchased directly from the provider after viewing information in brochures or on the internet. Visual considerations will dominate the purchasing process, though I do not discount aural considerations completely as these consumers may receive word-of-mouth recommendations or wish to discuss the services with the provider before making a purchase.

### **Distinctive character of the earlier mark**

31. In *Lloyd Schuhfabrik Meyer*, 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 *WindsurfingChiemsee 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 *WindsurfingChiemsee*, paragraph 51).”

32. Registered trade marks possess varying degrees of inherent distinctive character. These range from the very low, such as those which are suggestive or allusive of the goods or services, to those with high inherent distinctive character, such as invented words. Dictionary words which do not allude to the goods or services will be somewhere in the middle. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark, the greater the likelihood of confusion.

33. Although the distinctiveness of a mark may be enhanced as a result of it having been used in the market, the opponent has filed no evidence of use; accordingly, I have only the inherent position to consider.

34. The earlier mark is in word-only format and consists of the word ‘WOW’. As it is the only element in the mark, the distinctiveness lies in the word itself. The word ‘WOW’ is an exclamation used to show surprise or pleasure.<sup>3</sup> It has no descriptive or allusive qualities. It could be considered mildly laudatory, i.e. a promotional statement used to attract attention to positive characteristics of the goods and services. However,

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<sup>3</sup> <https://dictionary.cambridge.org/dictionary/english/wow>

when used on its own, this meaning is somewhat ambiguous. Overall, I find that the earlier mark possesses no more than a medium level of inherent distinctive character.

### Comparison of trade marks

35. It is clear from *Sabel* 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 *Bimbo* 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.”

36. Therefore, it would be wrong to dissect the trade marks artificially, though it is necessary to take into account the distinctive and dominant components of the marks; due weight must be given to any other features which are not negligible and hence contribute to the overall impressions created by the marks.

37. The competing trade marks are as follows:

The earlier mark	The contested mark
WOW	

### Overall impressions

38. The earlier mark is in word-only format and comprises the word 'WOW'. As there are no other components in the mark, the overall impression rests in the word itself.

39. The contested mark is figurative and consists of several elements. At the top-centre of the mark appears the word 'WOW'. Emanating from the letters are hammer, plant and computer mouse devices. Behind the word appears an incomplete circle, reminiscent of a globe with lines. The words 'World of Work' appear below these elements. The elements in the contested mark are presented in orange, green, purple and blue. Due to its size and relative position within the mark, it is my view that the word 'WOW' dominates the overall impression. The words 'World of Work' are much smaller and appear below this element; as such, whilst still contributing, they play a lesser role in the overall impression. The devices and colours used provide a contribution, but will be seen as decorative and, therefore, play a lesser role.

### Visual comparison

40. Clearly, the competing marks are visually similar in the shared use of the word 'WOW'. This word forms the entirety of the earlier mark and the dominant element in the contested mark. I do not consider the particular font used in the contested mark to be a point of significant visual difference between the marks as it is a standard typeface which is likely to go unnoticed by relevant consumers. Visually, the competing marks differ in all other respects. Bearing in mind my assessment of the overall impressions, I find that there is a medium degree of visual similarity between them.

### Aural comparison

41. The word 'WOW' in the competing marks is a one-syllable word which will be given its ordinary pronunciation. Consumers will make no attempt to articulate the figurative elements. In my view, the contested mark is, therefore, likely to be pronounced as "WOW-WORLD-OF-WORK". The competing marks aurally coincide insofar as the only syllable of the earlier mark appears at the beginning of the contested mark, a

position which is generally considered to have more impact.<sup>4</sup> They differ in that the contested mark contains three additional syllables. Overall, I find that the competing marks are aurally similar to a medium degree.

### Conceptual comparison

42. As explained previously, the earlier mark will be understood in accordance with its dictionary meaning, i.e. an exclamation used to show surprise or pleasure. The words 'World of Work' in the contested mark are likely to be understood as a collective reference to the wide variety of occupations, jobs, careers and opportunities that exist. They are, therefore, descriptive of a characteristic of the goods and services, e.g. the subject of the educational materials and services. The word 'WOW' in the contested mark may be perceived by some consumers as an acronym for the words below, namely, 'World of Work'. In these circumstances, the word 'WOW' will reinforce the meaning conveyed by these words and the competing marks will share no concept. However, it is my view that at least a significant proportion of relevant consumers will understand the word 'WOW' in the same sense as in the earlier mark. For such consumers, the competing marks both convey the meaning associated with the exclamation, though differ in that the contested mark conveys an additional concept. In respect of this significant proportion of consumers, I find that the competing marks are conceptually similar to a medium degree.

### **Likelihood of confusion**

43. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. One such factor is the interdependency principle, i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods or services, and vice versa. As mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer

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<sup>4</sup> *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02



rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

44. 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.

45. Earlier in this decision, I concluded that:

- The parties' goods and services are identical;
- Relevant consumers of the goods and services will consist of the general public and business or professional users, who will both demonstrate at least a medium level of attention when selecting the goods and services;
- The purchasing process will be predominantly visual in nature, though aural considerations have not been excluded;
- The earlier mark possesses a medium level of inherent distinctive character;
- The overall impression of the earlier mark is dominated by the word 'WOW';
- The overall impression of the contested mark is dominated by the word 'WOW', while the words 'World of Work', the figurative elements and the colours play lesser roles;
- The competing marks are visually and aurally similar to a medium degree;
- Depending on how the word 'WOW' in the contested mark is perceived, the competing marks are either conceptually similar to a medium degree or dissimilar.

46. In *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, Kitchin LJ stated that:

“[...] if, having regard to the perceptions and expectations of the average consumer, the court concludes that a significant proportion of the relevant public is likely to be confused such as to warrant the intervention of the court then it may properly find infringement.”

47. Although this was in the context of infringement, the same approach is appropriate when considering a claim under section 5(2) of the Act.<sup>5</sup> It is not, therefore, necessary for me to find that the majority of consumers will be confused. The question is whether there is a likelihood of confusion amongst a significant proportion of the public displaying the characteristics attributed to an average consumer.

48. I acknowledge that the competing marks differ in that the contested mark contains additional elements that have no counterparts in the earlier mark. As previously outlined, these comprise the words ‘World of Work’, the figurative elements and the use of colour. Nevertheless, taking into account the overall levels of similarity between the competing marks, I am of the view that the aforementioned differences are likely to be insufficient to distinguish the parties’ goods and services, particularly considering they are identical. The additional words in the contested mark describe a characteristic of the goods and services. Moreover, the figurative elements are likely to be perceived as decorative, as is the use of colour. Whilst these elements are not replicated in the earlier mark, they play lesser roles in the overall impression of the contested mark. The entirety of the earlier mark is reproduced in the contested mark and dominates its overall impression. For a significant proportion of consumers, the common presence of this element results in a shared concept. Taking into account imperfect recollection, it is my view that at least a significant proportion of consumers – even when paying a slightly higher level of attention during the purchasing process – may not recall the respective marks with sufficient accuracy to differentiate between them. To my mind, it is highly likely that such consumers may misremember the particular decorative

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<sup>5</sup> *Soulcycle Inc v Matalan Ltd* [2017] EWHC 496 (Ch)

presentation of the mark and whether the dominant element is accompanied by a descriptive reference to the goods and services. For the reasons previously outlined, I consider it far more likely that this proportion of consumers will retail and recall the word 'WOW'. Consequently, I find that there is a likelihood of direct confusion.

49. If I am wrong in this finding, I now go on to consider indirect confusion. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis QC, 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.

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).”

50. These three categories are not exhaustive. Rather, they were intended to be illustrative of the general approach, as has been confirmed by the Court of Appeal.<sup>6</sup> However, I recognise that a finding of indirect confusion should not be made merely because the competing marks share a common element. In this connection, it is not sufficient that a mark merely calls to mind another mark: this is mere association not indirect confusion.<sup>7</sup> The Court of Appeal has also emphasised that, where there is no direct confusion, there must be a “proper basis” for finding indirect confusion.<sup>8</sup>

51. Having regard to all the above principles, in the event that consumers immediately notice and recall the differences between the competing marks, they will also recognise the identical word ‘WOW’. Whether consciously or unconsciously, this will lead consumers through the mental process described in *L.A. Sugar*. This word is the sole element of the earlier mark and dominates the overall impression of the contested mark. For a significant proportion of relevant consumers, it also conveys an identical concept. Whilst the word is not strikingly distinctive, the differences between the competing marks appear consistent with the use of a sub-brand. Particularly considering that the parties’ goods and services are identical, it is likely that the addition of the words ‘World of Work’ will be perceived by such consumers as the use of a sub-brand of the ‘WOW’ mark with an indication as to the topic of the particular educational materials and services offered in connection with it, e.g. the limb of the ‘WOW’ brand which offers customers materials and education relating to employment. Moreover, it is my view that the devices and use of colour present in the contested mark are likely to be perceived as a variation of the earlier mark with additional decorative elements. Taking all of the above into account, I am satisfied that a

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<sup>6</sup> *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207

<sup>7</sup> *Duebros Limited v Heirler Cenovis GmbH*, Case BL O/547/17

<sup>8</sup> *Liverpool Gin Distillery*

significant proportion of consumers – even when paying a slightly higher level of attention – would assume a commercial association between the parties, or sponsorship on the part of the opponent, due to the presence of the identical word 'WOW'. Accordingly, I find that there is a likelihood of indirect confusion.

### **Conclusion**

52. The opposition under section 5(2)(b) of the Act has succeeded in full. Subject to any successful appeal, the application will be refused.

### **Costs**

53. As the opponent has been successful, it is entitled to a contribution towards its costs. Based upon the scale published in Tribunal Practice Notice 2/2016, I award the opponent the sum of **£600** as a contribution towards the cost of the proceedings. This sum is calculated as follows:

Preparing a statement and considering the applicant's counterstatement	£200
Preparing written submissions	£300
Official fee	£100
<b>Total</b>	<b>£600</b>

54. I hereby order Sue Prior to pay Living Streets (The Pedestrians Association) the sum of **£600**. 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 the proceedings if any appeal against this decision is unsuccessful.

**Dated this 6<sup>th</sup> day of March 2023**

**James Hopkins**  
**For the Registrar**