

BL O/0343/23

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK REGISTRATION NO. 3508059

IN THE NAME OF JOLLY TURTLE LTD

REGARDING THE TRADE MARK:



AND

AN APPLICATION FOR THE INVALIDATION THEREOF UNDER NO. 504810

BY

PNM Kits Limited

Background and pleadings

1. On 3 July 2020, Jolly Turtle Ltd (the “Proprietor”) applied to register the trade mark as seen on the cover of this decision, for the following goods in Class 18:

Class 18 *All-purpose carrying bags; Bags; Bags (Net -) for shopping; Canvas bags; Canvas shopping bags; Carrying bags; Cloth bags; Cosmetic bags sold empty; Drawstring pouches; Grocery tote bags; Mesh bags for shopping; Mesh shopping bags; Net bags for shopping; Reusable shopping bags; Shopping bags; String bags for shopping; Tote bags.*

2. It was registered on 9 October 2020.

3. On 16 May 2022, PNM Kits Limited (the “Applicant”) applied to have the contested mark declared invalid under Section 47 of the Trade Marks Act 1994 (“the Act”), with the Applicant claiming that registration of the contested mark was contrary to Section 5(2)(b) of the Act.

4. For the purposes of the invalidation, the Applicant relied upon all of the services for which its earlier United Kingdom Trade Mark (UKTM) is registered:

UKTM 3476212



Filing date: 19 March 2020

Registration date: 9 August 2020

Class 35 *Retail services connected with the sale of beauty products; toiletries; torches; portable power banks; detox tablets; chewing gum; water bottles; stainless steel straws; cotton bags; clothing.*

5. Since the filing date of the earlier mark predates that of the contested mark, the Applicant's mark is an "earlier mark" in accordance with section 6 of the Act. However, as it had not been registered for five years or more before the filing date of the contested mark, it is not subject to the use requirements specified within section 6A of the Act. As a consequence, the Applicant may rely upon any or all of the services for which the earlier mark is registered without having to show that it has used the mark at all.

6. The Applicant submitted that the similarities between the marks at issue are either likely to lead to direct confusion on the part of the public as to the origin of the contested goods, or would confuse the public into thinking that the products bearing the marks are economically linked. The Applicant submitted that the similarities between the marks at issue include:

- Both marks have the figure of a turtle at the centre.
- Both turtles are green.
- Both marks contain the words "Jolly Turtle".
- Both marks use playful font.
- Both marks are used in relation to identical environmentally friendly goods, and are sold on the same platform.

7. On 9 August 2022, the Proprietor filed a counterstatement that was contained within the body of text of exhibit DS1 (the exhibits DS1 – DS19 were officially accepted into the proceedings at a later stage). The counterstatement provided detail as to the origin and ongoing business of the Proprietor company. The counterstatement contended that the Applicant re-branded its company name to adopt that of the Proprietor's three months after the Proprietor had registered its company at Companies House.

8. The Proprietor's arguments that the marks are not confusable can be summarised in the following statements: the contested mark is illustrative of the Proprietor's company name whilst the earlier mark is not; the Applicant does not use its earlier mark on the individual products within the kits; the earlier mark does not appear on the Applicant's website; the Applicant provides services whilst the Proprietor provides

goods; the goods and services are not in direct competition; the registration of the Proprietor’s company was before the Applicant used its mark; and the turtles and nomenclature of “Jolly Turtle” are very different in each mark. The Proprietor submitted that the turtle in the contested mark was designed by Emily Welfare (freelance graphic designer) in January 2020, and is “unique in its form, detail, orientation, colouring, script and wording”. The Proprietor argued that the marks are visually different and demonstrate no similarities other than both designs being based on a turtle, which the Proprietor claimed is a design used by many other companies on their products.

9. The Proprietor argued that the Applicant had not detailed how the goods and services at issue are identical or similar. The Proprietor claimed that the Applicant’s original trade was “festival kits”, which is not in competition with the trade of the Proprietor. The Proprietor also claimed that the Applicant’s “kits” contain beauty products, toiletries, torches, portable power banks, detox tablets, chewing gum, water bottles, stainless steel straws, cotton bags and clothing, all of which contrast to the eco-friendly and environmentally sustainable contested goods.

10. The Proprietor provided the following information in relation to the volume of sales of the contested goods:

Product	01.02.21-31.01.22 Sales (units)	01.02.22-03.08.22 Sales (units)
Drinking Straws	1255	491
Shopping Bags	197	107
Fresh Produce Bags	493	453
Sandwich Bags	297	182

Evidence and submissions

11. Both sides have filed evidence and submissions in these proceedings, which shall be summarised to the extent that I consider necessary.

12. On 28 September 2022, the Applicant filed evidence and submissions consisting of the witness statement of Jodie Samantha Boyd, Director of PNM Kits, accompanied by exhibits JSB1 – JSB6. The witness statement explained that PNM was incorporated

on 8 September 2016 in order to market and sell festival kits to event attendees. Having been influenced by a nature documentary, PNM was then “re-positioned” as a business concept that would source and supply customers with environmentally friendly products under the brand “The Jolly Turtle”. On 2 April 2020, PNM launched its website www.thejollyturtle.co.uk aimed at offering environmentally friendly products upon which appear the earlier mark appeared, including bags and straws (JSB1 and JSB3). The witness statement explained that the Applicant occasionally supplies products with other logos dependant on any specific requirements. The witness statement reiterated its original submissions as to what it considered the similarities between the marks at issue to be, and argued that consumers would be confused when viewing the marks side by side (JSB2).

13. In specific response to the Proprietor’s counterstatement, the witness statement argued that it is not necessary for a company’s name and trade mark to be one and the same, and that it is the dates of filing and registering prior rights which are fundamental. The witness statement explained that the Applicant had put the Proprietor on notice that it had infringed its earlier mark by way of letters dated 7 February 2022 and 2 March 2022 (JSB 5).

14. On 15 November 2022, the Proprietor filed evidence and submissions consisting of the witness statement of Daniel Seldon, Director of Jolly Turtle Ltd. The witness statement (identified as exhibit DS19) largely reiterated the submissions of the counterstatement. The witness statement submitted that the Applicant’s trade mark only appears on the bags of the festival and travel “kits”, whereas the contested mark appears on each of the individual contested goods. The witness statement focused on the apparent difference between the Applicant’s steel drinking straws and the Proprietor’s natural wheat straws, and also disputed that the marks are likely to lead to confusion as evidence of such had not occurred or been proven.

15. The witness statement detailed the research conducted by the Proprietor prior to applying for registration at Companies House and the UKIPO, and remarked that it did not encounter similar names or marks. The witness statement claimed that continued use of the earlier mark would damage the reputation and goodwill the Proprietor has established in the marketplace, which is reflected by its products being frequently placed as ‘Amazon’s Choice’, with one product (the fresh produce bags) being rated

“no. 1”. Further submissions as to the Proprietor’s reputation included referring to its association with the ‘Big Blue Ocean Cleanup’.

16. The witness statement provided direct responses to several of the Applicant’s submissions, which shall not be detailed here, rather they shall be kept in mind during my own comparison of the marks at issue. That having been said, it is worth noting that the Proprietor stated although the Applicant’s earlier trade mark was approved two months before the contested mark had been approved, the contested mark was apparently nevertheless commissioned and “received at the beginning of February 2022”. It is also of note that the witness statement denied having received the infringement notice letters from the Applicant.

17. The exhibits that had previously been filed prematurely with the counterclaim were officially accepted into the proceedings along with the Proprietor’s submissions and evidence. The exhibits included, *inter alia*:

- DS6 – email from Amazon Brand Registry, dated 26 March 2021, approving the application for Jolly Turtle.
- DS8 – letter written to Companies House, asking for it to reject PNM Kits Limited’s application for the business name The Jolly Turtle.
- DS20 – response from Companies House, advising that if the Proprietor wishes to complain about the application it should visit www.ipo.gov.uk/cna

18. On 7 December 2022, the Applicant filed further evidence of fact in reply consisting of the 2nd witness statement of Jodie Samantha Boyd. The witness statement submitted that the question at issue in these proceedings does not relate to infringement, but whether the grounds for invalidity as set out in Section 5 of the Trade Marks Act are satisfied. In this contention, the Applicant argued that the distinctive element of a green turtle and words Jolly Turtle are represented in each mark, with each party selling environmentally friendly goods. The witness statement further submitted that any correspondence to Companies House is not relevant.

19. No hearing was requested.

20. Only the Proprietor filed submissions in lieu of a Hearing, filed on 11 January 2023. The submissions reflected the previous submissions made during the proceedings, and no new submissions of substance were made other than a brief claim that the “Cancellation Application has been made in bath faith”.

21. Neither party is professionally represented.

Decision

Section 5(2)(b)

22. Section 5(2)(b) of the Act is as follows:

“(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”.

23. 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.

24. 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.

Comparison of goods and services

25. Both parties provided submissions in relation to the respective goods and services at issue. Whilst the parties’ comments are noted, the degree of similarity or identity of the goods and services at issue, or the lack thereof as the case may be, is something which fundamentally contributes to whether there is a likelihood of confusion. I must therefore conduct my own full analysis of the goods and services at issue. I shall refer to the submissions of each party if and when I consider them to provide assistance and clarity.

Earlier mark	Contested registration
<p><i>Class 35: Retail services connected with the sale of beauty products; toiletries; torches; portable power banks; detox tablets; chewing gum; water bottles; stainless steel straws; cotton bags; clothing.</i></p>	<p><i>Class 18: All-purpose carrying bags; Bags; Bags (Net -) for shopping; Canvas bags; Canvas shopping bags; Carrying bags; Cloth bags; Cosmetic bags sold empty; Drawstring pouches; Grocery tote bags; Mesh bags for shopping; Mesh shopping bags; Net bags for shopping; Reusable shopping bags; Shopping bags; String bags for shopping; Tote bags.</i></p>

26. 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.

27. In *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs K.C. as the Appointed Person reviewed the law concerning retail services v 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.”

28. However, on the basis of the European courts’ judgments in *Sanco SA v OHIM*¹, and *Assembled Investments (Proprietary) Ltd v. OHIM*², upheld on appeal in *Waterford Wedgwood Plc v. Assembled Investments (Proprietary) Ltd*³, Mr Hobbs concluded that:

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

¹ Case C-411/13P

² Case T-105/05, at paragraphs [30] to [35] of the judgment

³ Case C-398/07P

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).

29. In *Tulliallan Burlington Ltd v EUIPO*, Cases C-155/18P to C-158/18P, the CJEU considered the correct approach to determining the appropriate scope of protection afforded to trade marks that were registered for retail services prior to the court's judgment in *Praktiker*, Case C-418/02. This judgment required applicant's to register trade marks for such services to specify the goods to which the services relate. The General Court had decided that, absent such a list of goods, it was not possible to compare retail services-type registrations with later applications to register trade marks in relation to particular goods. The applicant appealed. The CJEU upheld the appeal ruling that:

"132. In that regard, admittedly, the Court of Justice has held that, for the purposes of registration of a trade mark covering services provided in connection with retail trade, it is not necessary to specify in detail the service or services for which that registration is sought, but that, on the other hand, the applicant must be required to specify the goods or types of goods to which those services relate (judgment in *Praktiker*, paragraphs 49 and 50).

133. However, first, the Court has made clear that the line of authority derived from the judgment in *Praktiker* concerns only applications for registration as trade marks and does not concern the protection of trade marks registered at the date of that judgment's delivery (judgment of 11 October 2017, *EUIPO v Cactus*, C-501/15 P, EU:C:2017:750, paragraph 45). Since in the present case *Tulliallan Burlington's* three earlier United Kingdom trade marks, which

Tulliallan Burlington relied on in support of its opposition, were registered before the date on which the judgment in Praktiker was delivered, they were not, in any event, concerned by the obligation arising from that judgment.

134. Secondly, it cannot be inferred from the considerations in the judgment in Praktiker mentioned in paragraph 132 of the present judgment that, when a trade mark covering retail services, registered after that judgment's delivery, is relied on in support of the ground of opposition referred to in Article 8(1)(b) of Regulation No 207/2009, that ground of opposition may be rejected from the outset, simply by invoking the absence of any precise statement of the goods to which the retail services covered by the earlier trade mark may relate.

135. To act in such a manner would mean that the earlier trade mark is precluded from being relied upon in opposition in order to prevent the registration of an identical or similar mark in respect of similar goods or services and, consequently, refuse to recognise it as having any distinctive character, even though that mark is still registered and it has not been declared invalid on one of the grounds laid down in Regulation No 207/2009.

136. In addition, as EUIPO in essence notes, it is possible, by means of a request seeking proof of genuine use of the earlier trade mark, within the meaning of Article 42(2) of Regulation No 207/2009, to determine the precise goods covered by the services for which the earlier trade mark was used and, therefore, pursuant to the last sentence of that paragraph, to take into account, for the purposes of the examination of the opposition, only those goods.

137. Accordingly, it is apparent from all the foregoing considerations that, in finding, in paragraph 71 of the judgments under appeal, that the absence of any precise statement of the goods which may be sold in the various shops comprising a shopping arcade, such as the shopping arcade referred to by the earlier trade marks, precluded any association between those shops and the goods of the mark applied for, the General Court erred in law.”

30. The earlier mark is registered for retail services, which have been identified as relating specifically to goods that include cotton bags. The contested goods are all varying forms of bags. Several of the contested bags do not indicate the material they are made from, and therefore are considered to be a general category of bag that could include bags made from cotton. The remaining contested goods which do indicate the material they are made from are either canvas or cloth bags, with both materials being derivatives of cotton.

31. I envisage the normal retail service associated with the contested goods to be the retail of bags. With this in mind, such a retail service is provided by the earlier mark. As a result, and in light of the above case law, all of the contested goods are considered to be complementary to the services of the earlier mark.



Comparison of the marks

32. 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.”

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

34. The respective trade marks are shown below:

Earlier mark	Contested registration
 <p>The Jolly TURTLE</p>	 <p>Jolly Turtle</p>

35. The earlier mark is a composite mark consisting of both word and figurative elements. The mark contains the words 'The Jolly' written in a black script-style text, with the word 'TURTLE' written in a green, block-style, upper case text appearing below. All of the words are written over a pale green outline of a rudimentary turtle, which is facing right. Whilst the green turtle is certainly noticeable, the words draw the eye first by virtue of being in the foreground. As such, the words are considered to be the more dominant element. Neither the words nor the figurative element relate descriptively to the goods at issue, and therefore they are considered to be equally distinctive.

36. The contested mark is a composite mark consisting of both word and figurative elements. The mark contains the words 'Jolly' and 'Turtle' in a blue stylised font. The letter 'J' in 'Jolly' has a swash, or stylised serif, in the form of a wave. Between the words is a smiling turtle, which is facing right. Neither element is considered to be more dominant and because neither the word nor figurative elements relate descriptively to the goods at issue, they are considered to be equally distinctive.

Visual similarity

37. The marks are visually similar insofar as they each contain the words 'Jolly' and 'Turtle', although they appear in different fonts. The marks also each contain a figurative reproduction of a turtle facing right. The marks differ visually due to the inclusion of the word 'The' in the earlier mark, which has no counterpart in the contested mark. The marks also differ visually in regards to the particular rendition of the turtle, with it being a more rudimentary outline in the earlier mark and a more

cartoonish and colourful rendition in the contested mark. Overall, the marks are considered to be visually similar to at least a medium degree.

Aural similarity

38. The marks are aurally similar insofar as they each contain the words 'Jolly Turtle', which will be pronounced identically in each mark. The marks differ aurally to the extent that the earlier mark also contains the word 'The', which has no counterpart in the contested mark. The figurative elements of each mark will not be enunciated and therefore have no aural impact. Overall, the marks are aurally similar to a very high degree.

Conceptual similarity

39. Despite being on different levels I consider all of terms in the earlier mark to hang together, with the first part 'The Jolly' describing the second part 'TURTLE'. The terms are basic English-language words which will be perceived to create the overall concept of a particularly happy/cheerful (Jolly) shelled reptile (TURTLE). The word 'The' will be recognised as a determiner, being used to identify the subject turtle. The figurative element serves to reinforce the message of a turtle. In comparison, the overall impression of the contested mark is also that of a particularly happy/cheerful shelled reptile. The figurative element serves to reinforce the message of a particularly jolly turtle, by virtue of the turtle smiling.

40. Although the contested mark does not contain a determiner (The), I consider the marks to nevertheless be conceptually identical. In the alternative, and dependant on the different representations of the turtle detracting from a finding of identity (I acknowledge only the turtle in the contested mark is smiling), the marks are nevertheless conceptually similar to at least a high degree.

Average consumer and the purchasing act

41. 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.⁴ 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.”

42. It is noted that both parties have made submissions as to whether the goods and services at issue are environmentally friendly, and the effect this would have on their potential similarity or lack thereof. Whilst I acknowledge that such submissions have been made, it is incumbent on me to consider the goods and services in the form as registered. The categories of goods and services at issue are relatively broad and have not been specifically limited to being only environmentally friendly versions. For example, the earlier mark is registered for retail in connection with portable power banks, and the contested mark is registered for bags at large, which would include bags made from all materials including plastic and leather.

43. The goods at issue are everyday items insofar as they are bought and used on a daily basis. Similarly, the services of the earlier mark are used on a daily basis, with people tending to purchase the items being sold frequently. The contested goods and items being sold under the retail services can vary in price, but in general fall within an affordable price range of inexpensive items. Based on the nature of the goods at issue, they are invariably made available for purchase in a retail store, a magazine or online. The retail services at issue are also made available via a store, magazine or online. As such, the purchase process would predominantly depend on the visual aspect of the marks. I do not discount the possibility that the goods and retail services are

⁴ *Lloyd Schuhfabrik Meyer*, Case C-342/97

available over the telephone from a telemarketer, for example, and therefore there may also be an aural aspect to the purchasing process.

44. The relevant consumer of the goods and services will be the average consumer of the general public at large, as most people make retail purchases of the identified goods on a daily basis. As a result, the level of attention will be no more than medium.

Distinctive character of the earlier trade mark

45. It is noted that the Applicant filed the witness statement of Jodie Samantha Boyd together with exhibits JSB1 – JSB6 during the course of the proceedings. The witness statement did not claim that the earlier mark had acquired an enhanced degree of distinctive character, and having assessed the submitted evidence I do not consider it to otherwise support such a position. My assessment of the degree of distinctive character of the earlier mark is therefore to be made only on the basis of its inherent features.

46. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section

of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

47. In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. 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 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.”

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.

48. I have previously indicated that the word elements of the earlier mark are the more dominant by virtue of being placed over/on top of the figurative element. That having been said, although the figurative element is less dominant it is no less distinctive. The figurative element of a green turtle is clearly visible and has no descriptive relationship to the goods or services at issue. It is therefore as equally distinctive as the words ‘The Jolly TURTLE’. The distinctiveness of the earlier mark lies in the combination of the composite mark as a whole, and is ultimately distinctive to a high degree.

Likelihood of confusion

49. 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.

50. 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 (see *Sabel*, C-251/95, para 22). The first 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 and services and vice versa (see *Canon*, C-39/97, para 17). It is necessary for me to keep in mind the distinctive character of the Opponent's trade mark, the average consumer for the services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

51. In *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03, the GC stated that:

“49. However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (*BUDMEN*, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumer choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the

other hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs.”

52. In *Quelle AG v OHIM*, T-88/05, the GC found that visual similarity (and difference) is most important in the case of goods that are self-selected or where the consumer sees the mark when purchasing the goods. The Court stated that:

“68... If the goods covered by the marks in question are usually sold in self-service stores where consumers choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any phonetic similarity between the signs (*NLSPORT*, *NLJEANS*, *NLACTIVE* and *NLCollection*, paragraph 53 supra, paragraph 49).

69. Likewise, the degree of phonetic similarity between two marks is of less importance in the case of goods which are marketed in such a way that, when making a purchase, the relevant public usually perceives visually the mark designating those goods (*BASS*, paragraph 56 supra, paragraph 55, and Case T-301/03 *Canali Ireland v OHIM – Canal Jean (CANAL JEAN CO. NEW YORK)* [2005] ECR II-2479, paragraph 55)... The same is true of catalogue selling, which involves as much as does shop selling a visual assessment of the item purchased by the consumer, whether clothing or shoes, and does not generally allow him to obtain the help of a sales assistant. Where a sales discussion by telephone is possible, it takes place usually only after the consumer has consulted the catalogue and seen the goods. The fact that those products may, in some circumstances, be the subject of discussion between consumers is therefore irrelevant, since, at the time of purchase, the goods in question and, therefore, the marks which are affixed to them are visually perceived by consumers.”

53. Having conducted a full analysis and thorough comparison of the marks and their respective goods and services at issue I have determined that it is the visual considerations which are of a greater importance in the assessment of a likelihood of

confusion, due to the purchasing process of the respective goods and services being visually dominated. With this in mind, it is important to reaffirm that I have found the marks to be visually similar to at least a medium degree. It is also important to reaffirm that I did not rule out a part of the relevant public paying attention to the aural aspect of the marks during the purchasing process, in which case I consider the finding of aural similarity to a very high degree to be of significance, also.

54. In addition to the visual and aural aspects of the marks having been compared, the conceptual aspect of the marks has been compared also, with the marks having been found to be conceptually identical. If I am wrong in my finding that the marks are conceptually identical, due exclusively to the different representations of the turtles in the respective marks, I nevertheless consider the marks to be conceptually similar to at least a high degree. This is because both marks contain the concept of a 'Jolly TURTLE/Turtle', which is an inherently distinctive concept in relation to the goods and service at issue. Whilst I note that the particular renditions of the figurative turtles in each mark are different they are nevertheless both clearly turtles, which is also an inherently distinctive concept in relation to the goods and service at issue.

55. The determination of a likelihood of confusion involves a global assessment which includes the principle of imperfect recollection, whereby it must be kept in mind that the average consumer rarely makes direct comparisons between marks and instead relies upon an imperfect picture of the earlier mark they have retained in their mind. In my opinion, upon seeing a mark that consists of the words 'Jolly Turtle' and accompanied by a depiction of a turtle in relation to *bags*, the average consumer could in all likelihood mistake it for an earlier mark consisting of the words 'The Jolly TURTLE' accompanied by a depiction of a turtle in relation to the *retail of cotton bags*. I do not believe that the consumer would notice that the word 'The' is missing, nor do I think they would notice the depiction of the turtle is different. Instead, I believe they would recall having encountered a mark containing the words 'Jolly turtle' and a depiction of a turtle and mistake the contested representation for the earlier version.

56. An additional factor to be considered as part of the global assessment is the interdependency principle, whereby a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the

respective goods and services, and vice versa⁵. Although the relationship between the goods and service at issue is only complementary, this is offset by the degree of similarity between the marks themselves. Overall, I am of the opinion that there is a likelihood of direct confusion.

57. As an alternative and additional finding I consider the marks at issue to at least lead to a likelihood of indirect confusion. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., (as he then was) 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).

⁵ *Canon*, C-39/97, para 17

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

58. In my opinion, the common element of ‘Jolly Turtle/TURTLE’ is so strikingly distinctive that the consumer would assume only the brand owner uses it. I do not believe that the removal of the word ‘The’ from the contested mark would alter this assumption. As for the change in depiction of the turtle, I find it quite likely that the consumer would assume this to be a brand extension. The consumer would (potentially) recognize that the turtle in the contested mark is smiling and is generally more cartoonish than the depiction in the earlier mark, but would consider this to be a development of the original concept of a turtle used in conjunction with the words ‘Jolly Turtle/Turtle’.

59. It seems to me that if the average consumer does not directly confuse the marks at issue by way of simply mistaking one for the other, they would in the alternative put the coincidence of the words ‘Jolly Turtle/TURTLE’ used in combination with a depiction of a turtle down to the undertakings being one and the same. I therefore also find there to be a likelihood of indirect confusion.

Conclusion

60. The invalidation is successful under Section 5(2)(b) of the Act. Subject to an appeal, the contested registration shall be deemed never to have been made.

Costs

61. The Applicant has been successful and is entitled to a contribution towards its costs. I am aware that the Applicant is unrepresented. I am also aware that the Applicant was advised (as was the Proprietor) that if it intended to request costs it should complete a pro forma with a breakdown of its costs by 12 January 2023. It is noted that the Applicant did not return a pro forma.

62. As explained in the correspondence of 15 December 2022, if a pro forma was not returned the costs to be claimed would be limited to official fees. In the circumstances I therefore award the Applicant the sum of £200 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Fee for Form TM26(I)	£200
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63. I therefore order Jolly Turtle Ltd to pay PNM Kits Limited the sum of £200. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 5th day of April 2023

Dafydd Collins

For the Registrar