

O/0447/23

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION
NO. WO0000001607478 BY
GUANGDONG BANSHANG DINGDING
PROTECTION TECHNOLOGY CO., LTD.
TO REGISTER AS A TRADE MARK:**

LIONGRIP

IN CLASS 25

AND

**OPPOSITION THERETO
UNDER NO. 428730
BY TIGER GRIP SAS**

Background & Pleadings

1. Guangdong Banshang Dingding Protection Technology Co., Ltd. (“**the applicant**”) is the holder of the International Registration (“IR”) WO0000001607478 (“the designation”) in respect of the mark shown on the front page of this decision with a UK designation date of 20 May 2021. The IR was accepted and published in the Trade Marks Journal for opposition purposes on 22 October 2021 in respect of the following goods:

Class 25: Clothing; non-slipping devices for footwear; footwear; inner soles; fittings of metal for footwear; gaiters; galoshes; slippers; soles for footwear; hosiery.

2. Tiger Grip Sas (“**the opponent**”) opposes the application on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent is the proprietor of the following mark:

Trade Mark no.	UK00918276957
Trade Mark	TIGER GRIP
Goods & Services Relied Upon	Classes 9, 25 & 35
Relevant Dates	Filing date: 23 July 2020
	Date of entry in register: 11 December 2020

3. On 1 January 2021, the UK left the EU. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing registered EUTM. As a result, the opponent’s earlier mark was automatically converted into a comparable UK trade mark. Comparable UK marks are now recorded on the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and the original filing dates remain the same.

4. The opponent relies on all goods and services for the purposes of this opposition proceedings, which are as follows:

Class 9: Protective footwear for the prevention of accident or injury; Protective industrial boots; Protective industrial footwear; Protective industrial shoes; Shoes for protection against accidents and fire; Shoes for protection against accidents, irradiation and fire.

Class 25: Footwear; Overshoes; Athletic footwear; Athletic footwear for hiking; Climbing footwear; Climbing shoes; Embossed soles and heels of rubber or of plastic materials; Flipflops for use as footwear; Footwear uppers; Footwear for men and women; Footwear, namely, rubbers; Footwear, namely, work boots; Heel pieces for shoes; Insoles; Insoles for footwear; Mountaineering shoes; Non-slip socks; Non-slip soles for footwear; Non-slip soles for footwear, namely, for workshoes and hiking shoes; Protective metal members for shoes and boots; Rubber shoes; Running pads that strap onto shoes; Sandals and beach shoes; Shoe covers for use when wearing shoes; Shoe soles; Shoe straps; Shoe uppers; Shoes featuring non-slip soles; Soles for footwear; Track and field shoes; Traction attachments for footwear; Water repelling footwear; Waterproof footwear; Work shoes and boots.

Class 35: Business consulting in the field of environmental management, namely, advising businesses and individuals on issues of environmental impact, conservation, preservation and protection, and economic analysis for business purposes; Catalog ordering service in relation to shoes and shoe covers.

5. Under Section 6(1) of the Act, the opponent's trade mark clearly qualifies as an earlier trade mark. Further, as protection of the opponent's earlier mark was conferred less than five years before the application date of the contested mark, proof of use is not relevant in these proceedings as per Section 6A of the Act.

6. The opponent in its notice of opposition claims the following:

“TRADEMARKS: The trademarks have the element "GRIP" in common. Both trademarks also refer to an animal in the wild. We have looked at the case law and several cases have shown that the similarity of both referring to an animal, can cause likelihood of confusion. This was the case in the following trademark comparisons: (1) Crazy Horse vs. Crazy Bats (EUIPO, Fifth Board of Appeal, Case R 1321/2020-5); (2) Crazy Wolf vs. Crazybuffalo (device) (EUIPO Opposition No B 3 092 268); (3) Smart-cat vs. Smartpet (device) (EUIPO Opposition No B 2 965 476); (4)LADYBIRD vs. Ladybug adventures (EUIPO Opposition No B 2 472 036); (5) Dark Horse vs. Dark Stag (EUIPO Opposition No B 2 447 442); (6) Frucht-tiger vs. Fruchtli~we (EUIPO Opposition No B 000989 022). These cases from the EUIPO clearly confirm that there is a big chance of a likelihood of confusion amongst the consumers because of the identical element GRIP and the similar element Tiger and Lion, both wild animals. GOODS: The trademarks have class 25 in common. The footwear products are identical. The other goods in the trademark application are also highly similar to the products, as they are all types of clothing, fashion elements, to cover (and protect) the body. All products are identical or highly similar. CONCLUSION: The high similarity between the goods and the trademarks results into a high risk of likelihood of confusion with an average consumer (relevant public) with an average level of attention.”

7. The applicant filed a defence and counterstatement, denying any similarity between the marks, stating the following:

“1.Lack of Phonetic Similarity: The phonetic similarity comes only out of the descriptive word elements "GRIP" and does not extend in any way to the distinctive "Tiger" and "Lion" word elements. 2.Lack of Visual Similarity: The "Tiger" and "Lion" letters are very different in construction and don't cause any confusion. 3.Lack of Conceptual

Similarity: The element "Tiger" and "Lion" are both different animals, the earliest wild animals known to people, and it is easy for people to recognize and distinguish them. As a result, the marks have a low degree of conceptual similarity. In short, there are obvious differences between the disputed and cited trademarks. Our mark is entirely dissimilar to the opponent's from a visual point of view and clearly distinguishes the products and services for which registration is being sought from the Opponents'.

The cases cited by the opponents are completely different from the present case, in which: Crazy Wolf vs. Crazybuffalo {device} (EUIPO Opposition No B 3092268): "The signs are visually, aurally and conceptually similar to an average degree on account of the common verbal element 'crazy', which is the initial verbal element in both signs."

LADYBIRD vs. Ladybug adventures {EUIPO Opposition No B 2472036): "A 'ladybird' in the earlier mark is the British word for a small beetle with a domed back, typically red or yellow with black spots. A 'ladybug', in the contested sign, is the term used in North America to refer to the same insect and it will be understood as such by the English-speaking part of the relevant territory. " ... " In any case, since the public reads from left to right, the part placed at the left of the sign (the initial part) is the one that first catches the attention of the reader."

8. While the EUIPO cases have been taken into consideration, I am not bound by them.
9. None of the parties filed evidence or submissions in these proceedings.
10. No hearing was requested and so this decision is taken following a careful perusal of the papers.
11. In these proceedings, the opponent is represented by KOB nv and the applicant by Whalemaks Service Limited.

12. 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 Trade Marks 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.

Decision

Section 5(2)(b)

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

“5(2) A trade mark shall not be registered if because-

[...]

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

14. The principles considered in this opposition stem from the decisions of the European 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 BV* (Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (Case C-3/03), *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* (Case C-120/04), *Shaker di L. Laudato & C. Sas v OHIM* (Case C-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):

- 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.

Comparison of Goods and Services

15. When making the comparison, all relevant factors relating to the goods/services in the specifications should be taken into account. In *Canon Kabushiki Kaisha*, the Court of Justice of the European Union (“CJEU”) stated that:

“23. 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 complementary.”

16. Guidance on this issue was also given by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] RPC 281. At [296], he identified the following relevant factors:

- “(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.”

17. The General Court (“GC”) confirmed in *Gérard Meric v OHIM*, Case T-133/05, paragraph 29, that, even if goods or services are not worded identically, they can still be considered identical if one term falls within the scope of another, or vice versa:

“In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

18. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), paragraph 12, Floyd J (as he then was) gave the following guidance on construing the words used in specifications:

“[...] Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the

observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless, the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of ‘dessert sauce’ did not include jam, or because the ordinary and natural description of jam was not ‘a dessert sauce’. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

19. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU held that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods or services. The GC clarified the meaning of “complementary” goods or services in *Boston Scientific Ltd v OHIM*, Case T-325/06, at paragraph 82:

“[...] there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking.”

20. The competing goods and services to be compared are shown in the following table:

Opponent’s Goods and Services	Applicant’s Goods
<p>Class 9: Protective footwear for the prevention of accident or injury; Protective industrial boots; Protective industrial footwear; Protective industrial shoes; Shoes for protection against accidents and fire; Shoes for</p>	

<p>protection against accidents, irradiation and fire.</p>	
<p>Class 25: Footwear; Overshoes; Athletic footwear; Athletic footwear for hiking; Climbing footwear; Climbing shoes; Embossed soles and heels of rubber or of plastic materials; Flipflops for use as footwear; Footwear uppers; Footwear for men and women; Footwear, namely, rubbers; Footwear, namely, work boots; Heel pieces for shoes; Insoles; Insoles for footwear; Mountaineering shoes; Non-slip socks; Non-slip soles for footwear; Non-slip soles for footwear, namely, for workshoes and hiking shoes; Protective metal members for shoes and boots; Rubber shoes; Running pads that strap onto shoes; Sandals and beach shoes; Shoe covers for use when wearing shoes; Shoe soles; Shoe straps; Shoe uppers; Shoes featuring non-slip soles; Soles for footwear; Track and field shoes; Traction attachments for footwear; Water repelling footwear; Waterproof footwear; Work shoes and boots.</p>	<p>Class 25: Clothing; non-slipping devices for footwear; footwear; inner soles; fittings of metal for footwear; gaiters; galoshes; slippers; soles for footwear; hosiery.</p>
<p>Class 35: Business consulting in the field of environmental management, namely, advising businesses and individuals on issues of environmental impact, conservation,</p>	

preservation and protection, and economic analysis for business purposes; Catalog ordering service in relation to shoes and shoe covers.	
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21. In its statement of grounds, the opponent contends that the competing goods are similar or identical.
22. It is noted that the applicant, without putting forward a blanket denial for the competing specifications, is deemed to have accepted the opponent's contentions in relation to the competing terms.¹ That said, I will need to assess the degree of similarity between the goods and services.
23. For the purpose of considering the issue of similarity of goods and services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way for the same reasons.²

Footwear; Soles for footwear; inner soles

24. The contested goods are identically worded or ostensibly the same as the opponent's goods in Class 25, and, thus, they are identical.

¹ Prof. Phillip Johnson, sitting as the Appointed Person, in *SKYCLUB*, BL O/044/21, at paragraph 24 states:

"The position in the Civil Procedure Rules (CPR) is clear; namely, a defendant must state which allegations are denied, which allegations a defendant is unable to admit or deny, and which allegations the defendant admits (CPR, 16.5(1)). Where a defendant fails to deal with an allegation it is taken to be admitted (CPR 16.5(5)). This is subject to the rule that where an allegation is not dealt with, but the defence sets out the nature of his case in relation to the issue to which that allegation is relevant, then the allegation must be proved by the Claimant (CPR 16.5(3)). Thus, the filing of a "blank" defence would lead to the whole of the Claimant's case being admitted."

² *Separode Trade Mark* BL O-399-10 and *BVBA Management, Training en Consultancy v BeneluxMerkenbureau* [2007] ETMR 35 at paragraphs 30 to 38.

Fittings of metal for footwear; non-slipping devices for footwear

25. The contested goods are broad terms that could readily cover the opponent's "*Protective metal members for shoes and boots; Non-slip soles for footwear; Non-slip soles for footwear, namely, for workshoes and hiking shoes; Shoes featuring non-slip soles*". Thus, I find them to be identical as per *Meric*.

Slippers; Galoshes

26. The contested term is encapsulated by the opponent's term "*footwear; Overshoes*". Therefore, the respective goods are identical in accordance with *Meric*.

Gaiters

The contested goods are protective garments offering protection, for example, from rain. The opponent's "*Shoe covers for use when wearing shoes; Overshoes*" terms are the closest ones. The nature of the goods may overlap as they could be made from the same materials. They also share the same general purpose, namely protection from external elements. The respective goods coincide in users, method of use, and trade channels sold in the same retail shops potentially close to each other. Further, I consider there to be a degree of competition as one may choose one over the other. However, there is no element of complementarity. Therefore, I find a high degree of similarity.

Hosiery

27. The contested term is an item of clothing. The closest comparable term in the earlier specification is the term "*non-slip socks*" in Class 25. The respective goods may have the same purpose, are made of the same material and have the same method of use, users, trade channels, and are

likely to be produced by the same undertakings. They are at least similar to a high degree.

Clothing

28. The contested term serves the same broad purpose as the opponent's "footwear", given that they are used for covering and protecting parts of the human body and for fashion, though footwear is intended specifically for the feet as opposed to the rest of the body. The competing goods could be sold in the same shops, potentially close to each other in retail premises, thereby overlapping in users. There is also an element of complementary, as they may be worn together and produced by the same undertaking. I find a medium degree of similarity between these goods.

Average Consumer and the Purchasing Act

29. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purposes 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 and services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. In *Hearst Holdings & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), at paragraph 70, Birss J described the average consumer in these terms:

"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 word 'average' denotes that the person is typical. The term 'average' does not denote some form of numerical mean, mode or median."

30. The goods at issue cover a range of items of footwear, including clothing. The average consumer of the goods will be a member of the general

public, but there is also the potential for specialised customers for certain types of footwear. The goods can be selected from outlets, stores, including specialist ones, brochures, catalogues, and online. In retail premises, the goods will be displayed on shelves, where they will be viewed and self-selected by consumers. Therefore, visual considerations will dominate the selection of the goods in question, particularly clothing goods in Class 25,³ but aural considerations will not be ignored in the assessment. The cost of the goods may vary, but in any case, and irrespective of the cost, the average consumer may examine the products to ensure that they select the correct type, quality, size and/or aesthetic appearance. In this regard, the average consumer is likely to pay an average degree of attention when selecting the goods at issue.

Comparison of Trade Marks

31. 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

³ The General Court highlighted this in *New Look Ltd v OHIM Cases T-117/03 to T-119/03* and T-171/03, at paragraph 50:

“Generally, in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly, the visual aspect plays a greater role in the global assessment of the likelihood of confusion.”

to the circumstances of the case, to assess the likelihood of confusion.”

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

33. The marks to be compared are:

Opponent's Mark	Applicant's Mark
TIGER GRIP	LIONGRIP

Overall Impression

34. The earlier mark is a word only mark presented in a standard typeface and upper case. Registration of a word mark protects the word itself.⁴ The overall impression of the competing marks lies in the words themselves.

35. The applicant's mark consists of the conjoined word elements "LIONGRIP" in bold and standard typeface. The overall impression of the mark lies in the conjoined words, with neither word component dominating the other.

Visual Comparison

36. The earlier mark consists of the two words "TIGER GRIP" and has nine letters, whereas the contested mark, "LIONGRIP", is a conjoined word and eight letters long. Bearing in mind, as a rule of thumb, that the beginnings of words tend to have more impact than the ends,⁵ the competing marks differ in their beginnings, namely "TIGER" v "LION-". The competing marks

⁴ See *LA Superquímica v EUIPO*, T-24/17, para 39; and *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17, paragraph 16.

⁵ See *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02.

share a common ending based on the second word component “GRIP”. Taking into account the above and the overall impressions of the marks, I find that they are visually similar to between a low to medium degree.

Aural Comparison

37. The earlier mark will be pronounced as “TIE-GUH-GRIP” and the contested as “LIE-UHN-GRIP”. Although the marks have the same number of syllables, they only share the same last syllable “GRIP”. I find that they are aurally similar to a low degree.

Conceptual Comparison

38. The average consumer will readily understand the meaning of the word elements in the competing marks. Even though both marks feature a wild animal from the Panthera genus, specifically a tiger and a lion, they are different species that the average consumer would be able to distinguish. Further, the marks share the common word “GRIP”, which has more than one meaning and will be perceived as the act of grasping or in relation to the goods the friction created between an object such as footwear and a surface. Against this background, the competing marks as a whole may evoke the concept of delivering a strong grip similar to that of a wild animal. Overall, taking into account the various factors and the overall impressions of the marks, I find the respective marks to be conceptually similar to a medium degree.

Distinctive Character of the Earlier Trade Mark

39. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, paragraph 22 and 23, the CJEU stated that:

“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).

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).”

40. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.
41. I have only the inherent distinctiveness of the earlier mark to consider. The average consumer will readily conceptualise the earlier mark based on its ordinary meaning as detailed previously in this decision. I bear in mind that only the common element between the respective marks should be considered to evaluate the relevant (to the question of confusion) distinctiveness,⁶ a point that I shall return to later in this decision. This is because the word component “GRIP” is weaker, conveying a clear meaning to the relevant public in relation to the property of the goods, that

⁶ See *Kurt Geiger v A-List Corporate Limited*, BL O/075/13.

of traction, for which it is registered. That said, the word element “TIGER” will elevate inherent distinctiveness of the mark having no suggestive meaning in relation to the registered goods. Consequently, I consider that the earlier mark as a whole is inherently distinctive to a below medium degree.

Likelihood of Confusion

42. In assessing the likelihood of confusion, I must adopt the global approach set out in the case law to which I have already referred above in this decision. Such a global assessment is not a mechanical exercise. I must also have regard to the interdependency principle, that a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa.⁷ It is essential to keep in mind the distinctive character of the opponent’s trade mark since the more distinctive the trade mark, the greater the likelihood of confusion. I must also keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon imperfect recollection.⁸
43. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. Indirect confusion is where the consumer notices the differences between the marks but concludes that the later mark is another brand of the owner of the earlier mark or a related undertaking. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Iain Purvis K.C., sitting as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark

⁷ See *Canon Kabushiki Kaisha*, paragraph 17.

⁸ See *Lloyd Schuhfabrik Meyer*, paragraph 27.

for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

44. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. considered the impact of the CJEU’s judgment in *Bimbo*, on the court’s earlier judgment in *Medion v Thomson*. He stated:

“18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).”

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

45. In *Kurt Geiger v A-List Corporate Limited*, BL O/075/13, Mr Iain Purvis Q.C. (as he then was) 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.”

46. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, James Mellor K.C., sitting as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

47. In *Liverpool Gin Distillery Ltd and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207, the Court of Appeal dismissed an appeal against a ruling of the High Court that trade marks for the words EAGLE RARE registered for whisky and bourbon whiskey were infringed by the launch of a bourbon whiskey under the sign "American Eagle". In his decision, Lord Justice Arnold stated that:

"13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/219/16) at [16] "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Mr Mellor went on to say that, if there is no likelihood of direct confusion, "one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion". I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion."

48. Earlier in this decision I have concluded that:

- the goods at issue range from identical to similar to a medium degree;
- the average consumer is a member of the general public. The selection process is predominantly visual without discounting aural considerations. The average consumer may examine the products to ensure that they select the correct type, quality, size and/or aesthetic appearance. The level of attention paid will be average;

- the competing marks are visually similar to between a low to medium degree, aurally to a low degree, and conceptually similar to medium degree;
- the earlier mark has a below medium degree of inherent distinctiveness.

49. Taking into account the above factors, I find that there is no likelihood of direct confusion for identical goods. Notwithstanding the concept of imperfect recollection, the marks will not be directly confused for one another. This is because the shared common word element/component “GRIP” is weak for the average consumer to misremember/misrecall as each other,⁹ especially when the different dictionary word element “TIGER” and word component “LION-” are placed at the beginning of the marks. Thus, the first word element/component will be likely fixed itself in the average consumer’s mind and act as a point of distinction when recalling the competing marks. Further, despite the conceptual similarity of the marks, it is my view that the common element does not retain an independent distinctive role. It follows that there will be no direct confusion. This finding extends to the goods that I found to be similar to a high degree.

50. Even if the average consumer recalls the points of similarity between the marks, such as that they contain the word “GRIP”, I still consider the marks would not be indirectly confused. Sitting as the Appointed Person in *Eden Chocolat*,¹⁰ James Mellor QC (as he then was) stated:

“81.4 [...] I think it is important to stress that a finding of indirect confusion should not be made merely because the two marks share a common element. When Mr Purvis was explaining¹¹ in more formal terms the sort of mental process involved at the end of his [16], he

⁹ See *Kurt Geiger v A-List Corporate Limited*.

¹⁰ Case BL O/547/17 *Eden Chocolat be more chocstanza (word & device) v Heirler Cenovis GmbH* (27 October 2017).

¹¹ In *L.A. Sugar*.

made it clear that the mental process did not depend on the common element alone: ‘Taking account of the common element in the context of the later mark as a whole.’” (Emphasis added)

In light of the guidance above, the conjoined words in the contested mark form a cohesive whole. The overall impression lies within the conjunction of the word components of the mark. Thus, the average consumer will not consider the competing marks as variants or sub-brands of each other nor that the goods and services in question are from the same or economically linked undertakings merely on the use of the common word component “GRIP”, which is allusive to the goods. Thus, I find that the guidance given in *Duebros* applies to this case, namely that an average consumer may merely associate the common word element in the marks but would not confuse them. Consequently, I find that there is no likelihood of indirect confusion. This finding extends to the goods that I found to be similar to a high degree.

Outcome

51. The opposition under Section 5(2)(b) of the Act is **unsuccessful in its entirety**. Therefore, subject to appeal, the application can proceed to registration.

Costs

52. This opposition has failed in its entirety and the applicant is entitled to a contribution towards its costs of defending its application. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 2/2016. I award costs as follows:

Considering the other side's statement and preparing a counterstatement	£250
Total	£250

53. I, therefore, order, Tiger Grip Sas to pay Guangdong Banshang Dingding Protection Technology Co., Ltd. the sum of £250. 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 12th day of May 2023

Dr Stylianos Alexandridis

For the Registrar,

The Comptroller General