

O-305-16

**TRADE MARKS ACT 1994
IN THE MATTER OF
APPLICATION NO 3118544
BY BETTINA SEWELL
TO REGISTER THE TRADE MARK**

Quirky Mindz Understanding the Misunderstood

**IN CLASSES 25 & 41
AND
OPPOSITION THERETO (UNDER NO. 405133)
BY
PAULINE QUIRKE ACADEMY LIMITED**

BACKGROUND

1) On 20 July 2015, Bettina Sewell ('the applicant') applied to register the following trade mark for the goods and services listed below:

Quirky Mindz Understanding the Misunderstood

Class 25: Casual clothing.

Class 41: Education services.

2) The application was published on 14 August 2015 in the Trade Marks Journal and notice of opposition was subsequently filed by Pauline Quirke Academy Limited ('the opponent').

3) The opponent claims that the application offends under section 5(2)(b) of the Act. It relies upon the UK Trade Mark ('UKTM') shown in the table below:

UKTM details	Goods and services relied upon
UKTM No: 3061092 Quirky Kidz Filing date: 23 June 2014 Date of entry in the register: 05 December 2014	Class 25: Clothing, footwear and headgear. Class 41: Educational and training services relating to music, dance and drama, including educational and training services relating to theatre, film and television; organization of cultural and educational exhibitions and performances relating to music, dance and drama; provision of seminars, workshops and classes relating to

	music, dance and drama; entertainment agency services; entertainment agency services relating to music, dance, drama, theatre, film and television.
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4) The opponent's trade mark is an earlier mark in accordance with section 6 of the Act and, as it had not been registered for five years or more before the publication date of the applicant's mark, it is not subject to the proof of use requirements, as per The Trade Marks (Proof of Use, etc) Regulations 2004.

5) The applicant filed a counterstatement in which it denies that its mark is similar to the opponent's mark and further states that the parties businesses are very different, operating in different industries. It also requested the opponent provide proof of use, however, for the reasons given in the preceding paragraph, the opponent is not required to do so (this was also pointed out to the applicant in the official letter of 07 December 2015). Accordingly, the opponent can rely on the full breadth of its specification of goods and services as set out in the table above.

6) Neither party filed evidence, nor did they request to be heard. Only the opponent filed written submissions in lieu of a hearing. I now make this decision on the basis of the papers before me.

PRELIMINARY ISSUES

7) The opponent makes a number of references in its submissions to the "well known UK Actress Pauline Quirke" who is "the founder and owner of the opponent" and uses this as support for its arguments in relation to how the "Quirky" part of its mark will be perceived, the similarities between the marks and the level of distinctive character of its mark. It also speaks of "damage" being caused to the opponent and the applicant gaining a "significant benefit". None of these points can be taken into account in the instant case. Firstly, it is well established that reputation is not a factor

which is relevant to the assessment of the similarity of the marks¹. Secondly, as there is no evidence before me in these proceedings, it is only the inherent meaning and distinctiveness of the opponent's mark which I am able to consider. Thirdly, arguments relating to potential damage to the opponent's business or benefit to the applicant are not relevant considerations under section 5(2)(b) of the Act.

8) As to the applicant's contention that there will be no likelihood of confusion because the parties operate in different industries, this is also not something which I can take into account. I am required to make the assessment of the likelihood of confusion under section 5(2)(b) notionally and objectively solely on the basis of the marks and goods and services as they appear before me. The manner in which either party currently chooses to operate is irrelevant because marketing strategies are temporal and may change with the passage of time. See for instance, *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P, where the Court of Justice of the European Union stated:

“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.”

9) For all of these reasons, neither of the parties' respective arguments above will have any bearing on my decision and I will make no further mention of them.

DECISION

10) Section 5(2)(b) of the Act provides:

“5. (2) A trade mark shall not be registered if because –
(a)

¹ *Ravensburger AG v OHIM*, Case T-243/08, [27]

(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.”

11) The leading authorities which guide me are from the Court of Justice of the European Union ('CJEU'): *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles

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

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

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

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when

all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

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

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

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

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

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

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

Comparison of goods and services

12) The goods and services to be compared are:

Opponent's goods and services	Applicant's goods and services
<p>Class 25: Clothing, footwear and headgear.</p> <p>Class 41: Educational and training services relating to music, dance and drama, including educational and training services relating to theatre, film and television; organization of cultural and educational exhibitions and performances relating to music, dance and drama; provision of seminars, workshops and classes relating to music, dance and drama; entertainment agency services; entertainment agency services relating to music, dance, drama, theatre, film and television.</p>	<p>Class 25: Casual clothing.</p> <p>Class 41: Education services.</p>

13) In *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM Case T-133/05) ('*Meric*'), the General Court ('GC') held:

"29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03

Koubi v OHIM – Flabesa (CONFORFLEX) [2004] ECR II-719, paragraphs 41 and 42).”

The applicant’s goods in class 25 fall within the broad term, ‘Clothing’ in the opponent’s specification. The respective goods are identical in accordance with *Meric*.

14) The opponent’s specification in class 41 includes the term ‘Educational and training services relating to music, dance and drama, including educational and training services relating to theatre, film and television’ which falls within the broader term ‘Education services’ in the applicant’s specification. The respective services are also identical in accordance with *Meric*.

Average consumer and the purchasing process

15) It is necessary to determine who the average consumer is for the respective goods and services and the manner in which they are likely to be selected. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

16) The average consumer for the goods and services at issue is the general public. As regards the goods in class 25, in *New Look Ltd v Office for the Harmonization in the Internal Market (Trade Marks and Designs) Joined Cases T-117/03 to T-119/03 and T-171/03* the GC stated:

“43 It should be noted in this regard that the average consumer’s level of attention may vary according to the category of goods or services in question (see, by analogy, Case C-342/97 Lloyd Schuhfabrik Meyer [1999] ECR I-3819, paragraph 26). As OHIM rightly pointed out, an applicant cannot simply assert that in a particular sector the consumer is particularly attentive to trade marks without supporting that claim with facts or evidence. As regards the clothing sector, the Court finds that it comprises goods which vary widely in quality and price. Whilst it is possible that the consumer is more attentive to the choice of mark where he or she buys a particularly expensive item of clothing, such an approach on the part of the consumer cannot be presumed without evidence with regard to all goods in that sector. It follows that that argument must be rejected.

...

53. 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.”

As stated by the GC, clothing will vary greatly in price. Accordingly, the purchase may not always be particularly considered. That said, as the consumer may wish to try on the goods, or to ensure that they are of a preferred colour, pattern, size or material (for example), it is likely, in my view, that at least a reasonable degree of attention is still likely to be afforded, even for those goods which carry a more inexpensive price tag. The purchasing act will be primarily visual on account of the goods being commonly purchased based on their aesthetic appeal; they are likely to be selected after perusal of racks/shelves in retail establishments, or from photographs on Internet websites or in catalogues. However, I do not discount aural considerations which may also play a part.

17) I would also expect the respective services in class 41 to attract at least a reasonable degree of attention given that the consumer may take into consideration factors such as the variety of courses on offer, the content of syllabuses, tuition fees, etc. Again, the purchasing act is likely to be mainly visual given that the consumer is likely to seek out the services on the internet, through brochures or prospectuses, for example. However, I bear in mind the potential for oral use of the marks such as through oral recommendations and therefore the aural aspect must also be considered.

Comparison of marks

18) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

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

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19) The opponent's mark consists of the words 'Quirky Kidz' presented in plain letters. For goods and services which are not aimed at children, the words hang together as a phrase with neither word dominating the overall impression. In relation to clothing for children or educational services specifically aimed at children, again the words hang together but, given that 'Kidz' will likely be perceived as a misspelling of the word 'Kids', the relevance of that word to those goods and services means that the word 'Quirky' has slightly greater weight in the overall impression.

20) The applicant's mark naturally breaks down into two elements, each hanging together as a phrase. The first element is the phrase 'Quirky Mindz' and the second is the phrase 'Understanding the Misunderstood'. The first element carries the greater weight in the overall impression owing, in particular, to its prominent position at the beginning of the mark. That said, the second element also makes an important contribution to the mark's overall impression, particularly since it occupies a substantial proportion of the mark; in my view, it carries only slightly lesser weight than the words 'Quirky Mindz'.

21) On the matter of visual similarity, the opponent submits:

"Whilst there are some visual differences between the marks, the Opponent submits that the correct comparison to make is between "Quirky Kidz" and "Quirky Mindz", being the key first element of the respective marks, which are the elements most recognised, most used and most likely to be remembered by users. Visually, those elements are highly similar."

I have already concluded that both elements of the applicant's mark contribute to its overall impression. Neither element is negligible; far from it. As such, it is not permissible to make the comparison on the basis contended by the opponent. I must take into account both elements of the applicant's mark. The single point of visual coincidence between the marks is that both contain the word 'Quirky' at the beginning. In all other respects they are very different to the eye. Given that the opponent's mark is much longer than the applicant's mark, these differences are particularly pronounced. On the whole, I consider there to be a very low degree of visual similarity.

22) Aurally, again the opponent takes no account of the second element of the applicant's mark, and submits that:

“Aurally, the “Quirky” element of the respective marks are identical. The “Mindz” and “Kidz” elements are similar...”

Plainly the opponent is correct to point out that the respective 'Quirky' aspects of the marks are aurally identical. However, aside from the 'z' sound at the end of the words 'Mindz' and 'Kidz' there is no aural similarity between those words. I find that, in the event that the applicant's mark *may* be referred to solely by its first element (i.e. 'Quirky Mindz'), the overall level of aural similarity would be no more than moderate and in the event that the average consumer does articulate the whole of the applicant's mark, the degree of aural similarity would be very low overall.

23) Conceptually, the opponent's mark, which I have concluded hangs together, portrays the idea of unusual children. As for the applicant's mark, bearing in mind that it is only concepts that are capable of immediate grasp that are relevant,² the main conceptual image for the consumer is likely to come from the first element, 'Quirky Mindz' which instantly conveys the idea of unusual minds. The message conveyed by the second element, 'Understanding the Misunderstood', whilst self-explanatory, is a less concrete and precise concept which, as such, is less likely to

² This is highlighted in numerous judgments of the GC and the CJEU, including *Ruiz Picasso v OHIM* [2006] e.c.r. –I-643; [2006] E.T.M.R. 29.

form part of the conceptual hook. The opponent submits that the marks are conceptually highly similar because:

“If a kid is quirky, then his or her mind is the origin of that quirkiness.”

It seems to me that this approach requires too great a degree of mental analysis. In my view, whilst the main conceptual hook for both marks is of something unusual, as the object of that unusualness is not the same, being children (specifically) on the one hand and minds (in general) on the other, the conceptual similarity is no more than moderate.

Distinctive character of the earlier mark

24) The distinctive character of the earlier mark must be considered. The more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined 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).”

As I have already stated, there is no evidence before me in this case and therefore, I can only take into account the inherent qualities of the earlier mark. The opponent submits that its mark is highly distinctive on account, in particular, of the word ‘Quirky’ which “has no descriptive value”. The applicant makes no submissions on the point.

25) Whilst the opponent’s mark is not descriptive of the relevant goods, it does not automatically follow that the mark should be attributed with a high degree of distinctive character. There are various rungs on the distinctiveness ladder. The mark will be perceived as two familiar English words (despite the misspelling of ‘Kids’ as ‘Kidz’) presented in a standard font with no additional stylisation. I have already found that those two words hang together; the concept portrayed by the mark is not of the general concept of quirkiness *per se* but of the more precise concept of quirky kids (i.e. unusual children). In the context of at least some of the opponent’s goods (i.e. those specifically tailored to children), that concept is not highly distinctive since it alludes, to a certain degree, to the target market. I find that the mark has, at best, an average degree of distinctive character in relation to the goods and services covered by the opponent’s mark.

Likelihood of confusion

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

27) Earlier in this decision, I found the following:

- The respective goods and services are identical.
- The average consumer is the general public who are likely to pay, at least, a reasonable degree of attention during the purchase.
- The purchase is likely to be mainly visual.
- The level of distinctiveness of the earlier mark is average, at best.
- The respective marks share a very low degree of visual similarity, a moderate/very low degree of aural similarity (the former if only the first element of the applicant's mark is vocalised, the latter if both elements are vocalised) and no more than moderate degree of conceptual similarity.

I will firstly consider the likelihood of direct confusion (where the average consumer mistakes one mark for the other). Although I have found that the respective goods and services are identical, which is an important factor weighing in the opponent's favour, I have also found that the marks have only a moderate/very low degree of aural similarity and no more than a moderate degree of conceptual similarity.

Moreover, I have concluded that the marks have only a very low level of visual similarity; a factor which is to be given the greater weight in the global assessment as a consequence of the purchase being likely to be mainly visual.³ Bearing these factors in mind, together with my finding that the consumer is likely to pay, at least, a reasonable degree of attention during the purchase, I find that the consumer is unlikely to mistake one mark for the other. There is no likelihood of direct confusion.

³ In *New Look Ltd v OHIM* Joined cases T-117/03 to T-119/03 and T-171/03, the GC stated: "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."

28) Confusion can, of course, be indirect, rather than direct, in the sense that the average consumer recognises that the marks are different but nonetheless puts the similarities that do exist between them down to the respective goods and services coming from the same or linked undertakings. On this matter, it is helpful to consider the comments of Mr Iain Purvis Q.C., sitting as the Appointed Person in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, where he stated:

“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).”

Having considered all relevant factors, I do not consider that the marks before me will be indirectly confused in the manner described in any of the three categories identified by Mr Purvis. The common element is not “so strikingly distinctive”, the later mark does not simply add a non-distinctive element to the earlier mark and neither does the later mark appear to be “entirely logical and consistent with a brand extension” of the earlier mark. I, of course, bear in mind that the three categories identified by Mr Purvis are illustrative rather than exhaustive. However, I also cannot see any other manner, which may fall outside of those three categories, in which indirect confusion is likely to occur and I am not persuaded by the opponent’s contention that the “unusual” spelling of ‘Mindz’ and ‘Kidz’ (with the letter ‘s’ substituted by the letter ‘z’ in both marks) would lead to indirect confusion. That misspelling is, in my view, such an obvious one, it will not be put down to the goods emanating from the same or linked undertaking(s). There is no likelihood of indirect confusion.

The opposition fails.

COSTS

29) As the applicant has been successful, it is entitled to a contribution towards its costs. Using the guidance in Tribunal Practice Notice 4/2007, but bearing in mind that the applicant has not incurred the expense of legal representation, I award the applicant £100 for considering the opponent’s statement and preparing the counterstatement.

30) I order Pauline Quirke Academy Limited to pay Bettina Sewell the sum of **£100**. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 27th day of June 2016

**Beverley Hedley
For the Registrar,
the Comptroller-General**