

**O/269/19**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. UK00003344024  
BY RICHARD GRAYSON COLEMAN, ISAAC COLEMAN AND VICTORIA  
COLEMAN**

**TO REGISTER THE TRADE MARK:**

**T.one.D**

**IN CLASS 25**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 600001026 BY  
GEORGE MARSHALL**

## BACKGROUND AND PLEADINGS

1. On 8 October 2018, Richard Greyson Coleman, Isaac Coleman and Victoria Coleman (“the applicants”) applied to register the trade mark **T.one.D** in the UK. The application was published for opposition purposes on 19 October 2018. Registration is sought for the following goods:

Class 25 Tee-shirts; Tops [clothing]; Track suits; Tracksuit bottoms; Tracksuit tops; Tracksuits; T-shirts; Baseball caps and hats; Body warmers; Bottoms [clothing]; Boxer briefs; Boxer shorts; Boy shorts [underwear]; Boys' clothing; Briefs; Briefs [underwear]; Crop tops; Caps being headwear; Caps [headwear]; Casual clothing; Casual shirts; Children's clothing; Childrens' clothing; Children's footwear; Children's wear; Clothes; Clothes for sport; Clothes for sports; Clothing; Clothing for leisure wear; Clothing for men, women and children; Clothing for wear in judo practices; Coats; Coats for men; Coats for women; Coats made of cotton; Coats (Top -); Dresses; Gloves; Gymwear; Hats; Hooded pullovers; Hooded sweat shirts; Hooded sweatshirts; Hooded tops; Hoodies; Infants' clothing; Jackets [clothing]; Jackets (Stuff -) [clothing]; Jogging bottoms; Jogging bottoms [clothing]; Jogging outfits; Jogging pants; Jogging sets [clothing]; Jogging shoes; Jogging suits; Jogging tops; Jumpers; Jumpers [pullovers]; Jumpers [sweaters]; Knickers; Ladies' clothing; Ladies' outerclothing; Leggings [leg warmers]; Leggings [trousers]; Leisure clothing; Leisurewear; Long sleeved vests; Long-sleeved shirts; Lounge pants; Loungewear; Men's and women's jackets, coats, trousers, vests; Men's clothing; Men's underwear; Menswear; Articles of outer clothing; Articles of sports clothing; Athletic clothing; Night shirts; Nightdresses; Nightshirts; Outerclothing; Outerclothing for boys; Outerclothing for girls; Outerclothing for men; Polo neck jumpers; Polo shirts; Printed t-shirts; Rugby jerseys; Rugby shirts; Rugby shorts; Rugby tops; Shirts; Shorts; Shorts [clothing]; Short-sleeve shirts; Short-sleeved shirts; Short-sleeved T-shirts; Sleepwear; Sports caps; Sports caps and hats; Sports clothing; Sports garments; Sports shirts; Sports

shirts with short sleeves; Sports vests; Sports wear; Sweat shirts; Sweat shorts; Sweatshirts; Tank-tops; Tee-shirts; Tops; Tops [clothing]; Tracksuit bottoms; Tracksuit tops; Tracksuits; Trunks [underwear]; T-shirts; Under garments; Underclothing; Underclothing for women; Underpants; Undershirts; Underwear; Vest tops; Vests; Women's clothing.

2. The application was opposed under the fast track opposition procedure by George Marshall (“the opponent”). The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies on UK registration no. 3236010 for the trade mark **TONED** which has a filing date of 7 June 2017 and a registration date of 1 September 2017. The opponent relies on all of the goods for which the mark is registered, namely:

Class 5      Dietary supplements.

Class 18     Gym bags.

Class 25     Clothing for sports.

3. The opponent submits that the respective goods are identical or similar and that the marks are similar. In his Notice of Opposition, the opponent states:

“The mark T.one.D is visually, aurally and conceptually similar to my UK Trade mark Registration for TONED. In addition, the application covers identical and similar goods in Classes 18 and 25 to my earlier registration. If printed on clothing, the increase in letter size will be proportionally much larger than the increase in size of the punctuation, and it will be read as TONED. This renders the use of punctuation even less likely to sufficiently differentiate between the two marks and will result in a likelihood of confusion with my own branded clothing.”

4. The applicants filed a counterstatement denying the claims made. In their Counterstatement, the applicants state:

“I deny the claim that the mark T.one.D is visually, aurally and conceptually similar to your Registration for TONED.

They look totally different as shown below and would stand out when printed on clothing as they are very different[...]

[...] We also intend to change the font and style of the T and the D as per some options below, which would further indicate the differentiation and highlight the punctuations and case of the whole word.[...]

[...] The “one” will always be preceded by a punctuation in bold and followed by the same punctuation in bold. At no point will the mark be all in uppercase as per your mark. Therefore, will ensure differentiation from your brand.

They will be in a similar goods class, but this was purely to sell T-shirts and hoodies for followers of my sons cause. It may branch out to other goods, for example shorts and pants but this will be due to how successful the initial offerings are. I/We assure you we are not trying to infringe on your Mark and we believe there would be no confusion with your branded clothing either now or in the future.”

5. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 2235, disappplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

6. The net effect of these changes is to require the parties to seek leave in order to file evidence in fast track oppositions. No leave was sought in respect of these proceedings.

7. Neither party is represented. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken. A hearing was neither requested not considered necessary;

neither party filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

## **DECISION**

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

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

(a)...

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

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

9. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b) subject to its being so registered.”

10. The trade mark upon which the opponent relies qualifies as an earlier trade mark under the above provisions. As this trade mark had not completed its registration process more than 5 years before the publication date of the application in issue in these proceedings, it is not subject to proof of use pursuant to section 6A of the Act. The opponent can, therefore, rely upon all of the goods he has identified.

### **Section 5(2)(b) – case law**

11. 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 greater 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 to mind the earlier mark, 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**

12. The competing goods are as follows:

<b>Opponent's goods</b>	<b>Applicants' goods</b>
<u>Class 5</u> Dietary supplements.	<u>Class 25</u>

<p><u>Class 18</u> Gym bags.</p> <p><u>Class 25</u> Clothing for sports.</p>	<p>Tee-shirts; Tops [clothing]; Track suits; Tracksuit bottoms; Tracksuit tops; Tracksuits; T-shirts; Baseball caps and hats; Body warmers; Bottoms [clothing]; Boxer briefs; Boxer shorts; Boy shorts [underwear]; Boys' clothing; Briefs; Briefs [underwear]; Crop tops; Caps being headwear; Caps [headwear]; Casual clothing; Casual shirts; Children's clothing; Childrens' clothing; Children's footwear; Children's wear; Clothes; Clothes for sport; Clothes for sports; Clothing; Clothing for leisure wear; Clothing for men, women and children; Clothing for wear in judo practices; Coats; Coats for men; Coats for women; Coats made of cotton; Coats (Top -); Dresses; Gloves; Gymwear; Hats; Hooded pullovers; Hooded sweat shirts; Hooded sweatshirts; Hooded tops; Hoodies; Infants' clothing; Jackets [clothing]; Jackets (Stuff -) [clothing]; Jogging bottoms; Jogging bottoms [clothing]; Jogging outfits; Jogging pants; Jogging sets [clothing]; Jogging shoes; Jogging suits; Jogging tops; Jumpers; Jumpers [pullovers]; Jumpers [sweaters]; Knickers; Ladies' clothing; Ladies' outerclothing; Leggings [leg warmers]; Leggings [trousers]; Leisure clothing; Leisurewear; Long sleeved vests; Long-sleeved shirts; Lounge pants; Loungewear; Men's and women's</p>
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	jackets, coats, trousers, vests; Men's clothing; Men's underwear; Menswear; Articles of outer clothing; Articles of sports clothing; Athletic clothing; Night shirts; Nightdresses; Nightshirts; Outerclothing; Outerclothing for boys; Outerclothing for girls; Outerclothing for men; Polo neck jumpers; Polo shirts; Printed t-shirts; Rugby jerseys; Rugby shirts; Rugby shorts; Rugby tops; Shirts; Shorts; Shorts [clothing]; Short-sleeve shirts; Short-sleeved shirts; Short-sleeved T-shirts; Sleepwear; Sports caps; Sports caps and hats; Sports clothing; Sports garments; Sports shirts; Sports shirts with short sleeves; Sports vests; Sports wear; Sweat shirts; Sweat shorts; Sweatshirts; Tank-tops; Tee-shirts; Tops;Tops [clothing]; Tracksuit bottoms; Tracksuit tops; Tracksuits; Trunks [underwear]; T-shirts; Under garments; Underclothing; Underclothing for women; Underpants; Undershirts; Underwear; Vest tops; Vests; Women's clothing.
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13. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be

taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

14. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (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.

15. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“... 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.”

16. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

“I should add that I see no reason to give the word “cosmetics” and “toilet preparations”... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context.”

17. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut for 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. I have no detailed submissions from the parties on the similarity of the goods.

19. “Clothing for sports” in the opponent’s specification is plainly identical to “Clothes for sport”, “Clothes for sports”, “Articles of sports clothing”, “Sports clothing”, “Sports garments” and “Sports wear” in the applicants’ specification.

20. “Track suits”, “Tracksuit bottoms”, “Tracksuit tops”, “Tracksuits”, “Clothing for wear in judo practices”, “Gymwear”, “Jogging bottoms”, “Jogging bottoms [clothing]”, “Jogging outfits”, “Jogging pants”, “Jogging sets [clothing]”, “Jogging suits”, “Jogging

tops”, “Athletic clothing”, “Rugby jerseys”, “Rugby shirts”, “Rugby shorts”, “Rugby tops”, “Sports shirts”, “Sports shirts with short sleeves”, “Sports vests”, “Tracksuit bottoms”, “Tracksuit tops” and “Tracksuits” in the applicants’ specification all fall within the broader category of “clothing for sports” in the opponent’s specification. These goods can, therefore, be considered identical on the principle outlined in *Meric*.

21. “Clothing for sports” in the opponent’s specification falls within the broader categories of “Clothes” and “Clothing” in the applicants’ specification. These goods can, therefore, be considered identical on the principle outlined in *Meric*.

22. “Tee-shirts”, “Tops [clothing]”, “T-shirts”, “Body warmers”, “Bottoms [clothing]”, “Boxer briefs”, “Boxer shorts”, “Boy shorts [underwear]”, “Boys' clothing”, “Briefs”, “Briefs [underwear]”, “Crop tops”, “Casual clothing”, “Casual shirts”, “Children's clothing”, “Childrens' clothing”, “Children's wear”, “Clothing for leisure wear”, “Clothing for men, women and children”, “Coats”, “Coats for men”, “Coats for women”, “Coats made of cotton”, “Coats (Top -)”, “Dresses”, “Hooded pullovers”, “Hooded sweat shirts”, “Hooded sweatshirts”, “Hooded tops”, “Hoodies”, “Jackets [clothing]”, “Jackets (Stuff -) [clothing]”, “Jumpers”, “Jumpers [pullovers]”, “Jumpers [sweaters]”, “Knickers”, “Ladies' clothing”, “Ladies' outerclothing”, “Leggings [leg warmers]”, “Leggings [trousers]”, “Leisure clothing”, “Leisurewear”, “Long sleeved vests”, “Long-sleeved shirts”, “Lounge pants”, “Loungewear”, “Men's and women's jackets, coats, trousers, vests”, “Men's clothing”, “Men's underwear”, “Menswear”, “Articles of outer clothing”, “Outerclothing”, “Outerclothing for boys”, “Outerclothing for girls”, “Outerclothing for men”, “Polo neck jumpers”, “Polo shirts”, “Printed t-shirts”, “Shirts”, “Shorts”, “Shorts [clothing]”, “Short-sleeve shirts”, “Short-sleeved shirts”, “Short-sleeved T-shirts”, “Sweat shirts”, “Sweat shorts”, “Sweatshirts”, “Tank-tops”, “Tee-shirts”, “Tops”, “Tops [clothing]”, “Trunks [underwear]”, “T-shirts”, “Under garments”, “Underclothing”, “Underclothing for women”, “Underpants”, “Undershirts”, “Underwear”, “Vest tops”, “Vests” and “Women's clothing” in the applicants’ specification are all types of clothing. They are all capable of being worn for sports purposes. In my view, these goods can fall within the broader category of “Clothing for sports” in the opponent’s specification. They can, therefore, be considered identical on the principle outlined in *Meric*. In any event, there will be a significant overlap in users. The fundamental use will be the same as they are all worn to cover the body. The method of use and trade channels

will overlap. The nature of the goods is the same. If I am wrong in my finding that these goods are identical, they will at least be highly similar.

23. “Infants' clothing”, “Night shirts”, “Nightdresses”, “Nightshirts” and “Sleepwear” in the applicants' specification are unlikely to be worn for sports purposes. Nightwear and sleepwear are clearly intended to be worn whilst sleeping and infants will be too young to participate in sports. The uses will, therefore, differ (albeit they share the same fundamental purpose of covering the body). Whilst nightwear may overlap in user with sportswear, infantwear and sportswear will differ in users. The nature of the goods is the same and there may be overlap in trade channels. I consider these goods to be similar to a medium degree to “clothing for sports” in the opponent's specification.

24. “Gloves”, “baseball caps and hats”, “caps being headwear”, “caps [headwear]”, “hats”, “sports caps” and “sports caps and hats” in the applicants' specification are all commonly worn for sporting purposes. For example, goal keepers may wear gloves for football and baseball players commonly wear hats. In any event, they have the same use as sportswear as they are intended to cover the body. They will overlap in user, trade channel and method of use. In my view, these goods are highly similar to “clothing for sports” in the opponent's specification.

25. “Children's footwear” and “jogging shoes” in the applicants' specification are both capable of being worn for sporting activities. They cannot be said to be types of clothing. They differ in nature. There is a degree of overlap in purpose as both shoes and clothing are worn to cover parts of the body, but shoes are worn to provide protection from the surfaces with which the feet come into contact with and clothing is worn to provide warmth. They will overlap in user and trade channels. I consider these goods to be similar to a medium degree.

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

26. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The*

*Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J 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.”

27. I have no submissions from either party on the average consumer or the nature of the purchasing process. In my view, the average consumer for the goods in issue will be members of the general public or sporting professionals. These purchases are likely to vary in frequency and cost. Various factors will be taken into account when purchasing the goods such as material, cost and quality. Performance related factors may also be taken into consideration in the context of sports related items. Overall, the level of attention paid by the average consumer during the purchasing process will be average.

28. The goods are, in my experience, most likely to be obtained by self-selection from the shelves of a retail outlet or from an online or catalogue equivalent. In the context of sports related items, endorsements by professionals may be observed in adverts or on the television. Consequently, visual considerations are likely to dominate the selection process. However, I do not discount that there may be an aural component to the purchase of the goods given that advice may be sought from a sales assistant.

### **Comparison of trade marks**

29. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade mark must be assessed by reference to the overall impressions created by the trade 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.”

30. 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 impression created by the marks.

31. The respective trade marks are shown below:

<b>Opponent's trade mark</b>	<b>Applicants' trade mark</b>
TONED	T.one.D

32. I note the applicants' submissions that they intend to introduce further points of difference between the marks when presented on the market, through use of stylisation. However, for the purposes of my assessment, I must take into account only the marks as applied for/registered. As word only marks both parties' marks could be used in any standard typeface.

33. The opponent's mark consists of the five-letter dictionary word TONED. There are no other elements to contribute to the overall impression, which is contained in the word itself. The applicants' mark consists of the same five letters – T, O, N, E and D. However, in the applicants' mark full stops are used to divide the T and the O and the

E and the D. There are no other elements to contribute to the overall impression, which lies in the combination of letters and full stops.

34. Visually, the marks both consist of the same five letters presented in the same order. The first point of visual difference between the marks lies in the use of capitalisation in the applicants' mark. That is, the T and D presented in upper case and the O, N and E presented in lower case. However, as noted above both marks could be used in any standard typeface and so differences created by the capitalisation are irrelevant. The second point of visual difference lies in the addition of full stops to the applicants' mark. This breaks up, what would otherwise be the word TONED, into the word ONE preceded by the letter T and followed by the letter D. However, notwithstanding the full stops, both marks clearly consist of the same five letters in the same order. I consider the marks to be visually similar to a high degree.

35. Aurally, the opponent's mark will be given its ordinary English pronunciation – TONE-D. If consumers recognise both marks as the word TONED then they will be aurally identical. However, for consumers who do not recognise the presence of the word TONED, the applicant's mark will be pronounced TEE-ONE-DEE. In this case, the marks will be aurally dissimilar.

36. Conceptually, the opponent's mark will be given its ordinary dictionary meaning. If the applicants' mark is recognised as the same word then the marks will be conceptually identical. If the applicants' mark is viewed as being the letter T, the word ONE and the letter D, then the word ONE will be understood as the number and the letters T and D will convey no particular meaning. In this case, the marks will be conceptually dissimilar.

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

37. 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-2779, 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 promotion of 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).”

38. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

39. I have no submissions from either party on the inherent distinctive character of the opponent’s mark. I must consider the inherent distinctiveness of the earlier mark as a whole. The earlier mark consists of the word TONED. This is an ordinary dictionary word. It will be allusive for sports related goods, as it may be seen as a reference to toned muscles achieved through sports. In my view, the earlier mark is inherently distinctive to a low to medium degree.

### **Likelihood of confusion**

40. 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. 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. 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. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade mark, the average consumer for the goods 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.

41. I have found there to be a high degree of visual similarity between the marks. If the consumer recognises the applicants' mark as the word TONED then the mark will be aurally and conceptually identical. If the consumer does not recognise the applicants' mark as the word TONED and sees it as the word ONE preceded by the letter T and followed by the letter D, then they will be aurally and conceptually dissimilar. I have found the earlier mark to have a low to medium degree of inherent distinctive character. I have identified the average consumer to be a member of the general public or a sports professional who will select the goods primarily through visual means (although I do not discount an aural component). I have concluded that an average degree of attention will be paid during the purchasing process. I have found the parties' goods to be identical or similar to a medium or high degree.

42. For those consumers who do not recognise the presence of the word TONED in the applicants' mark, the marks will be aurally and conceptually dissimilar. However, the presence of the same five letters in the same order in both marks will mean that there will still be a high degree of visual similarity. Given that the purchasing process is likely to be dominated by visual considerations, I consider that it is likely that the marks will be misremembered or mistakenly recalled as each other. There is a likelihood of direct confusion for these consumers in relation to all of the applicants' goods.

43. For those consumers who recognise the word TONED in both marks, the marks will be visually similar to a high degree and aurally and conceptually identical. Consumers will not have the benefit of being able to compare the marks side by side and, in my view, the marks are likely to be misremembered or mistakenly recalled as each other. This is particularly the case given that only an average degree of attention will be paid during the purchasing process. I consider there to be a likelihood of direct confusion.

44. I must give due weight to the range of reactions of average consumers; provided that a significant number of those average consumers would be confused, this is sufficient for a finding of confusion<sup>1</sup>. Even if I am wrong in my finding that there remains a likelihood of confusion for those consumers who do not recognise the presence of the word TONED in the applicants' mark, I consider that a significant number of average consumers will recognise the presence of the word TONED in both marks. This is enough for a finding of confusion.

## **CONCLUSION**

45. The opposition is successful and the application is refused.

## **COSTS**

46. As the opponent has been successful, he is entitled to a contribution towards his costs. The opponent is unrepresented and has submitted a costs proforma outlining the number of hours spent on these proceedings. In awarding costs, I bear in mind the guidance in Tribunal Practice Notice 2/2015 which governs costs in fast track proceedings issued after 1 October 2015.

47. The opponent has claimed 2 hours for completing his Notice of Opposition and 1 hour for reviewing forms filed by the applicants. I consider a cost award for this number of hours to be reasonable.

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<sup>1</sup> *Interflora v Marks and Spencer* [2014] EWCA 1403 (Civ)

48. The opponent is also entitled to the official fee for filing the Notice of Opposition in the sum of £100.

49. The opponent has claimed £19 per hour. I note that The Litigants in Person (Costs and Expenses) Act 1975 (as amended) sets the minimum level of compensation for litigants in person in Court proceedings at £19.00 per hour. I see no reason to award anything other than this. I award the opponent the sum of £57 (3 hours at £19 per hour) plus the official fee of £100, totalling £157.

50. I therefore order Richard Greyson Coleman, Isaac Coleman and Victoria Coleman to pay George Marshall the sum of £157. This sum should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

**Dated 21 May 2019**

**S WILSON**

**For the Registrar**