

O/582/19

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO. 3378471

BY

HADSON GROUP LIMITED
TO REGISTER THE TRADE MARK

HADSONS

IN CLASS 35

AND OPPOSITION THERETO (NO. 600001113)

BY

DUFREY AG

Background and Pleadings

1. HADSON GROUP LIMITED (the Applicant) applied to register the trade mark HADSONS on the 26 February 2019 for services in class 35 namely:

CLASS 35: Advertising of the goods of other vendors, enabling customers to conveniently view and compare the goods of those vendors; Advertising of the services of other vendors, enabling customers to conveniently view and compare the services of those vendors; Advertising on the Internet for others; Advertising services relating to clothing; Affiliate marketing; Arranging and conducting of commercial exhibitions and shows; Arranging and conducting of fairs and exhibitions for business purposes; Arranging and conducting of Internet auctions; Arranging business introductions relating to the buying and selling of products; Arranging commercial transactions, for others, via online shops; Arranging of auctions; Arranging of presentations for advertising purposes; Arranging of presentations for commercial purposes; Arranging of presentations for trade purposes; Arranging of product launches; Arranging the buying of goods for others; Auctioneering provided on the internet.

2. DUFROY AG (the Opponent) opposes the application by way of the Fast Track opposition procedure, under section 5(2)(b) of the Trade Marks Act 1994 (the Act). This is on the basis of its three earlier UK trademarks shown below:

Mark 1: UK 3160547



Filed: 20 April 2016

Registered: 22 July 2016

Class 35: Retail services featuring newspapers, magazines, books, including downloadable electronic formats of these publications, confectionery products and snack food, non-alcoholic drinks, including bottled water, juice and carbonated soda drinks, clothing, films, travel necessities and souvenirs, non-prescription (over the counter) medication, personal electronics, DVD's and CD's, greeting cards and stationery supplies; the bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof) namely newspapers, magazines, books, including downloadable electronic formats of these publications, confectionery products and snack food, non-alcoholic drinks, including bottled water, juice and carbonated soda drinks, clothing, films, travel necessities and souvenirs, non-prescription (over the counter) medication, personal electronics, DVD's and CD's, greeting cards and stationery supplies, enabling customers to conveniently view and purchase those goods.

Mark 2: UK 3160542

Hudson News

Filed: 20 April 2016

Registered: 16 June 2017

Class 35: Duty free and travel retail services connected with the sale of: newspapers, magazines, books, including downloadable electronic formats of these publications, confectionery products and snack food, non-alcoholic drinks, including bottled water, juice and carbonated soda drinks, clothing, films, travel necessities and souvenirs, non-prescription (over the counter) medication, personal electronics, DVD's and CD's, greeting cards and stationery supplies; the bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof) namely newspapers, magazines, books, including downloadable electronic formats of these publications, confectionery products and snack food, non-alcoholic drinks, including bottled water, juice and carbonated soda drinks, clothing, films, travel necessities and souvenirs, non-prescription (over the counter) medication, personal electronics, DVD's and CD's,

greeting cards and stationery supplies, enabling customers to conveniently view and purchase those goods.

Mark 3: UK 3160690

HUDSON NEWS

Filed: 21 April 2016

Registered: 16 June 2017

Class 35: Duty free and travel retail services connected with the sale of: newspapers, magazines, books, including downloadable electronic formats of these publications, confectionery products and snack food, non-alcoholic drinks, including bottled water, juice and carbonated soda drinks, clothing, films, travel necessities and souvenirs, non-prescription (over the counter) medication, personal electronics, DVD's and CD's, greeting cards and stationery supplies; the bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof) namely newspapers, magazines, books, including downloadable electronic formats of these publications, confectionery products and snack food, non-alcoholic drinks, including bottled water, juice and carbonated soda drinks, clothing, films, travel necessities and souvenirs, non-prescription (over the counter) medication, personal electronics, DVD's and CD's, greeting cards and stationery supplies, enabling customers to conveniently view and purchase those goods.

3. The Opponent relies on all the services in class 35 for which the marks are registered claiming that there is a likelihood of confusion because the trade marks are similar and are to be registered for services identical or similar to those for which the earlier marks are protected.

4. The Applicant filed a defence and counterstatement denying the claims made that the marks are similar or that there is any identity or similarity between the respective services.

5. The Applicant is unrepresented whereas the Opponent is represented by Haseltine Lake Kempner LLP. The Opponent filed written submissions whereas the Applicant did not; I will treat the contents of its statement of grounds as its written submissions. Neither party applied for leave to file evidence.¹ The matter has therefore proceeded in accordance with the Fast Track procedure. Whilst I have considered both parties' submissions I do not propose to reproduce them in full but will refer to them where necessary within my decision.

6. The Opponent asserts that the Applicant has not specifically referred to the UK trade mark no. 3160690 in its defence and counterstatement and that this implies that this mark is not contested. Whilst the Applicant has not specifically referred to the mark by number, in my view this is not sufficient to conclude that the Opponent concedes a likelihood of confusion in relation to it.

Decision

7. Section 5(2)(b) of the Act states 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”.

8. In these proceedings, the Opponent is relying upon its UK trade mark registrations, shown above, which qualify as earlier marks under section 6 of the Act because each

¹ Rule 20(4) Trade Mark Rules 2008

was applied for at an earlier date than the Applicant's contested mark. As the earlier marks had been registered for less than five years at the date the application was filed they are not subject to the proof of use provisions contained in section 6A of the Act. Consequently, the Opponent is entitled to rely upon all the Class 35 services of its registrations, without having to show that it has used the marks at all.

9. 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.

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 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 the services

10. The Opponent is relying upon all services for which its three marks are registered; however, I consider that the specification in the Opponent's first mark represents its best case since it refers to retail services generally, whereas its second and third mark are specifically directed towards duty free and travel retail services which in my view are considered as services being offered at airports, train stations, bus stations and ferry ports. The goods to which the services relate are much the same in each mark. I will only go on to consider marks two and three therefore if it becomes necessary to my assessment.

11. The parties' competing services are therefore as follows:

Applicant's Services	Opponent's Services (Mark 1)
<p>Class 35: Advertising of the goods of other vendors, enabling customers to conveniently view and compare the goods of those vendors; Advertising of the services of other vendors, enabling customers to conveniently view and compare the services of those vendors; Advertising on the Internet for others; Advertising services relating to clothing; Affiliate marketing; Arranging and conducting of commercial exhibitions and shows; Arranging and conducting of fairs and exhibitions for business purposes; Arranging and conducting of Internet auctions; Arranging business introductions relating to the buying and selling of products; Arranging commercial transactions, for others, via online shops; Arranging of auctions; Arranging of presentations for advertising purposes; Arranging of presentations for commercial purposes; Arranging of presentations for trade purposes; Arranging of product launches; Arranging the buying of goods for others; Auctioneering provided on the internet.</p>	<p>Class 35: Retail services featuring newspapers, magazines, books, including downloadable electronic formats of these publications, confectionery products and snack food, non-alcoholic drinks, including bottled water, juice and carbonated soda drinks, clothing, films, travel necessities and souvenirs, non-prescription (over the counter) medication, personal electronics, DVD's and CD's, greeting cards and stationery supplies; the bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof) namely newspapers, magazines, books, including downloadable electronic formats of these publications, confectionery products and snack food, non-alcoholic drinks, including bottled water, juice and carbonated soda drinks, clothing, films, travel necessities and souvenirs, non-prescription (over the counter) medication, personal electronics, DVD's and CD's, greeting cards and stationery supplies, enabling customers to conveniently view and purchase those goods.</p>

12. In assessing the similarity of the respective services, all relevant factors should be considered. 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.²

13. I am also guided by the relevant factors for assessing similarity identified by Jacob J in *Treat*, [1996] R.P.C. 281 namely:

- (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.

14. In *YouView Ltd v Total Ltd* [2012] EWHC 3158 (Ch) at [12] Floyd J stated:

“...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

² *Canon Kabushiki Kaisha v Metro Goldwyn Mayer Inc* Case C-39/97

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”.

15. 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.”

16. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

17. The Opponent submitted that those contested services it highlighted in green were identical, with the remainder being similar and that “the services set out [in the applicant’s specification] all constitute services which could properly be described as part and parcel of, or ancillary to, retail trade. The services constitute promotion of services with the aim of enticing the consumer to trade with a particular entity.” The Applicant submits that the services are dissimilar; the respective uses are distinct as are the channels of trade and that “there is in fact no overlap whatsoever between the goods and services provided engaged under either trade mark.”

18. The Applicant also submits that “the respective trade channels are also distinct-where Dufry utilises a variety of stores, including ones providing duty free and travel retail services, Hadson operates through two locations on Edgware Road, London.” On that point it should be noted that the earlier mark is a national trade mark and as such is protected against confusion anywhere within the UK. Similarly, the Applicant is seeking to register a UK-wide trade mark registration for its mark. The fact that the parties are currently trading at different locations is not a matter that has any bearing on whether there is a likelihood of confusion between the respective marks.

19. The Opponent’s services specify “retail services” or “the bringing together, for the benefit of others”, followed by the words “namely”, “featuring” and “connected with” and then by a list of goods; the effect of this being to confine the scope of protection of those services, only to the specifically listed goods.³ In contrast while the Applicant states that its business relates specifically to “retail sale of textiles, building completion and as a real estate agency”, the services for which it has applied contain no limitation. In addition, the Applicant refers to the nature of its business as specified in the Companies House Register which demonstrates that there is no overlap between the respective goods and services. Neither the details contained in the Company House register nor the Applicant’s current use of its mark are relevant factors when assessing a likelihood of confusion. Trading conditions are apt to change and my assessment of whether there is a likelihood of confusion must be based on an objective assessment of all the relevant factors in which the applied for mark might be used if it were registered and not just those that it currently uses.⁴

20. The services are clearly not identical as the contested specifications do not include identical wording nor do the services of one fall within a broader or more general category of the other.⁵ However, I must consider whether and to what extent there exists any similarity between the contested services. For the purposes of considering

³ *Praktiker Bau-und Heimwerkermärkte AG v Deutsches Patent-und Markenamt C-418/02*. Ordinarily the word “featuring” does not limit the scope of protection but in the context of retail services I consider this to be the case.

⁴ *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited Para 66 C-533/06*

⁵ *Gérard Meric v Office for Harmonisation in the Internal Market, Case T- 133/05*

the issue of similarity of services it is permissible to group terms collectively where they are sufficiently comparable so that they can be assessed in essentially the same way for essentially the same reasons.⁶ I have set out above, factors from case law that guide in assessing similarity between contested goods or services; in the paragraphs immediately below I refer to two other cases, which although concerning quite different goods/services from the present case, provide some insight on complementarity.

21. In *Bankia SA v OHIM*, case T-323/14, where the General Court (GC) held that financial and banking services are not similar to estate agency services. The court held that the nature, purpose and method of the services are different. Estate agency services are not generally provided in the same places as financial and banking services, and although the purchase of properties often involves the use of financial services, the relationship between the services is not such that consumers would expect the providers of the services to be the same or that they are economically connected.

22. In addition, the case of *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, may be of assistance when considering the comparison between retailing and other services. Whilst I note that this case relates to a comparison between goods and retailing, Mr Geoffrey Hobbs Q.C. as the Appointed Person, reviewed the law concerning retail services against goods. He said (at paragraph 9 of his judgment) that:

“9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a

⁶ Separode Trade Mark BL O-399-10 and BVBA Management, Training en Consultancy V Beneleux-Merkenbureau [2007] ETMR 35 at paragraphs [30] to [38]

trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent's earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are 'similar' to goods are not clear cut."

23. Neither the Opponent nor the Applicant's services involve financial or estate agent services, nor is the comparison between goods and retail services; however, these cases set out what constitutes a sufficiently pronounced relationship between one type of service and another in order to find complementarity. The purpose of examining whether there is a complementary relationship between the services is to assess whether the relevant public believe that the responsibility for the services lies with the same or economically linked undertaking.

24. The Applicant's services include "*Advertising of the goods of other vendors, enabling customers to conveniently view and compare the goods of those vendors; Advertising of the services of other vendors, enabling customers to conveniently view and compare the services of those vendors; Advertising on the Internet for others; Advertising services relating to clothing; Arranging of product launches;*" The Opponent argues that these services are part and parcel or ancillary to its retail services; I do not agree.

25. All the Opponent's services consist in the bringing together and offering for sale a wide variety of different products, thus allowing consumers to conveniently satisfy different shopping needs at one stop; this is what is meant by "retail services". This is not the purpose of the Applicant's services, which are all in connection with advertising, marketing and promotional services. The Applicant's services provide others, particularly businesses, with assistance in promoting their goods or services,

be it launching them or publicising them in the market place or maintaining their position against competitors or being facilitators in the organisation of such services. These types of services are normally provided by specialist companies and are not generally provided in the same place as retail services. The fact that a retailer may advertise itself, its own goods or the goods that it sells, does not mean that it offers an advertising service. Advertising services are fundamentally different in nature and purpose from the retail of goods. The services do not compete and nor do I consider there exists a complementary relationship between them as described by the case law. The relationship is not such that consumers would expect the providers of the services to be the same or that they are economically linked.

26. For the same reasons I see no obvious similarity with the Applicant's "*Affiliate marketing; Arranging and conducting of commercial exhibitions and shows; Arranging and conducting of fairs and exhibitions for business purposes; Arranging of presentations for trade purposes; Arranging business introductions relating to the buying and selling of products; Arranging the buying of goods for others; Arranging of presentations for commercial purposes*". These are all services in connection with the management or commercial function of a business or enterprise, namely the marketing, facilitating or promoting the business, its goods, services or that of a third party and are therefore dissimilar to the Opponent's retail services.

27. On the basis of these findings it follows that similarity is even more unlikely in relation to those services which are specified in the Opponent's second and third marks as those relating to "duty free and travel retail services".

28. This leaves, "*Arranging and conducting of Internet auctions; Arranging of auctions; Auctioneering provided on the internet.*"

29. The Opponent argues that "Internet auctions (eBay etc) are commonly used to purchase goods of all types by the general public at large. Such services are ...

essentially identical to the [Opponent's services] (which would include internet shopping).”

30. To my mind, auction services are broad ranging and include the purchase and sale of goods through traditional auction houses but may also include online market places such as “eBay”. At the highest point of similarity, the contested services would share the same users and purpose in so far as both providers are making goods available to purchase. There may be a degree of competition; consumers choosing to purchase new goods as opposed to bidding for a second hand equivalent. However, the respective methods of use and nature of the services would differ; bidding for goods and selling to the highest bidder (auction services) as opposed to buying and selling at a fixed price (retail services). There is no similarity between the respective channels of trade nor is there an obvious complementary relationship between the contested services. I consider that overall there is a low degree of similarity between the Opponent's first mark and the Applicant's “*Arranging and conducting of Internet auctions; Arranging of auctions; Auctioneering provided on the internet*” services.

31. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, where Lady Justice Arden stated that (my emphasis):

“49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. **If there is no similarity at all, there is no likelihood of confusion to be considered.** If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.”

32. As some similarity between the services is necessary in order to establish a likelihood of confusion between the marks, taking into account my findings above and

the caselaw, this would mean that the opposition fails under section 5(2)(b) in respect of the following services:

CLASS 35: Advertising of the goods of other vendors, enabling customers to conveniently view and compare the goods of those vendors; Advertising of the services of other vendors, enabling customers to conveniently view and compare the services of those vendors; Advertising on the Internet for others; Advertising services relating to clothing; Affiliate marketing; Arranging and conducting of commercial exhibitions and shows; Arranging and conducting of fairs and exhibitions for business purposes; Arranging business introductions relating to the buying and selling of products; Arranging of presentations for advertising purposes; Arranging of presentations for commercial purposes; Arranging of presentations for trade purposes; Arranging of product launches; Arranging the buying of goods for others;

Average Consumer

33. The average consumer is deemed to be reasonable well informed and reasonably observant and circumspect. When considering the opposing trade marks, I must consider the level of attention taken and how they are selected.

34. 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.”

35. The Opponent submits that the services are “either targeted solely at the general public (arranging and conducting of internet auctions for example) or at both the general and professional public.” The Applicant has not made any submissions regarding the consumer of the respective services.

36. In relation to those services where I found some similarity i.e. “*Arranging and conducting of Internet auctions; Arranging of auctions; Auctioneering provided on the internet*” and the Opponent’s retail services, I consider that the average consumer to be a member of the general public. The selection process of the Opponent’s retail services is primarily a visual process where the consumer will select the services following the display of its name at the actual retail premises, via the internet or on advertising material. Aural considerations cannot be discounted either, allowing for word of mouth recommendations. This purchasing process is therefore likely to be both visual and aural. I do not consider that the average consumer will pay more than an average degree of attention in the selection process taking into account such things as quality, price and the variety of goods being offered for sale by the Opponent. This will be lower if the business relies on passing trade or where the goods are such things as confectionery or newspapers. Of course, for goods of a higher value perhaps antiques, art or jewellery being sold at auction, a higher level of care will be taken. Without any specific evidence to the contrary, however, I consider that overall the selection process of the services at issue will be no more than average.

Comparison of the marks

37. 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.”

38. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to consider 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.

39. The respective trade marks are shown below:⁷

Applicant's mark	Opponent's First Mark	Opponent's Third mark
HADSONS		HUDSON NEWS

40. The Applicant's mark consists of the single word only mark HADSONS presented in capitals. There are no other elements to contribute to the overall impression, and therefore the distinctive and dominant component of the mark is contained in the word itself.

⁷ Marks one and three are closest in terms of similarity to the application as mark two is a stylised version of mark three.

42. The Opponent's first mark consists of a device which includes a stylised letter "H" presented inside a black square. Alongside this device is the slightly stylised word Hudson where the letters "d","s" and "n" are conjoined. The overall impression of the mark is dominated by the word Hudson, the device and stylisation playing a lesser role. The Opponent's third mark consists of the two words HUDSON NEWS. The word HUDSON is longer in length (six letters as opposed to four) and will be read first; moreover, insofar as the services relate to those of a newsagent shop, the distinctiveness of the word "news" may be considered reduced. However, both elements contribute to the overall impression of the mark.

Visual Comparison

43. Visually, the Opponent's first mark and the Applicant's mark coincide in five of the letters, namely H, D, S, O and N, which gives rise to some visual similarity. However, there are also the visual differences, notably the second letter A as opposed to U and the device present only in the Opponent's mark. Some visual difference also arises from the stylisation of the word in the Opponent's first mark and from the absence of the letter S at the end of the word. In my view the marks are visually similar to a low degree. In the Opponent's third mark, there is no stylisation or device, but the presence of the word NEWS creates a visual difference and I consider those marks visually similar to a degree more than low but less than medium.

Aural Comparison

44. Aurally, the Applicant's mark will be pronounced "HAD-SUNS" whereas the Opponent's first mark will be pronounced "HUH-D-SUN"; the device will not be articulated. The word NEWS in the Opponent's third mark will be given its normal pronunciation meaning that the mark will be pronounced as "HUH-D-SUN - NEWS". In relation to the Opponent's first mark the parties' marks are aurally similar to a medium degree, whereas, in relation to its third mark the similarity is lowered by the

presence of the second element NEWS. I consider those marks aurally similar to a degree between low and medium.

Conceptual Comparison

45. Notwithstanding the absence of a possessive apostrophe, I consider that the applied for mark will be understood by the average consumer as the possessive form of HADSON (indicating that the services are sold under the brand HADSON). Both HADSONS and HUDSON will be perceived as names/surnames, although within the UK not particularly common ones. The additional word NEWS will either be considered as an abbreviation for newsagent or by its more common definition of the imparting of information.

46. I am mindful of the recent case of Luciano Sandrone v EUIPO Case T-268/18, where the GC upheld the current view that names which do not convey a 'general and abstract idea' lack any "concept" thus making a conceptual comparison impossible. It stated:

“85 ... a first name or a surname which does not convey a 'general and abstract idea' and which is devoid of semantic content, is lacking any 'concept', so that a conceptual comparison between two signs consisting solely of such first names or surnames is not possible.

86. Conversely, a conceptual comparison remains possible where the first name or surname in question has become the symbol of a concept, due, for example, to the celebrity of the person carrying that first name or surname, or where that first name or that surname has a clear and immediately recognisable semantic content.

87. The Court has thus previously held that the relevant public would perceive marks containing surnames or first names of persons as having no specific conceptual meaning, unless the first name or surname is particularly well known as the name of a famous person (see, to that effect, judgments of 18 May 2011, IIC v OHIM - McKenzie (McKENZIE), T-502/07, not published, EU:T:2011:223, paragraph 40; of 8 May 2014, Pedro Group v OHIM - Cortefiel (PEDRO), T-38/13, not published, EU:T:2014:241, paragraphs 71 to 73; and of 11 July 2018, ANTONIO RUBINI, T-707/16, not published, EU:T:2018:424, paragraph 65).”

47. Although not particularly common, neither the respective parties’ names/surnames has a clear semantic content and will merely be considered as the name of (most probably) the founder of the business, and overall I consider that the position in terms of assessing conceptual similarity of the marks is neutral.

Distinctive character of the earlier marks

48. 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).”

49. 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. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark the greater the likelihood of confusion.

50. In *Becker v Harman International Industries*, Case C-51/09 P, the distinctive character of a surname was considered and the CJEU stated as follows:

“Although it is possible that, in part of the European Union, surnames have, as a general rule, a more distinctive character than forenames, it is appropriate to take account of factors specific to the case and, in particular, to the fact that the surname concerned is unusual or, on the contrary, very common, which is likely to have an effect on that distinctive character.”

51. The first earlier mark consists of the word Hudson and a device whereas the third earlier mark consists of the words HUDSON NEWS. As outlined above, the word Hudson will be seen as a name/surname indicative of a family business. Names are commonly used as trade marks and are therefore not considered as greatly distinctive. The more common the name/surname, the less distinctive the character of the mark. The name/surname Hudson is not particularly common within the UK, but neither is it particularly unusual that it enhances the marks’ level of distinctive character.

52. A name/surname followed by a descriptive element to denote the type of business is a familiar construction in trade marks. Whilst the word NEWS is not directly descriptive of the Opponent's services as a whole, in relation to newspapers or newsagents it has a degree of descriptive quality and alludes to the nature of the undertaking providing the services. Overall, I place the level of distinctive character of both marks at no higher than average.

Likelihood of confusion

53. A likelihood of confusion may arise in a form that may be direct or indirect. Before I set out my own global assessment of likelihood of confusion, I note the following relevant points from case law. Indirect confusion (and its distinction from direct confusion), was considered by Mr Iain Purvis QC, sitting as the Appointed Person,⁸ in *L.A. Sugar Limited v By Back Beat Inc*⁹, where he noted that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognised 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, I conclude that it is another brand of the owner of the earlier mark.”

⁸ An Appointed Person is a senior lawyer, expert in intellectual property law, who hears appeals against decisions of the trade mark tribunal.

⁹ Case BL-O/375/10

54. In determining whether there is a likelihood of confusion there are a number of factors to bear 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 or 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 marks, the average consumer for the services and the nature of the purchasing process. In doing so, I must consider 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.

55. I have identified the average consumer to be a member of the general public, who would primarily select the services via visual means but with aural considerations not being discounted. I have found at least an average level of attention being paid in the purchasing process.

56. In making my assessment of a likelihood of confusion, I bear in mind the purpose of a trade mark namely to distinguish the goods and services of one undertaking from another. In so doing, I consider the relationship between the Applicant's auctioneering services and the Opponent's retail services, which I concluded were only similar to a low degree. In my experience a single undertaking is not usually responsible for the provision of both services and consequently consumers are unlikely to be predisposed to the idea of making a connection between the undertakings. Whilst the interdependency principle allows for a low degree of similarity between goods and services, to be offset by a high degree of similarity between the marks, in this case I have only found the marks to share a low/more than low but less than medium degree of visual similarity; aurally the marks are similar to between a low and medium/medium degree and conceptually the position is neutral. Whilst I accept that the names/surnames HUDSON and HADSONS will not be considered as particularly common within the UK, neither are they strongly distinctive. In this regard I also note that neither party has filed any evidence that would assist me one way or the other. Since there is only a low degree of similarity between the services and the visual and aural similarities are between low to medium with no possible conceptual comparison,

I do not consider that the respective marks will be mistaken one for the other. Consumers are accustomed to seeing names/ surnames as trade marks, particularly for retail services and are therefore able to distinguish between them. I do not consider that the similarities between the marks, even for those services which I have determined are similar to a low degree will lead to a likelihood of direct confusion.

57. I also find it improbable that consumers would, when encountering the applied for mark, acknowledge the differences, but then consider that they are brand extensions or services provided by the same undertaking. It would be highly unusual for a sub brand to adopt a name which is different to the original, other than some overlap in their letters. In my view it would be implausible for consumers to believe that there is an economic link between them, merely because the names within the marks are similar. There is nothing to suggest that the two are connected.

58. Finally, for clarification, even if I am incorrect in my findings regarding the Applicant's services where I found no similarity, I would consider that any similarity could only be to a very low degree. Were this to be the case, I would apply the same reasoning as above and, again, would find no likelihood of confusion in respect of the services for which registration is sought. In relation to the Opponent's third mark confusion is even more unlikely as it is further away in terms of similarity due to its stylisation.

59. On this basis the opposition fails and subject to any successful appeal, the application can proceed to registration.

Costs

60. As the Applicant has been successful ordinarily it would be entitled to an award of costs. However, as it has not instructed solicitors to defend the matter it was invited

by the tribunal to indicate whether it intended to make a request for an award of costs, including accurate estimates of the number of hours spent on a range of given activities relating to defending the proceedings. It was made clear by letter dated the 4 June 2019 that if the pro-forma was not completed, no costs would be awarded. No response was received. On this basis no costs are awarded to the Applicant.

Dated this 02nd day of October 2019

Leisa Davies

For the Registrar