

BL O-656-19

TRADE MARKS ACT 1994

**IN THE MATTER OF INTERNATIONAL REGISTRATION NO. 1424120
DESIGNATING THE UNITED KINGDOM BY CJ OLIVENETWORKS CO., LTD
TO REGISTER:**

The logo consists of the word 'WAKE' in a bold, black, sans-serif font. The letters are highly stylized, with the 'W' and 'A' being particularly prominent and overlapping. The 'W' is formed by two vertical lines that cross at the top and bottom, creating a central negative space. The 'A' is a simple, blocky letter. The 'K' and 'E' are also blocky and simple. The overall appearance is that of a modern, geometric typeface.

AS A TRADE MARK IN CLASSES 3 & 21

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 415149 BY
MANA PRODUCTS, INC.**

BACKGROUND & PLEADINGS

1. On 8 June 2018, CJ OliveNetworks Co., Ltd (“the applicant”), designated the UK seeking protection of the trade mark shown on the cover page of this decision for a range of goods in classes 3 and 21. The designation was published for opposition purposes on 19 October 2018.

2. On 18 January 2019, the application was opposed, in part, by Mana Products, Inc. (“the opponent”); the opposed goods are shown in paragraph 9 below. The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), in relation to which the opponent relies upon the goods shown in paragraph 9 below in the following International Registration designating the UK (“IRUK”): no. 1383244 for the trade mark:



MAKE

which designated the UK on 13 October 2017 (claiming an international convention priority date of 29 June 2017 from an earlier filing in the USA) and which was granted protection on 22 February 2019.

3. The applicant filed a counterstatement in which the basis of the opposition is denied.

4. In these proceedings, the opponent is represented by Ashfords LLP and the applicant by Potter Clarkson LLP. Although only the opponent filed evidence, the applicant filed written submissions during the evidence rounds. Neither party requested a hearing, nor did they file written submissions in lieu of attendance.

DECISION

5. The opposition is based upon section 5(2)(b) of the Act which reads 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.”

6. An earlier trade mark is defined in section 6 of the Act, which states:

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

(a) a registered trade mark, international trade mark (UK), 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.”

7. The trade mark relied upon by the opponent qualifies as an earlier trade mark under the above provisions. Given the interplay between the dates on which the opponent’s trade mark was granted protection and the date of designation, the earlier trade mark relied upon is not subject to the proof of use provisions. The opponent can, as a consequence, rely upon it in relation to all the goods claimed without having to demonstrate that it has been used in relation to such goods.

Case law

8. The following principles are gleaned from the decisions of the courts of the European Union 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 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

9. The competing goods are as follows:

The opponent's goods	The applicant's goods being opposed
Class 3 - Cosmetics and cosmetic preparations; make-up removing preparations; cosmetic creams for skin care; cosmetics and make-up; eye make-up remover; gels for cosmetic	Class 3 - Polishing preparations; nail enamel; lipsticks; make-up; hair colorants; shampoos; toiletry preparations; skin lotions; eye shadow; cosmetics for animals; essential oils;

<p>purposes; lipstick; make-up primer; non-medicated skin care preparations; non-medicated toiletry preparations; skin moisturizer; skin softeners; skin toners.</p>	<p>adhesive for false eyelashes, hair and nails; soaps for personal use; lip skin protecting materials (cosmetics); dentifrices; oils for perfumes and scents; perfumes; cotton wool and cotton tip sticks for cosmetic purposes; cosmetics.</p> <p>Class 21 - Combs and sponges; brushes; appliances for applying make-up, electric; fitted vanity cases; cosmetic utensils; bottles for cosmetics.</p>
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10. 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:

“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”.

11. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (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.

12. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) 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 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."

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

"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."

14. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court (“GC”) stated that “complementary” means:

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

15. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the GC stated:

“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 für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

16. In its submissions, the applicant states:

“Whilst there is an overlap between the Class 3 goods, it is submitted that since the marks are dissimilar there cannot be a likelihood of confusion...With regard to the Class 21 goods, it is submitted that these goods are dissimilar to the Opponent's Class 3 goods. The nature and intended purpose of these goods are different to the Opponent's Class 3 goods and it is therefore submitted that these goods are dissimilar to the Opponent's goods.”

Class 3

17. It appears that the applicant accepts that the competing goods in class 3 are to be regarded as similar, even if to only a low degree. On closer inspection, one can

see that the applicant's specification includes a range of terms which find exact counterparts in the opponent's specification, "lipsticks", "make-up", "toiletry preparations" and "cosmetics" for example; such goods are literally identical. As the terms "cosmetics for animals" and "lip skin protecting materials (cosmetics)" are encompassed by the term "cosmetics" in the opponent's specification, they are to be regarded as identical on the inclusion principle outlined in *Meric*.

18. In addition, the opponent's specification also contains a range of broad terms such as "cosmetics and cosmetic preparations", "non-medicated skin care preparations" and "non medicated toiletry preparations" which collectively are, in my view, broad enough to include goods such as "polishing preparations", "nail enamel", "shampoos", "skin lotions", "eyes shadow", "essential oils", "soaps for personal use", "dentifrices", "oils for perfumes and scents" and "perfumes" which are, as a consequence, also to be treated as identical on *Meric*.

19. That leaves the following goods to be considered:

Hair colorants; adhesive for false eyelashes, hair and nails; cotton wool and cotton tip sticks for cosmetic purposes.

20. While the physical nature of some of the remaining goods may differ from those of the opponent, the users may be the same and the intended purpose is, broadly speaking, the same i.e. they may all form part of an average consumer's grooming regime. They are likely to pass through the same trade channels and will be made available for sale in, if not exactly the same areas of retail outlets, in fairly close proximity to one another. Considered overall, I think the remaining goods in the applicant's specification are similar to the opponent's goods to an above medium degree.

Class 21

21. In my view, the applicant's goods fall into two categories. The first is:

Sponges; brushes; appliances for applying make-up, electric; cosmetic utensils; bottles for cosmetics.

22. Sponges and brushes for cosmetic purposes are, of course, proper to this class. Although the physical nature of the applicant's above named goods will differ from those of the opponent, the users may be the same and the applicant's goods may be used to apply or store cosmetics. As to trade channels, although I have no evidence on the point, it would, in my view, be unsurprising to find that the above goods passed through the same trade channels and were made available for sale in at least relatively close proximity to the goods in relation to which they may be used. The above named goods are complementary to the opponent's cosmetics and make-up and, in my view, similar to a moderate i.e. between low and medium degree.

23. That leaves "combs" and "fitted vanity cases" to be considered, in relation to which many of the same considerations mentioned above in relation to nature and users also applies. A comb may, of course, be used as part of one's daily grooming regime and a fitted vanity case will be used to store, inter alia, one's cosmetics for ease of location or when travelling. Once again it would be unsurprising to find such goods passing through the same trade channels as inter alia, make-up and cosmetics and being made available in, at the very least, relatively close proximity to one another in retail outlets. Considered overall, I regard the above named goods to be complementary to the opponent's cosmetics and make-up and, in my view, similar to a low degree.

The average consumer and the nature of the purchasing act

24. As the case law above indicates, it is necessary for me to determine who the average consumer is for the goods at issue. I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. 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 word “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

25. The average consumer of the “general consumer items” (the opponent’s characterisation) and goods “for mass consumption” (the applicant’s characterisation) is a member of the general public. In my experience, such goods will, in the main, be obtained by self-selection from the shelves of a bricks and mortar outlet or the equivalent pages of a website. As a consequence, visual considerations are likely to dominate the selection process, although not to the extent that aural considerations in the form, for example, of word-of-mouth recommendations or oral request to sales assistants can be ignored. As to the degree of care with which such goods will be selected, the parties suggest an average degree; I agree.



Comparison of trade marks

26. 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 marks must be assessed by reference to the overall impressions created by them, 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.”

27. It would be wrong, therefore, artificially to dissect the trade 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 they create. The trade marks to be compared are as follows:

Opponent's trade mark	Applicant's trade mark
	

28. In reaching a conclusion, I have taken into account, but do not intend to record here, all of the parties' competing submissions on this point.

29. The opponent's trade mark consists of the well-known English language word "MAKE" presented in a slightly stylised but unremarkable bold font. It is in that word the overall impression conveyed by the trade mark lies.

30. In its submissions, the applicant states that its trade mark:

“...is clearly a logo as opposed to a stylised word mark, and when viewed as a whole all of the elements are conjoined within the mark. The creation of the logo stems from the word WAKEMAKE...”

31. Despite the undeniable degree of stylisation present in the applicant's trade mark, it is still, as the applicant appears to accept, intended to be understood as consisting of the words "WAKE" and "MAKE". Although the overall impression conveyed resides in the trade mark as a whole including its stylisation, as the word "WAKE" is readily discernible and appears at the top of the trade mark, it is likely that it is that word which will be noticed first.

Visual similarity

32. The applicant's trade mark consists of, inter alia, two words which, despite the degree of stylisation, is intended to be understood as consisting of four letters each i.e. W-A-K-E and M-A-K-E. The four letters in the second word will be understood as being identical to the four letters in the opponent's trade mark. In its Notice of opposition, the opponent submits that the impression conveyed is that the letters in both trade marks have been "stretched". While I think there is some merit in that submission, given the degree of stylisation present in the applicant's trade mark, it results in what I regard as only a moderate degree of visual similarity overall.

Aural similarity

33. The words in the competing trade marks and their meanings will be well-known to the average consumer. Despite the degree of stylisation and the applicant's submissions to the contrary, its trade mark will, in my view, be referred to as a two syllable combination i.e. WAKE-MAKE. Although the word WAKE will be articulated first, as the second word in the applicant's trade mark will be pronounced in exactly the same way as the opponent's trade mark, it results in what I regard as a medium degree of aural similarity between them.

Conceptual similarity

34. Although the meanings of the words WAKE and MAKE will be well known to the average consumer, when considered as a totality, the applicant's trade mark is unlikely to convey any concrete conceptual message. However, the fact that the average consumer will recognise that the applicant's trade mark contains the word MAKE will result in a degree of conceptual similarity with the opponent's trade mark which consists exclusively of that word.

Distinctive character of the earlier trade mark

35. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by

reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

36. In its Notice of opposition, the opponent stated that its trade mark:

“f...has at least an average degree of inherent distinctive character. The word “MAKE” does not describe the goods at issue nor their characteristics.”

37. In its Counterstatement, the applicant responded to the above stating that it:

“would question whether the Opponent's mark has sufficient distinctive character for registration, bearing in mind that it is the term MAKE in relation to various 'make-up and make-up removing products', and at best, it would only have a very low level of distinctiveness...”

Inherent distinctiveness

38. Although the word MAKE appears in the word make-up, when used alone, the opponent's submission is to be preferred. Absent use, its trade mark is possessed of an average degree of inherent distinctive character.

Enhanced distinctiveness – the opponent's evidence

39. This consists of a witness statement dated 28 May 2019 from William Robert Smolen, accompanied by seven exhibits. Mr Smolen is the opponent's Senior Director of Retail Sales and Business Director for the “MAKE beauty brand.” He has been employed by the opponent since May 2012. The main points emerging from his evidence are, in my view, as follows:

- the MAKE beauty brand was co-founded by Mr Smolen and Ariana Mouyiaris;
- Mr Smolen manages the MAKE brand's day-to-day operations, including sales, marketing, partnerships, communications, SEO, public relations and events, product development and retail and product launches;
- since 2013 when the range was launched, all of the goods offered under the MAKE brand have borne the MAKE stylised trade mark, an example of which, taken from exhibit WRS1, is shown below:



- the opponent began selling cosmetics under the MAKE trade mark in the United States in January 2013, via its www.makebeauty.com website;
- in October 2013 the product range was launched in Barney's stores in New York, Los Angeles, Las Vegas, Chicago and Brooklyn. Goods were also available on www.barneys.com;
- the MAKE brand has been featured in articles in various well-known publications, including *Vogue*, *Vanity Fair*, *Us Magazine* and *Brides Magazine* (exhibit WRS1 refers);
- the opponent began selling products in the UK on 1 August 2016. The first sales were made through the third party website www.birchbox.co.uk. Invoices from May 2016 showing MAKE branded products purchased by birchbox are provided as exhibit WRS2;

- in March 2017, the opponent began selling MAKE branded products in the UK through the Net-a-Porter website at www.net-a-porter.com. This included a range of approximately 30 products, including colour cosmetics, lipsticks, blush, makeup remover, bronzers, cosmetic brushes and various skin and lip care products. Exhibits WRS3 and WRS4, which consists of: (i) a screen capture of an Instagram promotion of the launch of the MAKE brand on Net-a-Porter, (ii) a web archive screen capture (obtained via the Wayback Machine) dated 6 September 2017, showing the (then) Net-a-Porter United Kingdom 'MAKE' online storefront, and (iii) a copy of a sample invoice from January 2017 showing MAKE branded products purchased by Net-a-Porter for sale in the UK, refer;
- online sales in the UK through Feel Unique (www.feelunique.com), started in March 2018. Exhibit WRS5 consists of a copy invoice issued in February 2018 to Feel Unique, showing MAKE branded products purchased by them for sale in the UK;
- since June 2018, MAKE branded products have been sold in Selfridge's stores in London and Manchester and on the Selfridge's website;
- since August 2016, MAKE branded beauty products have been promoted in the UK through a variety of channels (including birchbox, Net-a-Porter and Feel Unique online stores), and in digital advertising, print advertising, press and other media coverage, and advertising on websites. The goods have also been advertised and sold via in-store promotional displays and signage at Selfridge's. Promotions in the UK have also included the distribution of sample products and the offering of shipping and product discounts;
- the opponent has expended “significant” sums and effort on its promotional efforts which has included \$5,000 to train the Net-a-Porter UK team;
- the launch of the MAKE brand in the UK received press attention. This included mentions in various beauty and fashion publications. Exhibit WRS6 contains examples of the type of attention to which Mr Smolen refers;

- consumers have come to recognise the brand. Exhibit WRS7 consists of a range of customer reviews from feelunique.com all of which Mr Smolen states originate from before 8 June 2018. It appears that some of the reviews are from consumers based in the USA;
- sales have been steadily growing since the MAKE branded products were launched in the UK. In 2016, sales via the birchbox website were \$7,900 with 10,280 units sold and/or sampled. In 2017, UK sales via the Net-a-Porter website were \$55,154 representing 6,465 units, and sales from the start of 2018 to 8 June 2018 in the UK totalled approximately \$12,000 representing 1,050 units. Prior to 8 June 2018, the opponent sold \$28,296 worth of product, representing 3,006 units, to Feel Unique for sale on its UK website.

40. In its submissions, the applicant states:

“The Opponent has filed certain evidence regarding sales of their products in the UK. However, it is submitted that this does not provide evidence that its mark has acquired distinctiveness with the average consumer.”

Summary of the opponent’s evidence

41. Mr Smolen’s evidence explains that the opponent’s MAKE trade mark was first used by it in the USA in January 2013 in relation to a range of cosmetics. Having initially sold its products via its own website, in October 2013, its products were sold in a range of Barney’s stores in the USA and on Barney’s website. Following its appearance in a range of publications including *Vogue* and *Vanity Fair*, the opponent began selling its MAKE branded cosmetics products in the UK on 1 August 2016. Sales were made initially via the birchbox website with sales via the Net-a-Porter website commencing in March 2017. In March 2018, sales began via the Feel Unique website. Sales of MAKE branded cosmetics in Selfridges stores in London and Manchester and via the website followed in June 2018. Although the opponent indicates that it has spent “significant” sums on its various promotional efforts, the only amount it actually refers to is the \$5k spent training the team at Net-a-Porter. By

my reckoning, since its launch in August 2016, the opponent has sold \$103,350 of its MAKE branded cosmetics in the UK amounting to some 20,800 units. At today's exchange rate, that equates to approximately £79,640.

42. In reaching a conclusion on enhanced distinctiveness it is, of course, only use in the UK that matters. There is no doubt the opponent's MAKE branded cosmetics have generated interest in a range of publications and attracted comments from average consumers. However, although I have no evidence as to the size of the market for cosmetics in the UK, it is likely, I would suggest, to run to hundreds of millions if not billions of pounds each year. Considered in that context, the opponent's turnover of £80k is, in my view, unlikely to have enhanced its trade mark's inherent distinctiveness to any material extent.

Likelihood of confusion

43. In determining whether there is a likelihood of confusion, 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 vice versa. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and 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 he has retained in his mind.

44. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods down to the responsible undertakings being the same or related. Earlier in this decision I concluded that:

- the applicant's opposed goods in class 3 are either identical or similar to an above medium degree to those of the opponent, whereas the applicant's opposed goods in class 21 are similar to either a moderate or low degree;

- the average consumer is a member of the general public who, whilst not ignoring aural considerations, will select the goods at issue using predominantly visual paying an average degree of attention during that process;
- the competing trade marks are visually similar to a moderate degree, aurally similar to a medium degree and conceptually similar to the extent that they either consist of or contain the word MAKE;
- the opponent's earlier trade mark is possessed of an average degree of inherent distinctive character, which has not, at least to any material extent, been enhanced by the use that has been made of it in the UK since August 2016.

45. The applicant's stylised trade mark contains the word "WAKE" at the top of the trade mark. That, together with the stylisation present is, in my view, most unlikely to result in a consumer paying an average degree of attention during the selection process mistaking one trade mark for the other, even when considered in relation to identical goods. There is, in my view, no likelihood of direct confusion. That leaves indirect confusion to be considered. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

"16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: "The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark."

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

47. Even if I consider the matter from the position most favourable to the opponent i.e. in relation to identical goods, inter alia, the inclusion of the word “WAKE” in the applicant’s trade mark together with the significant visual and, to a lesser extent, aural differences between the competing trade marks is, I think, sufficient to avoid a likelihood of indirect confusion. The opponent’s position is, of course, weaker in relation to goods which are only similar to the varying degrees I have described earlier. Finally, even if it was thought that the applicant’s trade mark may call the opponent’s trade mark to mind (which, in my view, is unlikely), as Mr Mellor Q.C. points out in *Duebros*, that is mere association not indirect confusion. As a result of the above conclusions, the opposition fails.

Overall conclusion

48. The opposition has failed and, subject to any successful appeal, the designation will become protected.

Costs

49. As the applicant has been successful, it is entitled to a contribution towards its costs. Awards of costs in proceedings are governed by Annex A of Tribunal Practice Notice (“TPN”) 2 of 2016. Applying the above guidance, I award costs to the applicant on the following basis:

Reviewing the Notice of opposition and filing a counterstatement:	£200
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Considering the opponent’s evidence and the filing of written submissions:	£600
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Total:

£800

50. I order Mana Products, Inc. to pay to CJ OliveNetworks Co., Ltd the sum of **£800**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 29th day of October 2019

C J BOWEN

For the Registrar