

O-411-20

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3297463

BY QUEENIE CHAN

TO REGISTER:

QUIN

AS A TRADE MARK IN CLASSES 16, 18, 25 & 35

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NO. 413045 BY

KAST SERVICES LIMITED

BACKGROUND & PLEADINGS

1. On 16 March 2018, Queenie Chan (“the applicant”) applied to register the trade mark shown on the cover page of this decision for the goods and services shown below. The application was published for opposition purposes on 13 April 2018.

Class 16 - Paper products, namely stationery, prints, books, magazines, cards, diaries, newsletters, catalogues, booklets, leaflets, flyers, promotional cards, newspapers, brochures, leaflets, posters, photographs; stationery.

Class 18 - Leather products, namely leather handbags, leather wallets, leather coin bags, leather shoes and leather accessories therefor.

Class 25 - Clothing and clothing accessories.

Class 35 - Business management in the field of fashion business; professional consultation in the field of fashion business.

2. On 10 July 2018, the application was opposed in full by Kast Services Limited (“the opponent”). The opposition is based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). In relation to its objections based upon sections 5(2)(b) and 5(3), the opponent relies upon all the goods and services in the United Kingdom and European Union Trade Mark (“EUTM”) registrations shown in the Annex to this decision. The opponent states:

“The Applicant's Mark and the Opponent's Mark are visually and phonetically highly similar. The goods and services of the Opponent's Mark are identical to the goods and services of the Applicant's Mark. If any of the goods and services of the Applicant's Mark are considered not to be identical to the goods and services of the Opponent's Mark they must be considered to be substantially

identical or highly similar. There can be no argument that this will lead to a likelihood of confusion among the relevant consumers.”

3. Insofar as its objection based upon section 5(3) of the Act is concerned, the opponent states that its trade marks enjoy a reputation for all the goods and services shown in the Annex to this decision, adding that it considers all the goods and services for which registration is sought would take unfair advantage of, or be detrimental to, the distinctive character or reputation of its trade marks. Having answered “Yes” to question 3 in the Notice of opposition which states:

“Is it claimed that the similarity between the [trade marks being relied upon] and the later trade mark is such that the relevant public will believe that they are used by the same undertaking or think that there is an economic connection between the users of the trade marks?”,

the opponent further states:

“The Trade Mark applied for is highly similar to the opponent's earlier Trade Mark and the opponent has significant reputation in the industry under its Mark such that there can be no doubt the relevant public will assume that highly similar or identical goods emanate from the same undertaking.”

4. In relation to questions 4, 5 and 6 in the Notice of opposition which begin “Is there any other basis for your claim other than your answer to Q3”, the opponent states:

Unfair advantage

“The Applicant is seeking an unfair advantage by seeking to benefit from the reputation and attractiveness of the earlier significant right by misappropriating goodwill. The opponent has acquired a substantial reputation as a result

of its longstanding use of its mark. The Opponent's mark is therefore undoubtedly a well known mark. Use of the contested mark would gain an unfair advantage as it would misappropriate and ride on the coat tails of the Opponent's attractive fame and reputation which has been built up over a significant period of time. The contested mark would therefore need little advertising or promotion as consumers will wrongly believe that the contested goods are reputable and provided by the Opponent, or that the Applicant is endorsed by the opponent, or is an economically linked undertaking. Also, the Applicant would benefit from increased sales and custom by riding on the coat tails of the Opponent's reputation particularly as the Opponent's goods have a sterling reputation. Use of the contested mark would therefore unfairly exploit the repute of the Opponent's mark.”

Detriment to reputation

“In view of the repute of the Opponent's Mark, detriment is foreseeable in the ordinary course of events. The Opponent is likely to suffer or has suffered a decrease in the supply of goods and/or a loss of consumers. Detriment is foreseeable to the Opponent's reputation as it would have no control over the quality, prestige, reliability or image of the goods supplied under the contested mark which, if inferior or below the high standards of the Opponent, has the potential to damage the Opponent's reputation, including a loss of reputation, future custom and detriment to its reputation as a result of poor feedback.”

Detriment to distinctive character

“The Applicant can only benefit from evoking associations with the Opponent's earlier Mark and with the Opponent and its earlier reputation, whereas the Opponent's reputation can only be tarnished by a negative association with the

Applicant. Therefore, damage is foreseeable to the Opponent's undertaking, whilst the Applicant can benefit from evoking associations with the Opponent's reputation, the Opponent's reputation may be eroded, diluted and tarnished by negative association and by feedback mistakenly identifying the Opponent. Detriment is also foreseeable to the distinctive character of the Opponent's mark by way of erosion, dilution, tarnishing and by negative association as a result of the use of the contested mark. This means that the relevant public may not purchase the Opponent's goods in the mistaken belief that these emanate from the Applicant.”

5. Finally, in relation to its opposition based upon section 5(4)(a) of the Act, the opponent relies upon the same goods and services for which its trade marks are registered. It states that it's QUIZ trade mark has:

“...been used in the United Kingdom and elsewhere since at least 1993 and the Opponent has acquired goodwill and reputation throughout the United Kingdom through the use that has been made of its Marks. Rights to the Marks were acquired prior to the date of application for the Applicant's Mark...”

6. The applicant filed a counterstatement in which it makes a number of admissions. It does, however, deny the grounds upon which the opposition is based.

7. In these proceedings, the opponent is represented by Murgitroyd & Company and the applicant by Blaser Mills LLP. Both parties filed evidence; the opponent's evidence-in-chief was accompanied by written submissions. At the conclusion of the evidence rounds the parties were asked if they wished to be heard, failing which, a decision from the papers would be issued. Periods expiring on 24 March and 7 April 2020 respectively were allowed for these purposes. Both of these periods fell within the “interrupted days” period implemented by the Intellectual Property Office as a result of the disruption caused by the Covid outbreak. However, as the parties had agreed that a hearing was

not necessary, the period in which they had to file written submissions was extended until 30 July 2020. On 30 July 2020, both parties filed written submissions. I shall keep all of these submissions in mind, referring to them to the extent I consider it appropriate to do so.

EVIDENCE

8. It is at this point in my decision I would normally provide a summary of the evidence filed by both parties. However, for reasons which will shortly become obvious, I do not intend to do so. For the avoidance of doubt, I have read all of the evidence provided, details of which is shown below.

The opponent's evidence-in-chief

9. This consists of a witness statement, dated 21 October 2019, from Sheraz Ramzan, the opponent's Chief Commercial Officer. It is accompanied by five exhibits and written submissions, of the same date, from its legal representatives.

The applicant's evidence-in-chief

10. This consists of a witness statement, dated 26 October 2019, from Aaron Wood, the applicant's legal representative. It is accompanied by four exhibits.

The opponent's evidence-in-reply

11. This consists of a further witness statement, dated 24 February 2020, from Mr Ramzan.

DECISION

12. The opposition is based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Act which read 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.

(3) A trade mark which is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b)...

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

13. Under sections 5(2)(b) and 5(3) of the Act, the opponent is relying upon the three trade marks shown in the Annex to this decision, all of which qualify as earlier trade marks under the provisions of section 6 of the Act. Given the interplay between the date on which the opponent’s trade marks were entered in the register and the publication date of the trade mark being opposed, the earlier trade marks are, in principle, subject to the proof of use provisions contained in section 6A of the Act. In its Notice of opposition, the opponent states that it has used its trade marks in relation to all the goods and services upon which it is relying. However, as the applicant did not ask the opponent to make good on those claims, the opponent can rely upon all of the goods and services shown in the Annex to this decision without having to establish genuine use.

The objection based upon section 5(2)(b) of the Act

Case law

14. 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.

My approach to the comparison

15. In these proceedings, the opponent is relying upon the three trade marks shown in the Annex to this decision, which consist of either the word “QUIZ”, “QUIZZ” or:



QUIZ

16. As trade mark no. 2 i.e. UK no. 2585713 has the broadest specification of goods and services and is for the word “QUIZ” presented in block capital letters (as opposed to being stylised or accompanied by an additional letter “Z”), it is, self-evidently, this trade mark that offers the opponent its best prospect of success. If the opponent does not succeed on the basis of this trade mark, it will be in no better position in relation to the other trade marks upon which it relies.

17. In its submissions, the applicant admits that: (i) its goods in class 18 are either identical or similar to a medium degree to the opponent's goods, and (ii) the competing goods in class 25 are identical. It denies that its goods in class 16 and services in class 35 are similar to any of the goods and services upon which the opponent relies. However, in the interests of procedural economy, I shall proceed on the basis most favourable to the opponent i.e. that all of the goods and services for which registration is being sought are identical to its own goods and services. If the opponent does not succeed on this basis, it will be in no better position should the applicant's goods and services be found to be only similar to the goods and services upon which it relies, or, not similar at all.

The average consumer and the nature of the purchasing act

18. As the case law above indicates, it is necessary for me to determine who the average consumer is for the goods and services at issue. I must then determine the manner in which these goods and services 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 words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

19. The average consumer of the goods and services at issue is a member of the general public or, in relation to the applicant's services in class 35, most likely, a business user. The goods at issue are, for the most part, likely to be obtained by self-selection from bricks and mortar retail outlets on the high street or from the equivalent pages of a website or catalogue. The services at issue are most likely to be self-selected from signage appearing on the high street, or having conducted searches on-line. Although visual considerations are likely to dominate the selection process, as such goods and services may also be, for example, the subject of oral requests to sales assistants or word-of-mouth recommendations, aural considerations must not be ignored. As to the degree of care the average consumer will display when selecting such goods and services, the cost of the goods can vary widely in price. However, as the goods in classes 18 and 25 are either personal items or items of clothing, a range of factors such as material, colour, size, cost and compatibility with other similar items are all likely to be in play. As such, I would expect an average consumer to pay a medium degree of attention to the selection of such goods. While I take the same view in relation to the opponent's services in class 35, I think a somewhat lower degree of attention will be paid to the selection of the vast majority of the goods in class 16 and a fairly high degree of attention will be paid by a business user selecting the applicant's services in class 35.

Comparison of trade marks

20. 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 Court of Justice of the European Union ("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.”

21. 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
QUIZ	QUIN

22. The opponent's trade mark consists of the word "QUIZ" presented in block capital letters. This word and its meaning will be very well known to the average consumer. Consisting of a single word in which no part is emphasised or highlighted in any way, the overall impression it conveys and its distinctiveness lies in the single word of which it is composed.

23. The applicant's trade mark also consists of a single word. It is presented in a slightly stylised, but unremarkable font. Like the opponent's trade mark, the overall impression it conveys and its distinctiveness lies in the single word of which it is composed.

Visual similarity

24. Both parties' trade marks consist of a four letter word in which the first three letters are identical. However, the final letter in each trade mark differs and bears no visual similarity to one another. While I accept that as a rule of thumb the beginning of words tend to have more impact than their endings, bearing in mind that in short words a difference of a single letter can be significant (even if it appears at the end of the trade mark), it results in what I regard as at least a medium degree of visual similarity between the competing trade marks.

Aural similarity

25. As I mentioned above, the word "QUIZ" will be very well known to the average consumer. As a consequence, its pronunciation is entirely predictable. As to the applicant's trade mark, it is likely to be pronounced as it is in the first part of the words "QUINTET" or "QUINTESSENTIAL" (I shall return to these words when I undertake the conceptual comparison). Although the endings of the respective trade marks differ, the similarity in the manner in which the first part of the competing trade marks will be pronounced, results, once again, in at least a medium degree of aural similarity between them.

Conceptual similarity

26. Collinsdictionary.com defines the word "QUIZ" as meaning "a game or competition in which someone tests your knowledge by asking you questions." That is a meaning with which the average consumer will be very familiar. As to the applicant's trade mark, in its counterstatement, the applicant states:

“8c...the word QUIN is a common version of the word quintuplet or may be understood as a reference to the prefix quint (as in quintet) or the word quintessential.”

27. In its written submissions filed in lieu of a hearing, the opponent states:

“From a conceptual point of view, and considering the imperfection (sic) recollection of the average consumer, QUIN can be interpreted as being a variation of QUIZ insofar as it would suggest being the “Quintessential QUIZ range of clothing.”

28. In my view, the opponent’s submission is far-fetched. While it is possible that some average consumers may treat the word “QUIN” as a shortening of the word quintuplet, in my view, it is much more likely that they will treat it as either a variant spelling of the surname “QUINN” or accord it no meaning at all. Consequently, while the opponent’s trade mark will create a clear and unambiguous concept in the average consumer’s mind, the applicant’s trade mark is most likely to evoke either a different conceptual picture, or no conceptual picture at all.

Distinctive character of the earlier trade mark

29. The distinctive character of a trade mark can be appraised only, first, by reference to the goods and services 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 and services for which it has been registered as coming from a particular undertaking and thus to distinguish those goods and services from those of other

undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

30. In its submission filed during the evidence rounds, the opponent states:

“It is submitted that not only is the QUIZ trade mark highly distinctive in its own right, but as a result of the substantial use that has been made of it...it benefits from an enhanced distinctive character as a result of such use.”

31. Although a well-known word with a well-known meaning, as far as I am aware, the word “QUIZ” is neither descriptive of or non-distinctive for the goods and services upon which the opponent is relying. As a consequence, it is, absent use, possessed of at least a medium degree of inherent distinctiveness.

32. By reference to the witness statement of Mr Wood, in her written submissions, the applicant comments in detail on what she regards as failings in Mr Ramzan’s evidence. While I have noted these comments, in the interests of procedural economy, I shall proceed on the basis that the opponent is entitled to rely upon such use, and that the use that has been made of the “QUIZ” trade mark has resulted in it becoming highly distinctive for all of the goods and services relied upon.

Likelihood of confusion

33. 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 services and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent’s trade mark as the more distinctive it is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods and services,

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.

34. 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/services down to the responsible undertakings being the same or related.

35. Having indicated that for reasons of procedural economy I would proceed on the basis that: (i) the applicant's goods and services are identical to those upon which the opponent relies, and (ii) the opponent's trade mark is highly distinctive, I further concluded that:

- the average consumer is a member of the general public or business user who, whilst not ignoring aural considerations, is likely to select the goods and services at issue by predominantly visual means whilst paying a varying degree of attention during that process;
- the competing trade marks are visually and aurally similar to at least a medium degree;
- while the opponent's trade mark sends a very clear conceptual message, the applicant's trade mark will either send a different conceptual message or no conceptual message at all.

36. In *The Picasso Estate v OHIM*, Case C-361/04 P, the CJEU found:

“20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law.”

37. In *Nokia Oyj v OHIM*, Case T-460/07, the General Court stated:

“Furthermore, it must be recalled that, in this case, although there is a real conceptual difference between the signs, it cannot be regarded as making it possible to neutralise the visual and aural similarities previously established (see, to that effect, Case C-16/06 P *Éditions Albert René* [2008] ECR I-0000, paragraph 98).”

38. I remind myself that I am proceeding on the basis that the goods and services at issue are identical and the opponent’s trade mark is highly distinctive; those are points in the opponent’s favour. Notwithstanding the at least medium degree of visual and aural similarity at play, the very clear conceptual message which will be conveyed by the opponent’s trade mark will, in my view, fix itself in the mind of the average consumer and act as a “hook” to prompt their recall. Consequently, even if the applicant’s trade mark does not convey any conceptual message and even if an average consumer pays a low degree of attention during the selection process (thus making him/her more prone to the effects of imperfect recollection), the very clear conceptual message sent by the opponent’s trade mark is, in my view, sufficient to counteract the visual and aural similarities between the competing trade marks. That conclusion is, of course, even stronger if the average consumer conceptualises the applicant’s trade mark in the

manner I have suggested and/or if such a consumer pays a higher than low degree of attention during the selection process. In short, there is no likelihood of direct confusion.

39. 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.”

40. 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 trade marks share a common element. In this connection, he pointed out that it is not sufficient that a trade mark merely calls to mind another trade mark. This is mere association not indirect confusion.

41. Even if the applicant’s trade mark creates no conceptual picture in the mind of the average consumer, given the very clear conceptual message sent by the opponent’s trade mark, I see absolutely no reason why an average consumer who has noticed the trade marks are different, would assume that the applicant’s trade mark was connected with the opponent, simply because its trade mark has the same first three letters. Once

again, the applicant's position is even stronger if the average consumer conceptualises her trade mark in the manner I have suggested. There is no likelihood of indirect confusion.

Conclusion under section 5(2)(b) of the Act

42. The opposition has failed.

The objection based upon section 5(3) of the Act

43. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Addidas-Salomon*, Case C-487/07, *L'Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows:

- a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

- (b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

- (c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

- (d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant

consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation

and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

44. In *General Motors*, Case C-375/97, the CJEU held:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

45. In Case C-408/01, *Adidas-Salomon*, the CJEU held:

“28. The condition of similarity between the mark and the sign, referred to in Article 5(2) of the Directive, requires the existence, in particular, of elements of visual, aural or conceptual similarity (see, in respect of Article 5(1)(b) of the Directive, Case C-251/95 *SABEL* [1997] ECR I-6191, paragraph 23 in fine, and Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraphs 25 and 27 in fine).

29. The infringements referred to in Article 5(2) of the Directive, where they occur, are the consequence of a certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them (see, to that effect, Case C-375/97 *General Motors* [1999] ECR I-5421, paragraph 23).”

46. Notwithstanding the applicant’s criticisms of the opponent’s evidence, I shall, once again, proceed on the basis that the opponent is entitled to rely upon such use and that the evidence that has been provided of the use made of the “QUIZ” trade marks has resulted in them achieving the necessary qualifying reputation in relation to all the goods and services claimed. I begin by reminding myself that the trade marks being relied upon are the same as that under section 5(2)(b). However, even if used on identical goods and services, the conceptual “hook” which the opponent’s trade mark will create in the mind of the average consumer is, in my view, sufficient to avoid a “link” being established, even if the applicant’s trade mark conveys no conceptual meaning. Where a conceptual meaning is attributed to the applicant’s trade mark it will, as noted above, be different to that of the opponent’s trade mark and will make it even less likely that a “link” will be established. Without a “link” the opponent cannot succeed and the opposition based upon section 5(3) fails and is dismissed accordingly.

Conclusion under section 5(3) of the Act

47. The opposition has failed.

The objection based upon Section 5(4)(a) of the Act

48. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “*a substantial number*” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

49. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC as the Appointed Person considered the relevant date for the purposes of s.5(4)(a) of the Act. Having reviewed the relevant case law, he stated:

“43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.’ ”

50. As the applicant has filed no relevant evidence of any use she may have made of her trade mark, the relevant date is the date of the filing of the application i.e. 16 March 2018. Even if I proceed on the basis that the business conducted under the trade marks has the necessary goodwill in relation to all the goods and services claimed and that such goodwill accrues to the opponent, the trade marks being relied upon are the same as that under section 5(2)(b), in relation to which I have already concluded that there is no likelihood of either direct or indirect confusion. Given the comments of the court in *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, it seems doubtful whether the difference between the legal tests will (all other factors being equal) produce different outcomes. As a consequence, there will, in my view, be no misrepresentation, without which there can be no damage. The opposition based upon section 5(4)(a) fails and is dismissed accordingly.

Conclusion under section 5(4)(a) of the Act

51. The opposition has failed.

Overall conclusion

52. The opposition has failed on all grounds and, subject to any successful appeal, the application will proceed to registration.

Costs

53. As the applicant has been successful, she is entitled to a contribution towards her costs. Awards of costs in proceedings are governed by Annex A of Tribunal Practice Notice (“TPN”) 2 of 2016. As I mentioned earlier, in her written submissions, the applicant made a number of criticisms of the opponent’s evidence. She states:

“54. If you decide that our criticisms of the evidence of Ramzan are correct you may wish to consider whether Kast has acted unreasonably, and to depart from the scale of costs. There is little authority on what suffices to allow for a departure and what is unreasonable.”

And:

“62. If you should find that there has been obfuscation then we invite you to consider whether this amounts to an abuse of process or is otherwise unreasonable behaviour such as to warrant an award above the scale. We also ask you to consider whether certain grounds under the s.5(3) case had any prospect of success insofar as there is an assertion of dilution, tarnishment and unfair advantage beyond the simple case based on confusion where quite clearly there was no basis to argue it and no evidence to support it. At the very least the case should have been withdrawn to the extent that these grounds were asserted at the closure of the evidence rounds to avoid the parties and the Tribunal having to consider them.”

54. In her written submissions, the applicant points to the guidance provided in TPN 2 of 2000 in relation to costs which, I note, contains the following:

“5. In the light of Rizla, the Office considers that the existing legislation provides the power to operate a nominal cost regime or a full cost recovery regime - or

anything in between - and that no legislative change is necessary to put in hand any revision of that sort.”

55. A number of the applicant’s criticisms of the opponent’s evidence appear well founded. In his first statement, Mr Ramzan stated:

“1. I am Chief Commercial Officer of Kast Services Limited, (hereinafter referred to as "the Company"), a position I have held for over two years, having been in continuous employment with the business for thirteen years. Unless otherwise stated, the facts and matters described in this statement come from my own personal knowledge of the Company and from consulting records belonging to the Company to which I have full and free access. I am duly authorised to speak on behalf of the Company in the prosecution of this Opposition...”

56. I note that Mr Ramzan’s first statement also contains the following:

“7. **The Company's** approximate annual turnover for goods and services provided under the QUIZ Mark is substantial. In the six-year period prior to the filing date of the opposed application, **the turnover figures for the QUIZ group of companies** are as follows...” (my emphasis)

57. From the information provided in his statement in reply, it transpires that Mr Ramzan holds the position of Chief Commercial Officer at both Kast Services Limited and QUIZ plc. In his second statement, he explains that QUIZ plc:

“1...is the parent company of [Kast Services Limited]. QUIZ plc owns a number of trading subsidiaries which sell QUIZ branded product (“the Group”). [Kast Services Limited] holds the intellectual property associated with the QUIZ brand which is licensed to other companies in the Group I have been in continuous employment with the QUIZ business for thirteen years.”

58. Attached to Mr Wood's statement as exhibit ARW1 is an extract obtained from Companies House which indicates that the opponent, Kast Services Limited, was incorporated on 23 March 2017; it is accompanied by a copy of the company's annual report for the period ending 31 March 2018. In his first statement, Mr Ramzan states:

“8...In the three year period from 2015-2018...[Kast Services Limited] spent almost £12m on its direct advertising spend in the UK.”

59. As the applicant points out, that cannot be correct as Kast Services Limited was not in existence until March 2017. As I noted in paragraph 56 above, in his first statement, Mr Ramzan refers to “the Company's approximate annual turnover” and later in the same paragraph “the turnover figures for the QUIZ group of companies.” Thus it appears there was some confusion when Mr Ramzan completed his first statement. That confusion may have arisen because Mr Ramzan holds the position of Chief Commercial Officer at both Kast Services Limited and QUIZ plc. Regardless, I agree with the applicant that he ought to have more precisely explained the relationship between the opponent and the other entities in the Group in his first statement. However, even if he had, given the manner in which I have approached this case, it would not have affected the outcome of these proceedings. While that lack of clarity does not, in my view, amount to either an abuse of process or unreasonable behaviour, I accept that it required the applicant to investigate the matter further and increased her costs as a result.

60. As to the fact that the opponent relied upon various heads of damage under section 5(3) beyond that linked to confusion between the competing trade marks, that was a point identified by the applicant in her counterstatement. The fact that the opponent elected to continue with its original 5(3) pleading is likely to have stemmed from a misunderstanding on its part. While it does not, in my view, constitute an abuse of process or unreasonable behaviour, once again, I accept it would have increased the applicant's costs.

61. Bearing all the above in mind and having applied the guidance in the TPNs mentioned, I award costs to the applicant on the following basis:

Reviewing the Notice of Opposition and filing a counterstatement:	£500
Preparing evidence and considering the opponent's evidence:	£800
Written submissions:	£500
Total:	£1800

62. I order Kast Services Limited to pay to Queenie Chan the sum of **£1800**. 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 27th day of August 2020

C J BOWEN
For the Registrar

(1) UK no. 1542042

Trade marks: QUIZ, QUIZZ (series of 2)

Filing date: 15 July 1993

Registered: 28 April 1995

Goods

Class 25

Articles of outerclothing; articles of leisure clothing; shirts; T-shirts; all included in Class 25.

(2) UK no. 2585713

Trade mark: QUIZ

Filing date: 24 June 2011

Registered: 23 September 2011

Goods and services

Class 14

Jewellery, precious stones, watches, clocks, precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; bracelets, brooches, cufflinks, medals, ornaments, shoe ornaments, objects of imitation gold, ornamental pins, tie pins, tie clips, watch straps.

Class 18

Leather and imitations of leather, and goods made of these materials and not included in other classes; bags, travelling bags, cases, suitcases, briefcases, straps of leather or imitation leather, handbags, garment bags, haversacks, rucksacks, trunks; purses, wallets, key cases, pouches; canes, sticks, saddlery, belts.

Class 25

Clothing, footwear, headgear.

Class 35

The bringing together, for the benefit of others, of clothing, footwear, headgear, jewellery, precious stones, watches, clocks, precious metals and their alloys and goods in precious metals or coated therewith, bracelets, brooches, cufflinks, medals, ornaments, shoe ornaments, objects of imitation gold, ornamental pins, tie pins, tie clips, watch straps; leather and imitations of leather, and goods made of these materials, bags, travelling bags, cases, suitcases, briefcases, straps of leather or imitation leather, handbags, garment bags, haversacks, rucksacks, trunks, purses, wallets, key cases, pouches, canes, sticks, saddlery, belts, enabling customers to conveniently view and purchase those goods; retail services in the fields of clothing, footwear, headgear, jewellery, precious stones, watches, clocks, precious metals and their alloys and goods in precious metals or coated therewith, bracelets, brooches, cufflinks, medals, ornaments, shoe ornaments, objects of imitation gold, ornamental pins, tie pins, tie clips, watch straps, leather and imitations of leather, and goods made of these materials, bags, travelling bags, cases, suitcases, briefcases, straps of leather or imitation leather, handbags, garment bags, haversacks, rucksacks, trunks, purses, wallets, key cases, pouches, canes, sticks, saddlery, and belts.

(3) EUTM no. 8804874

Trade mark:



Filing date: 12 January 2010

Registered: 27 July 2010

Goods and services

Class 14

Jewellery, precious stones, watches, clocks, precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; bracelets, brooches, cufflinks, medals, ornaments, shoe ornaments, objects of imitation gold, ornamental pins, tie pins, tie clips, watch straps.

Class 18

Leather and imitations of leather, and goods made of these materials and not included in other classes; bags, travelling bags, cases, suitcases, briefcases, straps of leather or imitation leather, handbags, garment bags, haversacks, rucksacks, trunks; purses, wallets, key cases, pouches; canes, sticks, saddlery, belts.

Class 25

Clothing, footwear, headgear.

Class 35

The bringing together, for the benefit of others, of jewellery, leather goods and clothing (excluding transport thereof), enabling customers to conveniently view and purchase those goods; retail services in the fields of jewellery, leather goods and clothing.