

O/120/21

TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL REGISTRATION NO. WO0000001535509

DESIGNATING THE UK

BY BLAZER AND FLIP FLOPS, INC.:

xOS

IN CLASS 9 AND 42

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 600001463

BY BUHO ELECTRONICS GLOBAL COMPANY, S.L.

Background and pleadings

1. International trade mark 1535509 (“the IR”) consists of the sign shown on the cover page of this decision. The holder is Blazer and Flip Flops, Inc. The IR is registered with effect from 23 January 2020. With effect from the same date, the holder designated the UK as a territory in which it seeks to protect the IR under the terms of the Protocol to the Madrid Agreement. The holder seeks protection for the IR in relation to the following goods and services:

Class 9 Computer application software for portable devices, namely, software for delivery of real-time interactive content associated with a location for use on portable devices.

Class 42 Design and development of application software for delivery of real-time interactive content associated with a location for use on portable devices.

2. The request to protect the IR was published on 10 July 2020. On 9 September 2020, Electronics Global Company, S.L. (“the opponent”) opposed the protection of the IR in the UK based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) through the fast track procedure. The opponent relies on the following trade mark:



EUTM registration no. EU016987588¹

Filing date 14 July 2017; registration date 29 December 2017

¹ Although the UK has left the EU and the transition period has now expired, EUTMs, and International Marks which have designated the EU for protection, are still relevant in these proceedings given the impact of the transitional provisions of The Trade Marks (Amendment etc.) (EU Exit) Regulations 2019 – please see Tribunal Practice Notice 2/200 for further information.

Relying upon all goods for which the earlier mark is registered, namely:

Class 9 Data storage devices; Apparatus for data transmitting; Data collection apparatus; Data monitoring instruments.

Class 37 Predictive maintenance of machines.

Class 42 Hosting of software platforms; Monitoring of computer systems by remote access; Computer system monitoring services; Monitoring of computer systems to detect breakdowns; Monitoring of alarms.

3. The opponent claims that there is a likelihood of confusion because its mark is similar to the IR and the parties' respective goods and services are similar. The opponent is opposing all goods and services for which the holder seeks protection.

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

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

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

6. Rule 62 (5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken. A hearing was neither requested nor considered necessary.

7. The opponent is represented by Bryers LLP and the holder is represented by D Young & Co LLP. Neither party requested a hearing, however, the opponent attached

their statement of grounds to their TM7F and the holder filed written submissions in lieu. Whilst I do not propose to summarise the submissions here, I have taken them into consideration, and will refer to them below where necessary. This decision is taken following a careful perusal of the papers.

8. Although the UK has left the EU, section 6(3)(a) of the European (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

Section 5(2)(b)

9. Section 5(2)(b) reads 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.”

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

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

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of IR 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.”

11. The trade mark upon which the opponent relies qualifies as an earlier trade mark because it was applied for at an earlier date than the IR pursuant to section 6 of the Act. As the opponent’s mark had not completed its registration process more than 5 years before the filing date of the designation in issue, it is not subject to proof of use pursuant to section 6A of the Act. The opponent can, therefore, rely upon all of the goods and services it has identified.

Section 5(2)(b) case law

12. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

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

- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

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

Comparison of goods and services

13. The competing goods and services are as follows:

Opponent's goods and services	Holder's goods and services
<p><u>Class 9</u> Data storage devices; Apparatus for data transmitting; Data collection apparatus; Data monitoring instruments.</p>	<p><u>Class 9</u> Computer application software for portable devices, namely, software for delivery of real-time interactive content associated with a location for use on portable devices.</p>
<p><u>Class 37</u> Predictive maintenance of machines.</p>	<p><u>Class 42</u> Design and development of application software for delivery of real-time interactive content associated with a location for use on portable devices.</p>
<p><u>Class 42</u> Hosting of software platforms; Monitoring of computer systems by remote access; Computer system monitoring services; Monitoring of computer systems to detect breakdowns; Monitoring of alarms.</p>	

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

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;

- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and, in particular, whether they are or are likely to be found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance, whether market research companies, who of course act for industry, put the goods or services in the same or different sectors

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

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of ‘dessert sauce’ did not include jam, or because the ordinary and natural description of jam was not ‘a dessert sauce’. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

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

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

17. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as the 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.”

18. 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 the responsibility for those goods lies with the same undertaking.”

19. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. chicken against transport services for chickens. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted, as the Appointed Person, in *Sandra Amelia Mary Elliot v LRC Holdings Limited*, BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense – but it does not follow that wine and glassware are similar goods for trade mark purposes.” Whilst on the other hand: “... it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

Whilst on the other hand:

“... it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

20. In making my assessment, I note that the Tribunal Manual states that specifications which include the wording ‘namely’ should be interpreted as covering only the named goods within that specification. Therefore, the specification is limited only to those goods.

Class 9

Computer application software for portable devices, namely, software for delivery of real-time interactive content associated with a location for use on portable devices.

21. The holder submits that this term is not similar with “data storage devices” in the opponent’s specification on the basis of the case law set out in *Les Éditions Albert René v OHIM*². However, this case makes it clear that similarity should not be established purely on the basis that components of goods or services are within the opposing specification. However, it does not mean that there can never be similarity between such goods/services where there is overlap in the factors identified in *Treat*.

22. I consider that this term is similar with “data storage devices” in the opponent’s specification. Although it is not specified as to whether the devices in the opponent’s specification are portable, many storage devices such as USBs, laptops, tablets and

² Case T-336/03

smart phones are portable in nature. It may, therefore, be the case that the holder's software goods would be used with the opponent's devices. Consequently, there may be an overlap in trade channels as businesses that provide portable devices may also provide tracking software for the portable device. The user of the goods will also overlap. However, the purpose and nature of these goods differ as the holder's goods are location tracking software (like GPS) for portable devices, whereas the opponent provides the device itself. These will not, therefore, be in competition with each other. However, they will be complimentary within the meaning of the above case law. Taking the above into account, I consider the goods to be similar to a medium degree.

Class 42

Design and development of application software for delivery of real-time interactive content associated with a location for use on portable devices.

23. This term is similar to "data storage devices" in the opponent's specifications. As established above, data storage devices can be portable in nature and these would be devices with which the holder's software would be used. There will be an overlap of user, and an overlap in trade channels because businesses that provide portable devices may also provide the design and development of location tracking software which can be used on these devices. For example, it is common for businesses that provide devices to subsequently provide updates for those devices, in particular, to the software used on them. However, the purpose and nature of these goods and services differ and consequently they will not be in competition with each other. Taking the above into account, I consider the goods and services to be similar to between a low and medium 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 respective parties' goods and services. I must then determine the manner in which the goods and services are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc*,

Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited, [2014] EWHC 439 (Ch), Birss J described the average consumer in these terms:

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

25. The average consumer for the goods and services will range from business users to members of the general public. The cost of purchase is likely to vary, but it is not likely to be at the very highest end of the scale. The frequency of the purchase is also likely to vary, although it is unlikely to be particularly regular. Even where the cost of the purchase is low, various factors will be taken into account by the average consumer such as the quality, ease of use and suitability of the goods or services for the user’s particular requirements. Consequently, I consider that a medium degree of attention will be paid during the purchasing process.

26. The goods are likely to be purchased from the shelves of a retail outlet or their online equivalent or following inspection of a specialist catalogue. Consequently, visual considerations are likely to dominate the selection process. However, I recognise that word-of-mouth recommendations and verbal advice means that aural considerations cannot be discounted.

27. The services are likely to be purchased from specialist retail outlets or their online equivalents. Alternatively, the services may be purchased following perusal of advertisements. However, I do not discount that there may be an aural component to the purchase of the services given that advice may be sought from a sales assistant or a recommendation may have been given through word-of-mouth.


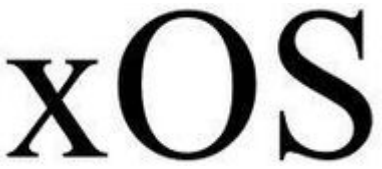
Comparison of the trade marks

28. 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 the trade marks, 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.”

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

30. The respective trade marks are shown below:

Opponent’s trade mark	Holder’s IR
	

31. The opponent's mark consists of text intended to represent the word KOS, which is split in half horizontally with a green line, with three dots placed at the centre of each letter. The wording "keep online systems" lies underneath. The overall impression of the mark lies in the combination of all these elements, with the word KOS playing the greater role due to its size.

32. The IR consists of the word, xOS, which is not a recognisable dictionary word. There are no other elements to contribute to the overall impression which lies in the word itself.

33. Visually, to the extent that the opponent's mark will be recognised as containing the word KOS, the marks will overlap in the presence of the letters OS in the same position.

34. The different first letters – K in the opponent's mark and x in the IR - act as a point of visual difference. It was noted in *Deutsche Bahn v OHIM* by the GC that where the marks were two or even three letters long, the significance of any differences would be heightened by the brevity of the marks.³ Therefore, where the length of the parties' marks are short, differences are more likely to be noticed. The opponent's mark and the IR both contain three letters, therefore, the different first letters will have more of an impact. The split letters, green line device and "keep online systems" elements in the opponent's mark are also all points of visual difference. Consequently, I consider the marks to be visually similar to between a low and medium degree.

35. Aurally, the IR could be pronounced as either EX-OS or EX-OH-ES. As the IR is not a recognisable word, I consider that a significant proportion of average consumers will pronounce the letters individually as EX-OH-ES.

36. Aurally, the "keep online systems" element of the opponent's mark may or may not be pronounced. If it is, then the opponent's mark would be pronounced KAY-OH-ES KEEP ON-LINE SIS-TEMS or KOS KEEP ON-LINE SIS-TEMS. Therefore, I consider

³ Case T-274/09 *Deutsche Bahn v OHIM* EU:T:2011:451, [78] (ICE/IC4)

the marks to be aurally similar to a low degree. If “keep online systems” is not pronounced, then the opponent’s mark would either be pronounced as KAY-OH-ES or KOS. In the former case, I consider the marks to be aurally similar to a medium degree and in the latter, they will be similar to between a low and medium degree.

37. Conceptually, the opponent’s mark could have multiple conceptual meanings assigned to it by the average consumer. Firstly, the average consumer could read KOS as an invented word with no meaning. Secondly, as submitted by the holder, the average consumer could recognise KOS as the Greek island. As established above, in the opponent’s mark, KOS is followed by “keep online systems”. If they recognise KOS as the acronym for “keep online systems” then it would be assigned that conceptual meaning.

38. The IR could also be seen as an acronym. However, the average consumer may not recognise the meaning, or they may recognise OS which, as submitted by the opponent, is a well-known abbreviation for ‘operating system’. It is also possible that for those average consumers who are familiar with the meaning of OS, the same letters and meaning could be identified in the opponent’s mark.

39. As the opponent’s mark and the holder’s IR both have multiple possible conceptual meanings assigned to them by the average consumer, then the following can be concluded as to the conceptual similarity between them:

- a) If the average consumer recognises the opponent’s mark to mean “keep online systems” and they recognise the holder’s IR to be a meaningless acronym, then the mark and IR would be conceptually dissimilar.
- b) If the average consumer recognises the opponent’s mark as a Greek island, and the holder’s IR is conceptually meaningless, then again, the marks would be conceptually dissimilar. However, the words “keep online systems” would still be a point of conceptual difference.

- c) If the average consumer views both KOS and xOS as meaningless acronyms, then they would be conceptually neutral, but the words “keep online systems” would still be a point of conceptual difference.
- d) If the average consumer noticed the OS in both, and assigned the conceptual meaning of operating system to both, then they would be conceptually similar to a medium degree.
- e) If the average consumer recognises the opponent’s mark to mean “keep online systems” and they recognise the holder’s IR to be an acronym referring to an operating system, then there may be some conceptual overlap to the extent that both refer to types of systems. However, any such overlap would result in only a low degree of conceptual similarity.

Distinctive character of the earlier trade mark

40. 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 C108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promotion of the mark; the proportion of the relevant

section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see Windsurfing Chiemsee, paragraph 51).”

41. 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 distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

42. As the opponent has not filed any evidence to show that the distinctiveness of its mark has been enhanced through use, I only have the inherent position to consider.

43. As established in paragraph 39, conceptually the opponent’s mark has multiple meanings. For the purpose of determining the distinctive character of the mark, each must be explored:

- a) If KOS is seen as an acronym which means “keep online systems” the mark will be allusive. I consider the opponent’s mark to be inherently distinctive to between a low and medium degree.
- b) If KOS is seen as the Greek island, then it may be seen as indicating geographical origin. The “keep online systems” element of the mark is allusive of the goods and services for which the mark is used. I consider the opponent’s mark to be inherently distinctive to between a low and medium degree.
- c) If KOS, is recognised as containing OS, which is itself recognised as the abbreviation for operating system, alongside the “keep online systems” element, the mark is allusive of the goods and services. I consider the opponent’s mark to be inherently distinctive to between a low and medium degree.
- d) Lastly, if KOS is viewed as an invented word then it will be highly distinctive.

44. In all four variants, I do not consider that the stylisation and use of colour in the mark increases its inherent distinctive character significantly.

Likelihood of confusion

45. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods or services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. It is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

46. The following factors must be considered to determine if a likelihood of confusion can be established:

- I have found the marks to be visually similar to between a low and medium degree.
- I have found the marks to be aurally similar to either a medium degree, a low degree, or between a low and medium degree, depending on how the marks are pronounced.
- I have found the marks to be conceptually dissimilar, neutral or similar to either a low or medium degree depending on how the marks are interpreted.

- I have found the earlier mark to vary from being inherently distinctive to between a low and medium degree, to highly distinctive, depending upon how it is interpreted.
- I have identified the average consumer to be business users or members of the general public, who will select the goods and services primarily by visual means, although I do not discount an aural component.
- I have concluded that a medium degree of attention will be paid during the purchasing process.
- I have found the parties goods and services to be similar to either a medium degree or to between a low and medium degree.

47. I bear in mind the decision of the CJEU in *L'Oréal SA v OHIM*, Case C-235/05 P, in which the court confirmed that weak distinctive character of the earlier trade mark does not preclude a likelihood of confusion. Further, I bear in mind the comments of Mr Iain Purvis Q.C., sitting as the Appointed Person, in *Kurt Geiger v A-List Corporate Limited*, BL O-075-13. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

48. In other words, it is important to ask, ‘in what does the distinctive character of the earlier mark lie?’ Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

49. The KOS element of the opponent's mark will either be recognised as the Greek Island, a meaningless word/acronym, an acronym standing for "keep online systems" or an acronym containing OS which stands for operating system.

50. If the opponent's mark is recognised as the Greek island that will act as a conceptual hook to assist in distinguishing between the marks. That, combined with the visual and aural differences, will be sufficient to differentiate between the marks. If the KOS element of the opponent's mark is recognised as standing for "keep online systems" that will again act as a conceptual hook which, along with the visual and aural differences, will allow the average consumer to differentiate between the marks.

51. For those average consumers who view "OS" as meaning "operating system", more emphasis will be placed on the first letter of both marks to indicate trade origin. I do not consider that the different first letter will be overlooked. Notwithstanding the principle of imperfect recollection, I consider that the different letters at the start of the opponent's mark and IR, as well as the additional wording and devices in the opponent's mark, will be sufficient to enable the consumer to differentiate between them. This is particularly the case as consumers will be paying a medium degree of attention when selecting the goods and services in issue. I do not, therefore, consider that there is a likelihood of direct confusion.

52. The opponent's best case lies in the proportion of average consumers who will identify the word KOS as an invented term, with no particular meaning. For those average consumers, the word KOS will be highly distinctive and there will be no conceptual hook to assist in differentiating between the marks. However, I bear in mind that, where the length of the parties' marks are short, the differences are more likely to be noticed.⁴ The differing first letters – K and x – will, therefore, have more of an impact. I consider that this, combined with the differences between the goods and services, will be sufficient to offset the high distinctive character attributed to the earlier mark. Taking the above into account, I do not consider that there is a likelihood of direct confusion.

⁴ Case T-274/09 *Deutsche Bahn v OHIM* EU:T:2011:451, [78] (ICE/IC4)

53. It now falls to me to consider the likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

“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.”

54. If the average consumer recognises the differences between the opponent’s mark and the IR, I see no reason why the average consumer would assume that they come from the same or economically linked undertakings. Even where the opponent’s mark is recognised as containing OS which stands for operating system, and therefore the common element lies in this, it is allusive of the goods and services for which the opponent’s mark and IR are applied for/registered. The consumer would have no reason to believe that only one undertaking would use this abbreviation in relation to computer systems and device-based goods and services. I do not, therefore, consider there to be a likelihood of indirect confusion.

Conclusion

55. The opposition is unsuccessful and the IR may proceed to registration.

Costs

56. The holder has been successful and is entitled to a contribution towards its costs. Awards of costs in fast track proceedings are governed by Tribunal Practice Notice 2/2015. In the circumstances, I award the holder the sum of **£400** as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Considering the Notice of opposition and preparing a Counterstatement	£200
Preparing and filling written submissions in lieu	£200
Total	£400

57. I therefore order Buho Electronics Global Company, S.L. to pay Blazer and Flip Flops, Inc. the sum of £400. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 24th day of February 2021

L FAYTER
For the Registrar