

O/699/21

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003546846

BY FROM THE COLD LTD

TO REGISTER THE FOLLOWING MARK:

FROM THE COLD

IN CLASS 25

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 600001649

BY KAMAL TINGLIN-DRUMMOND

Background and pleadings

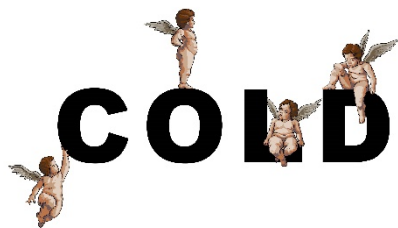
1. On 21 October 2020, FROM THE COLD LTD (“the applicant”) applied to register the trade mark shown below and the application was published for opposition purposes on 18 December 2020.

FROM THE COLD

2. Registration is sought for:

Class 25 Clothing.

3. Kamal Tinglin-Drummond (“the opponent”) opposes the trade mark on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against the single Class 25 term that is applied for and is reliant on the mark set out below.
4. Trade mark UK00003353247, filed on 14 November 2018, registered on 8 February 2019.



5. The mark is registered for the following goods, all of which the opponent relies upon in his opposition:

Class 25 Adhesive bras; After ski boots; Aikido suits; Aikido uniforms; Albs; Aloha shirts; American football bibs; American football pants; American football shirts; American football shorts;

American football socks; Anglers' shoes; Ankle boots; Ankle socks; Anklets [socks]; Anoraks; Anoraks [parkas]; Anti-perspirant socks; Anti-sweat underclothing; Anti-sweat underwear; Après-ski boots; Apres-ski shoes; Aprons; Aprons [clothing]; Aqua shoes; Arm warmers [clothing]; Army boots; Articles of clothing; Articles of clothing for theatrical use; Articles of clothing made of hides; Articles of clothing made of leather; Articles of outer clothing; Articles of sports clothing; Articles of underclothing; Ascots; Ascots (ties); Athletic clothing; Athletic footwear; Athletic shoes; Athletic tights; Athletic uniforms; Athletics footwear; Athletics hose; Athletics shoes; Athletics vests; Babies' clothing; Babies' outerclothing; Babies' pants [clothing]; Babies' pants [underwear]; Babies' undergarments; Babushkas; Baby bibs [not of paper]; Baby bodysuits; Baby boots; Baby bottoms; Baby clothes; Baby doll pyjamas; Baby layettes for clothing; Baby pants; Baby sandals; Baby tops; BalACLavas; Ball gowns; Ballet shoes; Ballet slippers; Ballet suits; Ballroom dancing shoes; Bandanas; Bandanas [neckerchiefs]; Bandannas; Bandeaux [clothing]; Barber smocks; Baseball caps; Baseball caps and hats; Baseball hats; Baseball shoes; Baseball uniforms; Baselayer bottoms; Baselayer tops; Basic upper garment of Korean traditional clothes [Jeogori]; Basketball shoes; Basketball sneakers; Bath robes; Bath sandals; Bath shoes; Bath slippers; Bathing caps; Bathing costumes; Bathing costumes for women; Bathing drawers; Bathing suit cover-ups; Bathing suits; Bathing suits for men; Bathing trunks; Bathrobes; Bathwraps; Beach clothes; Beach clothing; Beach cover-ups; Beach footwear.

6. The opponent opposed the application using the “fast track” procedure by filing a Form TM7F. This procedure can be used when the grounds of opposition are limited to sections 5(1) and/or 5(2) of the Act.

7. In its Form TM7F, the opponent argues that the respective goods are identical or similar and that the marks are similar and that there exists a likelihood of confusion on the part of the public. The opponent makes a number of points. He says that the applied for mark could be confused with “COLD” (albeit he erroneously cites reference number UK00003061391, which is the number for “Coldlondon”, rather than UK00003353247 which is the reference number of the contested mark) and talks of “passing off”. However, I note that, in a fast track opposition, an opposition can only be brought under sections 5(1) and/or 5(2). The opponent has reservations about the applicant’s “FROM THE COLD” mark in that shortened forms of the phrase – “THE COLD” and “COLD” – “would become more practical in cases where specific pieces of clothing won’t allow for the full phrase.” In that respect, I note that I must assess the marks as registered/applied for.
8. The opponent goes on to state that he can “prove” that the terms “THE COLD” or “COLD” have been used by the applicant on “garments”. He also claims that “there was a recent situation where a customer asked their parents for a COLD item as a Christmas gift and instead of COLD the parents mistakenly made a “from the COLD” purchase.” Although the opponent states that he would be happy to submit any evidence regarding these statements, he did not seek leave to file any evidence. In any event, my decision must be made on the basis of the marks before me and not a different one that the applicant may have been using, so the evidence would not have assisted. Further, this also applies to the suggestion of actual confusion because, even if there was evidence of actual confusion, this might have been on the basis of the mark allegedly used, not the one before the Tribunal.
9. The applicant filed a Form TM8 and a counterstatement, making a number of points. It denies that the use and/or registration of the applicant’s mark would give rise to a likelihood of confusion on the part of the relevant public and expressly denies that there is a risk of the public associating the applicant’s mark with the opponent’s mark. It further denies that the presence of the word “COLD” in the applicant’s mark would “easily be associated,

misinterpreted and / or confused” with the opponent’s mark or that the applicant’s mark could be seen as a subsidiary or extension of the opponent’s mark.

10. 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 it 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.”

11. The net effect of these changes is to require parties to seek leave in order to file evidence in fast track oppositions. 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.

12. In this case, neither party sought leave to file evidence.

13. A hearing was neither requested nor was it considered necessary.

14. Neither party elected to file written submissions.

15. The applicant is represented by J A Kemp LLP, whereas the opponent is unrepresented.

DECISION

16. Section 5(2)(b) of the Act 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.”

17. 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) a European Union 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.”

18. Given its filing date, the trade mark upon which the opponent relies qualifies as an earlier trade mark as defined in section 6(1) of the Act. Also, as this trade mark had not completed its registration process more than 5 years before the filing date of the application in issue in these proceedings, it is not subject to proof of use pursuant to section 6A of the Act.

Section 5(2)(b) – case law

19. Although the UK has left the EU, section 6(3)(a) of the European Union (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 Trade Marks 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.

20. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-*

Goldwyn-Mayer Inc, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

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

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive

role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings to mind the earlier mark, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

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

Comparison of the goods

21. The goods in question are as follows:

Opponent's goods	Applicant's goods
<u>Class 35</u> Adhesive bras; After ski boots; Aikido suits; Aikido uniforms; Albs; Aloha shirts; American football bibs; American football pants; American football shirts; American football shorts; American football socks; Anglers' shoes; Ankle	<u>Class 35</u> Clothing.

boots; Ankle socks; Anklets [socks];
Anoraks; Anoraks [parkas]; Anti-
perspirant socks; Anti-sweat
underclothing; Anti-sweat underwear;
Après-ski boots; Apres-ski shoes;
Aprons; Aprons [clothing]; Aqua shoes;
Arm warmers [clothing]; Army boots;
Articles of clothing; Articles of clothing
for theatrical use; Articles of clothing
made of hides; Articles of clothing made
of leather; Articles of outer clothing;
Articles of sports clothing; Articles of
underclothing; Ascots; Ascots (ties);
Athletic clothing; Athletic footwear;
Athletic shoes; Athletic tights; Athletic
uniforms; Athletics footwear; Athletics
hose; Athletics shoes; Athletics vests;
Babies' clothing; Babies' outerclothing;
Babies' pants [clothing]; Babies' pants
[underwear]; Babies' undergarments;
Babushkas; Baby bibs [not of paper];
Baby bodysuits; Baby boots; Baby
bottoms; Baby clothes; Baby doll
pyjamas; Baby layettes for clothing;
Baby pants; Baby sandals; Baby tops;
Balaclavas; Ball gowns; Ballet shoes;
Ballet slippers; Ballet suits; Ballroom
dancing shoes; Bandanas; Bandanas
[neckerchiefs]; Bandannas; Bandeaux
[clothing]; Barber smocks; Baseball
caps; Baseball caps and hats; Baseball
hats; Baseball shoes; Baseball
uniforms; Baselayer bottoms; Baselayer

tops; Basic upper garment of Korean traditional clothes [Jeogori]; Basketball shoes; Basketball sneakers; Bath robes; Bath sandals; Bath shoes; Bath slippers; Bathing caps; Bathing costumes; Bathing costumes for women; Bathing drawers; Bathing suit cover-ups; Bathing suits; Bathing suits for men; Bathing trunks; Bathrobes; Bathwraps; Beach clothes; Beach clothing; Beach cover-ups; Beach footwear.	
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22. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court (“GC”) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut for Lernsysteme v OHIM – Educational Services* (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

23. The applicant’s “Clothing” is identical to the opponent’s “Articles of clothing”. Consequently, it is not necessary to further analyze the opponent’s other goods as they could not put the opponent in any stronger a position.

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. I must then determine the manner in which the goods are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc*,

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

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

25. The applicant contends that, for clothing, “the visual impression created by a mark is of particular importance (*McKenzie (GC, T-502/07, para. 50)*). This is because, having regard to the manner in which clothing products are commonly marketed, sold and purchased, consumers generally place greater reliance on the way in which a mark is represented visually rather than how a mark is pronounced.”

26. Clothing being the goods in conflict in this case, it consists of consumer items that would warrant more than a cursory degree of attention in that they would normally require the scrutiny necessary to determine size and fit, as well as style. Attention would also be paid to cost and quality. Generally, the average consumer, a member of the general public, would pay a medium degree of attention during the purchasing process. However, at the top end of the market the consumer would pay a high degree of attention.

27. As there is a varying degree of attention, I will assess the likelihood of confusion taking into account the public with the lower level of attention¹.

¹ See, for example, Case T-356/14, *CareAbout v OHMI - Florido Rodríguez (Kerashot)*, paragraph 25.

28. Although there might be some verbal interaction when requesting a particular brand of clothing, visual considerations would usually predominate during the purchasing process.

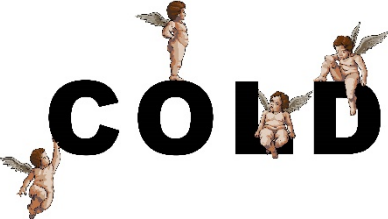
Comparison of the trade marks

29. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

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

31. The opponent's and the applicant's marks are shown below:

Opponent's trade mark	Applicant's trade mark
	<p data-bbox="858 443 1302 488" style="text-align: center;">FROM THE COLD</p>

32. In his TM7F, the opponent contends that “it would be easy to possibly see “from the COLD” as an extension or subsidiary of COLD”. He also states that “the string of words leading up to COLD, words 1 and 2 put a strong emphasis on the third (COLD). From a grammatical standpoint one could argue that the phrase would be incomplete without the word COLD.”

33. Conceptually, the opponent says that, “COLD is a pun ... relating to some of the harsh environments inner city youth are subjected to ... The many meanings of the term COLD shape the brand behind it.” While indicating that the term “COLD” can have a number of meanings, the opponent considers the applicant’s statement on its website that, “We embody the unforgiving environments that form the breeding ground for creativity and art ... ” as very similar conceptually to his own interpretation of the word.

34. The opponent declares that, “Based on the type of works that have already been produced by “from the cold” it has caused a lot of confusion from customers, visually, orally and conceptually all of which distinguish a brand.” He has filed no evidence to support his statements.

35. In its counterstatement, the applicant points out that the opponent’s mark, as well as containing the word “COLD”, has “added stylisation, namely, illustrated depictions of cherubs on each of the included letters.” It goes on to say that the additional “FROM” and “THE” in its mark further distinguishes the respective marks and it denies that “the inclusion of these elements emphasises the word “COLD.””

36. The applicant also states that “FROM THE ... ” is the first part of the mark and that consumers generally pay more attention to the beginning of a mark than to the end and considers that they are more likely to forget or misremember the word “COLD” at the end. It contends that the words “FROM THE COLD” have no emphasis placed on any single word. It is also of the view that there are “perceptible and significant” aural differences between the marks.

37. Conceptually, the applicant considers that the opponent’s mark, in the context of clothing “would likely be understood as a descriptive reference to a quality or characteristic of the goods (or alternatively, it is simply non-distinctive – one of the key functions of clothing being to stop the wearer from becoming cold).” It therefore regards that opponent’s “COLD” as a word that consumers would likely understand as describing cold weather clothing or as a reference to the colloquial term “cool”, indicating that the opponent’s mark has desirable qualities or characteristics. By contrast, in the view of the applicant, the addition of “FROM THE ... ” causes “COLD” to be perceived as a place “(whether physical or as a state of mind (“cold” can also mean to be without emotion)).” It says that this interpretation is supported by the mark being part of the phrase “in from the cold” as in being accepted after having been ostracised or having spent a period in isolation.

38. I now carry out my analysis of the marks.

39. The opponents’ mark is figurative, consisting of the word “COLD” in spaced out bold block capitals adorned with four cherubs, one for each letter. The cherubs either hang from, stand on, or sit on the letters. The letters of the word are prominent and one’s eye is drawn to them given that they can be read, but the cherubs are definitely noticeable. However, I consider the word element to be the more dominant in the overall impression of the mark.

40. The applicant’s mark consists of the plain words “FROM THE COLD” in which no word dominates any other, the three words forming a unit. There are no other elements that contribute to the overall impressions of the mark.

41. Visually, although the word “COLD” in the opponent’s mark is common to the applicant’s mark, the word in the opponent’s mark is adorned with cherubs which are not separately displayed, but directly adorn the word. The applicant’s mark also has two additional words which precede the common word, “COLD”. Overall, I consider the marks to be of low to medium visual similarity.
42. Aurally, the respective marks would be pronounced as written. The applicant’s mark necessarily begins differently, in phonetic terms, but ends identically in that the last word of the applicant’s mark is identical to the single word in the opponent’s mark. I find the marks to be of medium aural similarity.
43. Conceptually, the opponent’s mark has the single word “COLD” which conveys the generic concept of something of a low temperature. The cherubs which adorn the word have a lesser conceptual role, conveying ideas of the angelic or of playfulness. The applicant’s mark “FROM THE COLD” would either give rise to the concept of something coming from a cold place or would engender thoughts of the phrase “coming in from the cold”, either literally, or in the sense of being brought back into the fold. Overall, I consider the marks to be of medium similarity conceptually.

Distinctive character of the earlier mark

44. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in *Joined*

Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

45. 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, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

46. The applicant states that the word in the earlier mark, “COLD”, “must be considered descriptive and / or non-distinctive. This is on the basis that the word would be understood by consumers as a reference to cold-weather clothing or, alternatively, to clothing that is intended to keep the wearer cool.” According to the applicant “the Earlier Mark obtains its distinctive character from the included stylised depictions of cherubs”.

47. While the word “COLD” could be suggestive of the goods to the extent that clothing has the characteristic of protecting the body from cold, pointing to the low end of the spectrum of inherent distinctiveness, even if the earlier mark were to be used on items of clothing that are intended for use in warm weather, the word “COLD” in itself is very common and not particularly distinctive and would have at most a low to medium degree of distinctiveness. However, I take into account the cherubs that adorn the

letters of the mark which are not suggestive or allusive of the goods for which the mark is registered and so, overall, I find the mark to be of medium inherent distinctiveness. I do, however, bear in mind that the degree of distinctiveness of the earlier mark is only likely to be significant to the extent that it relates to the point of commonality between the marks² and in that respect, I find the word “COLD” alone to have a low to medium degree of distinctiveness at most.

Likelihood of confusion

48. 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 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 vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent’s trade mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

49. When compared with the applicant’s mark, I have found the earlier mark to be of low to medium visual similarity, and of medium similarity aurally and conceptually. The respective goods are identical and the average consumer, a member of the public, will pay a medium degree of attention during the purchasing process, except where the goods are at the top end of the market

² See, *Kurt Geiger v A-List Corporate Limited*, BL O-075- 13

where they will pay a high degree of attention, with visual considerations usually predominating in both cases. The earlier mark is of medium inherent distinctiveness, with the word alone that is common to the later mark being of a low to medium degree of distinctiveness at most.

50. I consider there to be sufficient differences between the opponent's mark and the applicant's mark to avoid them being mistakenly recalled as each other. The opponent's mark is adorned with cherubs, while the applicant's mark is a plain word mark which has two additional words which are not present in the opponent's mark. The average consumer could not fail to notice these differences when considering the respective marks. There is no likelihood of direct confusion.

51. 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 recognised that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: "The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark."

52. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. considered the impact of the CJEU's judgment in *Bimbo*,

Case C-591/12P, on the court's earlier judgment in *Medion v Thomson*. The judge said:

“18. The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19. The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20. The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21. The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a

likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

53. While the average consumer would notice the differences between the marks, I now consider whether they would see one as a brand variation of the other, or whether there is some other reason why they would conclude that the goods come from the same or an economically linked undertaking. “FROM THE COLD” forms a wholistic unit i.e. these words are likely to be perceived and remembered cohesively as “FROM-THE-COLD” (the preposition – the linking word – “FROM” indicating the source or provenance of “THE COLD”) rather than segmentally as “FROM” plus “THE” plus “COLD” or “FROM/THE/COLD”. As such, the word “COLD” in “FROM THE COLD” does not perform an independent distinctive role within the mark. As noted in *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, I must guard against finding that there is a likelihood of indirect confusion merely due to the presence of a common element in the marks.

54. I am also conscious of the examples referred to in the *L.A. Sugar* case:

“17. Instances where one may expect the average consumer to reach such a conclusion [that the later mark is another brand of the owner of the earlier mark] tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

Looking at the examples given above, the common element is by no means strikingly distinctive, nor does this case involve a logical and consistent change of elements. However, while “FROM THE ... ” could be said to add a non-distinctive element to the earlier mark, it does not constitute a plausible sub-brand because the word in the earlier mark, “COLD” would be read as an adjective by contrast with the preceding words of the later mark which result in the word “COLD” in that mark being a noun. Furthermore, the fact that one mark is adorned with cherubs and the other is not weakens the argument for brand variation.

If the marks in question were “COLD”/“FROM COLD” there would be some logic in the branding i.e. “COLD”/“FROM (the owners of) COLD”, but the marks at issue do not link together in that way. Consequently, when considering Iain Purvis Q.C.’s analysis of the average consumer’s mental process in the *L.A. Sugar* case, “COLD” and “FROM THE COLD” would not prompt the average consumer to consider that what the marks have in common derives from them being part of the same or related undertakings. At most, one mark might be called to mind by the other and that is not a sufficient basis for a finding of indirect confusion, it being mere association (as noted in the *Duebros Limited* case). Overall, I find no likelihood of indirect confusion between the marks in this case.

CONCLUSION

55. The opposition has failed. The application will proceed to registration, subject to appeal.

COSTS

56. The applicant having been successful, I award it £200 for considering a notice of opposition and filing a counterstatement, that being the capped amount for that type of activity in fast track oppositions as per Tribunal Practice Notice 2 of 2015.

57. I order Kamal Tinglin-Drummond to pay FROM THE COLD LTD the sum of £200. 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 23rd day of September 2021

JOHN WILLIAMS
For the Registrar