

O-615-22

**TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK APPLICATION NO. 3562249
BY CPM UNITED KINGDOM LIMITED
TO REGISTER**



**AS A TRADE MARK
IN CLASS 35
AND OPPOSITION THERETO (UNDER NO. 425457)
BY
BFS GROUP LIMITED**

Background and pleadings



1. CPM United Kingdom Limited (“the applicant”) applied to register the trade mark set out on the title page of this decision on 30 November 2020. The mark was published on 9 April 2021 in class 35. On 9 September 2021, the applicant requested an amendment to its published services by means of a form TM21B. The services now stand as:

Marketing services; social media marketing; field marketing; direct marketing; in-store marketing services; retail marketing; retail consumer insight analysis, advice and assessment; retail consumer research; production, acquisition and evaluation of retail consumer intelligence; advisory services in relation to retail consumer intelligence; digital and electronic marketing services; market and marketing research, analysis and evaluation; marketing strategy development and implementation; market and consumer surveys; market research and analysis; qualitative market research; provision of market and marketing information; marketing and business reporting; marketing methodology services; market testing; market positioning; consumer research and analysis; provision of sales advice and consulting services; merchandising services; provision of marketing, sales, retail and merchandising support; compilation and analysis of sales and marketing data; promotional services; promotional consulting and support services; applied sales consultancy; retail consultancy services; retail sales auditing services; advertising and publicity services; dissemination of advertising matter; business research, analysis and information services; demonstration of products; distribution of samples; brand consultancy services; brand performance analysis and evaluation; promoting the sale of goods or of services of others through the distribution of printed materials and advertising design for promotional contracts; management administration of firms in respect of sales of goods or of services; promoting the sale of goods or of services of others through the distribution and positioning of point of sale materials; consultancy, advisory and information services relating to all the aforesaid services.

2. BFS Group Limited (“the opponent”) opposed the application in full on 9 July 2021, under sections 5(2)(b) and 5(4)(a) of the Trade marks Act 1994 (“the Act”). The section 5(4)(a) pleading was subsequently withdrawn and the proceedings continued

under section 5(2)(b) only. The opponent relies on three earlier UK trade marks, the details of which are set out below (the services are identical in each case).

Earlier UK TMs	Services relied on
<p>UK TM No.3338039</p>  <p>(series of two)</p> <p>Filing date:12 September 2018 Registration date: 14 December 2018</p>	<p>Class 35: <i>Organisation, operation and supervision of sales and promotional incentive schemes; publicity, promotional and advertising services; marketing services; information, advice and business assistance, all relating to the aforesaid services.</i></p> <p>Class 36: <i>Issue and redemption of tokens and vouchers; discount card services; credit, debit and charge card services; information and advisory services, all relating to the aforesaid services.</i></p>
<p>UK TM No.3338034</p>  <p>(series of two)</p> <p>Filing date:12 September 2018 Registration date: 14 December 2018</p>	<p>As above</p>

<p>UK TM No.3338037</p>   <p>(series of two)</p> <p>Filing date: 12 September 2018 Registration date: 14 December 2018</p>	<p>As above</p>
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3. The applicant filed a defence and counterstatement in which it denied all the claims made against it.

4. The opponent's registrations are earlier marks, in accordance with section 6 of the Act, but as none have been registered for five years or more before the filing date of the application, they are not subject to the proof of use requirements, as per section 6A of the Act.

5. The parties have been represented throughout these proceedings. The applicant by Decisis Limited and the opponent by HGF Limited.

6. Only the applicant filed evidence during these proceedings. A hearing was requested and took place before me, via video conference, on 12 May 2022. The applicant was represented by Mr Michael Bilewycz of Decisis Limited and the opponent by Mr Lee Curtis of HGF Limited.

Preliminary issue

7. 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 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.

Applicant's evidence

8. The applicant's evidence consists of the following witness statements, all dated 10 February 2022, and all with appended exhibits.

- Witness statement in the name of Michael Bilewycz, the applicant's legal representative, who appended two exhibits.
- Witness statement in the name of Nicholas Jones, the Chief Operating Officer for the CPM Group which operates as an umbrella for the CPM Group of companies including the applicant. Mr Jones appended one exhibit.
- Witness statement in the name of Nigel Davey, a marketing consultant, who appended three exhibits.

9. I have read the witness statements and all the exhibits but do not intend to summarise the evidence in detail here but suffice to say that it consists of a detailed analysis of the services provided under the respective trade marks by the applicant and the opponent.

10. The opponent criticised the evidence in its skeleton argument by stating that, "...what is being considered is not that the respective parties use of the two trade marks, which is what the applicant's evidence principally centres on, but whether a trade mark application covering a range of services is confusing with three earlier trade mark registration which are not open to proof of use. A key question in this opposition centres on the concept of 'notional fair use'. This refers to use across the range of goods/services claimed in any way that would be considered to be normal use of the trade mark in relation to the goods/services in question. The fact that the goods/services may only be sold in a certain environment or in a special price range, should not be taken into account when deciding the case. The full breadth of the earlier trade mark registrations must be considered."

11. I agree with the opponent's submission on the point of notional and fair use and will proceed on that basis without further reference to the applicant's evidence as it does not assist me in the considerations I must undertake.

Decision

12. Section 5(2)(b) of the Act states:

"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, or there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

13. In making this decision, I bear in mind the following principles 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 services

14. With regard to the comparison of services, in the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*¹, the court stated at paragraph 23 that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

15. When it comes to assessing services which are identically worded to those of the opponent, or those terms in either parties’ specifications which are broad enough to encompass narrower terms then I shall rely on the principle outlined in *Gérard Meric v Office for Harmonisation in the Internal Market*,² in which 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 für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

16. The services to be compared are

¹ Case C-39/97

² Case T- 133/05.

Opponent's relied on services	Applicant's amended services
<p><i>Class 35: Organisation, operation and supervision of sales and promotional incentive schemes; publicity, promotional and advertising services; marketing services; information, advice and business assistance, all relating to the aforesaid services.</i></p>	<p><i>Class 35: Marketing services; social media marketing; field marketing; direct marketing; in-store marketing services; retail marketing; retail consumer insight analysis, advice and assessment; retail consumer research; production, acquisition and evaluation of retail consumer intelligence; advisory services in relation to retail consumer intelligence; digital and electronic marketing services; market and marketing research, analysis and evaluation; marketing strategy development and implementation; market and consumer surveys; market research and analysis; qualitative market research; provision of market and marketing information; marketing and business reporting; marketing methodology services; market testing; market positioning; consumer research and analysis; provision of sales advice and consulting services; merchandising services; provision of marketing, sales, retail and merchandising support; compilation and analysis of sales and marketing data; promotional services; promotional consulting and support services; applied sales consultancy; retail consultancy services; retail sales auditing services; advertising and publicity services; dissemination of</i></p>

	<p><i>advertising matter; business research, analysis and information services; demonstration of products; distribution of samples; brand consultancy services; brand performance analysis and evaluation; promoting the sale of goods or of services of others through the distribution of printed materials and advertising design for promotional contracts; management administration of firms in respect of sales of goods or of services; promoting the sale of goods or of services of others through the distribution and positioning of point of sale materials; consultancy, advisory and information services relating to all the aforesaid services.</i></p>
<p><i>Class 36: Issue and redemption of tokens and vouchers; discount card services; credit, debit and charge card services; information and advisory services, all relating to the aforesaid services.</i></p>	

17. The opponent claims in its skeleton argument that,

“All of the applicant’s services are literally identical, such as ‘marketing services’ or fall within the general category of publicity, promotional, advertising or marketing services such as ‘*social media marketing*’ or ‘*digital and electronic marketing services*’. Therefore, according to the principal set

out in *Gerard Meric*, the respective services should be seen as identical or are identical from a literal reading of the respective specifications.”

18. The applicant, for its part, accepted at the hearing that it would “acknowledge the applicability of the *Meric* case” in the comparison of services.

19. Taking these views into account, I will proceed on the basis that the applicant’s services are either literally identical or *Meric* identical to the opponent’s class 35 services. I do not need to consider the opponent’s class 36 services as it does not put the opponent in any stronger a position.

Average consumer and the purchasing act

20. I next consider who the average consumer is for the contested services and the way in which these are purchased. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer’s level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

21. In *Hearst Holdings Inc*³, 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.”

22. The average consumer of the contested services are businesses. The applicant stated in its skeleton argument that business professionals would exercise “a very

³ *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)

high degree of care and attention” when procuring or purchasing the contested services. I agree that organising marketing promotions or launching a publicity campaign are services for which business may pay a considerable sum and would indeed require a high degree of attention in the purchasing process. The process itself would be primarily visual but clearly there would be an aural element involved in dealing with professional marketing advisors for example.

Comparison of the marks

23. It is clear from *SABEL* (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 in *Bimbo* that:

“... it is necessary to ascertain in each individual case, the overall impression made on the target public by the sign for which the 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.”⁴

24. It would be wrong, therefore, artificially to dissect the 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 created by the marks.

25. The respective marks to be compared are shown below:

Opponent’s earlier registrations	Applicant’s mark
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⁴ Paragraph 34.

<p>UK TM 3338039</p>  <p>UK TM 3338034</p>  <p>UK TM 3338037</p> 	
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26. Each of the opponent's earlier registrations comprises a series of two marks. The difference between the marks in each series is that one mark is depicted in colour and the other is depicted in its greyscale equivalent. The earlier registrations all share the same presentation namely the word **safari** in a lower case stylised font set above a smaller sized word, these being **rewards**, **boost** and **xtra**. In the case of the words **boost** and **xtra**, they are presented inside a shaped border. For the earlier registration ending '039, the word **safari** has a different colour for each letter whereas for the other two earlier marks, the words **safari boost** and **safari xtra** are set out in one single colour. I find that the additional words, namely **rewards**, **boost** and **xtra** are not particularly distinctive given the nature of the services being incentive and promotional related services and whilst the stylisation of the earlier marks is not negligible, to my mind it will be the word **safari** which plays the greatest role in the overall impression of these marks, with the additional words being somewhat subordinate in their significance.

27. The applicant's mark is a composite arrangement consisting of words and a device. The device is an arrangement of multi-coloured concentric circles positioned

in front of the words **retail safari**. The word **retail** is in block capitals and in a sans serif font and the word **safari** is in lower case, in bold and in a serif font. I find the word **retail** to be non-distinctive in relation to services specifically provided in the retail sector but find it has little distinctive character even in relation to the other services. Given the size and position of the device I find it does make a contribution to the overall impression of the mark, but I consider the word **safari** to be the dominant element with **retail** playing a subordinate role.

28. In a visual comparison, the word in common to all marks is **safari**. In the opponent's registrations it is the first word, whereas in the applicant's mark it is the second word. Each of the respective marks has an additional word as a point of difference, although I have found that those words lack distinctiveness to varying degrees. The stylisation and device elements will also make a visual difference. Taking all the factors in to consideration, I find that the marks are visually similar to a medium degree.

29. In an aural comparison, the device and stylisation element will play no role so it is a direct comparison of the word elements. As previously stated, the word in common to all marks is **safari** which will be given its usual pronunciation and will be identical in each case. For the opponent's registration the word **safari** will be articulated first and will likely have the second word articulated as well if customers are distinguishing between the various schemes. For the applicant's mark, customers are also likely to articulate both word parts of the mark as they are presented side by side with no obvious break between them. Overall I find the respective marks to be aurally similar to a medium degree.

30. In terms of a conceptual comparison, the shared word **safari** will bring to mind its usual dictionary definition, namely "an organised journey to look at, or sometimes hunt, wild animals, especially in Africa"⁵. The additional words in the opponent's registrations **rewards**, **boost** and **xtra** will all be seen as words which in some way remunerate, enhance or increase. With regard to **xtra**, although it is misspelled, it is a very common misspelling of the word 'extra' in trade mark terms and additionally is

⁵ [SAFARI | meaning in the Cambridge English Dictionary](#) – accessed 14/7/22

a phonetic equivalent so consumers will see it as simply meaning 'extra'. In the syntax of the applicant's mark, the word **retail** acts as an adjective and therefore attributes a feature of the word **safari**, namely that it operates in some retail context. The applicant's device has no conceptual meaning. Taking all these factors into account I find that the respective marks have a conceptually identical distinctive element in **safari** resulting in an overall medium level of conceptual similarity.

Distinctive character of the earlier marks

31. The degree of distinctiveness of the earlier marks must be assessed. This is because the more distinctive the earlier marks, based either on inherent qualities or because of use made, the greater the likelihood of confusion. In *Lloyd Schuhfabrik Meyer*⁶ 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).”

⁶ *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97

32. As there is no evidence before me in relation to enhanced distinctiveness, I am only considering the inherent distinctiveness of the earlier registrations.

33. As previously stated, the earlier registrations are constructed in the same way namely the word **safari** plus the additional words **rewards**, **boost** and **xtra**. I find the additional words to be low in distinctive character (even for the misspelling of 'extra') in relation to the services. The word **safari** has no meaning in relation to the services and increases the overall level of distinctive character in the marks as a whole to a medium degree.

Likelihood of confusion

34. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them that they have kept in mind.⁷ I must also keep in mind the average consumer for the services the nature of the purchasing process and have regard to 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 services and vice versa.

35. 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 and services down to the responsible undertakings being the same or related.

36. In *L.A. Sugar Limited*⁸ Mr Iain Purvis Q.C., as the Appointed Person, explained that:

⁷ *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27

⁸ *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

37. Whereas in *Liverpool Gin Distillery*⁹, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion. Moreover, it is not sufficient that a mark merely calls to mind another mark as set out in *Duebros*¹⁰. This is mere association not indirect confusion.

38. I am also guided by the judgement given in *Whyte and Mackay Ltd*¹¹, where Arnold J. (as he then was) considered the impact of the CJEU’s judgment in *Bimbo*¹², 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

⁹ *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207

¹⁰ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

¹¹ *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch)

¹² Case C-591/12P

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.”

39. So far in this decision I have found that,

- the services are identical

- the average consumer will pay a high level of attention during a primarily visual purchasing process although an aural element is also accepted
- there is an overall medium degree of visual, aural and conceptual similarity
- the earlier registrations as a whole have a medium degree of inherent distinctive character

40. In considering direct confusion first, I find that the respective marks share the word **safari** but the word is positioned differently in each mark, i.e. in the earlier registrations it is the first word followed by different second words whereas in the applicant's mark it is the second word preceded by a different first word and a device. Taking into account the case law relating to the notion of imperfect recollection, I find the shared word element is outweighed by these differences which, in my view, changes things sufficiently for the average consumer not to directly confuse the marks, that is to mistake one mark for the other even for identical services. As such I do not find there is a likelihood of direct confusion.

41. Having found no likelihood of direct confusion, I turn to the possibility of indirect confusion. I remind myself of the guidance given in *L.A. Sugar* that indirect confusion requires a consumer to undertake a thought process whereby they acknowledge the differences between the marks yet attribute the common element to a shared undertaking, taking the later mark to be a possible brand extension or sub brand of the earlier marks. I am also alert to the guidance in *Duebros* that a finding of indirect confusion should not be made simply because two marks share a common element.

42. I have previously found that the word **safari** plays an independently distinctive role in the marks and the additional words lack some degree of distinctiveness. It follows then that the first point raised in the *Whyte and Mackay* extract shown above is applicable here, namely, that the word in common is the most distinctive element and therefore consumers may be confused into thinking there is a similarity to the same element in the earlier marks. I also find that the additional non-distinctive words in each case all perform the role of adding a qualifying attribution to the word **safari** in some way. For example, the additional words in the opponent's earlier

registrations can be seen as sub brands or different schemes of the **safari** service offering. I find that the word **retail** also performs the same function and could be seen as a plausible brand extension or sub brand and consumers will likely see the services as coming from the same undertaking. Therefore I find there is a likelihood of indirect confusion.

Conclusion

43. The opposition has succeeded in full. Subject to any appeal against this decision, the application is to be refused.

Costs

44. The opponent has been successful, so it is entitled to a contribution towards the costs incurred in these proceedings. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 2/2016. Although ultimately the applicant's evidence was not a factor in my decision, nonetheless it had to be considered by the opponent so I have made a provision for it in the costs set out below. Bearing in mind the guidance given in TPN 2/2016, I award costs as follows:

£100 Notice of Opposition fee¹³

£300 Considering the counterstatement

£300 Considering the other side's evidence

£500 Preparation for and attending a hearing

£1200 Total

45. I order CPM United Kingdom Limited to pay BFS Group Limited the sum of £1200. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

¹³ Although the opponent initially opposed under section 5(2)(b) and 5(4), the latter ground was withdrawn without being evidenced so the case proceeded on 5(2)(b) only. Therefore I have reduced the opposition fee accordingly.

Dated this 20th day of July 2022

June Ralph

For the Registrar

The Comptroller-General