

O/665/22

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NUMBER 3608922

BY

ICE COOL DESIGNERS LIMITED

TO REGISTER THE FOLLOWING TRADE MARK
IN CLASS 25



AND

OPPOSITION THERETO UNDER NUMBER 426142

BY

GILMAR S.P.A.

Background and Pleadings

1. On 12 March 2021, Ice Cool Designers Limited (“the Applicant”) applied to register in the UK the trade mark as displayed on the front cover page for ‘*Clothing; Clothes; Tops [clothing]; Leisure clothing; Casual clothing; Denims [clothing]; Shorts [clothing]*’ in class 25. It was accepted and published in the Trade marks Journal on 14 May 2021.

2. GILMAR S.P.A.(“the Opponent”) issued opposition proceedings on 16 August 2021, under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). It relies on its two earlier trade mark registrations as set out below:

i. UKTM no. 910941615

ICE

Filed on 6 June 2012 and registered on 9 June 2017 for goods and services in classes 9, 11, 16, 18, 20, 21, 24, 25, 27 and 35. For the purposes of this opposition it relies upon the following goods and services:

Class 9: Sunglasses

Class 18: Leather and imitations of leather, and goods made of these materials and not included in other classes; Animal skins, hides; Trunks and travelling bags; Umbrellas, parasols and walking sticks.

Class 25: Clothing, footwear, headgear.

Class 35: Sales services for bringing together, for others, of a variety of goods, (excluding the transport thereof), enabling customers to conveniently view and purchase those goods, in particular leatherware, clothing, footwear, headgear.

ii. UKTM no. 915402266

ICE PLAY

Filed on 5 May 2016 and registered on 6 October 2016 for goods in the following classes:

Class 18: Hand bags; Travel bags; Card holder and briefcases; Leather briefcases; Leather credit cards holders; Wallets; File folders made of leather; Leather key cases; Bags; Suitcases; Empty bags for cosmetics; Sports bags included in this class; Bags for athletics; Shoulder bags for ladies; Leather bags for shopping; School bags; Travel garment bags; Shoe bags for travel; Beach bags; Backpacks; Boston bags; Travelling trunks; Canvas bags; Briefcase bags; Trolleys; Folders; Beauty cases sold empty; Leather; Leather cases and boxes; Leather covers; Leather straps; Umbrellas; Leather leashes; Purses belts; Faux furs; Semi-worked furs.

Class 25: Clothing; Footwear; Headgear; Caps; Headbands; Sun visors; Clothing for men and women; Clothing for babies and children; Clothing for kids; Sportswear; Dresses; Bathrobes; Leisurewear; Bandanas; Headscarves; Underwear; Socks; Trousers; Shirts; Coats; Fur coats; Stoles; Jackets; Belts; Ties; Sweatshirts; Jackets; Skirts; Jeans; Jerseys; Knitwear; T-shirts; Sweaters; Trousers; Scarves; Tee-shirts; Suits; Leather clothing; Pajamas; Swimwear; Shorts; Sarongs; Boots; Sandals; Slippers.

3. The Opponent pleads that the sign applied for contains “www.icecoolfashion.com”, which plays an independent role within the composite sign. It is contended that the element ‘icecoolfashion’ is the key part of this element since the remaining elements are generic components of a domain name and that the average consumer will clearly understand the sign as comprising three words namely ice, cool and fashion. The first word is the distinctive first and primary element of the sign and is identical to the sole verbal element of the first earlier mark and first element of the second earlier mark. Furthermore, the words ‘cool’ and ‘fashion’ in the context of the goods are descriptive and non-distinctive or alternatively of weak distinctive character. The Opponent claims that the additional elements of the sign do not distinguish the standalone character of the element ‘www.icecoolfashion.com’ from the earlier marks. Consequently, the marks are highly similar overall. In respect of the goods in class 25, it is claimed that they are identical and/or similar to the goods and services of the earlier marks.

4. In addition the Opponent relies on an earlier decision of the registry dated 23 February 2021, under number BL O/115/21, which it states has parallels with the decision in suit and should be followed. The Opponent contends that, in view of the strong similarity between the contested mark and the earlier marks and the identity/similarity of the goods/services, there exists a likelihood of confusion on the part of the public including indirect confusion and association.

5. The Applicant filed a defence and counterstatement denying the claims made. In particular, it denies that the respective marks are similar since the application is a complex, composite mark consisting of a number of elements. It argues that it is the words Paulo Due which are the most prominent elements of its application. It contends that both marks consist of additional elements which have no counterpart in the other's mark; visually and aurally the marks are distinct and conceptually they do not share the same concept. The Applicant admits that the goods applied for are identical/similar to those covered by the earlier marks.

6. The Opponent relies upon both its UKTMs which qualify as earlier trade marks pursuant to section 6 of the Act. Neither mark completed its registration process more than five years before the filing date of the application and consequently the Opponent may rely on the entirety of the goods and services of its registrations without having to demonstrate use.

7. Both parties are represented, the Opponent by Boulton Wade Tennant LLP and the Applicant by ip21 Limited. Only the Opponent filed evidence during the evidence rounds. The Applicant, however, filed submissions dated 24 January 2022. The Opponent requested to be heard on the matter, that hearing took place before me on 30 May 2022 via video conference. At the hearing the Opponent was represented by Mr Christopher Hall (counsel) of 11 South Square chambers, instructed by Boulton Wade and Tennant LLP. Neither the Applicant nor its representative attended the hearing however it filed submissions in lieu of hearing dated 26 May 2022. In so far as the submissions filed, I do not propose to summarise them, but I have considered their content and shall refer to the salient points later in my decision.

8. 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. That is why this decision continues to refer to the case law of the EU courts on trade mark matters.

Evidence

9. The Opponent's evidence consists of the witness statement of Catherine Wolfe dated 22 November 2021, together with 10 exhibits marked CW1-CW10.

10. Ms Wolfe is a chartered trade mark attorney and a partner in the firm of the Opponent's representative. She has conducted the opposition proceedings and has authority to complete the statement on her client's behalf.

11. Ms Wolfe exhibits a number of documents to her statement and provides comments regarding the contents of this material, these are outlined as follows:

- Earlier decision under reference O/115/21.¹
- Appeal decision O/660/21 and Appeal decision order dated 10.9.21.²
- Print outs taken from the Applicant's website "www.icecoolfashion.com" dated 18 November 2021. Ms Wolfe states that icecoolfashion.com is displayed at the top of the homepage and towards the bottom there is a welcome statement which reads "*Welcome to icecoolfashion – welcome to icecoolfashion.co! ICE is a fresh and exciting online store that has grown from having high profile retail stores in many shopping centres.....*"³
- Print outs taken from www.amazon.co.uk dated 18 November 2021 are produced showing the Applicant's store on this platform. A copy of the banner (reproduced below) from the Applicant's store, as it appears on Amazon's website, is produced.⁴

¹ CW1

² CW2 and CW3

³ CW4

⁴ CW5



- Various screenshots are produced taken from www.debenhams.com; [www.marks and spencer.com](http://www.marksandspencer.com); www.johnlewis.com; www.direct.asda.com and www.ralphlauren.com all dated 18 November 2021. The purpose of these screenshots is to show that the retailers identified, promote sub brands on their main 'house mark' websites and use a number of trade marks together in conjunction with their main brand name. Screen shots are produced showing the use of Marks and Spencer alongside Per Una/Autograph; Debenhams together with Mantaray; John Lewis and ANYDAY; Asda together with George; Ralph Lauren alongside PURPLE LABEL.⁵

Decision

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

“5(2) A trade mark shall not be registered if because-

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

13. 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

⁵ CW6-CW10

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 the goods/services

14. The Applicant seeks registration for '*Clothing; Clothes; Leisure clothing; Casual clothing; Tops [clothing]; Denims [clothing]; Shorts [clothing];*' It concedes that the applied for goods are identical to those covered by the earlier marks either self-evidently or in accordance with the principles as outlined in *Meric*.⁶ The Opponent submits that the respective goods are identical.

15. I agree. The Applicant's terms "*Clothing; Clothes*" are self-evidently identical to the Opponent's *Clothing*. Its remaining terms namely "*Tops [clothing]; Leisure clothing; Casual clothing; Denims [clothing]; Shorts [clothing]*" are all items of clothing encompassed within the Opponent's general category of goods and thus identical in accordance with the principles in *Meric*.

16. On this basis, I consider that it is not necessary for me to undertake a further assessment against the Opponent's remaining goods/services as relied upon, as this does place it in any stronger position. Having raised this approach with Mr Hall at the hearing he confirmed he was content for me to proceed on this basis.

Average consumer and the purchasing process

17. When considering the opposing marks the average consumer is deemed reasonably informed and reasonably observant and circumspect. For the purposes of assessing the likelihood of confusion the average consumer's level of attention is likely to vary according to the category of goods in question.⁷

⁶ Para 34 submissions dated 24 January 2022; *Gérard Meric v Office for Harmonisation in the Internal Market (OHIM)*, Case T-133/05.

⁷ *Lloyd Schuhfabrik Meyer*, case c- 342/97.

18. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J described the average consumer in these terms:

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

19. Neither party addressed the question of the average consumer or the purchasing process in their pleadings or submissions. However, at the hearing, when pressed, Mr Hall confirmed that the selection process for the goods would be predominantly visual. He submitted that no more than an average level of attention would be undertaken. I agree. Overall, I consider that the contested goods will be directed at members of the general public, who select the goods by inspection from rails or shelves of retail premises or their online equivalents. Aural considerations may also play a part, where requests are made to sales assistants for example.⁸ Whilst accounting for variations in price, overall, the goods are neither particularly expensive nor infrequent purchases, with considerations such as fashion trends, price, quality and suitability/fit taken into account in the selection process. For these reasons, I consider that an average degree of attention will be undertaken in the purchasing process i.e. no higher or lower than the norm for such goods.

Comparison of marks

20. 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

⁸ *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03

CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

21. It would be wrong, therefore, 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.

22. The respective trade marks are shown below:

Applicant's Mark	Opponent's Marks
	<p data-bbox="858 1055 1102 1084">First earlier mark</p> <p data-bbox="858 1155 1182 1312">ICE</p>
	<p data-bbox="858 1337 1150 1366">Second earlier mark</p> <p data-bbox="959 1447 1150 1485">ICE PLAY</p>

Relevance of previous decision

23. The Opponent refers to the previous decision of Ms C Boucher, the Registrar's Hearing Officer, (O/115/21) in relation to the same parties stating that, as a result of the parallels between that decision and the decision in suit, I should follow the same outcome as previously determined in the Opponent's favour. Mr Hall referred me to

the case of *Asia Standard* (at first instance⁹ and on appeal¹⁰) in which Mr Justice Smith confirmed that the approach taken by the Hearing Officer in adopting the findings of an earlier decision was legitimate. Mr Hall invited me to adopt the same approach and to “rely heavily upon the result of the earlier decision between the parties”. The Applicant however submitted that ‘each case must be considered on its own merits and the opposition and appeal history of ‘icecoolfashion’ is irrelevant....the prior proceedings between the parties should have no bearing on the present case. These proceedings concern an entirely different mark.”

24. This case is not on all fours with the situation which arose in *Asia Standard*. In that decision the hearing officer concluded that the differences between the original trade mark and the new application were not material, such that it entitled him to adopt the earlier findings. He found that:

“26. The only difference between the marks in the original decision and in the instant case are the stylised letters “A” and “S” at the start of the mark.the average consumer is likely to look at the stylised letters and initially dismiss them as being of no consequence, only realising after they have read the rest of the mark that they are the letters “A” and “S” and so are a shorthand reference to Asia Standard. **In my opinion, the reduction of similarity represented by the stylised letters “AS” at the start of the applicant’s mark is sufficiently small that the marks continue to share a medium degree of similarity overall.** [original emphasis]”

25. Firstly, I am not bound by my colleague’s decision, and, secondly, I consider that in the case before me the assessment is different. Whilst there may be some overlap in the elements of the respective applications, the additional elements which are present in the application before me, but which were omitted from the earlier application, are material to the comparison and therefore I consider it appropriate to approach the matter afresh, albeit that it is open to me to come to the same conclusion in relation to the comparison between the common elements already determined.

⁹ BL O/125/19

¹⁰ *Asia Standard Management Services Limited v Standard International Management LLC* [2020] EWHC 28 (Ch)

26. The Applicant submits:¹¹

“4. The Opponent’s Marks are short marks consisting of one and two words only. The Applicant’s Mark is a complex composite mark consisting of a number of elements. Given their size and positioning, the words ‘PAULO DUE’ and the figurative peace sign are by far the most memorable, dominant, and distinctive elements of the Applicant’s Mark. These elements play no part in the Opponent’s Mark.

5. The Applicant’s mark is visually distinct from the Opponent’s Marks. The only common element is the word ‘ice’ which is proportionately much smaller and clearly secondary in nature within the Applicant’s Mark. Furthermore, this word forms part of a domain name which, by its nature, has no inherent trade mark value. The Applicant’s mark is visually dominated by the words ‘PAULO DUE’ and the figurative peace sign, which play no part in the Opponent’s Mark.

6. The Applicant’s mark is phonetically distinct from the Opponent’s mark. Given that the overall impression of the Applicant’s mark is dominated by the words PAULO DUE and the figurative peace sign (the latter of which is not pronounced), it is most probable that the words ‘PAULO DUE’ will be the only part of the Applicant’s Mark which is articulated – in which case the marks will be aurally dissimilar since this element plays no part in the Opponent’s marks, which will be pronounced ‘ICE’...

7. Given its positioning and non distinctive nature, it is highly unlikely that the domain name ‘www.icecoolfashion.com’ will be verbalised by the average consumer when referring to the Applicant’s mark. In the unlikely event that the domain name is verbalised, it will be pronounced in full, “www.icecoolfashion.com”, as is usual with domain names.

8. The Applicant’s mark is conceptually distinct from the Opponent’s marks. The Opponent’s marks convey a message that the goods sold under it are cold frozen, icy and bleak. The words ‘ICE’ and ‘ICE PLAY’ therefore have no meaning in the context of the goods registered. By contrast the ‘ice cool’ element of the Applicant’s Mark is slang for something which is highly desirable

¹¹ Submissions in lieu of hearing 26 May 2022

and up to date, the coolest there is. 'Ice cool' is a term which has been in widespread use for several decades to describe a person's demeanour. Applying this description of ice cool to the Applicant's goods, consumers would understand the goods clothing to be fashionable and attractive. The words ICE and ICE COOL do not mean the same thing in relation to the goods at issue.

9. Regarding the other, more dominant, and distinctive elements the Applicant's Mark, these have no immediate meaning to the English speaking consumer since they are not recognised words in the English dictionary."

27. At the hearing and in its submissions/skeleton arguments Mr Hall submitted that:

"... the way in which clothing is routinely advertised means that the average consumer will perceive the Applicant's sign as being comprised of two separate and independently distinctive components; on the one hand the words Paulo Due together with the hand gesture and the other hand the URL. Commercially the sign will mean to the average consumer a Paulo Due brand of clothing originating from 'icecoolfashion'.

Thus the likelihood of confusion between 'icecoolfashion' and 'ICE' remains in the present application as it did in the earlier decision, notwithstanding the addition of the other elements, because the average consumer will continue to perceive the mark as indicating a source with a commercial connection to the Opponent."

Overall impression of the marks

The Opponent's marks

28. The Opponent's first earlier mark is for the word ICE presented in an emboldened conventional black type face in capitals. Notwithstanding the stylisation, I consider that the overall impression of the mark essentially resides in the word itself.

29. The Opponent's second earlier mark consists of the two words ICE and PLAY in combination. The overall impression resides in the totality of the two words both playing an equal part in the mark as a whole.

My approach

30. Whilst the Opponent in its pleadings relied on its second earlier mark, in his skeleton argument and at the hearing Mr Hall focused his attention on the first earlier mark, accepting that the first earlier mark presents the Opponent with its best case, given that the additional word 'PLAY' is further away in terms of similarity. I shall adopt the same approach, therefore, and focus my assessment on the first earlier mark, only returning to the second earlier mark if it becomes necessary to do so.

The Applicant's mark

31. The Applicant's mark is a complex figurative mark, consisting of a number of elements. These consists of the following;

- i. the words Paulo Due, presented in a stylised blue script.
- ii. a grey coloured pictorial element depicting the image of a hand, configured into a v sign. The Applicant describes this image as representing the peace sign, which is not challenged by the Opponent and which I accept is a fair characterisation.
- iii. sitting underneath these two elements, in a smaller unremarkable blue coloured typeface, is the web address www.icecoolfashion.com.
- iv. a shaded blue and white rectangle.

The mark as a whole

32. The Applicant submits that "given its size and positioning within the Applicant's mark as a whole, any impact this word [ice] may have on the overall impression conveyed will be very limited and is in any case likely to be non-distinctive in nature....the word ICE is negligible within [its] mark and it is the words PAULO DUE and the figurative peace sign which makes the greatest contribution to the overall impression."¹²

33. Given its relative size and central position, I agree that the words Paulo Due and the hand image naturally draw the eye and have the greatest impact in the overall impression of the mark. However, the web address www.icecoolfashion.com, cannot

¹² Para 22 submissions January 2022

be dismissed entirely as it contributes to the distinctiveness of the mark when regarded as a whole. The words “icecoolfashion” carry the greatest weight in this component, given that the elements “www.” and “.com” purely depict a URL address. Furthermore, even though these three words are presented as a single word they will be seen by consumers as three distinct separate words, namely “ice”, “cool” and “fashion”. In my view neither word particularly dominates the other as they will be seen in combination to form a unit to make a laudatory term that means ‘super trendy fashion’ or similar. I will discuss this in more detail in paragraph 47, below. The presentation and position of this component as a whole will give the impression of a web address/domain name.

34. The stylisation of the letters and use of colour, whilst contributing, play a more limited role in the overall impression of the mark as does the blue and white rectangle which will purely be seen as a background upon which the other elements are presented.

35. I will bear the above conclusions in mind when comparing the competing trademarks.

Visual comparison

36. The only point of visual overlap between the respective marks is the word ice which is the entirety of the earlier mark and the first word of the combination of three words ‘icecoolfashion’ within the web address of the contested mark. The additional elements present in the application as already outlined, create the greater visual differences between the marks, there being no counterpart in the earlier mark. Weighing up the similarities and the differences I consider that the marks are visually similar to a very low degree.

Aural comparison

37. The earlier mark consists of an ordinary English dictionary word ICE which will be given its normal pronunciation.

38. Mr Hall did not advance any specific submissions regarding the aural similarity or otherwise between the marks referring, instead, to the conclusions of the Hearing Officer in the earlier decision. Whereas the Applicant argues that it is most probable that the words Paulo Due will be the only part of its mark which is articulated. It is common ground between the parties, however, that the average consumer is unlikely

to articulate the pictorial hand image in the contested mark and that the mark will be referred to by reference to the verbal elements only.

39. I acknowledge that the additional elements included within the Applicant's mark results in potentially a number of different combinations as to how it will be pronounced by consumers, leading to a lesser or greater degree of aural similarity. Any pronouncement of the mark will be dependent on the consumer's immediate and instinctive reaction to it on first encounter¹³ and what they view as the element that acts as the identifier for the entity in question.

40. The way in which the component "www.icecoolfashion.com" is presented is much less dominant than the Paulo Due element and will be seen as a web address. Consequently, given its position, size and role within the mark the average consumer is unlikely to pronounce this element when referring to the mark aurally taken as a whole. It is my view that upon first impression, the average consumer is more likely to simply refer to the contested mark as Paulo Due given that it is this element which dominates and draws the eye and given that consumers have a tendency to refer or search for a mark by the shortest option possible. The examples of undertakings filed by the Opponent in its evidence are unlikely to be referred to in their entirety. For example, I do not consider that consumers would refer to Per Una as "Per-Una-www-dot-marks-and-spencer-dot-com" or "Per-Una-by-marks-and-spencer". When referring to the trade mark or when requesting goods marketed under this brand they will simply ask or search for "Per Una".

41. This is the exact same scenario in the decision in suit. I consider it unlikely that all the verbal elements of the Applicant's mark will be articulated in full and consider that the majority of consumers, if not all, will simply refer to it only by reference to the Paulo Due element, since it is this element which dominates the mark. In this scenario, there will be no aural similarity between the marks.

42. If some consumers do make reference to the web address then it is unlikely that they will refer to it in its entirety and are more likely, in accordance with normal practices, to omit the "www-dot" element, only referring to it as "ice-cool-fashion-dot-com". In this scenario, the words "Paulo Due" are very unlikely to be omitted and not

¹³ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

articulated, meaning it will be pronounced as “paulo-due-ice-cool-fashion-dot-com”. If the mark is pronounced in this way, it is my view that it will only be done by a small minority and an insufficient proportion of average consumers. Even if the consumer refers to the web address in full or in part, I do not find that it would focus only on the element “ice” given its position as a middle syllable and because the words “ice”, “cool” and “fashion” form a unit (see paragraph 47, below).

43. Taking into account these factors and my conclusions regarding the overall impression of the marks, since the only common element between the marks is the word “ice” and given the number of additional elements present in the application, regardless of the various ways in which the contested mark may be articulated, taking the position most favourable to the Opponent, overall the aural similarity between the marks is at best very low.

Conceptual comparison

44. Mr Hall adopted the conclusions of the Hearing Officer in the earlier decision as his submissions which he states were unchallenged on appeal namely:

“48. The word “ice” refers to frozen water which is self-evidently at a very low temperature and one of the coldest substances the average consumer would encounter in everyday life. For some consumers, the mark would convey a message that the goods sold under it are so exceptionally fashionable and attractive (or “cool”) that they are as cool as ice – a concept that plays on the multiple meanings of the word “cool”. For those consumers, the marks are conceptually similar to a fairly low degree..... Other consumers will think that “ice” has the same meaning as it does in the earlier mark with cool and fashion being allusive and descriptive. For these consumers the marks will be conceptually similar to a high degree.”

45. The Applicant submits that the marks do not share the same concept. It accepts that the earlier mark “conveys the message that the goods sold under it are cold, frozen, icy and bleak” and that the word has no meaning in the context of the goods registered. But, conversely, it submits that “the ‘ice cool’ element in [its] mark is slang for something which is highly desirable and up to date, the coolest there is”. Therefore ‘ice cool’ it says describes a person’s demeanour meaning that ‘ice cool’ versus ‘ice’ do not mean the same thing in relation to the goods. Furthermore, the Applicant

submits that the “more dominant and distinctive elements” i.e Paulo Due have “no immediate meaning to the English speaking consumer since they are not recognised in the English dictionary.”

46. In my view the ordinary natural meaning will be attributed to the word ICE in the earlier mark namely that of frozen water.

47. In the application, I agree that the words Paulo Due have no immediate meaning but I believe that this element will be perceived by the average consumer as a name of foreign origin, the first element most probably recognised as the Spanish/Italian equivalent for the name Paul. The image of the hand is said to represent the ‘peace sign’ but consumers may or may not recognise this concept immediately and merely see it as no more than an image of a hand. The element “www.icecoolfashion.com” will be seen as a web address with the common word ‘ice’ seen as part of a three word unit which will be understood to mean fashion that is ice cool ie clothes that are “on trend” or are super trendy or hip. In this context the word ‘ice’ acts as an intensifier to the word ‘cool’ in the same way as, for example, scorching is used as an intensifier in the phrase “scorching hot”. I agree with the Applicant that in combination the words “ice” and “cool” will be understood to mean “the coolest there is”. Within the web address the common word ‘ice’, therefore, does not retain any independent distinctive character. The word ‘fashion’ will be given its ordinary meaning and may be regarded as descriptive of the goods on offer namely those typically sold within the fashion industry. Therefore, the three words “ice cool fashion” will form a unit to describe, or at least very strongly allude to, the coolest fashion. First and foremost, however, the element “www.icecoolfashion.com” will be seen as a web address and I do not consider that consumers will undertake an overly analytical breakdown of the meaning of each individual component on first impression.

48. The marks therefore are conceptually similar to a very low degree; the common word ‘ice’ (solus) has a clear meaning in the earlier mark, but which when taking the Applicant’s mark as a whole and seen within the web address in combination with the words ‘cool’ and ‘fashion’ forms a unit which when viewed separately, has a different meaning.

Distinctive character

49. 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).

50. Registered trade marks possess varying degrees of distinctive character (inherent or enhanced), some being suggestive or allusive of a characteristic of the goods and services on offer, others being highly inherently distinctive, such as invented words. The assessment must be undertaken by reference to the goods and the way in which the trade mark is perceived by the relevant public.

51. Whilst the Opponent filed evidence, it did not provide any evidence of the use that it has made of its trade mark, for example detailing the revenue generated, how it has been used, or the amount spent on promoting the mark. Mr Hall, confirmed at the hearing, that the Opponent was not claiming it had acquired an enhanced degree of distinctive character and consequently I shall only consider the position based on inherent characteristics.

52. The word ICE is an ordinary dictionary word with a meaning which will be well known to the average consumer. It is neither allusive nor descriptive of the goods for which the earlier mark is registered. The slight stylisation of the typeface used does not increase the inherent distinctiveness of the mark, which remains in the word itself and which I assess at a medium degree.

Likelihood of confusion

53. When considering whether there is a likelihood of confusion between the two marks, I must consider whether there is direct confusion, where one mark is mistaken for the other or whether there is indirect confusion; where the consumer recognises that the marks are not the same but, nevertheless, puts the similarities between the marks and the respective goods/services down to the same or related source.

54. A number of factors must also be borne in mind when undertaking the assessment of confusion. 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 or services and vice versa. As I mentioned above, it is also necessary for me to keep in mind a global assessment of all relevant factors when undertaking the comparison. In doing so, I must consider 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.

55. Earlier in my decision I found the marks to be visually similar to a very low degree overall and taking the case most favourable to the Opponent aurally similar to at best a very low degree. Conceptually the marks are conceptually similar to a very low degree for the reasons already outlined. The goods are identical. The average consumer to whom the goods are directed will be general members of the public selecting the goods predominantly by visual means, but not discounting aural considerations, paying an average level of attention in the purchasing process. The earlier mark is inherently distinctive to a medium degree.

56. There is no mathematical formula which calculates whether a likelihood of confusion will arise between marks. It is not a process of stacking similarities and differences up against each other and arriving at an overall percentage which points in favour of confusion or not. As the caselaw suggests the assessment must look at the whole picture and what the average consumer takes from a mark on first impression.

57. The Applicant submits that:

13. There is no likelihood of either direct or indirect confusion arising. A situation where an average consumer mistakes the trade mark PAULO DUE for ICE...is unlikely to happen. And a situation where the average consumer believes that the undertakings are in some way connected seems unlikely when the trade marks at issue have nothing in common.

14. ...when presented with the marks, the average consumer will immediately perceive the words PAULO DUE and the figurative peace sign in the Applicant's mark and by contrast will perceive the words ;'ICE' in the Opponent's mark and therefore not mistake one mark for the other, nor will they consider the marks to be a brand extension/variation of each other.

58. In his skeleton argument and at the hearing Mr Hall submitted that:

"...the purpose of the URL being there is to capture the consumer's attention and direct it towards the parent brand. [The Applicant's] sign will be perceived (no doubt as it is intended to be) by the public as indicating...Paulo Due by IceCoolFashion... leading to a likelihood of confusion."

59. In this regard he states that it does not matter that there may be some consumers who are not confused merely that a significant proportion of the relevant public is.¹⁴

60. Furthermore Mr Hall states that the evidence demonstrates that:

"..the way in which clothing is routinely advertised means that the average consumer will perceive the Applicant's sign as being comprised of two separate and independently distinctive components; on the one hand the words Paulo Due together with the hand gesture and on the other hand the URL. Commercially the sign will mean a Paulo Due brand of clothing originating from icecoolfashion"

61. Mr Hall referred me to paragraphs 19 to 21 of Arnold J's judgement in *Whyte and Mackay Ltd v Origin UK Wine Ltd and Another*¹⁵ and argued that:

¹⁴ *Interflora Inc v Marks and Spencer Plc* [2015] FSR 10, at paragraph [129]

¹⁵ [2015] EWHC 1271 (Ch)

“this is one of those situations in which the average consumer, whilst perceiving the composite mark as a whole will also perceive that the URL portion of it has a distinctive significance which is independent of the significance of the whole.”

62. Keeping in mind my findings, I do not consider that the average consumer will fail to recognise the differences between the marks as identified earlier in my decision. In particular the element Paulo Due, the device and the words “cool” and “fashion” connected to the word “ice” within a domain name. These factors are therefore unlikely to lead consumers to directly confuse the two marks or mistakenly or imperfectly recall one mark for the other.

63. Moving on to consider indirect confusion. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

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

17. Instances where one may expect the average consumer to reach such a conclusion 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).”

64. Mr Purvis set out the circumstances which may lead consumers to indirectly confuse two marks, but those examples were not supposed to be an exhaustive list. As Lord Justice Arnold stated in *Liverpool Gin*¹⁶:

“12. This is a helpful explanation of the concept of indirect confusion, which has frequently been cited subsequently, but as Mr Purvis made clear it was not intended to be an exhaustive definition. For example, one category of indirect confusion which is not mentioned is where the sign complained of incorporates the trade mark (or a similar sign) in such a way as to lead consumers to believe that the goods or services have been co-branded and thus that there is an economic link between the proprietor of the sign and the proprietor of the trade mark (such as through merger, acquisition or licensing).”

65. Furthermore he stated that “trade mark law was about consumers’ unwitting assumptions, not what they could find out if they thought to check.” It is necessary therefore for me to bear this in mind when undertaking the assessment and whether the common element ‘ice’ when viewed within the application is sufficiently powerful when weighed against the differences, that despite these differences the average consumer’s imperfect recollection of either mark on encountering the other gives rise to a belief that the two entities are connected, leading to a likelihood of confusion.¹⁷

66. I also note in *Duebros* that Mr James Mellor QC, sitting as the Appointed Person, stressed that the finding of confusion should not be made merely because two marks share a common element, if a mark merely calls to mind another mark this is insufficient.

¹⁶ *Liverpool Gin distillery Limited v Sazerac brands LLC* [2021] EWCA Civ 1207

¹⁷ James Mellor as the appointed person on appeal in *Ashish Sutaria v Cheeky Italian Limited* O/219/16

67. I accept that the evidence filed by the Opponent supports the argument that it is common practice in the clothing industry for retailers to market and use one or more brands/trade marks to denote the trade origin of their goods, one often as a sub brand with the other as a house brand. Whilst examples are produced within Ms Wolfe's statement of Per Una and Marks and Spencer being marketed alongside each other as one such example, it is clear that they are both marketed as trade marks. Whereas, in the decision in suit, the element "www.icecoolfashion.com" appears as a web address and in my view will be seen as such by the average consumer. In order for this component to be seen as a house mark, it presupposes that the average consumer will recognise the words 'icecoolfashion' within the web address as the parent brand and furthermore in order for confusion to arise that the consumer will extrapolate the word ice from these three words and come to a conclusion that it is connected to the Opponent.

68. The general principles as outlined in paragraph 13 have long been established and endorsed by the courts namely that "the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components"(d) and "it is quite 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"(f).

69. In my view taking account of the decision in *Whyte and Mackay*, whilst the component 'www.icecoolfashion.com' has retained an independent distinctive role within the mark as a whole, I do not consider that the word 'ice' within this element has, for the reasons already outlined, namely that it will be seen as a unit with a different meaning in combination to its individual components. It is unlikely that a significant number of average consumers will extrapolate the word 'ice' from this component on first impression, when taking the mark as a whole and conclude that it is connected with the earlier mark given that it is dominated by the Paulo Due words and the hand image. For this to occur it would require a degree of scrutiny, that I do not believe would be undertaken by the average consumer paying only an average level of attention.

70. As Mr Geoffrey Hobbs QC commented, sitting as the Appointed Person in *Dirtybird Restaurants Ltd v. Salima Vellani*, BL O/413/18:

“18. There is no rule or presumption to the effect that the concurrent use of a trade mark and one of its components for identical or similar goods or services will always or necessarily give rise to the perception that the goods or services concerned come from the same or economically linked undertakings. That might or might not be the case. In order to determine whether it is, the decision taker must give as much or as little significance to the visual, aural and conceptual differences and similarities between the marks in issue as the relevant average consumer would have attached to them at the relevant point in time (which in this case was July/August 2015). It is axiomatic that the relevant average consumer is to be regarded as reasonably well-informed and reasonably observant and circumspect. However, (s)he is not to be regarded as a person who normally engages in extended thought processes for the purpose of pairing and matching trade marks or actively considering how they might be developed or appropriated for use as siblings of other marks. Indirect confusion of the kind described by Mr Iain Purvis QC in paras. [16] and [17] of his decision in L.A. Sugar is a matter of instinctive reaction to precipitating factors rather than the result of detailed analysis, as emphasised by Mr James Mellor QC sitting as the Appointed Person in *Duebros Ltd v Heirler Cenovis GmbH* (BL O/547/17; 27 October 2017) at para. 81.”

71. Accepting that the element “www.icecoolfashion.com” is not an insignificant element within the mark as a whole, the mark is dominated by the words “Paulo Due” and the pictorial image of the hand. The web address serves to identify a location on the internet where the goods can be viewed and/or purchased. It is not clear to me that the consumer will attach any further meaning to this component. The term “ice cool fashion” is of low distinctive character and, consequently, it is not clear or obvious that its presence in the web address is sufficient to elevate it to being perceived as a house mark, within the mark as a whole. The way in which the mark is constructed will clearly indicate to consumers that the component Paulo Due and the hand image is the brand/entity to which the origin of the goods will be identified. Even if I am wrong, and the web address or the words “icecoolfashion” appearing therein are perceived as a house mark, this does not assist the Opponent because, as I found earlier, the words “ice”, “cool” and “fashion” form a unit that changes the role and meaning of the word

“ice” compared to its use solus. I do not consider that on this basis the contested mark will be regarded as originating from the same or linked undertaking as the Opponent’s.

72. Whilst I consider it unlikely, even if some consumers consider that there is a connection between ‘www.icecoolfashion.com and ICE and are confused, this group will be such an insufficient number to amount to a significant enough proportion.¹⁸ Any connection is more likely to be a bringing to mind, in a scenario as envisaged by Mr James Mellor in *Duebros*, rather than giving rise to a likelihood of confusion. Noting that the interdependency principle allows for a lower degree of similarity between the marks to be offset by the identity between the goods, in my view the differences between the marks as identified are too great for confusion to arise. Consumers will not view the contested mark as independent components or that the word ‘ice’ will have distinctive significance independent of the whole,¹⁹ and will not consider that the goods originate from the same or economically linked undertaking.

73. Having come to this conclusion in relation to the Opponent’s first earlier mark for the word ICE I consider it unnecessary to go on to consider its second earlier mark as this will not place it in any better position, given that this trade mark is still further away in terms of similarity by the addition of the word PLAY and that no confusion is likely to arise either directly or indirectly.

Conclusion

74. The opposition under section 5(2)(b) fails, subject to appeal, the application may proceed to registration.

Costs

75. As the Applicant has been successful, it is entitled to a contribution toward its costs. In its submissions dated 24 January 2022 (and repeated in its submissions in lieu of hearing) it requested off scale costs submitting that “the Applicant believes that the current opposition to be purely a vexatious one with no real prospect of success” only brought “out of frustration that the settlement negotiations had been concluded without success”. It outlines that it has incurred legal fees of approximately £4,000 (not including VAT or costs related to the negotiations advice) in the proceedings as at

¹⁸ *Comic Enterprises* as before

¹⁹ *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch)

January 2022. It requests an award of costs of that sum, and further costs to cover legal fees to prepare and attend a hearing if one is deemed necessary.

76. Other than the figure of £4,000 no breakdown has been provided as to how the £4,000 was calculated, nor what additional legal fees have been incurred to date. Furthermore, the Applicant chose not to attend the final hearing, nor made any further detailed submission regarding costs, other than those put forward in its submissions dated 24 January 2022. Whilst I note that a security of costs order was made in the Opponent's favour, this was primarily on the basis that the Applicant had not paid the previous cost award made against it, in the earlier proceedings. At the hearing, I was told by Mr Hall that the debt still remained unpaid at that date.

77. Any costs off scale are normally ordered in situations where a party has acted unreasonably during the course of proceedings, or where there has been a breach of the rules or delaying tactics. Nothing has been put before me to suggest that this has been the case in the proceedings in suit, other than the Opponent bringing proceedings. I note that the proceedings were not complex; only one ground was relied upon by the Opponent, and it only filed one statement during the evidence rounds which was not particularly lengthy. The fact that the Opponent lost, is not of itself sufficient to substantiate a claim that it acted unreasonably or that the proceedings were brought vexatiously or without merit. I consider that there was an issue to be tried and the proceedings were brought in the Opponent's bona fide belief that it was soundly based and for no other purpose other than to seek protection for its earlier right.²⁰ It was right and proper therefore for the matter to be brought before the tribunal, in order to resolve a genuine dispute as between the parties. Furthermore, the fact that negotiations broke down, is not a sufficient reason for off scale costs.

78. Taking all matters into consideration, the issue does not necessitate a further hearing and there has been nothing put forward which warrants a higher award or to justify me departing from the scale as set out in Tribunal Practice Note ("TPN") 2 of 2016. Applying the guidance as per the TPN, I award costs as follows:

²⁰ *Rizla Ltd's Application* [1993] RPC 365

Preparing a defence and counterstatement and considering the other side's statement:	£300
Considering the other side's evidence and considering and drafting submissions:	£300
Preparing submissions in lieu of hearing:	£300
Total	£900

79. I order Gilmar S.P.A. to pay Ice Cool Designers Ltd the sum of £900 as a contribution towards its costs. 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 the decision is unsuccessful.

Dated this 8th day of August 2022

Leisa Davies
For the Registrar