

O/0098/23

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION
NO. 03704335 BY
SWISS GEMO TECHNOLOGY GMBH
TO REGISTER THE TRADE MARK:**

The logo for Gemo, featuring the word "Gemo" in a bold, black, sans-serif font. The letter "O" is significantly larger and more rounded than the other letters, and it has a white circular cutout in its center. The entire logo is centered on the page.

IN CLASSES 8 & 21

AND

**OPPOSITION THERETO
UNDER NO. 430110
BY
GEMOLOGY**

Background & Pleadings

1. SWISS GEMO TECHNOLOGY GmbH (“**the applicant**”), applied to register the trade mark shown on the front page of this decision in the United Kingdom on 30 September 2021 and was accepted and published in the Trade Marks Journal on 17 December 2021. For the purposes of this opposition the relevant goods in the specification are:

Class 8: Depilation appliances, electric and non-electric; Electric hair clippers; Hair clippers for personal use, electric and non-electric; Hair braiders, electric; Manicure sets; Electric hair straighteners; Electric nasal hair trimmers; Laser hair removal apparatus, other than for medical purposes; Electric hair curling irons; Beard clippers; Fingernail polishers, electric or non-electric; Cuticle tweezers; Pedicure sets; Eyelash curlers; Nail files; Hair-removing tweezers; Tattoo needles; Curling tongs; Nail clippers, electric or non-electric; Razor blades.

Class 21: Hair brushes; Toothbrushes, electric; Toothbrushes; Perfume vaporizers; Eyelash brushes; Toothbrush cases; Cosmetic utensils; Make-up removing appliances; Heads for electric toothbrushes; Shaving brushes; Brushes; Electric combs; Make-up sponges; Make-up brushes; Powder puffs.

2. Gemology (“**the opponent**”) opposes the application on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (“**the Act**”). The opponent is the proprietor of the following mark:

Trade Mark no.	UK00810856886 ¹
Trade Mark	GEMOLOGY
Goods	Class 3
Relevant Dates	Filing date: 6 November 2017
	Date of entry in register: 13 June 2018

3. For the purpose of this opposition, the opponent relies on all goods in Class 3, as shown later in this decision. As shown above, the opposition concerns some of the applicant's goods in Classes 8 and 21.

4. In its notice of opposition, the opponent argues that:

“The later mark GEMO is wholly contained within the earlier mark GEMOLOGY. The later mark is identical to the first four letters of the earlier mark. The beginning of a mark is important in the comparison and is less likely to go unnoticed by the average consumer. GEMO is an invented term whereas GEMOLOGY refers to the study of gems/gemstones. The word GEM and its meaning will be apparent to the average consumer in the mark GEMO and therefore there is arguably some degree of conceptual similarity between the marks. The marks are visually and aurally highly similar. The stylisation of the later mark is minimal and will not detract from the visual and overall similarity with the earlier mark. The goods in class 3 of the earlier registration are similar to the opposed goods in classes 8 and 21. The goods have similar uses, users, and trade channels. The goods are complimentary. The goods are all in the same cosmetics and personal care sector.”

5. In response, the applicant filed a counterstatement, denying any similarity between the marks. I will return to some of the contentions of the applicant

¹ The trade mark relied upon by the opponent is a UK 'comparable' trade mark. It is based on the opponent's earlier International Registration which has designated the EU ("IR(EU)"). On 1 January 2021, in accordance with Article 54 of the Withdrawal Agreement between the UK and the European Union, the UK IPO created comparable UK trade marks for all right holders with an existing IR.

later in my decision. The applicant claims that “the [...] goods of the later trade mark are neither identical or similar to the goods of the earlier trade mark [...] None of the [...] goods are similar in nature. Whilst there might be an overlap in users and may share some trade channels, the goods are not in competition with each other and are not interchangeable or complementary.”

6. I note that the applicant, incorrectly filed evidence, namely screenshot from Meriam-Webster website, annexed to its counterstatement. However, that document provided by the applicant could not be admitted into the proceedings as evidence as it had not been filed in the correct format. Consequently, the given document will not be taken into consideration in the decision at hand.
7. None of the parties filed evidence or submissions in these proceedings.
8. No hearing was requested and so this decision is taken following a careful consideration of the papers.
9. In these proceedings, the opponent is represented by Wilson Gunn and the applicant by WPIPCN Limited.
10. 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.

Decision

Section 5(2)(b)

11. The relevant statutory provisions are as follows:

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

“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.”

12. The principles, considered in this opposition, stem from the decisions of the European 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 BV* (Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (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-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):

- 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 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 Goods

13. Section 60A of the Act provides:

“(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the “Nice Classification” means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975.”

14. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In *Canon Kabushiki Kaisha*, the Court of Justice of the European Union (CJEU) stated that:

“23. 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 complementary.”

15. Guidance on this issue was also given by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] RPC 281. At [296], he identified the following relevant factors:

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

16. In *Sky v Skykick* [2020] EWHC 990 (Ch), Lord Justice Arnold considered the validity of trade marks registered for, amongst many other things, the general term ‘computer software’. In the course of his judgment, he set out the following summary of the correct approach to interpreting broad and/or vague terms:

“[...] the applicable principles of interpretation are as follows:

- (1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.
- (2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.
- (3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.
- (4) A term which cannot be interpreted is to be disregarded.”

17. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), paragraph 12, Floyd J (as he then was) gave the following guidance on construing the words used in specifications:

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

18. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU held that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods or services. The GC clarified the meaning of “complementary” goods or services in *Boston Scientific Ltd v OHIM*, Case T-325/06, at paragraph 82:

“[...] there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking.”

19. The competing goods to be compared are shown in the following table:

Opponent's Goods	Applicants' Goods
<p>Class 3: Bleaching preparations and other substances for laundry use; cleaning, polishing, degreasing and scouring preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices; depilatories; make-up removing preparations; lipsticks; beauty masks; shaving products; leather preservatives (polishes); creams for leather.</p>	<p>Class 8: Depilation appliances, electric and non-electric; Electric hair clippers; Hair clippers for personal use, electric and non-electric; Hair braiders, electric; Manicure sets; Electric hair straighteners; Electric nasal hair trimmers; Laser hair removal apparatus, other than for medical purposes; Electric hair curling irons; Beard clippers; Fingernail polishers, electric or non-electric; Cuticle tweezers; Pedicure sets; Eyelash curlers; Nail files; Hair-removing tweezers; Tattoo needles; Curling tongs; Nail clippers, electric or non-electric; Razor blades.</p>
	<p>Class 21: Hair brushes; Toothbrushes, electric; Toothbrushes; Perfume vaporizers; Eyelash brushes; Toothbrush cases; Cosmetic utensils; Make-up removing appliances; Heads for electric toothbrushes; Shaving brushes; Brushes; Electric combs; Make-up sponges; Make-up brushes; Powder puffs.</p>

20. The opponent claims that:

“The goods have similar uses, users, and trade channels. The goods are complimentary. The goods are all in the same cosmetics and personal care sector.”

21. In contrast, the applicant contends that:

“None of the aforesaid goods are similar in nature. Whilst there might be an overlap in users and may share some trade channels, the goods are not in competition with each other and are not interchangeable or complementary.”

22. In addition, for the avoidance of doubt, pursuant to Section 60A(1)(b) of the Act, goods are not to be regarded as dissimilar simply because they fall in a different Class.
23. For the purpose of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way for the same reasons.²
24. I note that the parties have not provided any specific analysis or comparison between the competing terms to guide me. Therefore, my assessment is as follows:

Class 8

Razor blades

25. The contested goods are tools that can be used as razors to remove body hair. The earlier term “*shaving products*” in Class 3 is the closest comparable term from the opponent’s specification. Although the competing goods share the same purpose (shaving), they differ in nature as the contested goods are tools in contrast to the earlier goods, which are, for example, in the form of creams, foams, and lotions. Further, the competing goods may share the same users and trade channels and be sold in close proximity. However, the method of use is different. The earlier goods are applied on the skin while the contested goods are used against the skin. I consider that there might be an element of complementarity between the respective goods. I find them to be similar to a medium degree.

² *Separode Trade Mark* BL O-399-10 and *BVBA Management, Training en Consultancy v BeneluxMerkenbureau* [2007] ETMR 35 at paragraphs 30 to 38.

Depilation appliances, electric and non-electric; Electric hair clippers; Hair clippers for personal use, electric and non-electric; Electric nasal hair trimmers; Laser hair removal apparatus, other than for medical purposes; Beard clippers; Hair-removing tweezers

26. The contested goods are all hair removal tools or appliances (electric and non-electric). The contested goods share the same purpose as the opponent's "depilatories" goods. However, they differ in nature as the earlier goods are a chemical means of removing hair, usually sold in the form of a cream or foam, as opposed to the contested goods, which are mechanical (electric and non-electrical) depilation goods. In addition, the method of use is different, as the contested goods would require the application on the skin for depilation, whereas the earlier goods are devices that are used as such. The competing goods may share the same users (general public) and trade channels, but I do not consider that they will be sold in close proximity. I do not disregard the potential of competition between the respective products where one may choose over the other. However, there is no complementarity between the respective goods. I find them to be similar to between a low to medium degree.

Electric hair straighteners; Electric hair curling irons; Hair braiders, electric; Curling tongs; Eyelash curlers

27. The contested goods are all tools used to arrange and shape the hair, with most of them using heat. There is no obvious similarity between the contested goods and the opponent's. I find them to be dissimilar.

Fingernail polishers, electric or non-electric; Pedicure sets; Manicure sets; Nail clippers, electric or non-electric; Cuticle tweezers; Nail files

28. The contested goods are all tools intended to be used for the cosmetic treatment of the feet and fingernails. The closest comparable term from

the opponent's specification is "*cosmetics*" in Class 3, which includes goods such as hand and nail creams. The competing goods differ in nature and purpose. In the absence of evidence, there is no competition or complementarity between the goods. While such goods may be sold in the same shops and supermarkets, and to that extent, they may share the same end-users, I do not consider these to be sufficient factors to find similarity. Thus, I find the respective goods to be dissimilar.

Tattoo needles

29. The contested goods are tools used for tattooing. There is no apparent similarity with any of the earlier terms in the opponent's specification. Thus, I find the respective goods to be dissimilar.

Class 21

Shaving brushes

30. The contested term is used to apply soap or shaving cream to the face or body before shaving. There is similarity with the opponent's "*shaving products*" goods in Class 3, which are products, such as lotions, creams and balms. There is a degree of complementarity between the contested goods. Although they differ in nature, they may serve the same purpose. The users and trade channels are the same, and the respective goods could be sold in close proximity. I find the goods to be similar to a medium degree.

Make-up removing appliances

31. The contested goods are tools that remove make-up from the skin. There is similarity between the contested goods and the opponent's "*make-up removing preparations*" in Class 3, which include goods such as preparation creams, moisturisers, and lotions. I also find that the complementarity, in this case, is sufficiently pronounced. Although the

goods may differ in nature, they will coincide in purpose (make-up removal). They also overlap in users, method of use, and trade channels as they would be sold in close proximity to each other. There may also be a degree of competition. I find that there is a medium degree of similarity.

Cosmetic utensils; Make-up sponges; Make-up brushes; Powder puffs

32. In terms of the contested goods, they are all tools used to facilitate the application of make-up. The earlier goods, “*lipsticks*”, are similar to the contested goods. In particular, although they differ in nature, they may share the same purpose, namely to beautify and enhance one’s appearance. They also share the same users, method of use, i.e. application on the skin, and trade channels as they will be sold in the same retail shops potentially close to each other. I note that there is no element of competition between the goods. However, there might be a degree of complementarity in some cases as the competing goods could be indispensable when bought together in pans. I find the competing goods to be similar to between a low to medium degree.

Perfume vaporizers

33. The contested goods are the bottles where the perfume is packed for sale or used by the consumer to spray perfume to enhance the smell of an individual. The closest comparable goods from the opponent’s specification are “*perfumery*” in Class 3, which are not the finished products in the bottle with the packaging on it, but the liquid or cream. I note that this is how the average consumer will understand the term. The respective goods, however, serve different purposes. One is to contain perfumes/scented liquids, and the other is to enhance the smell of an individual. There might be a complementary relationship between the competing goods, potentially targeting the same end-users. Taking the above into account, I find them to be similar to a low degree.

Hair brushes; Eyelash brushes; Brushes; Electric combs

34. The contested terms are all brushes of some sort. The closest comparable earlier term is “*hair lotions*”. However, I can see no prominent aspect of similarity between the respective goods in terms of the nature, intended purpose, or method of use, nor are the goods at issue in competition with or complementary to the opponent’s goods. Thus, I find them to be dissimilar.

Toothbrushes, electric; Toothbrushes; Heads for electric toothbrushes; Toothbrush cases

35. These are goods, including their accessories, such as cases, intended for maintaining the oral hygiene. I can see no meaningful similarity in terms of the nature, intended purpose, or method of use nor are the goods at issue in competition with or complementary to the opponent’s goods. Thus, I find them to be dissimilar.

Average Consumer and the Purchasing Act

36. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purposes 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 and services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*. In *Hearst Holdings & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), at paragraph 70, Birss J described the average consumer in these terms:

“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.”

37. The goods in question will be purchased by members of the general public. Such goods are usually offered for sale in stores, for instance, high street retail stores, brochures, catalogues, and online. The goods will be displayed on shelves and racks in retail premises, where they will be viewed and self-selected by consumers. Similarly, for online stores, consumers will select the goods relying on the images displayed on the relevant web pages. Therefore, visual considerations will dominate the selection of the goods in question, but aural considerations will not be ignored in the assessment, as advice may be sought from a sales assistant or representative. Such goods range, in my experience, from fairly low, such as razor blades, hair brushes, and toothbrushes, to those of medium value, such as electric toothbrushes, and electric depilation appliances. Even for those at the inexpensive end of the scale, the average consumer may examine the product to ensure that they are suitable, for example, for their type of skin (e.g. sensitive skin) or that the goods possess the desired features. Thus, the average consumer will pay an average degree of attention.


Comparison of Trade Marks

38. 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.”

39. 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.
40. The marks to be compared are:

Opponent’s Mark	Applicants’ Mark
GEMOLOGY	

Overall Impression

41. The contested mark consists of the word element “GEMO”, capitalised and in a standard typeface, with the last letter, ‘O’, appearing slightly stylised and oversized than the other lower case letters. The greatest weight in the overall impression will reside in the verbal element of the mark “Gemo”, while the stylisation will have a less significant weight in the overall impression.
42. The earlier word mark consists of the word “GEMOLOGY” capitalised and in a standard typeface. Registration of a word mark protects fair and notional use of the word itself, which includes use in any regular typeface or font and irrespective of capitalisation.³ The overall impression of the respective mark lies in the word itself.

³ See *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17, paragraph 16.

Visual comparison

43. In its notice of opposition, the opponent contends that:

“The later mark GEMO is wholly contained within the earlier mark GEMOLOGY. The later mark is identical to the first four letters of the earlier mark. The beginning of a mark is important in the comparison and is less likely to go unnoticed by the average consumer.”

44. The applicant, however, claims that:

“The earlier mark comprises 8 letters, whereas the later mark comprises four letters. Whilst the later mark forms the prefix of the earlier mark (and is thus entirely subsumed therein), it is clear from It is clear from Sabel BV v. Puma AG that it is wrong to artificially dissect the trade marks. In any event, the Gemo element of the earlier mark is not by itself the distinctive and dominant component and overall the impression of the mark lies in the word “Gemology”, in its totality there and the overall impressions created marks are entirely different. The marks are visually different insofar as the later mark lacks the visually diverse suffix ology. This difference is particularly noticeable, given the relatively short length of the later mark and given that fact that the suffix ology is commonly used in the English language to denote a field of study e.g. biology, archaeology, audiology, pathology, sociology and technology.”

45. The earlier mark is eight letters long (GEMOLOGY), whereas the contested mark is four (GEMO). The contested mark incorporates all the first four letters of the earlier mark, “GEMO-”, thereby sharing the same first four letters. However, a point of visual difference is introduced with the last four letters found in the earlier mark, namely “-LOGY”. As a rule of thumb, I note that this divergence appears at the end of the mark, a position which is generally considered to have less impact due to

consumers in the UK reading from left to right.⁴ Taking into account the overall impression of the marks and the similarities and differences, I find that the competing marks are visually similar to a medium degree.

Aural comparison

46. The applicant in its counterstatement asserts that:

“The earlier mark comprises 4 syllables. The later mark consists of two syllables. The major difference between the marks is that the later mark lacks the last two syllables of the earlier mark, i.e. “ology” and thus we submit that the earlier and later marks are aurally different.”

47. The average consumer will articulate the earlier mark as “JE-MO-LUH-JEE”. However, the verbal element of the contested mark will be pronounced as “JE-MO”. The competing marks coincide in the first two syllables, “JE-MO”, but they differ in the presence/absence of the phonetic counterpart “LUH-JEE” in the earlier mark. Taking into account the overall impressions, I consider that the marks are aurally similar to a medium degree.

Conceptual comparison

48. On the one hand, the opponent puts forward that:

“GEMO is an invented term whereas GEMOLOGY refers to the study of gems/gemstones. The word GEM and its meaning will be apparent to the average consumer in the mark GEMO and therefore there is arguably some degree of conceptual similarity between the marks.”

49. On the other, the applicant claims the following:

⁴ See *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02.

“1.2.5.1. The earlier mark would be seen as comprising the English word Gemology, meaning the science of gems.

[...]

1.2.5.2. Although the term Gemology has no direct reference to the goods, the word is nevertheless a relatively well known / recognisable word and consumers would immediately bring this to mind and may be lead into believing that goods had some bearing to the science of gemology, perhaps because the goods were produced by or for people involved in the science of gemology.

1.2.5.3. The later mark would be seen by the average consumer as a meaningless invented word. The word Gemo is not a recognised abbreviation of the word Gemology and as such, we submit that the earlier and later marks are conceptually different.”

50. In terms of the earlier word mark “GEMOLOGY”, I agree with the parties’ contentions that the UK average consumer will understand the term as the study/science of gems. In addition, I consider that the contested mark as a whole will be perceived as an invented word with no particular meaning. In this regard and in the absence of evidence, I disagree with the opponent’s position that there is a conceptual similarity between the marks based on the first three letters (GEM-) in the contested mark. Taking all the above into account together with the overall impressions, I find that the marks are conceptually dissimilar.

Distinctive Character of The Earlier Trade Mark

51. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, paragraph 22 and 23, the CJEU stated that:

“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).

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).”

52. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.
53. As described above, the earlier mark consists of the word “GEMOLOGY”, which will be understood as the study of gems/gemstones. I do not consider that there is any allusion to the goods. I find, therefore, that the earlier mark is inherently distinctive to a medium degree.

Likelihood of Confusion

54. In assessing the likelihood of confusion, I must adopt the global approach set out in the case law to which I have already referred above in this decision. Such a global assessment is not a mechanical exercise. I must also have regard to the interdependency principle, that 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.⁵ It is essential to keep in mind the distinctive character of the opponent's trade mark since the more distinctive the trade mark, the greater the likelihood of confusion. I must also keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon imperfect recollection.⁶

55. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. Indirect confusion is where the consumer notices the marks are different, but concludes, due to the similarities between them, that the later mark is another brand of the owner of the earlier mark or a related undertaking (or vice versa).
56. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Iain Purvis K.C., sitting 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.”

⁵ See *Canon Kabushiki Kaisha*, paragraph 17.

⁶ See *Lloyd Schuhfabrik Meyer*, paragraph 27.

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)."

I note that the categories identified above by Mr Purvis K.C. are not exhaustive.⁷

57. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, James Mellor KC, sitting as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

58. Earlier in this decision I have concluded that:

- the goods at issue range from a medium degree of similarity to dissimilar;

⁷ *Thomson Hotels LLC v TUI Travel Amber E&W LLP* BL- O-440/14 at paragraph 29.

- the average consumer for the goods is a member of the general public, who will select the goods by predominantly visual means, but without dismissing the aural means. The cost of goods ranges from fairly low to medium, and the average consumer will examine the goods to identify suitability, thereby selecting the relevant goods with an average degree of attention, heightened slightly for the more expensive goods;
- the competing marks are visually and aurally similar to a medium degree, and conceptually dissimilar;
- the earlier mark is inherently distinctive to a no more than medium degree.

59. Taking into account the above factors, I am persuaded that there is no likelihood of direct confusion for similar goods. Notwithstanding the principle of imperfect recollection, I find that when the marks are considered as a whole, the average consumer would recall that one mark is the word “GEMOLOGY”, which would be understood to relate to gems in some way. The other is the invented word “GEMO”. The ‘GEMO’ element plays no independent role within the word “GEMOLOGY” and when used alone will simply be seen as an invented word. This creates a strong conceptual dissimilarity which will prevent the average consumer from confusing the marks. In this regard, and despite the medium degree of inherent distinctiveness of the earlier mark, I consider that the average consumer will not overlook the differences between the competing marks, and, thus, it is unlikely to mistake one mark for the other, even on similar goods. This finding extends to the goods for which I found any degree of similarity. Where I found dissimilarity between the goods, there can be no likelihood of confusion.⁸

⁸ Case C-398/07, *Waterford Wedgwood plc v OHIM*; and *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, para 49.

OUTCOME

60. There is no likelihood of confusion. **The opposition on the basis of the claim under Section 5(2)(b) fails.** Therefore, subject to appeal, the application can proceed to registration.

COSTS

61. This opposition has failed in its entirety and the applicant is entitled to a contribution towards its costs of defending its application. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 2/2016. I award costs to the applicant as a contribution towards the cost of the proceedings on the following basis:

Considering the other side's statement and preparing a counterstatement	£350
Total	£350

62. I, therefore, order, Gemology to pay SWISS GEMO TECHNOLOGY GmbH the sum of £350. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 2nd day of February 2023

Dr Stylianos Alexandridis
For the Registrar,
The Comptroller General