

BL O/0302/23

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION 3705284

BY

EBEBEK MAĞAZACILIK A.Ş.

TO REGISTER THE FOLLOWING TRADE MARK:



AND

OPPOSITION NO. 60002356 THERETO

BY

GINGER RAY LTD

Background and pleadings

1. Although EBEBEK MAĞAZACILIK A.Ş. (the “Applicant”) filed the contested application in the UK on 30 September 2021, it was filed pursuant to Article 59 of the Withdrawal Agreement between the United Kingdom and the European Union, with a priority EU filing date of 3 March 2020. The contested application was accepted, and published for opposition purposes in the Trade Marks Journal on 18 March 2022. Registration of the mark is sought in respect of goods and services in Classes 9, 12, 16, 20, 24, 25, 35 and 42.

2. On 29 July 2022, Ginger Ray Ltd (the “Opponent”) filed a Fast Track opposition, in which it partially opposed the application under Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). Whilst the Opponent indicated clearly that the opposition was based on Section 5(2)(b), it did not make any specific pleadings or file a Statement of Grounds.¹

3. The opposition was brought against the following goods only:

Class 16 *Paper napkins, paper and cardboard’ paper and cardboard for packaging and wrapping purposes.*

Class 25 *Clothing.*

4. Whilst it is noted that at Q12 of the TM7 the Opponent only included the word ‘*Clothing*’ in respect of the Class 25 goods being opposed, the reality is that the applied for specification in Class 25 also includes the following list of goods that are inextricably linked to ‘*Clothing*’, and therefore fall within its more general category:

“..., including underwear and outerclothing, other than special purpose protective clothings; socks, belts (clothing).

5. It is therefore considered that the opposition is effectively made against the above list also.

¹ The Opponent is not required to do so (see the decision of Phillip Johnson, sitting as the Appointed Person, in *Delta Air Lines, Inc v Ontro Limited*, BL O/044/21, at paragraph 22).

6. For the purposes of the opposition, the Opponent relied upon its earlier United Kingdom Trade Mark (UKTM):

UKTM 3407426

Hello Baby

Filing date 17 June 2019

Registration date 25 October 2019

Classes 16, 21, 25 and 28

7. The Opponent chose to rely only upon the following goods for which the earlier mark is registered:

Class 16 *Party stationery; Metallic paper party decorations; Paper party bags; Paper party decorations; Bunting [paper]; Bunting of paper; Paper bunting; Paper napkins; Napkin paper; Rosettes of paper; Guest books.*

Class 25 *Sashes for wear.*

8. Since the filing date of the earlier mark predates that of the contested mark, the Opponent's mark is an "earlier mark" in accordance with Section 6 of the Act. As the earlier mark has not been registered for five years or more before the filing date of the contested mark, it is not subject to the use requirements specified within section 6A of the Act, and as a consequence the Opponent may rely upon any or all of the goods for which the earlier mark is registered without having to show that it has used the mark at all.

9. Considering that this is a Fast Track opposition, it is necessary to highlight Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 2235, which disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20 (4) shall continue to apply. Rule 20 (4) states that:

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

10. The net effect of these changes is to require the parties to seek leave in order to file evidence in Fast Track oppositions. No leave was sought to file any evidence in respect of these proceedings by either party.

11. Rule 62 (5) (as amended) states that arguments in Fast Track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken. Neither party requested a Hearing, nor did the Office.

12. On 20 October 2022, the Applicant filed a TM21b to amend the specification of the contested mark. The Applicant requested the deletion of the following goods:

Class 16 *Paper napkins, paper and cardboard' paper and cardboard for packaging and wrapping purposes.*

Class 25 *Mufflers [clothing], shawls, bandanas, scarves.*

13. The Registry contacted the Opponent for confirmation as to whether the amended specification would allow the opposition to be withdrawn. The Opponent did not respond.

14. On 24 October, the Applicant filed a counterstatement in which it denied that the marks are similar. The Applicant submitted that the contested mark is fifteen digits in length, comprising the three words EBEBEK, HELLO and BABY, whereas the earlier mark is nine digits in length, comprising the two words HELLO and BABY. The Applicant argued that although the marks share the same two words HELLO and BABY, the first letter of each mark is different ('E' in the contested mark and 'H' in the earlier mark). In addition, the shared words HELLO BABY carry little or almost no distinctive character because the combination is descriptive in relation to childcare goods.

15. The Applicant argued that the contested mark is complex, consisting of separate rows for the words, a combination of upper and lower case letterings, a distinctive

orange mother and child motif, and a distinctive yellow heart motif inside the letter 'O'. By comparison, the earlier mark contains only words. The Applicant submitted that emphasis is always placed on the first part of a mark, in which case the word 'EBEBEK' in the contested mark is a relevant visual difference. The Applicant argued that the inclusion of EBEBEK also created a clear phonetic and conceptual difference between the marks.

16. The Applicant submitted that the only goods left to compare (following the TM21b) are the earlier mark's *sashes for wear* and the contested *clothing*. The Applicant argued that although a sash is worn on the body it is not clothing as such, and its nature is to decorate rather than protect or cover as clothing does. In addition, the points of sale and trade channels are different, as sashes are sold in specialist party shops. The Applicant argued that the consumer would not expect the goods at issue to come from the same source.

17. The Applicant is represented by Baron Warren Redfern. The Opponent is not represented.

Decision

Section 5(2)(b)

18. Section 5(2)(b) of the Act is as follows:

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

(a) ...

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

Section 5A

19. Section 5A of the Act is as follows:

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

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

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

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

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

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

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

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a 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.

21. 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 Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

Comparison of goods

22. The Applicant requested the removal of the Class 16 goods that were subject to the opposition. The opposition therefore remains against the contested Class 25 *Clothing, including underwear and outer clothing, other than special purpose protective clothings; socks, belts (clothing) only.*

23. The parties' respective specifications are:

Earlier mark	Contested mark
Class 25: <i>Sashes for wear.</i>	Class 25: <i>Clothing, including underwear and outerclothing, other than special purpose protective clothing; socks, belts (clothing).</i> ²

24. In the judgment of the Court of Justice of the European Union (CJEU) in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

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

25. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (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;

² As explained in paragraph 4, although the Opponent only included the word ‘Clothing’ in the TM7, the reality is that *Clothing* also includes “*underwear and outerclothing, other than special purpose protective clothing; socks, belts (clothing)*”.

(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.

26. It has been established by the General Court (GC) in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, that:

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

27. I note the Applicant’s position that the *Sashes for wear* of the earlier mark are worn as decoration rather than protection or cover, and are sold in speciality party shops. It appears to me that in essence the Applicant is arguing that the earlier mark’s *Sashes for wear* are novelty party items. It is worth mentioning that it is incumbent on me to consider the goods of the earlier mark in the form as registered. The earlier mark is not subject to proof of use, meaning that no indication as to the type of *Sashes for wear* has been evidenced. It must therefore be considered that the *Sashes for wear* of the earlier mark include all types of sashes captured by such wording, and not only the kind that are used for novelty purposes. Essentially, *Sashes for wear* are garments that are to be worn. As such, they have the same intended purpose, user, nature and trade channels as the contested *Clothing, including underwear and outerclothing, other than special purpose protective clothing*. In fact, the *Sashes for wear* of the earlier mark are included in the more general category of the contested *Clothing, including underwear and outerclothing, other than special purpose protective clothing*, and therefore the goods at issue are identical in accordance with the *Merici* principle.

28. The contested *socks, belts (clothing)* are dissimilar to the earlier mark's *Sashes for wear*. *Socks* are worn exclusively on feet, which *sashes* are not, whilst *belts* are used to hold in position trousers, skirts etc., which *sashes* are not. Both *socks* and *belts* therefore have a different intended purpose to *Sashes for wear*. In addition, they are of a different nature, and are neither in competition nor are they complementary.

Comparison of marks

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

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

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

31. The respective trade marks are shown below:

Earlier trade mark	Contested trade mark
<p>Hello Baby</p>	 <p>The contested trade mark logo consists of three levels. The top level features the word 'ebebek' in turquoise-blue lowercase letters, followed by an orange circular graphic containing a stylized figure. The middle level features the word 'HELLO' in grey uppercase letters, with a small yellow heart inside the letter 'o'. The bottom level features the word 'BaBY' in grey letters, where the 'a' is lowercase and the 'B' and 'Y' are uppercase, all set against a yellow rectangular background with a dashed border, giving it the appearance of a patch.</p>

32. The earlier mark consists of a combination of the two English-language words ‘Hello Baby’ presented in a plain, non-stylised font. The word ‘Hello’ is well-known as a salutation or greeting, or as a way to question. The word ‘Baby’ is well-known as meaning a very young child. In my opinion, the two words hang together as a combination to create the overall impression of a greeting to a young child. Because the words hang together and are the same size as one another neither word is considered to be more obviously dominant or distinctive than the other.

33. The contested mark is a composite mark consisting of both verbal and figurative elements, displayed over three levels. The top level contains the word ‘ebebek’ in turquoise-blue lower case letters. Neither party has provided submissions as to the meaning of the word ‘ebebek’, and it is therefore assumed to be a seemingly invented term. Next to the word ‘ebebek’ is a figurative element in orange. I do not discount the possibility that a certain number of consumers may perceive it as a “distinctive orange mother and child motif”, as argued by the Applicant. However, I consider it more likely that the majority of consumers would simply perceive it as an abstract orange graphic. Below the word ‘ebebek’ and orange graphic appears the word ‘Hello’ in grey text, which contains a yellow heart within the letter ‘o’. Below the word ‘Hello’ is the word ‘BaBY’ (with the lower case ‘a’ of equal size as the upper case letters). The word ‘BaBY’ appears on a yellow background with a stitch pattern along the border which has the effect of making it appear to be a patch. The word ‘BaBY’ and background are tilted. Although they are on different levels, I consider the words ‘Hello BaBY’ to hang together to form the overall impression of a greeting to a young child. The word

'ebebek' does not hang together with the combination 'Hello BaBY' because it is a seemingly invented word without concept that does not contribute to the phrase. Although the contested mark is composite, to my mind it contains two distinct parts which have significance separate from one another.

34. Whilst the word 'ebebek' and orange graphic are clearly visible, and in certain instances may draw the eye due to their position as the uppermost element, they are the smallest elements of the contested mark and are therefore less dominant than the combination of words 'Hello BaBY'. Although the word 'ebebek' is (one of) the smallest element(s), I nevertheless consider it to be the more distinctive element by way of being a seemingly invented word.

Visual similarity

35. The marks are visually similar insofar as they both contain the words 'Hello Baby/BaBY'. That having been said, the representation of the words differs in each mark, with the contested mark containing certain stylistic embellishments which are not present in the earlier mark, such as the type of font and letter casings. The marks also differ visually due to the use of colour in the contested mark, which is found in the form of a yellow patch, a turquoise-blue word (ebebek), a yellow heart, and an orange "mother and child motif"/abstract graphic. The word 'ebebek' and motif/graphic are themselves points of visual difference.

36. The visual differences between the marks are smaller in size and impact than the visual similarities caused by the sharing of the words 'Hello Baby/BaBY'. Notably, the words 'Hello Baby' represent the entirety of the earlier mark and the most dominant element of the contested mark. Overall, the marks are considered to be visually similar to at least a medium degree.

Aural similarity

37. The marks are aurally similar insofar as they each contain the words 'Hello Baby/BaBY', which will be pronounced identically in each mark. Based on its positioning on the top row of the contested mark, and in consideration of the habits and realities that people read left-to-right and top-to-bottom, I am of the opinion that the first element to be spoken in the contested mark will be the three-syllable word

'eb-eb-ek', which has no counterpart in the earlier mark. The marks therefore differ as to their respective first spoken word. That having been said, the only aural element of the earlier mark is identically replicated in the contested mark. The figurative elements in the contested mark will not be pronounced and so do not have an aural impact. Overall, the marks are considered to be aurally similar to at least a medium degree.

Conceptual similarity

38. I do not agree with the Applicant that the words 'Hello Baby/BaBY' are descriptive in relation to childcare goods. In my opinion, the words 'Hello Baby/BaBY' hang together as a combination to create the concept of a greeting to a young child. Such a concept has no directly descriptive meaning in relation to the goods. Although the word 'Baby' may be descriptive of the goods at issue in isolation, it cannot be dissected from the whole and assessed as such. Whilst I do not consider 'Hello Baby/BaBY' to be directly descriptive, I do not consider the combination to possess a particularly high degree of distinctive character in relation to the goods at issue, especially when each general category could include items to be worn by babies.

39. The marks are conceptually similar insofar as each mark contains the identical concept created by the combination of words 'Hello Baby/BaBY'. The marks differ conceptually due to the inclusion in the contested mark of the seemingly invented and subsequently distinctive term 'ebebek'. The term 'ebebek' does not hang together with the words 'Hello BaBY' as it has no meaning, and therefore cannot contribute conceptually to the combination 'Hello BaBY'. It therefore has independent significance, and has no counterpart in the earlier mark. For those consumers who perceive the orange graphic as a "mother and baby motif", this would represent an additional conceptual difference between the marks. A further conceptual difference is that created by the yellow heart within the letter 'o' of the contested mark. In my opinion, the identified conceptual differences between the marks rest in the less dominant elements, with the conceptual similarity resulting from the sharing of the dominant element in the contested mark and only element in the earlier mark. I therefore consider the marks to be conceptually similar to at least a medium degree.

Average consumer and the purchasing act

40. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

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

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

42. The goods at issue are everyday goods, insofar as they are bought and used/worn on a daily basis by every member of the general public. The price range of the contested goods varies considerably. However, on average most clothing items/items to be worn are relatively inexpensive goods. The level of attention will likely differ depending on the intended use of the goods, for example if the clothing were to be purchased for a one-off formal event or for everyday use. That having been said the contested goods are not specialist, and therefore the overall the level of attention will likely be medium.

43. Based on the nature of the goods at issue the purchasing process would be predominantly made on the basis of the visual aspect. The goods at issue would most likely be seen in shops, in magazines, or online, and in each instance would be viewed optically. I do not discount the possibility that some of the goods may also be bought over the telephone or following consultation with a shop assistant, for example, in

which case the aural aspect will also be of importance. However, I consider this to be a secondary purchasing process to the visually dominant process.

Distinctive character of the earlier trade mark

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

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

45. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask ‘in what does the distinctive character of the earlier mark lie?’ Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

46. The earlier mark is a plain word mark without any additional stylisation or figurative elements, and as such the distinctive character rests entirely in the meaning of the combination of words 'Hello Baby'. I have made it clear that I disagree with the Applicant's submission that the combination 'Hello Baby' is directly descriptive of the goods at issue. However, I have also made it clear that I do not consider the combination of terms to possess a particularly high degree of distinctive character. My verification as to the degree of distinctive character of the earlier mark has limits however³, and in light of the finding that the mark has no immediately or obviously direct relationship to the goods at issue I consider the mark to have between a low and medium degree of distinctive character.

Likelihood of Confusion

47. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related.

48. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind (see *Sabel*, C-251/95, para 22). The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa (see *Canon*, C-39/97, para 17). It is necessary for me to keep in mind the distinctive character of the Opponent's trade mark, the average consumer for the services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

49. In *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03, the GC stated that:

³ *Formula One Licensing BV v OHIM*, Case C-196/11P.

“49. However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (*BUDMEN*, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumer choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs.”

50. In *Quelle AG v OHIM*, Case T-88/05, the GC found that visual similarity (and difference) is most important in the case of goods that are self-selected or where the consumer sees the mark when purchasing the goods. The Court stated that:

“68... If the goods covered by the marks in question are usually sold in self-service stores where consumers choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any phonetic similarity between the signs (*NLSPORT*, *NLJEANS*, *NLACTIVE* and *NLCollection*, paragraph 53 supra, paragraph 49).

69. Likewise, the degree of phonetic similarity between two marks is of less importance in the case of goods which are marketed in such a way that, when making a purchase, the relevant public usually perceives visually the mark designating those goods (*BASS*, paragraph 56 supra, paragraph 55, and Case T-301/03 *Canali Ireland v OHIM – Canal Jean (CANAL JEAN CO. NEW YORK)* [2005] ECR II-2479, paragraph 55)... The same is true of catalogue selling, which involves as much as does shop selling a visual assessment of the item purchased by the consumer, whether clothing or shoes, and does not generally

allow him to obtain the help of a sales assistant. Where a sales discussion by telephone is possible, it takes place usually only after the consumer has consulted the catalogue and seen the goods. The fact that those products may, in some circumstances, be the subject of discussion between consumers is therefore irrelevant, since, at the time of purchase, the goods in question and, therefore, the marks which are affixed to them are visually perceived by consumers.”

51. The earlier mark consists exclusively of the plain-text words ‘Hello Baby’ with no additional elements. The distinctiveness of the earlier mark rests entirely in the overall impression of this combination, which is replicated identically in the contested mark. By virtue of coinciding in the words ‘Hello Baby/BaBY’ (with stylistic but ultimately merely decorative differences) the marks share an identical concept, and are also visually and aurally similar to at least a medium degree.

52. There do exist certain differences between the marks which constitute more than mere stylistic variations. Most notably, the contested mark contains the distinctive word ‘ebebek’ and orange graphic which have no counterparts in the earlier mark. That having been said, they are the smallest elements of the contested mark and are subsequently the least dominant elements. Further, the word ‘ebebek’ does not hang together with the other word elements ‘Hello BaBY’. The distinctive word ‘ebebek’ therefore has a distinctive significance independent of the whole. Although in certain instances the consumer’s eye may be drawn to the word ‘ebebek’ and orange graphic due their positioning on the first line, I am of the opinion that the consumer’s eye would more likely first be drawn to the larger words ‘Hello BaBY’, especially when considering the visual impact of the large yellow patch upon which the word ‘BaBY’ appears. The probability that the words ‘Hello BaBY’ draw the eye is of significance when considering that the visual aspect of the marks at issue are the more important in the purchasing process of the respective goods.

53. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. (as he then was) considered the impact of the CJEU’s judgment in *Bimbo*, Case C-591/12P, on the court’s earlier judgment in *Medion v Thomson*. The judge said:

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

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

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

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

54. Having conducted a global assessment of the marks at issue, and in light of the above *Whyte and Mackay* finding, I am of the opinion that the average consumer would

perceive the contested composite mark to contain two parts that have distinctive significance which is independent of the significance of the mark as a whole i.e., the word 'ebebek', and the combination 'Hello BaBY'. I have made it clear that I do not consider the word 'ebebek' to hang together with 'Hello BaBY', and that it has independent significance. Conversely, the combination 'Hello BaBY' also has independent significance.

55. In my opinion, the additional differences in the contested mark, which consist of the use of colour and figurative elements such as a heart and patch, are less impactful on the overall impression of the mark as a whole. With this in mind, I find it likely that the average consumer who is not paying a particularly high degree of attention in relation to the goods at issue will perceive the contested mark to contain 'Hello BaBY' as an independent sign, and subsequently confuse it with the earlier 'Hello Baby' mark, especially when considering they would both appear on identical goods.

56. Although I have indicated that I consider the shared element 'Hello Baby/BaBY' to be of a relatively low to medium degree of distinctive character, this does not preclude a finding of confusion. In *L'Oréal SA v OHIM*, Case C-235/05 P, the Court of Justice of the European Union found that:

"45. The applicant's approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders."

57. Essentially, even in a case involving a weakly distinctive earlier mark there may be a likelihood of confusion on account, in particular, of a similarity between the signs and between the goods or services covered (see most recently Case T-135/19 *Corporació Catalana de Mitjans Audiovisuals, SA v. EUIPO* at paragraph [66]).

58. One of the factors in the global assessment of comparing trade marks includes the interdependency principle, whereby a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services, and vice versa. I have found the goods at issue to be identical. This could in and of itself offset a lower degree of similarity between the respective marks. The fact that I have found the marks to be visually, aurally and conceptually similar to at least a medium degree therefore points towards a finding of confusion. Another factor to consider is that the consumer rarely has the opportunity to make direct comparisons between the marks at issue. It is therefore possible that the consumer could misremember having seen the visual differences between the marks and be directly confused.

59. It is worth also considering the likelihood of indirect confusion for the purposes of thoroughness, and in case the differences contained within the contested mark are noticed by a sufficient number of consumers, therefore preventing a finding of direct 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).”

60. In my opinion the stylistic changes that appear in the contested mark, such as the use of colour, change of font and even inclusion of an orange graphic, are likely to be perceived by the average consumer as additions of non-distinctive matter that are logical with a brand extension. Whilst I do not consider the distinctive word ‘ebebek’ in the contested mark to be the addition of a non-distinctive element to the same degree that ‘LITE’ or ‘EXPRESS’ may be, nor would it likely be perceived as logical or consistent with a brand extension, it is important to remember that the *L.A Sugar* categories are non-exhaustive.⁴ Further, the fact that the word ‘ebebek’ is the smallest and subsequently least dominant element of the contested mark would likely result in the marks at issue being perceived as ‘Hello Baby/BaBY’ marks.

61. In my view, consumers will not see ‘Hello Baby/BaBY’ appearing in two different marks used on identical goods and put it down to mere coincide. Rather, in the instances where the consumer does not directly confuse the marks due to imperfect recollection they will nevertheless likely assume a connection between the two

⁴ *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, paragraph 12

undertakings, with the contested 'Hello BaBY' mark which contains additional get-up and minor (less dominant) elements being perceived as a sub-brand of the earlier 'Hello Baby' mark. I therefore also find a likelihood of indirect confusion.

Conclusion

62. The opposition under section 5(2)(b) of the Act is partially successful. Subject to appeal, the application will be refused registration for *Clothing, including underwear and outerclothing, other than special purpose protective clothing; only.*

63. The application would proceed to registration for the following goods and services:

Class 9 *Measurement apparatus and equipment including those for scientific, nautical, topographic, meteorologic, industrial and laboratory purposes, thermometers, not for medical purposes, barometers, ammeters, voltmeters, hygrometers, testing apparatus not for medical purposes, telescopes, periscopes, directional compasses, speed indicators, laboratory apparatus, microscopes, magnifying glasses, stills for laboratory experiments, binoculars, ovens and furnaces for laboratory experiments; apparatus for recording, transmission or reproduction of sound or images, cameras, photographic cameras, television apparatus, video recorders; CD and DVD players and recorders; MP3 players, computers, desktop computers, tablet computers, wearable technological devices, namely, smartwatches, smart wristbands and head-mounted cameras; microphones; microphones, earphones, telecommunications apparatus, apparatus for the reproduction of sound or images, computer peripheral devices, cell phones, covers for cell phones, telephone apparatus, computer printers, scanners [data processing equipment], photocopiers; magnetic and optic data carriers and computer software and programmes recorded thereto, downloadable and recorded electronic publications, encoded magnetic and optic cards; movies, tv series and video music clips recorded on magnetic, optical and electronic media; antennas, satellite antennas, amplifiers for antennas, parts of the aforementioned goods; electronic components used in the electronic parts of machines and apparatus,*

semi-conductors, electronic circuits, integrated circuits, chips [integrated circuits], diodes, transistors [electronic]; magnetic heads for electronic apparatus, electronic locks, photocells, remote control apparatus for opening and closing doors, optical sensors; counters and quantity indicators for measuring the quantity of consumption, automatic time switches; eyeglasses, sunglasses, optical lenses and cases, containers, parts and components thereof; apparatus and instruments for conducting, transforming, accumulating or controlling electricity, electric plugs, junction boxes [electricity], electric switches, circuit breakers, fuses, lighting ballasts, battery starter cables, electrical circuit boards, electric resistances, electric sockets, transformers [electricity], electrical adapters, battery chargers, electric door bells, electric and electronic cables, batteries, electric accumulators, solar panels for production of electricity; alarms and anti-theft alarms, other than for vehicles, electric bells fire extinguishing apparatus, fire engines, fire hose and fire hose nozzles; decorative magnets.

Class 12 *Bicycles and their bodies; handlebars and mudguards for bicycles; vehicle seats; head-rests for vehicle seats; safety seats for children, for vehicles; seat covers for vehicles; vehicle covers (shaped); sun-blinds adapted for vehicles; luggage carriers for vehicles; bicycle and ski carriers for cars; saddles for bicycles or motorcycles; air pumps for vehicles, for inflating tires; baby carriages, wheelchairs, pushchairs.*

Class 16 *Cardboard boxes; paper towels; toilet paper; plastic materials for packaging and wrapping purposes; printing blocks and types; bookbinding material; printed publications; printed matter; books, magazines, newspapers, bill books, printed dispatch notes, printed vouchers, calendars; posters; photographs [printed]; paintings; stickers [stationery]; postage stamps; stationery, office stationery, instructional and teaching material [except furniture and apparatus]; writing and drawing implements; artists' materials; paper products for stationery purposes; adhesives for stationery purposes, pens, pencils, erasers, adhesive tapes for stationery purposes, cardboard cartons [artists'*

materials], writing paper, copying paper, paper rolls for cash registers, drawing materials, chalkboards, painting pencils, watercolors [paintings]; paint rollers and paintbrushes for painting.

Class 20 Furniture, made of any kind of material; mattresses; pillows; air mattresses and cushions, not for medical purposes, water beds; mirrors; bouncing chairs for babies, playpens for babies, cradles, infant walkers; display boards, frames for pictures and paintings, identification plates, identification tags, nameplates, identification labels made of wood or synthetic materials; packaging containers of wood or plastics, casks for use in transportation or storage, barrels, storage drums, tanks, boxes, storage containers, transportation containers, chests, loading pallets and closures for the aforementioned goods, of wood or plastics; furniture fittings, of wood or synthetic materials, opening and closing mechanisms of wood or synthetic materials; ornaments and decorative goods of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum, beeswax, plastic or plaster namely figurines, holiday ornaments for walls, sculptures, trophies; kennels, nesting boxes and beds for household pets; portable ladders and mobile boarding stairs of wood or synthetic materials; bamboo curtains, roller indoor blinds [for interiors], slatted indoor blinds, strip curtains, bead curtains for decoration, curtain hooks, curtain rings, curtain tic-backs, curtain rods.

Class 24 Woven or non-woven textile fabrics; textile goods for household use, not included in other classes: curtains, bed covers, sheets (textile), pillowcases, blankets, quilts, towels; flags, pennants, labels of textile; swaddling blankets; sleeping bags for camping.

Class 25 Socks, belts (clothing); footwear, shoes, slippers, sandals; headgear, hats, caps with visors, berets, caps (headwear).

Class 35 The bringing together, for the benefit of others, of a variety of goods, namely, measurement apparatus and equipment including those for scientific, nautical, topographic, meteorologic, industrial and laboratory

purposes, thermometers, not for medical purposes, barometers, ammeters, voltmeters, hygrometers, testing apparatus not for medical purposes, telescopes, periscopes, directional compasses, speed indicators, laboratory apparatus, microscopes, magnifying glasses, stills, binoculars, ovens and furnaces for laboratory experiments, apparatus for recording, transmission or reproduction of sound or images, cameras, photographic cameras, television apparatus, video recorders, CD and DVD players and recorders, MP3 players, computers, desktop computers, tablet computers, wearable technological devices (smart watches, wristbands, head-mounted devices) microphones, earphones, telecommunications apparatus, apparatus for the reproduction of sound or images, computer peripheral devices, cell phones, covers for cell phones, telephone apparatus, computer printers, scanners [data processing equipment], photocopiers, magnetic and optic data carriers and computer software and programmes recorded thereto, downloadable and recordable electronic publications, encoded magnetic and optic cards, movies, tv series and video music clips recorded on magnetic, optical and electronic media, antennas, satellite antennas, amplifiers for antennas, parts of the aforementioned goods, electronic components used in the electronic parts of machines and apparatus, semi-conductors, electronic circuits, integrated circuits, chips [integrated circuits], diodes, transistors [electronic], magnetic heads for electronic apparatus, electronic locks, photocells, remote control apparatus for opening and closing doors, optical sensors, counters and quantity indicators for measuring the quantity of consumption, automatic time switches, eyeglasses, sunglasses, optical lenses and cases, containers, parts and components thereof, apparatus and instruments for conducting, transforming, accumulating or controlling electricity, electric plugs, junction boxes [electricity], electric switches, circuit breakers, fuses, lighting ballasts, battery starter cables, electrical circuit boards, electric resistances, electric sockets, transformers [electricity], electrical adapters, battery chargers, electric door bells, electric and electronic cables, batteries, electric accumulators, solar panels for production of electricity, alarms and anti-theft alarms, other than for vehicles, electric

bells, fire extinguishing apparatus, fire engines, fire hose and fire hose nozzles, decorative magnets, bicycles and their bodies, handlebars and mudguards for bicycles, vehicle seats, head-rests for vehicle seats, safety seats for children, for vehicles, seat covers for vehicles, vehicle covers (shaped), sun-blinds adapted for vehicles, luggage carriers for vehicles, bicycle and ski carriers for cars, saddles for bicycles or motorcycles, air pumps for vehicles, for inflating tires, baby carriages, wheelchairs, pushchairs, paper and cardboard, paper and cardboard for packaging and wrapping purposes, cardboard boxes, paper towels, toilet paper, paper napkins, plastic materials for packaging and wrapping purposes, printing blocks and types, bookbinding material, printed publications, printed matter, books, magazines, newspapers, bill books, printed dispatch notes, printed vouchers, calendars, posters, photographs [printed]: paintings, stickers [stationery]: postage stamps, stationery, office stationery, instructional and teaching material [except furniture and apparatus], writing and drawing implements, artists' materials, paper products for stationery purposes, adhesives for stationery purposes, pens, pencils, erasers, adhesive tapes for stationery purposes, cardboard cartons [artists' materials], writing paper, copying paper, paper rolls for cash registers, drawing materials, chalkboards, painting pencils, watercolors [paintings], paint rollers and paintbrushes for painting, furniture, made of any kind of material, mattresses, pillows, air mattresses and cushions, not for medical purposes, water beds, mirrors, rocking chairs for babies, playpens for babies, cradles, infant walkers, display boards, frames for pictures and paintings, identification plates, identification tags, nameplates, identification labels made of wood or synthetic materials, packaging containers of wood or plastics, casks for use in transportation or storage, barrels, storage drums, tanks, boxes, storage containers, transportation containers, chests, loading pallets and closures for the aforementioned goods, of wood or plastics, small hardware goods of wood or synthetic materials included in this class, furniture fittings, of wood or synthetic materials, opening and closing mechanisms of wood or synthetic materials, ornaments and decorative goods of wood, cork, reed, cane,

wicker, horn, hone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum, beeswax, plastic or plaster namely figurines, holiday ornaments for walls, sculptures, trophies, kennels, nesting boxes and beds for household pets, portable ladders and mobile boarding stairs of wood or synthetic materials, bamboo curtains, roller indoor blinds [for interiors], slatted indoor blinds, strip curtains, bead curtains for decoration, curtain hooks, curtain rings, curtain tie-backs, curtain rods, clothing, including underwear and outerclothing, other than special purpose protective clothing, socks, mufflers [clothing], shawls, bandanas, scarves, belts [clothing], footwear, shoes, slippers, sandals, headgear, hats, caps with visors, berets, caps [headwear], enabling customers to conveniently view and purchase those goods, such services may be provided by retail stores, wholesale outlets, by means of electronic media or through mail order catalogues.

Class 42 *Scientific and industrial analysis and research services; engineering; engineering and architectural design services; testing services for the certification of quality and standards; computer services, namely, computer programming, computer virus protection services, computer system design, creating, maintaining and updating websites for others, computer software design, updating and rental of computer software, providing search engines for the Internet, hosting websites; consultancy in the design and development of computer hardware, rental of computer hardware; industrial design services, other than engineering, computer and architectural design; graphic arts designing.*

COSTS

64. The Opponent has been successful and is entitled to a contribution towards its costs. I bear in mind that the relevant scale for Fast Track oppositions is contained in Tribunal Practice Notice 2/2015. In the circumstances I award the Opponent the sum of £100 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Filing a notice of opposition	£100
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Total

£100

65. I therefore order EBEBEK MAĞAZACILIK A.Ş. to pay Ginger Ray Ltd the sum of £100. 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 24th day of March 2023

Dafydd Collins

For the Registrar