O/0619/24

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3855414

IN THE NAME OF

UK FLAVUOR FACTORY LTD

TO REGISTER THE FOLLOWING TRADE MARK:

IN CLASS 34

AND

IN THE MATTER OF OPPOSTION THERETO

UNDER NO. 439231

BY

ECO JUICES (GLOBAL) LIMITED

Background and pleadings

1. On 02 December 2022, UK FLAVUOR FACTORY LTD ("the applicant") applied to register the trade mark shown on the cover page in this decision, in the UK ("the contested mark"). It was accepted and published in the Trade Marks Journal on 23 December 2022 in respect of the following goods:

Class 34 *Oral vaporizers for smokers; Liquid for electronic cigarettes; Electronic cigarette liquid [e-liquid] comprised of propylene glycol; Liquids for electronic cigarettes; Electric cigarettes [electronic cigarettes].*

2. On 17 February 2023, ECO JUICES (GLOBAL) LIMITED ("the opponent") filed a notice of opposition on the basis of Section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opponent relies on the following trade marks:

Mark 1:

NYX

UK registration no.: UK00003370736

Filing date: 28 January 2019

Priority date: 28 August 2018 (EUIPO)

Date of entry in register: 19 April 2019

Mark 2:

NYX

UK registration no.: UK00917947972[1]

Filing date: 28 August 2018

[1] The earlier mark was initially registered at the European Union Intellectual Property Office (EUIPO). On 1 January 2021, the UK left the EU. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing EUTM. As a result of the earlier mark being registered as an EUTM, at the end of the Implementation Period, it was automatically converted to a comparable UK trade mark. The comparable UK mark is now recorded on the UK trade mark register and has the same legal status as if it had been applied for and registered under UK law, and the original filing date remains.

Date of entry in register: 11 April 2020

3. The opposition relies on all goods, namely:

UK registration no.: UK00003370736

Class 34 *Electronic cigarettes and parts and fittings therefor; liquid nicotine solutions for use in electronic cigarettes; electronic cigarettes for use as an alternative to traditional cigarettes, and parts and fittings therefor; smokeless cigarette vaporizer pipes and parts and fittings therefor; electronic smoking accessories, namely, electronic cigarette flavour refill cartridges sold empty, cartridges sold filled with chemical flavourings in liquid form to produce the vapour and supply the flavouring for electronic cigarettes, and chemical flavourings in liquid form used to refill electronic cigarette cartridges; electronic rechargeable cigarette cases.*

UK registration no.: UK00917947972

Class 34 *Electronic cigarettes and parts and fittings therefor; liquid nicotine solutions for use in electronic cigarettes; electronic cigarettes for use as an alternative to traditional cigarettes, and parts and fittings therefor; smokeless cigarette vaporizer pipes and parts and fittings therefor; electronic smoking accessories, namely, electronic cigarette flavour refill cartridges sold empty, cartridges sold filled with chemical flavourings in liquid form to produce the vapour and supply the flavouring for electronic cigarettes, and chemical flavourings in liquid form used to refill electronic cigarette cartridges; electronic rechargeable cigarette cases; none of the aforesaid products containing tobacco.*

4. The opponent claims that the marks are highly similar and that the contested goods are either identical or highly similar to those covered by the earlier marks.

5. The applicant filed an amended defence and counterstatement denying that the marks are similar, although admitting that the classes are the same. The applicant

stated: “I do accept that our usage classes are of the same as we are both within the vaping industry”.[2] I will return to this point later in this decision.

6. The applicant is unrepresented in these proceedings. The opponent is represented by HGF Limited.

7. No evidence was filed in these proceedings however both parties filed submissions in lieu of a hearing. These will not be summarised but will be referred to as and where appropriate during this decision.

8. No hearing was requested and so this decision is taken following a careful consideration of the papers.

DECISION

9. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK’s withdrawal from the EU.

Section 5(2)(b)

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

> “5(2) A trade mark shall not be registered if because-
>
> […]
>
> (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

[2] Applicant’s form TM8, Q8.

11. Given the priority and filing dates of the UK00003370736 mark and the filing date of the UK00917947972 mark, the opponent's marks each qualify as an earlier trade mark under section 6(1) of the Act. As the earlier marks had not completed their registration process more than five years before the filing date of the application in issue, they are not subject to proof of use pursuant to section 6A of the Act. The opponent can, therefore, rely upon all the goods it has identified without having to demonstrate use.

12. 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.

Comparison of goods

13. As outlined earlier in this decision, within the amended Form TM8 and counterstatement,[3] the applicant admits that the goods within their specification are in the same class as the opponent's goods. Without putting forward a blanket denial for the competing specifications, it is deemed to have accepted the opponent's contentions in relation to the competing terms.[4] Nevertheless, I must still undertake a comparison in order to identify the degree of similarity between the goods.

[3] Applicant's form TM8, Q8.
[4] Prof. Phillip Johnson, sitting as the Appointed Person, in *SKYCLUB*, BL O/044/21, paragraph 24.

14. I also note that in its written submissions,[5] the applicant states that their trademark is used on a wide array of products, which they consider distinguishes it from the earlier mark. This can have no bearing on my decision. I must consider the matter solely based on the terms the parties' have registered or seek to register.

15. The goods to be compared are set out below:

The opponent's goods	The applicant's goods
UK registration no.: UK00003370736 Class 34 *Electronic cigarettes and parts and fittings therefor; liquid nicotine solutions for use in electronic cigarettes; electronic cigarettes for use as an alternative to traditional cigarettes, and parts and fittings therefor; smokeless cigarette vaporizer pipes and parts and fittings therefor; electronic smoking accessories, namely, electronic cigarette flavour refill cartridges sold empty, cartridges sold filled with chemical flavourings in liquid form to produce the vapour and supply the flavouring for electronic cigarettes, and chemical flavourings in liquid form used to refill electronic cigarette cartridges; electronic rechargeable cigarette cases.* **UK registration no.: UK00917947972** Class 34	Class 34 *Oral vaporizers for smokers; Liquid for electronic cigarettes; Electronic cigarette liquid [e-liquid] comprised of propylene glycol; Liquids for electronic cigarettes; Electric cigarettes [electronic cigarettes].*

[5] Applicant's final written submissions dated 13 December 2023.

Electronic cigarettes and parts and fittings therefor; liquid nicotine solutions for use in electronic cigarettes; electronic cigarettes for use as an alternative to traditional cigarettes, and parts and fittings therefor; smokeless cigarette vaporizer pipes and parts and fittings therefor; electronic smoking accessories, namely, electronic cigarette flavour refill cartridges sold empty, cartridges sold filled with chemical flavourings in liquid form to produce the vapour and supply the flavouring for electronic cigarettes, and chemical flavourings in liquid form used to refill electronic cigarette cartridges; electronic rechargeable cigarette cases; none of the aforesaid products containing tobacco.	

16. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-133/05, the General Court ("GC") stated:

> "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 the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services* (ELS) [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark"

17. In comparing the respective specifications, all relevant factors should be considered, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*., where the

Court of Justice of the European Union ("CJEU") stated at paragraph 23 of its judgment:

> "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."

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

> (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.

19. For the purposes 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 and for the same reasons.[6]

20. The goods listed under both earlier marks are identical albeit the UK00917947972 mark contains the limitation '*none of the aforesaid products containing tobacco'.* As the earlier marks are identical, I will undertake the comparison based on the specification set out in the UK00003370736 mark, as it does not include a limitation, and therefore offers the greater scope of protection.

Oral vaporizers for smokers.

21. An oral vaporizer for smokers is a device used to vaporize substances for the user to inhale. The opponent's term *smokeless cigarette vaporizer pipes* falls within this broader term as it can be considered a type of oral vaporizer for smokers. The goods are therefore identical under the principle outlined in *Meric.*

Liquid for electronic cigarettes; Liquids for electronic cigarettes.

22. The opponent's term *Liquid nicotine solutions for use in electronic cigarettes* falls within the applicant's above broader category. The goods are therefore identical under the principle outlined in *Meric.*

Electronic cigarette liquid [e-liquid] comprised of propylene glycol.

23. I consider that the opponent's term *Liquid nicotine solutions for use in electronic cigarettes* is the closest comparator for the above opposed term. It is my understanding that e-liquids for electronic cigarettes are comprised of a selection of four ingredients (propylene glycol, vegetable glycerine, nicotine and flavourings). Propylene glycol and vegetable glycerine are used as a base ingredient, and nicotine and flavourings are added to this base to create a final mixture which will be added to an electronic cigarette and inhaled by the user. Therefore, the opponent's *Liquid nicotine solutions* would be added to the applicant's *Electronic cigarette liquid [e-liquid] comprised of propylene glycol* in order to create a mixture intended for use in an

[6] *Separode Trade Mark* (BL O/399/10), per Mr Geoffrey Hobbs QC, sitting as the Appointed Person; and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35, at paragraphs 30 to 38).

electronic cigarette. The goods therefore overlap in method of use, user and trade channels. I also consider there to be some overlap in nature, as both goods are liquids, although a point of difference exists in that one contains nicotine and the other does not. The intended purpose will differ as one is to enable the user to receive a dose of nicotine, and the other is intended as a base to suspend flavourings and nicotine. I do not find them to be competitive, as a consumer would not select a liquid nicotine solution instead of an e-liquid comprised of propylene glycol, instead, I find them to be complementary. In order to use liquid nicotine in an electronic cigarette, it must be added to an e-liquid solution comprised of either propylene glycol or vegetable glycerine, or a combination of both. Taking all the above into account, I find the goods similar to a high degree.

Electric cigarettes [electronic cigarettes]

24. These goods are self-evidently identical to the opponent's *electronic cigarettes.*

Average consumer and the purchasing act

25. The average consumer is a legal construct, deemed to be reasonably well informed and reasonably circumspect: see *Hearst Holdings Inc & Anor v A.V.E.L.A. Inc & Ors,* [2014] EWHC 439 (Ch), paragraph 60. 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, at [26].

26. The average consumer for the contested goods will be a member of the general public aged over 18. The goods will likely be a relatively frequent purchase and priced at a relatively low cost. During the purchasing process, consideration will be taken of factors such as price, flavour, nicotine content and, in the case of electronic cigarettes and oral vaporisers, design and appearance. Consequently, I consider that a medium degree of attention will be paid during the purchasing act.

27. The goods at issue will be purchased in general retail shops, specialist vape stores or via online retailers. In its submissions, the opponent claims that the consumer

will need to request the goods by name.[7] In the case of retail stores, I agree. These goods will be stored behind a counter and, in order to make a purchase, the customer will need to request them from a shop assistant. Aural considerations will therefore play an important role in the purchasing act. However, I also consider that visual considerations will play an equal role. Although the consumer will need to request the items, they will be on display behind the counter for visual inspection first, and then the consumer will have sight of the packaging at the point of sale. In the case of purchases from online retailers, visual considerations will dominate the purchasing process. However, I do not discount an aural aspect to the process as advice may be sought via telephone or through word-of-mouth recommendations. I therefore consider that both aural and visual considerations will play an equal role during the purchasing process.

Comparison of marks

28. The respective trade marks to be compared are shown below:

Earlier trade marks	Contested trade mark
Mark 1: UK00003370736 NYX **Mark 2:** UK00917947972 NYX	

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:

[7] Opponent's written submissions dated 20 December 2023, paragraph 18.

> ".....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.

Overall impression

31. The opponent's earlier marks are identical. Consequently, I will proceed to refer to them in the singular, i.e. the earlier mark. The earlier mark is a word only mark consisting of one word 'NYX'. The overall impression therefore lies within this word.

32. The contested mark is a figurative mark consisting of the two words 'NIX' and 'FIX'. The word 'NIX' is situated directly above the word 'FIX' with the letters 'IX' forming the visual impression of a mirror image, and giving an aural rhyme to the mark. The letters within the mark are minimally stylised, apart from the letter 'F', which is presented in an unusual font. Both words are of the same size with neither being dominant over the other and, given the rhyme created by the duplicate ending 'IX', I consider that the two words form a unit. As such, I find that each word plays an equal role within the mark and, as a result, the overall impression lies within the mark as a whole.

Visual comparison

33. The earlier mark, 'NYX', consists of three letters beginning with the letter 'N' and ending with the letter 'X'. This coincides with the beginning and end letters of the first word of the contested mark (from top to bottom), 'NIX', which is also a three letter word, but differing in the second letter 'NYX/NIX'. The contested mark also contains the word 'FIX' which introduces another point of difference. As stated earlier, I find that both words play an equal role within the overall impression of the mark. The stylisation

of the letter ‘F’ and repetition of the letters ‘IX,’ which are aligned as a mirror image under the ‘IX’ in the word ‘NIX’, also imbue the mark with a striking visual character which is absent from the earlier mark. Taking into account these differences, as well as the similarity created by the presence of the letters ‘N’ and ‘X’, and considering the principle of notional and fair use of word only marks,[8] I find the mark visually similar to a low degree.

Aural comparison

34. The earlier mark consists of the word ‘NYX’. In its written submissions,[9] the opponents submits that the word ‘NIX’ in the applicant’s mark, forms the dominant and distinctive element, and will be pronounced identically to the word ‘NYX’. I disagree. As explained above, I find that the words ‘NIX FIX’ play an equal role within the applicant’s mark, with neither being dominant or distinctive over the other. In addition, while there may be some consumers who will pronounce the earlier mark ‘NYX’ as the one syllable word “NICS”, I consider this proportion to be very small. Given the absence of vowels within the word, the vast majority will view the mark as an initialism rather than an acronym. The word will therefore be pronounced, by the majority, as the three separate syllables “EN/WHY/EKS”. In comparison, the contested mark consists of the two words ‘NIX FIX’, which will be pronounced as the two syllables “NICS-FICS”. Given the rhyme created by the duplicate word endings, ‘-ICS’, and the equal weighting both words have within the mark, I consider that both words will be articulated by the consumer. I therefore find that the marks are aurally dissimilar.

Conceptual comparison

35. The word ‘NYX’ in the earlier mark will be seen by the majority of consumers as an initialism with no known meaning. I acknowledge that, in Greek mythology, Nyx is the goddess and personification of the night, however, I consider the proportion of consumers who will identify this meaning, particularly in relation to the contested goods, to be negligible. The opponent submits that the words “NIX and NYX are meaningless, although weakly suggestive of the longer word ‘*nicotine*’”.[10] I am not

[8] Case T-24/17 *LA Superquimica v EUIPO* [2018], ECLI:EU:T:2018:668, paragraph 39 also see *Herno S.p.A. v Miss Sparrow Ltd,* O/645/21
[9] Opponent’s written submissions dated 20 December 2023, paragraph 15.
[10] Opponent’s final written submissions dated 20 December 2023, paragraph 20.

aware of these words being a common shortening of the word 'nicotine' and no evidence has been provided to demonstrate this assertion. When viewing the words, I consider it highly unlikely that the average consumer will make this connection and I therefore disagree that the earlier mark is weakly suggestive of the word 'nicotine'. Instead, I find that the mark has no immediate perceptible meaning, and therefore the average UK consumer will see the mark as an invented term with no identifiable concept.

36. The contested mark contains the words 'NIX' and 'FIX'. The opponent submits that the word 'FIX' is frequently used in connection with addictive substances to mean a 'dose' of that substance.[11] I agree with this submission. When used in relation to the contested goods, the word can therefore be considered allusive i.e. the goods will be used to provide a dose of something for the user to inhale. The word 'NIX' will be seen as an invented term with no known meaning. For the same reasons set out in the previous paragraph, I also disagree with the opponent's submission that this word is suggestive of the word 'nicotine'. Taking into account the contested goods, I consider that the mark 'NIX FIX', as a whole, will be conceptualised as relating to goods which provide a dose of something that is strongly desired or craved.

37. As the earlier mark has no identifiable concept, whereas the contested mark will be construed, as a whole, as providing the user with a dose of something, I find that the marks are conceptually dissimilar.

Distinctive character of the earlier trade mark

38. 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-

[11] Opponent's final written submissions dated 20 December 2023, paragraph 21.

108/97 and C-109/97 *WindsurfingChiemsee* 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)."

39. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with a very high inherent distinctive character, such as invented words which have no allusive qualities. The opponent has not filed any evidence to show that its mark has obtained enhanced distinctiveness, therefore, I have only the inherent position to consider.

40. As previously stated, the earlier mark is likely to be perceived by the vast majority of average consumers as an initialism with no known meaning. Consequently, I consider it to be inherently distinctive to a high degree.

Likelihood of Confusion

41. In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

"38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that 'the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion'. This is indeed what was said

in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it."

42. 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. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer of the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

43. Earlier in my decision I found the following:

a) The goods are either identical, or similar to a high degree.

b) The average consumer is a member of the general public aged over 18.

c) Both aural and visual considerations will play an equal role during the purchasing process.

d) A medium degree of attention will be paid during the purchasing act.

e) The marks are visually similar to a low degree.

f) The marks are aurally dissimilar.

g) The marks are conceptually dissimilar.

h) The opponent's mark is inherently distinctive to a high degree.

44. Taking all of the above into account, and considering that the average consumer tends to perceive trade marks as wholes, I find it unlikely that the differences between the marks will be overlooked, or that a consumer will mistakenly recall or misremember the marks. The aural and conceptual differences, particularly those created by the presence of the second word "FIX" in the contested mark, will not go unnoticed. In addition, the visual impact and the aural rhyme created by the duplication of the '-IX' in the contested mark, is absent from the earlier mark. Therefore, even when factoring in the principles of imperfect recollection and interdependency, I do not consider there to be a likelihood of direct confusion.

45. I now go on to consider indirect confusion. Indirect confusion involves recognition by the average consumer of the difference between the marks. It was described in the following terms by Iain Purvis Q.C. (as he was then) sitting as the Appointed Person in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10:

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

46. Whilst I note that the examples set out by Mr Purvis are not exhaustive, I note the recent case of In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, wherein Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

47. The common elements in the opposing marks are the letters 'N' and 'X' presented as the first and third letters in the earlier mark and the first word element in the competing mark "NYX / NIX FIX". In order to find indirect confusion, the average consumer will need to notice these common elements, while also recalling the differences between them, and assume that the marks derive from the same or connected undertakings. I consider it unlikely that the average consumer will reach this conclusion and, instead, will view the presence of these shared letters as coincidence rather than due to an economic connection. The visual, aural and conceptual differences between the marks are not consistent with a logical brand extension, sub-brand or rebrand.

48. Therefore, I do not find that the instant case falls within any of the categories identified by Mr Purvis. I acknowledge that these categories are not intended to be exhaustive, however, I cannot see any commercially sensible rationale for the marks to be considered related brands or variations of marks originating from the same or economically linked undertakings. Consequently, I do not consider that there is any likelihood of indirect confusion.

Conclusion

49. The opposition under Section 5(2)(b) of the Act has failed. Subject to any successful appeal against my decision, the application may proceed to registration for all its goods.

Costs

50. As the applicant has been successful, it would ordinarily be entitled to a contribution toward its costs. However, in an official letter dated 21 November 2023, the applicant was invited to complete a cost pro forma if it intended to make a request for costs. If the pro forma was not returned, the letter confirmed that “costs, other than official fees arising from the actions… may not be awarded.” On the basis that the applicant did not return a completed cost pro forma, I will not award any costs in this matter.

Dated this 28th day of June 2024

Nicola Janoo

For the Registrar