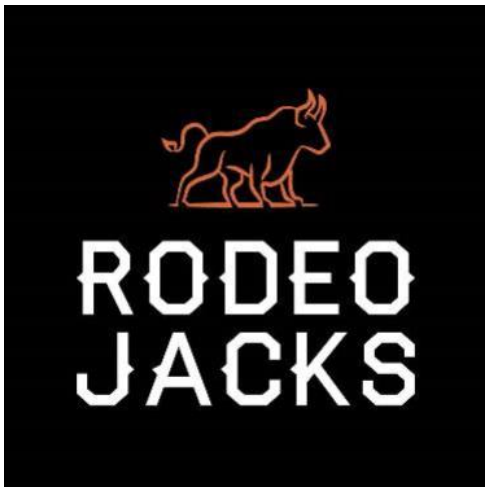
BL O/0648/24

IN THE MATTER OF THE TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO. 3651178

BY RODEOJACKS LIMITED FOR THE TRADE MARK



IN CLASSES 11, 16, 21, 28, 29, 30, 31, 35, 37, 39 and 43

AND THE OPPOSITION THERETO UNDER NO. 428075

BY SERVICE-BUND GMBH & CO KG

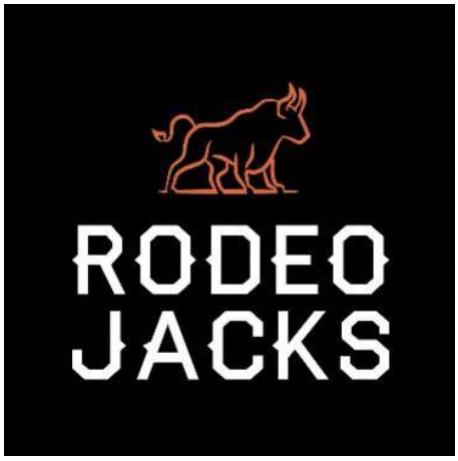
AND IN THE MATTER OF AN APPEAL FROM THE DECISION OF RHEA MORRIS (O/0024/24) DATED 15 JANUARY 2024.

DECISION

Introduction

1. This is an appeal by Service-Bund GmbH & Co. KG ("**Appellant**") from decision O/0024/24 of Ms N.R. Morris ("**Decision**") concerning the opposition by the Appellant to RodeoJacks Limited's ("**Respondent**") application for the figurative mark shown below ("**Application**"), applied for on 4 June 2021 in respect of goods and services in classes 11, 16, 21, 28, 29, 30, 31, 35, 37, 39 and 43[1].

[1] A full list of the goods and services applied for was included at Annex 1 to the Decision and is not repeated here.



2. The Appellant opposed the Application under section 5(2)(b) of the Trade Marks Act 1994 in respect of all goods in classes 11, 21, 29, 30, 31, 35 and 43, and *Food delivery* only in Class 39.

3. The Appellant relied upon three mark registrations, details of which are set out below:

Number	**Mark**	**Filing and registration date**	**Goods**
UK909273129	**Rodeo**	26/07/2010, 06/09/2014	Class 29: *Meat products; steaks, steak spices; meat* Class 30: *Spices; sauces (including salad dressings); steak sauces* Class 43: *Services for providing food and drink*
WO465144	**RODEO**	3 May 2017, 26/11/2019	Class 29: *Meat, sausages, slicing sausages and charcuterie; steaks,* *canned meat, sausages and slicing sausages; fish, poultry* *and game; preserved, dried and cooked vegetables; meat,* *fish, vegetable and fruit salads, salad dressings* Class 30: *Spices; sauces* Class 43: *Supply and provision of meals for consumers; catering* *services*
UK915333214	**Rodeo**	13/04/2016, 16/09/2016	Class 4: *Barbecue lighting fuel; igniters for barbecue grill; Combustible briquettes* Class 11: *Cooking apparatus, including barbecue grills and parts and accessories therefor, namely barbecue covers; Grills; Boxes for gas canisters; Connections for gas containers; barbecue rods; Warming racks and baskets; Charcoal grills; side burners; Holders for flavoriser bars; Holders for charcoal briquettes; Mechanical, electric and piezoelectric apparatus for igniting gas and*

			charcoal; Hub caps for barbecue grills; Ash pans for barbecue grills; Lid handles for barbecue grills; Casters or wheels for barbecue grills; Drip trays and drip tray holders for barbecue grills; Control knobs for barbecue grills; Plates of cast iron and steel; Gas burners for barbecue grills; Barbecue chimney starters; Roasting spits Class 21: *Hand-operated household utensils and containers for barbecues or for grilling or roasting (not of precious metal or coated therewith), in particular barbecue covers; Condiment holders; Holders for grill accessories; Basting brushes; Fish slices; Spatulas; Drip trays; Meat trays and Roasting trays; Woks for barbecue grills; Sponges; Brushes (except paint brushes); Articles for cleaning purposes*

4. I shall refer to the above as "**the '129 Mark**", "**the '144 Mark**" and "**the '214 Mark**" respectively, and collectively as the "**Earlier Marks**".

5. Each side filed evidence and written submissions. Neither party requested a hearing and the Hearing Officer therefore made a determination on the papers. In the Decision, N.R. Morris for the Registrar held that the oppositions were unsuccessful.

6. On 14 February 2024 the Appellant filed a Notice to Appeal to the Appointed Person against the Decision under Section 76 of the Trade Marks Act 1994.

The Hearing Officer's decision

7. The Hearing Officer held as follows (in summary, and insofar as is relevant to this appeal):

   a. The Appellant being put to proof of use of the '129 Mark, demonstrated genuine use in respect of *steaks, steak spices; lamb; beef* in class 29, and *sauces; steak sauces* in class 30. No proof of use being required, it was entitled to rely on the full specifications of the '144 and '214 Marks;

   b. The average consumer is a member of the general public or a business user. The average general public consumer will exercise no more than a medium degree of attention, whereas business consumers will pay a level of attention just above medium;

   c. The purchasing act will be primarily visual, but there may also be an aural aspect where advice is sought from retail/wholesale staff or purchases are made following word of mouth recommendations;

   d. The Earlier Marks have a level of distinctive character "*just above low"* in relation to any *beef/steak/barbeque* related goods, and in relation to the Appellant's services, and a "*medium level"* of inherent distinctive character in relation to the balance of the Appellant's goods, with no enhanced level of distinctiveness through use;

e. The Application is visually similar to a "*no more than medium"* degree; aurally similar to a *"medium to high degree"*; and conceptually similar to a "*medium degree"* to the Earlier Marks;

f. There are varying degrees of identity, similarity or dissimilarity between the Appellant's and Respondent's goods and services;

g. There is no likelihood of direct or indirect confusion, and the oppositions were therefore unsuccessful.

Grounds of Appeal

8. The Grounds of Appeal are as follows:

a. **Ground 1:** The Hearing Officer erred in the assessment of likelihood of confusion, including by (i) failing properly to apply their own findings as to similarity of marks (and unduly focussing on the different elements, to the exclusion of the similar ones) (ii) in circumstances where the findings as to similarity of marks were themselves incorrect, and (iii) failing otherwise properly to apply the law on likelihood of confusion, including the interdependency principle, and the possibility of imperfect recollection, by disregarding entirely the possibility of aural confusion.

b. **Ground 2:** The Hearing Officer failed to take due account of the interdependency principle, paying only lip-service to it.

c. **Ground 3:** The Hearing Officer gave too much weight to the additional word 'JACK' within the Application, and incorrectly minimised the importance of the identical word element 'RODEO'.

9. The Appellant's Counsel, Mr Carter, expanded upon the above in his skeleton argument and at the hearing, and I set out below further details as are necessary to understand my overall conclusions. The Respondent filed a skeleton argument and its Trade Mark Attorney, Mr Kingsley-Williams, expanded on those arguments in the hearing. I am grateful to both advocates for their clear and detailed written and oral submissions, which I found very helpful.

Standard of review

10. The approach to be adopted in an appeal hearing has been laid down a number of times in case law. It was summarised in *Axogen v Aviv* [2022] EWHC 95 (Ch) at §24-25:

"Appellate Function

24. Although I was referred to numerous cases on the subject (including *English v Emery Demibold & Struck Ltd* [2002] 1 WLR 2409, *REEF Trade Mark* [2003] RPC 5, *Fine & Country Ltd v Okotoks Ltd* [2014] FSR 11, *Fage UK Ltd v Chobani UK Ltd* [2014] EWCA Civ 5, *Shanks v Unilever Plc* [2014] RPC 29, *TT Education Ltd v Pie Corbett Consultancy* [2017] RPC 17, *Apple Inc v Arcadia Trading Limited* [2017] EWHC 440 (Ch), *Actavis Group PTC v ICOS Corporation* [2019] UKSC 1671 and *NINEPLUS* O/039/21), the approach of the appeal court to a statutory appeal under section 76(1) of the TMA is uncontroversial. I bear the following principles, relevant to the issues before me, firmly in mind:

i) The appeal is by way of a review, not a rehearing (see *TT Education Ltd v Pie Corbett Consultancy Ltd* (O/017/17) at [52(i)]);

ii) The appeal court will allow an appeal where the decision of the lower court was "wrong" (see CPR 52.11). Neither surprise at a Hearing Officer's conclusion, nor a belief that he or she has reached the wrong decision suffices to justify interference (*NINEPLUS* O/039/21 at [14]);

iii) The decision of the lower court will be "wrong" if the judge makes an error of law, which might involve asking the wrong question, failing to take account of relevant matters or taking into account irrelevant matters. Absent an error of law, the appellate court would be justified in concluding that the decision of the lower court was wrong if the judge's conclusion was "outside the bounds within which reasonable disagreement is possible" (*Actavis Group* at [81]);

iv) The approach required by the appeal court depends on a number of variables including the nature of the evaluation in question (*REEF Trade Mark* [2003] RPC per at [26]). There is a "spectrum of appropriate respect for the Registrar's determination depending on the nature of the decision" (*TT Education* at [52(ii)]), with decisions of primary fact at one end of the spectrum and multi-factorial decisions (of the type which the parties agree were made in this case by the Hearing Officer) being further along the spectrum.

v) In the case of a multifactorial assessment or evaluation, involving the weighing of different factors against each other, the appeal court should show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle. Special caution is required before overturning such decisions (*TT Education* at [52(iv)], *REEF* at [28] and *Fine & Country* at [50]-[51]).

vi) An error of principle is not confined to an error as to the law but extends to certain types of error in the application of a legal standard to the facts in an evaluation of those facts. The evaluative process is often a matter of degree upon which different judges can legitimately differ and an appellate court ought not to interfere unless it is satisfied that the judge's conclusion is outside the bounds within which reasonable disagreement is possible (*Actavis Group* at [80]).

vii) Another variable to be taken into account will be "the standing and experience of the fact-finding judge or tribunal" (*REEF* at [26], *Actavis Group* at [78]). Expert tribunals are charged with applying the law in the specialised fields and their decisions should be respected unless it is quite clear that they have misdirected themselves in law. Appellate courts should not rush to find such misdirections simply because they might have reached a different conclusion on the facts (*Shanks* at [28] citing the warning given by Baroness Hale in *AH (Sudan) v Secretary of State for the Home Department* [2007] UKHL 49).

viii) The appellate court should not treat a judgment as containing an error of principle simply because of its belief that the judgment or decision could have been better expressed; "The duty to give reasons must not be turned into an intolerable burden" (see *REEF* at [29]). The reasons need not be elaborate. There is no duty on a judge, in giving her reasons, to deal with every argument presented by counsel in support of his case. It is sufficient if what she says shows the basis on which she has acted (*English* at [17], *Fage* at [115]). The issues the resolution of which were vital to the judge's

conclusions should be identified and the manner in which she resolved them explained (*English* at [19]).

ix) In evaluating the evidence, the appellate court is entitled to assume, absent good reason to the contrary, that the first instance judge has taken all of the evidence into account (*TT Education* at [52(vi)]).

25. In the context of appeals relating to the likelihood of confusion, an evaluative issue described by Mr Iain Purvis QC sitting as an Appointed Person in *ROCHESTER Trade Mark* BL O/049/17 at [31] as "indeterminate and open to debate", Mr Purvis QC went on to say this at [33]:

"…the reluctance of the Appointed Person to interfere with a decision of a Hearing Officer on likelihood of confusion is quite high for at least the following reasons:

(i) The decision involves the consideration of a large number of factors, whose relative weight is not laid down by law but is a matter of judgment for the tribunal on the particular facts of each case

(ii) The legal test 'likely to cause confusion amongst the average consumer' is inherently imprecise, not least because the average consumer is not a real person

(iii) The Hearing Officer is an experienced and well-trained tribunal, who deals with far more cases on a day-to-day basis than the Appellate tribunal

(iv) The legal test involves a prediction as to how the public might react to the presence of two trade marks in ordinary use in trade. Any wise person who has practised in this field will have come to recognize that it is often very difficult to make such a prediction with confidence. Jacob J (as he then was) made this point in the passing off case *Neutrogena v Golden* [1996] RPC 473 at 482:

'It was certainly my experience in practice that my own view as to the likelihood of deception was not always reliable. As I grew more experienced I said more and more "it depends on the evidence."'

Any sensible Appellate tribunal will therefore apply a healthy degree of self-doubt to its own opinion on the result of the legal test in any particular case.

34. I shall therefore approach this appeal on the basis that in the absence of a distinct and material error of principle, I ought not to interfere with the decision of the Hearing Officer unless I consider that his view on the issue of likelihood of confusion was clearly wrong in the sense that it was outside the range of views which could have been reasonably taken on the established facts."

11. I shall bear all the above in mind when reviewing the Decision.

Discussion

12. As the Appellant contended in its skeleton argument, the three grounds of appeal are to a degree interrelated. Furthermore, given that the first ground is an overarching ground, I shall deal with the grounds in reverse order. Looking at each of the grounds in turn, my analysis is as follows.

(3) The Hearing Officer gave too much weight to the additional word 'JACK' within the Application, and incorrectly minimised the importance of the identical word element 'RODEO'.

13. Within this ground, the Appellant contends that the Hearing Officer (i) failed properly to apply their own findings as to the distinctive character and overall impression of the Application, which did (or logically should have) include(d) a finding that the RODEO element thereof was the most distinctive element (including because it was at the beginning, was conceptually reinforced by the device element, and qualified the word JACKS) (ii) failed to consider or apply the well-established rule of thumb that the beginnings of marks typically carry the most distinctive weight, because consumers read from left to right (iii) failed to consider or apply the well-established rule of thumb that words speak louder than devices (iv) incorrectly found that the RODEO element of the application did not retain an independent distinctive role within it, and (v) made incorrect findings as to visual, aural and conceptual similarity in light of the above.

14. I shall start by considering sub-ground (v), as this impacts on the other sub-grounds. The Hearing Officer's analysis of the conceptual meaning of the Application was as follows (§§184 and 194):

> "*The Applicant's mark will, to my mind, likely be understood by the average consumer as a reference to a person named Jack being a rodeo rider/cowboy. The idea conjured by the Applicant's mark will, in my view, be of something, perhaps an establishment, belonging to 'Jack'. Although both parties' marks contain the word 'Rodeo', the Opponent's marks ('Rodeo', solus) will be perceived as a reference to an event whereas the Applicant's mark 'Rodeo Jacks' will be seen as a reference to a person. In the light of the foregoing, I find the marks to be conceptually similar to a medium degree.*
>
> *…*
>
> *Although the element 'RODEO' is wholly incorporated into the Applicant's mark, the presence of the element 'JACKS' in the Applicant's mark, in my view, creates the impression of a person named 'Rodeo Jack' after whom something/an establishment is named. The element 'Rodeo', solus, in the Opponent's marks conveys the idea of the event by the name of Rodeo. In the Applicant's mark, the element 'Jacks' is linked to the word 'Rodeo' to form a conceptual unit, i.e. something (e.g. an establishment) belonging to a person named 'Rodeo Jack'. I therefore find that the element 'Rodeo' has not retained its independent distinctive role when forming part of the Applicant's mark.*"

15. The Respondent contends, and I agree, that the Hearing Officer held (in terms) that the phrase RODEO JACKS has its own conceptual identity, different and distinct from the word RODEO. Put another way, "the sum is more than the whole of the parts". The Appellant criticises the Hearing Officer's conceptual analysis of the Application. Specifically, it says that "the Hearing Officer's reasoning at §184 is deeply confused, and includes contradictory findings that the concept referred to by the Application is both "*a person named Jack being a rodeo rider/cowboy*", and *"an establishment belonging to 'Jack'"".*

16. I remind myself that the conceptual meaning of the Application was a matter for the Hearing Officer, and I am entitled to intervene only if she made an error of principle or was wrong. I agree that the way in which §184 is worded is a little confusing on a first reading. However, when read in conjunction with §194 it is clear to me that the Hearing Officer found that the Application would be understood as relating to:

- an establishment or some other thing;
- belonging to a man called Jack;
- who is a rodeo rider/cowboy;
- and is known as "Rodeo Jack".

17. It is noteworthy that neither party contended, before the Hearing Officer, for the above conceptual meaning. The Respondent submitted that the Application would be understood as relating to a famous former Rodeo bull-rider from the USA. In its submissions to the Hearing Officer, the Appellant rightly objected that the Respondent had not filed any evidence to support this meaning, for example evidence that a significant proportion of the UK population would recognise the name of that allegedly famous bull-rider. However, the Appellant did not submit any alternative conceptual meaning for the Application. The Hearing Officer therefore had to do her best to determine its conceptual meaning, and I am of the view that the meaning set forth in §§184 and 194 was one that was open to her. It is now too late for the Appellant to contend for some other meaning that was not advanced before the Hearing Officer.

18. Also in relation to sub-ground (v), the Appellant submits that the Hearing Officer should have held that there is a higher degree of visual, aural and conceptual similarity between the Application and the Earlier Marks. Specifically, that she ought to have concluded that the marks are:

- Visually similar to a high degree, or at least an above average degree;
- Aurally similar to a very high degree; and
- Conceptually similar to a very high degree.

19. I am not greatly attracted to this submission. In his well-known decision in *GREYBOX* (O/106/20), Mr Iain Purvis QC (as he then was), sitting as the Appointed Person, said:

> "*I do not consider there is any great value in debating differences between 'fairly low' and 'medium' degrees of similarity in the context of the overall assessment of likelihood of confusion. Certainly, I do not consider that such fine distinctions can properly be characterized as errors of principle. They are at best simply disagreements about the precise 'weight' to be given to a factor in the overall assessment, something which the Courts have consistently rejected as a proper ground of Appeal. Furthermore, given the lack of clarity and subjectivity of the terms in question, it is impossible to have any sensible debate on Appeal about whether the Hearing Officer was right.*"

20. I respectfully agree, and shall therefore not interfere with the Hearing Officer's assessments of level of similarity.

21. Dealing next with sub-ground (ii), as I explained in my decision in *LUCKY BAR* (O/0976/23) the principle laid down in *El Corté Ingles* and other case law is not a hard and fast rule of law. Rather, it is a practical rule of thumb, based on experience and observation. It amounts to no more than "All else being equal, the average consumer will tend to pay more attention to the beginnings of marks than other parts of marks, because consumers read from left to right". Furthermore, the presumption can easily be rebutted, for example where the beginning of the mark is descriptive.

22. The Appellant is right to say that the Hearing Officer did not directly address the pleaded argument that the beginnings of marks typically carry the most distinctive weight. However, two matters are noteworthy. First, the two words in the Application do not read from left to right, as the Application is figurative with one word appearing on top of the other. Secondly, the finding that RODEO JACKS forms its own conceptual unit is likely to militate, at least to some extent, against the *El Corté Ingles* principle.

23. Consequently, there are reasons (albeit not ones expressly identified by the Hearing Officer) why the *El Corté Ingles* principle is likely to have a lesser impact in this instance than it would to a normal word mark. Consequently, even had the Hearing Officer expressly considered the *El Corté Ingles* principle, I am not persuaded that her overall analysis would have been different.

24. Turning to sub-ground (iii), the Appellant contends that "*words speak louder than devices",* relying on *SKYRIOUSLY* O/265/22 at §15, and *Bentley 1962 Ltd v Brandlogic and Bentley Motors* [2020] FSR 15 at §66. Again, as recognised by the Appellant, this is a rule of thumb rather than a rule of law. At §180 the Hearing Officer said:

> "*The Applicant's mark is a composite mark comprising a slightly stylised text element 'Rodeo Jacks' and a device depicting what appears to be a stylised bull (or horned cow) rendered in a dark orange hue; all elements set against a solid black background. I consider that the word element 'Rodeo Jacks' plays the greater role owing to its size and the contrast accorded by the white characters being set against the black background. The device, to my mind, plays a lesser role owing to its comparatively muted tone"*.

25. It is clear to me that although the Hearing Officer did not expressly refer to the above-mentioned rule of thumb, or cite any of the case law relied upon by the Appellant, her conclusion as to the role played by the device was wholly in line with that rule of thumb and case law.

26. As to sub-ground (i), the Hearing Officer did not address the issue of which, if any, of the two words is the most distinctive and dominant element. I surmise therefore that she was of the view that the two words were equally distinctive and dominant. I have already addressed the Appellant's contentions regarding beginnings of marks. At §192 when considering likelihood of confusion, the Hearing Officer found that "*the device will likely reinforce the concept conveyed by the word 'Rodeo'*". The Appellant submits that the "logical conclusion necessitated by those findings [i.e. the words having a greater role than the device, and the word RODEO being reinforced by the device] is that the word RODEO is the dominant element of the Application – alternatively that it is the most distinctive element, and contributes the most to the overall impression of the Application, even if it is not strictly dominant".

27. It seems to me that the Appellant is correct in this regard. It follows as a matter of logic that if the device reinforces the concept conveyed by the first word, but not the second word, the distinctive character of the first word must be greater than that of the second word, even if only to a small extent.

28. With regard to sub-ground (iv), the Hearing Officer held at §194 that the word "*has not retained its independent distinctive role when forming part of the Applicant's mark*". That conclusion follows on from the Hearing Officer's analysis of the conceptual meaning of Application, as set out at §14 above. However, given my conclusion at §27 above, I am of the view that the Hearing Officer's finding that the device reinforces the concept conveyed by the word RODEO means

that she should, as a matter of logic, have held that the word RODEO retains at least some independent distinctive role within the Application.

29. Drawing the above threads together, I have dismissed sub-grounds (ii), (iii) and (v), but have held in relation to (i) and (iv) that the Hearing Officer's overall conclusion does not follow on from her findings. I am accordingly entitled to revisit the issue of distinctive and dominant elements for myself.

30. The starting point is the conceptual meaning of the Application, as found by the Hearing Officer, which I have upheld. That conceptual meaning is distinct from that of the Earlier Marks. Accordingly, it cannot in my view be said that the word RODEO is the dominant element of the Application. However, given that the device reinforces the concept of a rodeo event, the word RODEO does have a slightly greater distinctive role than the word JACK, and retains a small but appreciable degree of independent distinctive role within the Application.

(2) The Hearing Officer failed to take due account of the interdependency principle, paying only lip-service to it

31. The Hearing Officer at §31 set out the familiar list of principles for assessing likelihood of confusion, derived from CJEU case law, including at (g) the interdependency principle: "*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*".

32. At §191, when assessing likelihood of confusion, she said:

> "*I must keep in mind that a global assessment is required taking into account all of the relevant factors, including the principles a) – k) set out above at [31]. When considering all relevant factors 'in the round', I must bear in mind that a greater degree of similarity between goods may be offset by a lesser degree of similarity between the marks, and vice versa*."

33. The Appellant acknowledges, as it must, that the Hearing Officer mentioned the interdependency principle in the Decision. However, it contends that she paid mere lip service to the principle and failed to take it properly into account in her analysis.

34. The difficulty, of course, for the Appellant is in establishing that the Hearing Officer did not <u>in fact</u> apply the interdependency principle, or at least apply it properly, in her decision-making process. Where a Hearing Officer fails to mention a matter altogether, it is permissible to assume that he/she did not take it into account. Where, as here, an argument is mentioned (twice), how can it be established that the Hearing Officer paid mere lip service to it, and did not in fact apply it properly? I discussed this with Mr Carter in the hearing, and proposed that the only satisfactory approach is to ask whether the Hearing Officer's decision was "wrong" (in the sense set out at §10(iii) above). If it is wrong, then it may be appropriate to conclude that the (or at least one of the) reason(s) it is wrong is that the Hearing Officer failed to apply the interdependency principle. If, though, the decision is within the bounds within which reasonable disagreement is possible, no conclusion can properly be drawn about whether the interdependency principle was applied.

35. Mr Carter agreed with that approach, and added that I should bear in mind that the Decision contains no separate assessment by reference to identical goods and services, highly similar ones and so on, suggesting a blanket approach on the Hearing Officer's part. I agree, and propose to take the Respondent's case at its highest – identical goods and services – and ask

whether the finding of no likelihood of confusion was one that was open to the Hearing Officer. If it was, then the Appellant's case can be no better in relation to goods and services which are merely similar. Given that her assessment of likelihood of confusion is the subject of ground 1, to which I now turn, I shall carry out that analysis after considering the Appellant's other arguments in relation to ground 1.

(1) The Hearing Officer erred in the assessment of likelihood of confusion

36. The Appellant's criticisms under this head are two-fold. First, that the Hearing Officer was wrong, insofar as no reasonable Hearing Officer could have rejected a likelihood of confusion in the circumstances. Secondly, that in any case the Hearing Officer made errors of principle in her assessments of the likelihood of direct and indirect confusion.

37. Dealing first with the issue of whether the Hearing Officer was wrong, I shall take the Appellant's case at its highest:

- Identical goods and services;
- Medium level of inherent distinctiveness;
- Medium degree of attention on part of average consumer;
- Visually similar to a "*no more than medium"* degree; aurally similar to a *"medium to high degree"*; and conceptually similar to a "*medium degree*".

38. The Appellant submits that "*in the absence of a significant contrary factor, the Officer's analysis of the similarity of the marks and goods/services, along with the inherent distinctiveness of the earlier mark, should have led to a finding of there being a likelihood of confusion*". I accept that the above combination of factors would commonly, perhaps usually, lead to a finding of a likelihood of confusion. However, each case must be considered on its own facts. The Hearing Officer made a finding as to the conceptual meaning of the Application, which I have upheld. She then carefully explained why that conceptual meaning meant that, nothwithstanding the common word RODEO, there is no likelihood of direct or indirect conclusion. Whereas other Hearing Officers may have reached a different conclusion, it cannot be said that her overall conclusion was wrong.

39. Turning now to the alleged errors of principle, with regard to likelihood of direct confusion the Appellant contends that the Hearing Officer:

i) Took insufficient account of the common word RODEO;

ii) Focused too much on the differences between the marks; and

iii) Failed to consider the possibility of aural confusion.

40. The Hearing Officer's analysis of the visual and aural similarities of the marks was set out at §§181-183 (I have already cited her analysis of conceptual similarity at §14 above):

> "Visual comparison
> 181. Both parties' marks contain the word element 'Rodeo'. The points of visual difference are:
>
> - the presence of the 'bull' device in the Applicant's mark, which is absent from the Opponent's marks;

- the presence of the solid black background in the Applicant's mark, which is absent from the Opponent's marks;
- the presence of the word element 'Jacks' in the Applicant's mark, which is absent from the Opponent's marks.

I do not consider that the slight stylisation of the earlier figurative mark will be an appreciable difference from the standpoint of the average consumer.

182. I find the marks to have no more than medium level of visual similarity. I find this to be the case in respect of all three of the earlier marks.

Aural comparison

183. The Opponent's marks are likely to be articulated as 'ROE-DEE-OH'. The Applicant's mark will likely be articulated as 'ROE-DEE-OH JAKS'. The first three syllables of the Applicant's mark are aurally identical to the Opponent's mark. The only aural difference between the parties' mark is the presence of the 'JAKS syllable in the Applicant's mark, which is absent from the Opponent's mark. I find the parties' marks to be aurally similar to a medium to high degree".

41. Drawing all the various factors together, her analysis of likelihood of direct confusion was at §192:

> "*I have found a number of goods and services set to be identical or to have some level of similarity with the Opponent's goods and services. However, I am of the view that the net effect of the visual, aural and conceptual differences between the parties' marks is sufficient to prevent the average consumer from mistaking one party's mark for the other. I have found the marks to be visually similar to no more than a medium degree. The visual aspect of the marks will be particularly important given that the purchasing act will be primarily visual in nature. I consider that the differences that I have identified between the marks will be registered by the average consumer and are sufficiently marked that one party's mark would unlikely be mistaken for the other. I find that the difference in the length of the marks will be particularly apparent, visually speaking, because the Applicant's mark contains twice the number of characters as the Opponent's mark. The positioning and size of the element 'JACKS' is such that it would not be easily overlooked. The presence of the 'bull' device will also be noticed by the average consumer due to its central position above the text elements, although I appreciate that the device will likely reinforce the concept conveyed by the word 'Rodeo'. I find that there is no likelihood of direct confusion. I find this to be the case even where no more than a medium level of attention would be paid during the purchasing act*".

42. I consider that the Appellant's first two criticisms are unfounded. It is clear that the Hearing Officer had well in mind the common element RODEO – indeed it was the first thing she mentioned at §181. In considering whether there is a likelihood of direct confusion, i.e. one which "involves no process of reasoning – it is a simple matter of mistaking one mark for another" (Iain Purvis QC sitting as the Appointed Person in *L.A. Sugar Limited v Back Beat Inc*, O/375/10), the Hearing Officer was entitled to look at the differences as well as the similarities between the marks.

43. Nor in my view would her conclusion have been different had she approached the question on the basis that RODEO has a slightly greater distinctive role than the word JACK, and retains a

small but appreciable degree of independent distinctive role within the Application, as I have held she should have done. The differences she identified would still, I consider, ensure that the majority of average consumer would not be confused into mistaking the Application for the Earlier Marks.

44. Finally, with regard to aural confusion, the Hearing Officer held at §176: "*I acknowledge that there may be an aural aspect to the purchasing process where advice is sought from retail/wholesale staff or purchases are made after recommendations by way of 'word of mouth'*". She went on to say, in the second sentence of §192: "*I am of the view that the net effect of the visual, aural and conceptual differences between the parties' marks is sufficient to prevent the average consumer from mistaking one party's mark for the other*". It is clear, therefore, that she did consider aural similarity – her more detailed analysis of visual similarity in §192 was included because she held it "*will be particularly important*", rather than because she did not consider aural similarity.

45. With regard to indirect confusion, after citing the relevant law including the abovementioned *L.A. Sugar* decision, the Hearing Officer said at §196:

> "*The instant case does not fall into any of the categories identified above [i.e. the three L.A. Sugar categories]. While I accept that the categories are not intended to be exhaustive, I can see no other mental process by which the average consumer would arrive at a conclusion indicative of indirect confusion. The Applicant's mark is such that it would not, in my view, make commercial sense as a brand extension or variation of the Opponent's marks and the average consumer would not, therefore, presume both parties' marks to be from the same or economically-related undertakings. There is no likelihood of indirect confusion*".

46. The Appellant does not, I understand, contend that this particular instance falls strictly within any of the L.A. Sugar categories, but rather says:

> "There are multiple logical mental processes which might have led consumers to a belief in a brand connection. For example, consumers might have reasoned that there was a primary RODEO brand for e.g. *meat, sauces, spices, barbeque/cooking apparatus, provision of meals and/or catering services*, and:
>
> (a) the RODEO JACKS brand used for identical or similar goods denoted a sub-brand e.g. using "Jack's" spices/sauce;
>
> (b) the RODEO JACKS brand was one of a family of sub-brands comprising the addition of a common name (e.g. JACK/JILL/JIM) to the primary brand RODEO, each focussed on e.g. (i) a subset of meat (i.e. beef/pork/poultry etc), or (ii) different sauce/spice flavourings applied to common products;
>
> (c) the RODEO JACKS brand used for identical or similar goods or services indicated that this was an establishment under the RODEO brand, the proprietor of which was 'JACK', or was an offering of goods prepared by that establishment. The failure to consider this possibility is particularly striking in circumstances where, on the Hearing Officer's own findings at §184, the brand RODEO JACKS is suggestive of an establishment belonging to 'JACK'.

47. I accept that each of the above is arguable, however it is noteworthy that none of the above suggestions were put to the Hearing Officer by the Appellant. Indeed, the Appellant's

submissions were silent as to the manner in which indirect confusion might occur. In my view, whereas the *L.A. Sugar* categories are not exhaustive (as recognised by the Hearing Officer), if indirect confusion is alleged to occur in a manner falling outside those categories, it is incumbent upon the opponent to specify precisely how indirect confusion is said to arise. It is too late now for the Appellant to put forward what are in effect new arguments on appeal. The Hearing Officer was entitled to conclude that there was no likelihood of indirect confusion, given her finding as to conceptual meaning of the Application, which results in it being viewed by the average consumer as a free-standing brand with a composite meaning, as opposed to a brand extension.

48. In conclusion, therefore, the Hearing Officer made no error of principle, and her conclusion was not wrong. I dismiss this first and overarching ground of appeal.

Conclusion

49. The appeal is dismissed, and the Application may therefore proceed to registration in respect of all goods and services applied for.

Costs

50. Clearly, the Respondent has been the successful party in this appeal. I order that the Appellant shall pay the Respondent the sum of £1,200, comprising:

- Preparation of skeleton argument: £600; and
- Attendance at hearing: £600.

51. The Hearing Officer's order that the Appellant should pay the Respondent £800 by way of costs of the hearing below still stands, and this sum should be paid within 21 days of this decision.

Dr. Brian Whitehead

9 July 2024

Representation

Mr Sam Carter of Counsel, instructed by Dummett Copp LLP, for the Appellant/Opponent

Mr Mark Kingsley-Williams of Trade Mark Direct for the Respondent/Applicant