

O/0659/26

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. UK00004166820
BY YETUNDE INHERITED LIMITED
TO REGISTER:**

Sweat Priority

AS A TRADE MARK IN CLASS 25

AND

**IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 454639
BY O2 WORLDWIDE LIMITED**

BACKGROUND AND PLEADINGS

1. On 28 February 2025, Yetunde Inherited Limited (“the applicant”) applied to register the trade mark shown on the cover page of this decision, in the UK. The application was accepted and published in the Trade Marks Journal on 14 March 2025 in respect of the following goods:

Class 25: *Sweatshirts for men and women; Athletic sweatshirts for men and women; Hoodies; T-shirts; Jackets; Sweatpants; Activewear, namely sweatshirts, t-shirts, hoodies, jackets, and sweatpants*

2. On 10 June 2025, the application was opposed in its entirety by O2 Worldwide Limited (“the opponent”) based upon Sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”) with the opponent relying upon the following four trade marks:

UK00003491047 (“the first earlier mark”)



Filing date: 18 May 2020

Registration date: 21 August 2020

The mark is registered for goods and services in classes 9, 35, 36, 38, 41 and 42.

UK00003780806 (“the second earlier mark”)



Filing date: 25 April 2022

Registration date: 21 October 2022

The mark is registered for goods and services in classes 9, 35, 36, 38, 41 and 42.

UK00003956817 (“the third earlier mark”)

PRIORITY

Filing date: 14 September 2023

Registration date: 15 November 2024

The mark is registered for goods and services in classes 9, 35, 36, 38, 41 and 42.

UK00004033797 (“the fourth earlier mark”)



(series of two)

Filing date: 02 April 2024

Registration date: 27 February 2026

The mark is registered for goods and services in classes 9, 35, 36, 37, 38, 39, 41, 42, 43, 44 and 45.

3. By virtue of their earlier filing dates, the four trade marks relied upon by the opponent are “earlier marks” in accordance with Section 6 of the Act. None of these earlier marks had been registered for more than five years at the filing date of the contested mark, and, as such, are not subject to the use conditions under Section 6A of the Act.

4. Under Section 5(2)(b) the opponent relies upon all of the earlier marks set out above. However, under Section 5(3) the opponent relies on the first, third and fourth earlier mark, but not the second earlier mark.

5. In addition, the goods and services relied upon under Section 5(2)(b) were narrowed down at the hearing, with the opponent's best case being identified as *protected clothing* in class 9 and *retail services connected with the [sale of] clothing, footwear, headgear* in class 35 which are identically registered under each earlier mark. Likewise, at the hearing it was conceded, on behalf of opponent, that if any reputation exists, it ought to relate to goods and services relating to loyalty and incentive schemes as well as related telecommunication services. In this connection, I was referred to a previous decision (BL-O-0208-25) whereby the Hearing Officer found that the opponent's 'PRIORITY' trade marks enjoy a reputation for mobile software applications, for loyalty and incentive schemes (in class 9), organisation and operation of loyalty and incentive schemes (in class 35) and the provision of content, websites, and portals relating to loyalty or incentive schemes (in class 38).

6. Under Section 5(2)(b), the opponent claims that there is a likelihood of confusion because the marks are highly similar, and the goods and services are identical or similar.

7. Under Section 5(3), the opponent claims that the opponent is, through its 'PRIORITY' trade marks, portrayed as a young, trendy, healthy, cool and high tech brand to its consumers and that use of the applied-for mark will take unfair advantage of, or be detrimental to, the distinctive character and reputation of the earlier marks.

8. The applicant filed a defence and a counterstatement denying the claims made. In particular, the applicant submits that the coinciding element between the marks, namely the word 'PRIORITY', is a descriptive and commonly used term which cannot be monopolised by one party, and that the applied-for mark includes the distinctive word "Sweat", which relates directly to the goods. The applicant also states that the respective goods and services are different because the applicant sells specialist clothing designed to help people with hyperhidrosis (excessive underarm sweating), whereas the opponent operates in the field of telecommunications and related services.

9. Both parties filed evidence during these proceedings.

10. The opponent is represented by Stobbs. The applicant is a litigant in person. A hearing took place before me, by video conference, on 14 July 2026. At the hearing, Mr Blake Robinson appeared for the opponent. Although the applicant elected not to attend the hearing, it did file written submissions in lieu.

Relevance of EU Law

11. 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.

EVIDENCE

12. The opponent's evidence came in the form of a witness statement from Carlos Gomez Bassy dated 15 September 2025. Mr Bassy is the Brand Lead of one of the subsidiary companies which form part of the Telefónica Group of Companies; the latter includes O2 Worldwide Limited (i.e. the opponent), the IP holding company for the O2 brand and its sub-brand 'PRIORITY'. Mr Bassy's witness statement is accompanied by 15 exhibits, being those labelled CGB1-15, and is aimed at demonstrating use and reputation of the earlier marks.

13. The applicant's evidence came in the form of a witness statement from Yetunde Adisa dated 1 October 2025. Mr Adisa is the founder and owner of the applicant company. In his witness statement, Mr Adisa talks about the applicant's use of the contested mark, as well as third-party use of the term 'PRIORITY' in different sectors and produces four exhibits being those labelled Exhibits 1- 4.

14. I do not intend to summarise the evidence in full here. However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

MY APPROACH

15. Of the four earlier marks relied upon by the opponent, three consists of the single word 'PRIORITY' presented in different colours with minimal stylization, and one consists of the words 'PRIORITY MOMENTS'. The application is 'SWEAT PRIORITY'.

16. None of the opponent's four earlier marks is subject to proof of use. In addition, they all cover the goods and services which were identified by Mr Robinson as the opponent's best case. Since the opponent did not plead the family of marks argument, I do not think that the earlier mark 'PRIORITY MOMENTS' adds anything to the opponent's case given that the additional verbal element 'MOMENTS' has no counterpart in the application.

17. For reasons which will become apparent, I have decided to approach the Section 5(2)(b) ground based on the opponent's third earlier mark which consists of the coinciding word 'PRIORITY' presented in blue in standard capital letters. In my view, this is the closer mark to the application, because it does not include the additional non-coinciding figurative and verbal elements which are incorporated in the other earlier marks. However, I will return to the opponent's other marks if it becomes necessary as part of the assessment I am required to make.

DECISION

Section 5(2)(b)

18. Section 5(2)(b) of the Act reads 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.”

19. The following standard summary of the principles applicable to the assessment of the likelihood of confusion was approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor*, [2025] UKSC 25:

(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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may

retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;

(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; and

(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 and services

20. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. 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.”

21. 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;
- (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.

22. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the General Court (“GC”) stated that “complementary” means:

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

23. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services

are very different. The purpose of examining whether there is a complementary relationship between goods and services is to assess whether the relevant public are liable to believe that responsibility for the goods and services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander QC noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited*, BL O/255/13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense – but it does not follow that wine and glassware are similar goods for trade mark purposes.”

24. Whilst on the other hand:

“[...] it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

25. The competing goods and services are as follows:

The applicant's goods	The opponent's goods and services
Class 25: <i>Sweatshirts for men and women; Athletic sweatshirts for men and women; Hoodies; T-shirts; Jackets; Sweatpants; Activewear, namely sweatshirts, t-shirts, hoodies, jackets, and sweatpants.</i>	Class 9: <i>Protective clothing</i> Class 35: <i>Retail services connected with the [sale of] clothing, footwear, headgear.</i>

26. Before I turn to the comparison of the goods and services, I should address the applicant's argument that the goods and services covered by the marks are different because the applicant sells clothing designed to help people with excessive underarm sweating, whilst the opponent works in the field of telecommunication. This argument is not pertinent. The comparison I am required to make is a notional one which must be based on the goods and services as they are registered and applied for –

consequently, the segments of the market in which the parties have so far chosen to trade are irrelevant and cannot affect the outcome of the case.

27. Comparing the applied-for goods with the opponent's *protective clothing*, I consider that they are similar to a medium degree. This is because, the goods share the same nature, being all items of clothing. I accept that a key purpose of protective clothing is to protect the user from injury or accident. 'Ordinary' clothing, such as the applied-for *Sweatshirts for men and women; Athletic sweatshirts for men and women; Hoodies; T-shirts; Jackets; Sweatpants; Activewear, namely sweatshirts, t-shirts, hoodies, jackets, and sweatpants* also provide some protection for the body, but not specifically from accident or injury in potentially dangerous environments. The purpose of the respective goods is different to this extent. However, protective clothing also serves the same purpose as ordinary clothing (including the applicant's clothing), i.e. they cover the body and help to keep the body warm. I therefore find that the general purpose of the respective goods is the same, but the specific purpose of the applicant's goods is absent from the opponent's goods. The users of the goods may overlap and the method of use of the respective goods is plainly the same: they are worn on the body. The respective goods are not complementary and are unlikely to be in competition but might be sold through the same trade channels, such as sport shops. Overall, I consider these goods to be similar to a medium degree.

28. Likewise, I consider that the applied-for goods are similar to a medium degree to the opponent's retail services connected with the sale of clothing. In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the GC held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree. In this case, the opponent's retail services include services connected with the sale of the applicant's goods and applying the guidance in *Oakley* I find that they are similar to a medium degree.

Average consumer and the nature of the purchasing process

29. 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.

30. In *Iconix Luxembourg Holdings* (cited above), the Supreme Court approved the comments of Arnold LJ in *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor (Rev1)* [2024] EWCA Civ 262, where he pointed out that:

- (a) Consumers who are ill-informed or careless, or consumers with specialised knowledge or who are excessively careful are excluded from consideration;
- (b) The average consumer provides a standard which enables the courts to strike a balance between the competing interests involved, such as trade mark owners, their competitors and consumers;
- (c) The average consumer is neither a single hypothetical person nor a mathematical average; assessment from the perspective of the average consumer does not involve a statistical test. There is no single meaning rule and if, having regard to the perceptions and expectations of the average consumer, the court considers that a significant proportion of the relevant public is likely to be confused, a finding of infringement may properly be made;
- (d) Assessment from the perspective of the average consumer is intended to facilitate adjudication of trade mark disputes by providing an objective criterion, by promoting consistency of assessment and by enabling courts and tribunals to determine such issues so far as possible without the need for evidence;
- (e) The average consumer's level of attention varies according to the category of goods or services in question; and
- (f) the average consumer rarely has the opportunity to make direct comparisons between trade marks (or between trade marks and signs) and must instead rely upon the imperfect picture of the trade mark they have kept in their mind.

31. The average consumer of the parties' goods and services in classes 9, 25 and 35 is a member of the general public or business users. The goods are most likely to be the subject of self-selection from retail outlets, websites or catalogues; the services will be selected online and from marketing material as well as from signs displayed on business premises. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount an aural component to the purchase, particularly when advice is sought from a sales representative (for the goods), or a selection is made further to word-of-mouth recommendations.

32. The cost of the goods and services is likely to vary but, overall, they will not be expensive. On average, consumers are likely to purchase these goods and services rather frequently, though protective clothing may be purchased less often. As regards the goods, I find that considerations will be given to the materials used, the fit, the aesthetic appearance, the durability of the goods and their protective function. As regards the services, I find that considerations will be given to the availability of stock and to the clothing on offer. Taking the above factors into account, I find that the average consumer will demonstrate a medium level of attention in respect of these goods and services. Nevertheless, I acknowledge that the level of attention paid might be slightly higher where the goods are protective, because the user is going to be concerned with their own safety (or the safety of their employees if it is a business purchaser).

Comparison of marks

33. 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 Court of Justice of the European Union ("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.”

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

The applied-for mark	The earlier mark
Sweat Priority	PRIORITY

Overall impression

35. The opponent’s earlier mark is a figurative mark consisting of the word ‘PRIORITY’ presented in capital letters in a standard font, in blue. Whilst the colour blue has a visual impact, it is the word ‘PRIORITY’ which dominates the overall impression conveyed by the mark, being it the most distinctive element of the mark.

36. The application is a word-only mark consisting of the words ‘Sweat’ and ‘Priority’ presented in title case. Although the applied-for goods are not limited to goods designed to prevent excessive sweating, as it will be recalled, the applicant itself conceded that this is a function of the goods it sells. Accordingly, notional use of the application includes use in relation to goods for which the word ‘Sweat’ is descriptive. In those circumstances, although the word ‘Sweat’ is placed at the beginning of the mark, being it descriptive, it is less distinctive than the word ‘PRIORITY’ – which is the dominant and most distinctive element of the mark - and has less weight in the overall impression. This is something the average consumer will be alive to and thus they will

not focus on the beginning of the mark – accordingly, the rule of thumb that beginning of marks are more focused upon will not find application in this case. This is the opponent's best case, and I will proceed on this basis.

37. For the sake of completeness, I should say that I would have reached the same conclusion (i.e. that the word 'Sweat' is the weaker element of the mark) even without the applicant's concession, because in the context of clothing, it is likely to allude (at best) to clothing intended for use in physical exercise (i.e. that make the user sweat).

Visual similarity

38. Visually, the fact that the earlier mark is presented entirely in capitals and the applicant's in title case does not constitute a point of visual distinction, since the applicant's mark may notionally be presented in upper case, lower case, or a combination of the two because word marks are not limited by any features such as fonts or capitalisation appearing on the Register. In addition, whilst the word 'Sweat' is a point of visual distinction, it is a descriptive/allusive element and will have less weight in the overall impression. Overall, I consider the marks to be visually similar to a medium to high degree.

Aural similarity

39. Aurally, the marks will be pronounced as 'PRAI -OR-RI-TEE' and 'SWET 'PRAI -OR-RI-TEE', with the coinciding element being longer and dominant. Overall, I consider the marks to be aurally similar to a medium to high degree.

Conceptual similarity

40. Conceptually, both marks share the identical concept conveyed by the word 'PRIORITY' which means "*something that is very important and must be dealt with before other things*" (Cambridge online dictionary). The applied-for mark also conveys the concept borne by the non-coinciding word 'Sweat'. I accept that in the context of goods designed to manage hyperhidrosis (excessive underarm sweating), the words 'Sweat Priority' may be perceived as conveying the message that the main priority of

the goods is to manage a condition that makes people sweat excessively. In any event, even without the benefit of the applicant's concession as to function of the goods it sells, I would have concluded that the word 'SWEAT' alludes to a range of clothes for use in fitness/physical exercise and thus it would be understood as allusive (at best). Further, I consider that 'Sweat Priority' is grammatically awkward and that whilst perceiving the overall concept I have mentioned above, the average consumer is also likely to separate the two elements and give the word 'PRIORITY' independent trade mark significance within the mark, whilst seeing the combination as a play on words, which combines the independently distinctive element 'PRIORITY' with the descriptive/allusive element 'SWEAT'. Overall, I consider that the marks are conceptually similar to a medium to high degree.

Distinctive character of the earlier mark

41. 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)."

42. Registered trade marks possess various 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 high inherent distinctive character, such as invented words, which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it.

43. From an inherent point of view, the applicant argued there are other businesses using the term "Priority" across different sectors. In this connection, in his witness statement, Mr Adisa mentioned the following uses:

<https://www.priority.ltd/> – Business services

<https://www.thepsr.co.uk/> – Priority Services Register (utilities)

<https://www.prioritypass.com> – Travel and airport lounge access

44. Mr Adisa states that *"these uses demonstrate that the word "Priority" is not exclusively associated with O2, and that consumers are accustomed to seeing it across various unrelated industries"*. However, there is no further information about how widespread the use of these marks is in the UK, and nothing is said about the extent to which the average consumer has been exposed to them. Accordingly, this evidence does not really support the argument that the sign 'PRIORITY' is low in distinctiveness as a result of the use made by other traders of it in relation to goods and services identical to those at issue in these proceedings - i.e. protective clothing in class 9 and retail services connected with the sale of clothing in class 35 - or even in relation to other fields of activity.

45. In my view, whilst wearing clothing is a fundamental need for human beings, the same can be said for many other fundamental needs and for the goods and services which assist consumers in meeting those needs, including eating, sleeping, living in a functioning house, driving a car, communicating, protection, etc. As such, any allusive meaning the word 'PRIORITY' might have in relation to clothing, it is sufficiently generic to be removed from the specific characteristic of the goods and not to be

perceived as descriptive. Overall, I consider the word 'PRIORITY' to have a slightly below medium degree of distinctiveness.

46. As regards whether the evidence the opponent has filed is sufficient to demonstrate that the distinctiveness of the earlier mark has been enhanced to any material extent, at the hearing Mr Robinson conceded that if the opponent has built any reputation in the earlier marks it must be related to mobile software applications, for loyalty and incentive schemes in class 9, organisation of those schemes in class 35, and the provision of content, websites, and portals relating to loyalty or incentive schemes in class 38. However, Mr Robinson also seemed to accept that whilst this might be relevant under Section 5(3), it is unlikely to materially improve the opponent's case on the likelihood of confusion. I agree. In *ROJA DOVE* (BL-O-016/10), Mr Iain Purvis KC, sitting as the Appointed Person, dealt with the same point stating as follows:

"It seems to me that any increase in the likelihood of confusion as a result of enhanced distinctiveness through reputation inevitably diminishes as one moves away from the core products in relation to which the mark has been used. Particularly with marks which are not fanciful or invented words, the "trigger" which creates an association in the mind of the public between a mark and its proprietor is not simply familiarity with the mark, but familiarity with the mark in a particular context. Here the public have become used to seeing the word DOVE as a trade mark in the particular context of soap, deodorants, shampoos etc. – what Mr Malinicz calls "fast moving consumer products" - not in the context of perfumes. Inherently, therefore, they are much less likely to see a connection with the DOVE mark when they see a similar mark being used as the name of a perfume than when they see it being used as the name of (for example) a bar of soap".

47. In the present case the earlier mark 'PRIORITY' has no reputation for protective clothing or retail services relating to the sale of clothing. Further, the goods and services for which the mark 'PRIORITY' has a reputation (which is not denied by the applicant – see below) are sufficiently removed from protective clothing or retail

services relating to the sale of clothing not to increase the likelihood of confusion. Hence, I will proceed on the basis of the inherent position only.

Likelihood of confusion

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, including that a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. I must keep in mind the distinctive character of the earlier mark, the average consumer for the goods and services and the nature of the purchasing process. I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

49. Confusion can be direct or indirect. In *L.A. Sugar Limited v By Back Beat Inc*, 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)."

50. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ approved Mr Purvis's formulation but added:

"13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/219/16) at [16] 'a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion'. Mr Mellor went on to say that, if there is no likelihood of direct confusion, 'one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion'. I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion."

51. It is not sufficient that a mark merely calls to mind another mark: *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17. This is mere association not indirect confusion.

52. Earlier in this decision I found that:

- The marks are visually, aurally and conceptually similar to a medium to high degree.
- The parties' goods and services are similar to a medium degree.
- The average consumer is a member of the general public who will select the goods and services mainly visually, with a medium or slightly above medium degree of attention.
- The earlier mark is inherently distinctive to a slightly below medium degree.

53. In his skeleton argument Mr Robinson argued that this case falls within the first and/or second category identified by Mr Purvis in *L.A. Sugar*. I agree. The main difference between the marks is the addition of the descriptive/allusive word 'Sweat' in the application, which, in the context of goods designed to manage excessive underarm sweating or to be worn during physical exercise (both of which are notionally included in the applied-for specification) is descriptive/allusive. Further, the fact that the descriptive/allusive word 'Sweat' is placed at the beginning of the application does not prevent the coinciding word 'PRIORITY' from being independently distinctive within the mark; in this connection, I found that the addition of the word 'Sweat' in the application plays a lesser role in the overall impression and that the word 'PRIORITY' still remains the dominant and distinctive element of the application. In those circumstances, I consider that the average consumer is likely to indirectly confuse the marks, by considering the addition of the descriptive word 'Sweat' in the application as being consistent with a brand extension, in particular, a line of clothing produced under the earlier brand 'PRIORITY' and designed to manage excessive underarm sweating or to be used during physical activity or exercise. The opposition based on Section 5(2)(b) is successful.

Section 5(3)

54. I can deal with this ground very briefly. As Mr Robinson noted in his skeleton argument, the applicant did not deny the existence of a reputation. In particular, the

applicant's denial of the opponent's Section 5(3) ground is limited to the following statement:

"I submit that the use of my mark does not take unfair advantage or cause detriment to the opponent's earlier mark or reputation".

55. Technically, the opponent's reputation is admitted insofar as it has been subsequently narrowed down to the goods and services relating to loyalty schemes.

56. However, Mr Robinson appeared to concede at the hearing that the opponent's case under Section 5(3) is not stronger than that under Section 5(2)(b) due to the distance between the goods and services for which the earlier mark has a reputation (loyalty schemes and more broadly telecommunication) and the contested clothing goods. I agree on this point. In my view, the distance between the goods and services is such that even if the average consumer would make a link between the marks (due to the similarity between the marks and the reputation of the opponent's mark) in the sense that the application would bring the reputable mark to mind, any link would be so fleeting not to cause any damage. The opposition under Section 5(3) is unsuccessful.

OUTCOME

57. The opponent has been successful under Section 5(2)(b) and, subject to any appeal of my decision, the application will be refused registration.

COSTS

58. The opponent has been successful and is, therefore, entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award the opponent the sum of £2,200, calculated as follows:

Preparing opposition

and considering the counterstatement:

£300

Filing evidence:	£1,000
Preparing for and attending a hearing:	£800
Official fees:	£100
Total:	£2,200

59. I therefore order Yetunde Inherited Limited to pay O2 Worldwide Limited the sum of £2,200. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 28th day of July 2026

TERESA PINTO
For the Registrar