O/0686/24

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK3886216
IN THE NAME OF ANGIE MOXHAM
TO REGISTER THE FOLLOWING TRADE MARK:

3 Monkeys Communications

IN CLASS 35

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 600002948
BY ZENO GROUP, INC.

Background and pleadings

1. On 07 March 2024, Angie Moxham ("the Applicant") applied to register the trade mark shown on the cover page of this decision in the UK. It was accepted and published in the Trade Marks Journal on 26 May 2023 in respect of the following services;

> Class 35: Advertising and marketing; Advertising copywriting; Advertising and advertisement services; Publicity and advertising; Advertising and publicity; Advertising and marketing services; Advertising, marketing and promotional services; Marketing, advertising, and promotional services; Advertising, promotional and marketing services; Banner advertising; Television advertising; Advertising and marketing consultancy; Marketing, advertising and promotion services; Advertising, marketing and promotion services; Promotional and advertising services; Advertising and publicity services; Newspaper advertising; Online advertising; Leasing of advertising billboards; Copywriting for advertising and promotional purposes; Electronic billboard advertising; Radio advertising; Mail-order advertising; Magazine advertising; Outdoor advertising; Cinema advertising; On-line advertising; Radio advertising and commercials; Advertising research; Graphic advertising services; Advertising services for the promotion of e-commerce; Advertising agency services; Advertising planning; Preparation of advertising campaigns; Arrangement of advertising; Advertising consultation; Advertising analysis; Online advertising services; Consultancy services relating to advertising, publicity and marketing; Response advertising; Rental of billboards [advertising boards]; Press advertising services; Scriptwriting for advertising purposes; Advertising, promotional and public relations services; Production of advertising matter and commercials; Elevator advertising; Services of advertising agencies; Advertising research services; Press advertising consultancy; Design of advertising logos; Distribution of advertising announcements; Brand creation services (advertising and promotion); Direct market advertising; Consultancy relating to advertising; Advertising of business web sites; Marketing.

2. On 10 July 2023, Zeno Group, Inc. (“the Opponent”) opposed the application under Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) on the basis of its earlier UK Trade Mark:

3MONKEYS

UK Registration no. UK00003776605
Date of registration: 08 July 2022
Relying upon the following services:

Class 36: Public relations; marketing services, namely, communications marketing; Branding strategy; branding services, namely, consulting, development, strategy, marketing and management of brands for businesses; advertising agencies featuring social media strategy consulting and influencer consulting; providing marketing consulting in the fields of social media, social media marketing analysis, preparation of custom advertisements for others, preparing and placing advertisements and social media marketing campaigns for others.

3. The Opponent submits that the contested application is highly similar to the Opponent’s Mark and the services for which the Applicant’s mark is filed are identical or highly similar to those relied upon under the Opponent’s Mark. In view of this the Opponent submits that there exists a likelihood of confusion.

4. The Applicant filed a counterstatement denying the claims made.

5. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

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

6. The net effect of these changes is to require the parties to seek leave in order to file evidence in fast track oppositions. No leave was sought to file evidence in these proceedings.

7. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken.

8. The Opponent is represented by K&L Gates LLP and the Applicant does not have legal representation. Neither party requested a hearing, nor filed evidence in these proceedings, however, the Opponent filed submission in lieu of a hearing. This decision is taken following a careful perusal of the papers.

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.

Preliminary issue

10. In its counterstatement, the Applicant provides a history in regard to its trade mark, and the relationship between the parties. This included the submission that the Opponent "killed off the 2 Monkeys brand last year", which I understand as meaning that the Opponent no longer uses this mark. Moreover, under question 7 of its counterstatement, the Applicant requested proof of use of the Opponent's mark. However, as the Opponent's mark had not completed its registration process more than 5 years before the filing date of the application in issue, it is not subject to proof of use pursuant to section 6A of the Act. The Opponent is, therefore, entitled to rely upon its full specification. I will also be carrying out a notional assessment based upon all the ways in which the services covered by the

respective specifications could be used and sold, and my comparison will be of the marks as registered. The above submissions therefore do not assist the Applicant.

DECISION

Section 5(2)(b)

11. 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".

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; Page 8 of 20

(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 services

13. The services for comparison are as follows:

Opponent's services	Applicant's services
Class 36 *Public relations; marketing services, namely, communications marketing; Branding strategy; branding services, namely, consulting, development, strategy, marketing and management of brands for businesses; advertising agencies featuring social media strategy consulting and influencer consulting; providing marketing consulting in the fields of social media, social media marketing analysis, preparation of custom advertisements for others, preparing and placing advertisements and social media marketing campaigns for others.*	Class 36 *Advertising and marketing; Advertising copywriting; Advertising and advertisement services; Publicity and advertising; Advertising and publicity; Advertising and marketing services; Advertising, marketing and promotional services; Marketing, advertising, and promotional services; Advertising, promotional and marketing services; Banner advertising; Television advertising; Advertising and marketing consultancy; Marketing, advertising and promotion services; Advertising, marketing and promotion services; Promotional and advertising services; Advertising and publicity services; Newspaper advertising; Online advertising; Leasing of advertising billboards; Copywriting for advertising and promotional purposes; Electronic billboard advertising; Radio advertising; Mail-order advertising; Magazine advertising; Outdoor advertising; Cinema advertising; On-line advertising; Radio advertising and commercials; Advertising research; Graphic advertising services; Advertising services for the promotion of e-*

	commerce; Advertising agency services; Advertising planning; Preparation of advertising campaigns; Arrangement of advertising; Advertising consultation; Advertising analysis; Online advertising services; Consultancy services relating to advertising, publicity and marketing; Response advertising; Rental of billboards [advertising boards];Press advertising services; Scriptwriting for advertising purposes; Advertising, promotional and public relations services; Production of advertising matter and commercials; Elevator advertising; Services of advertising agencies; Advertising research services; Press advertising consultancy; Design of advertising logos; Distribution of advertising announcements; Brand creation services (advertising and promotion); Direct market advertising; Consultancy relating to advertising; Advertising of business web sites; Marketing.

14. In *Gérard Meric v OHIM,* Case T-133/05, the General Court ("GC") stated that:

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

where the goods designated by the trade mark application are included in a more general category designated by the earlier mark".[1]

15. When making the comparison, all relevant factors relating to the 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 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.

16. Guidance on this issue has come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

(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;

[1] Paragraph 29

(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.

17. For the purposes of considering the issue of similarity of services, 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.[2]

18. 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 Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM),* Case T-325/06, the 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."

19. 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, i.e. chicken against transport services for chickens. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-

[2] 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).

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."
>
> 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."

20. The Applicant submits that "whilst we're in similar industries, we do very different things, target different sectors and have never pitched for the same piece of business"[3]. The Opponent submits that the "respective services are inevitably going to reach the market through the same trade channels and would be purchased by a similar group of consumers looking for advertising, marketing, public relation and communications consulting services"[4]. I bear these submissions in mind in the following comparison of the services at issue.

21. In making my assessment, I also note that the Tribunal Manual states that specifications which include the wording 'namely' should be interpreted as covering only the named services within that specification. Therefore, the specification is limited to only those services.

"Advertising and marketing; Advertising and marketing services; Advertising, marketing and promotional services; Marketing, advertising, and promotional services; Advertising, promotional and marketing services; Marketing, advertising and promotion services; Advertising, marketing and promotion services;"

[3] Page 2 of Applicant's form TM8 and Counterstatement
[4] Opponent's submissions in lieu, paragraph 22

22. The Opponent's *"*marketing services, namely, communications marketing*"* falls within the Applicant's above broader services. They are, therefore, identical on the principle outlined in *Meric*.

"Advertising, promotional and public relations services;"

23. The Opponent's "public relations" services fall within the Applicant's above broader services. They are identical on the principle outlined in *Meric.*

"Services of advertising agencies;"

24. The Opponent's "advertising agencies featuring social media strategy consulting and influencer consulting" services fall within the Applicant's above broader services. They are identical on the principle outlined in Meric.

"Marketing;"

25. The Opponent's "marketing services, namely, communications marketing;" services fall within Applicant's above broader category. The services are identical on the principle outlined in Meric.

"Consultancy relating to advertising; Press advertising consultancy; Consultancy services relating to advertising, publicity and marketing; Advertising and marketing consultancy; Advertising consultation;"

26. The Applicant's above advertising consultancy services are similar to the Opponent's "providing marketing consulting in the fields of […] preparation of custom advertisements for others, preparing and placing advertisements..." services. It is clear from the Opponent's term, that marketing and advertising are interlinked services. Without any evidence or submissions before me, I consider advertising to be a specific step of marketing in that advertising uses the data and research collected by marketing to make the product known to consumers. I therefore consider that the parties services overlap in method of use, nature and in overall purpose, as they are all consultancy services in the field of advertising

and/or marketing. I also consider that these services would be provided by the same undertakings, and thus overlap in trade channels. The services could also be in competition with one another, with the average consumer picking one service over another. Taking the above into account, I consider that the services are similar to a high degree.

"Promotional and advertising services; Advertising and publicity services; Advertising research; Graphic advertising services; Advertising services for the promotion of e-commerce; Advertising agency services; Online advertising services; Advertising research services; Advertising copywriting; Advertising and advertisement services; Publicity and advertising; Advertising and publicity; Press advertising services; Advertising planning; Preparation of advertising campaigns; Arrangement of advertising; Advertising analysis;"

27. As noted in paragraph 26 above, I have concluded that advertising is a specific step of marketing. I therefore consider that the Applicant's above advertising services are similar to the Opponent's "marketing services, namely, communications marketing", which I consider to be marketing which is focused on communicating a message to the consumer. The services clearly overlap in purpose, method of use and nature, as they are all types of marketing services, which would be provided by the same marketing undertakings. I therefore consider that the services overlap in trade channels and user. Although the services are not necessarily in competition, I consider that they may be used alongside one another as part of creating a companies' advertisements. I therefore consider that the services are similar to between a medium and high degree.

"Brand creation services (advertising and promotion);"

28. I find the Applicant's above services are similar to the Opponent's "branding services, namely, consulting, development, strategy, marketing and management of brands for businesses". As both services encompass the creation and/or promotion a brand, I consider that the services overlap in nature, method of use and overall purpose. There would also be an overlap in trade channels as the same branding undertakings would provide both services to the same user, being

businesses or individuals interested in creating or developing a brand. The services may be in competition with each other, in that the consumer could choose one service over another. However, I do not consider that the services are complementary, as one is not indispensable or important to the other. Taking the above into account, I consider that the services are similar to a high degree.

"Banner advertising; Television advertising; Newspaper advertising; Online advertising; Electronic billboard advertising; Radio advertising; Mail-order advertising; Magazine advertising; Outdoor advertising; Cinema advertising; On-line advertising; Radio advertising and commercials; Elevator advertising; Response advertising; Direct market advertising; Advertising of business web sites"

29. The Applicant's above services are all specific forms of advertising. At paragraph 28 I considered the Opponent's "marketing services, namely, communications marketing" to be focused on communicating a message to the consumer. I consider the Applicant's contested terms listed above to be forms of advertising aimed at communicating directly with the consumer. In view of this, the services overlap in method of use, purpose and nature. The services overlap in trade channels and user, as they would be provided by the same marketing undertakings. However, I do not consider the services to be in competition, as the average consumer would not pick one service provider over another. I therefore consider that the parties' services are similar to a high degree.

"Rental of billboards [advertising boards]; Leasing of advertising billboards; Distribution of advertising announcements;"

30. The Applicant's above services are all related to the distribution of advertisements. At paragraph 28 I found advertising to be a subset of marketing. Bearing this in mind, I consider that the Applicant's above terms are similar to the Opponent's "providing marketing consulting in the fields of […] preparing and placing advertisements..." services. I consider that the services overlap in nature and trade channels, as they will be provided by the same marketing undertakings to the same users. However, the purpose differs as the Applicant's services concern the distribution and placing of advertisements, while the Opponent's term relates to

consultancy in this field. I do not consider that the services are complementary, and while they are not directly in competition, the services may be used jointly as part of implementing an advertising/marketing strategy. Overall, I find the terms to be similar to a medium degree.

"Design of advertising logos; Production of advertising matter and commercials; Scriptwriting for advertising purposes; Copywriting for advertising and promotional purposes;"

31. The Applicant's above services are all related to advertising and the creation of advertisements. I therefore consider that these terms are similar to the Opponent's "providing marketing consulting in the fields of […] preparation of custom advertisements for others, preparing and placing advertisements..." services. While the Applicant's services concern the actual production of advertising matter, and the Opponent's services relate to consultancy in this field, I consider there is an overlap in user and trade channels, with the same marketing undertakings providing all of these services to the same users. The services may not be in competition, nor complementary, but I consider that they may be used alongside one another as part of creating a companies' advertisements. I therefore consider the services are similar to a medium degree.

Average consumer and the purchasing act

32. It is necessary for me to determine who the average consumer is for the services in question; I must then determine the manner in which the services are likely to be selected by the average consumer in the course of trade.

33. 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 services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97.* In *Hearst Holdings Inc, Fleischer Studios Inc v A. V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox*

Limited, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

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

34. The average consumer of the contested services will be a business requiring marketing, advertising or publicity services; however I do not discount that the services may also be sought by a member of the general public. The cost of the services in question is likely to vary, as will the frequency of purchase. The average consumer will take various factors into consideration such as the nature of the services, cost, the reputational standing of the provider and the suitability of the services for their specific needs. Where the average consumer is a business, they are likely to pay a higher degree of attention due to the potential impact of the service on their company's reputation. Consequently, the level of attention paid during the purchasing process for the services will be a medium degree where the average consumer is a member of the general public, and between a medium and high degree where the average consumer is a business.

35. The services are likely to be obtained by visiting the service provider's physical premises or by visiting their website. Therefore, visual considerations are likely to dominate the selection process. However, I do not discount that there may also be an aural component to the purchase of services through advice sought from a sales assistant or representative, and word-of-mouth recommendations.

Comparison of marks

36. 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 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."

37. 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.

38. The respective trade marks are shown below:

Earlier trade mark	Contested trade mark
3MONKEYS	3 Monkeys Communications

39. The Opponent's word mark consists of the word element "3MONKEYS" which is composed of the number "3" and the word "MONKEYS". There are no other elements to contribute to the overall impression with lies in the word itself.

40. The Applicant's word mark consists of the number "3" followed by the words "Monkeys" and "Communications". For reasons I will come to discuss in my conceptual comparison, the highly allusive word "Communications" plays a lesser role in the overall impression, with the number "3" and word "Monkeys" playing a greater role in the overall impression of the mark.

41. Visually, the marks coincide in the number “3” at the beginning of the marks, a position to which the average consumer pays more attention to.[5] Both marks also consist of the word “MONKEYS”. These act as points of similarity. However, I note that these elements are separated by a space in the Applicant’s Mark. I also note that the Applicant’s mark ends in the word “Communications”. These act as visual points of difference. Whilst the Opponent’s marks are presented in upper-case, and the Applicant’s mark is presented in title-case, the parties marks are all word marks, and registration covers use in any standard typeface (including presenting the mark in upper and lower-case, or title-case). Therefore, taking all of the above into account, I consider that the marks are visually similar to between a medium and high degree.

42. Aurally, the competing marks overlap in the pronunciation of the number “3” and the word “MONKEYS”. While I note the Opponent’s mark does not contain a space between these elements, I consider that the average consumer will perceive a natural break between them. Therefore, the beginning of the marks are aurally identical. However, the Applicant’s mark ends in the ordinary dictionary word “Communications”. This is an aural point of difference, and therefore, the marks as a whole are aurally similar to between a medium and high degree.

43. The Opponent’s mark consists of the number 3 and the ordinary dictionary word “MONKEYS”, which together conveys the concept of their being a group of three monkeys. This conceptual message will also be conveyed at the beginning of the Applicant’s mark. However, the Applicant’s mark also ends in the ordinary dictionary word “Communications”. The Opponent submits that “the word “Communications” is descriptive of the purpose of the services for which protection is sought. Whilst I do not agree that it is wholly descriptive, I consider that it is highly allusive of the Applicant’s marketing and advertising goods and services, which is a form of communicating to consumers, encouraging them to buy an undertakings goods or services. Regardless, it is a conceptual point of difference, and therefore the marks are conceptually similar to between a medium and high degree.

[5] *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

Distinctive character of the earlier trade mark

44. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In *Lloyd Schuhfabrik*, the CJEU stated that:

> "In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* v *Huber and Attenberger* [1999] ECR I-0000, paragraph 49). In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)."

45. 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, 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 that has been made of it.

46. The Opponent has not filed any evidence to support that its mark's distinctive character has been enhanced through use. Consequently, I have only the inherent position to consider.

47. I do not consider that the mark has any descriptive or allusive qualities in relation to the services at issue. However, the mark "3MONKEYS" consists of a number and an ordinary dictionary word which conveys a recognisable meaning. Consequently, I consider the mark to be inherently distinctive to a medium degree.

Likelihood of Confusion

48. 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 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 services and vice versa. It is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

49. I have found the marks to be visually, aurally and conceptually similar to between a medium and high degree. I have found the Opponent's mark to have a medium degree of inherent distinctive character. I have identified the average consumer to be a business user, however I do not discount that the services may be sought by a member of the general public. I have found the services would be selected primarily by visual means (although I do not discount an aural component). I have concluded that the level of attention paid during the purchasing process will be medium where the average consumer is a member of the general public, and

between a medium and high where the average consumer is a business. I have found the parties' services to range from being identical to similar to a medium degree.

50. Taking all of the above into account, given that the average consumer rarely has the opportunity to compare marks side-by-side and will instead encounter them in different settings at different times will, to my mind, lead the average consumer to mistake one mark for the other, even for those who are paying between a medium and high degree of attention during the purchasing process. This is on the basis that the Opponent's 3MONKEYS mark is fully encompassed at the beginning of the Applicant's 3 Monkeys Communications mark, which, as noted above, the average consumer tends to pay more attention to. I consider that the average consumer would easily overlook or imperfectly recall the space between the 3 and MONKEYS in the Applicant's mark. I also consider that the average consumer could easily overlook the word Communications at the end of the Applicant's mark, especially as it highly allusive of the parties' marketing and advertising services. I consider that there is a likelihood of direct confusion for the services which are identical to similar to a medium degree, due to the effect of the interdependency principle.

51. That leaves indirect confusion to be considered. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis QC, (as he then was) sitting as the Appointed Person, explained that:

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

earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

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)."

52. These three categories are not exhaustive; rather, they were intended to be illustrative of the general approach, as has been confirmed by the Court of Appeal. I recognise that a finding of indirect confusion should not be made merely because the competing marks share a common element. In this connection, it is not sufficient that a mark merely calls to mind another mark: this is mere association not indirect confusion.[6]

[6] *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

53. Furthermore, in *Liverpool Gin*,[7] 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.

54. Taking all of the above into account, I consider that the common use of the number "3" in conjunction with the word "MONKEYS" at the beginning of both marks will lead the average consumer to conclude that the marks originate from the same or economically linked undertakings. I consider that the average consumer will see the addition of the highly allusive word "Communications" at the end of the Applicant's mark and will perceive it as an alternative or updated mark used by the same or economically linked undertakings, and therefore indicative of re-branding. Consequently, I therefore consider there to be a likelihood of indirect confusion, for consumers who are paying a medium degree, and a medium and high degree of attention during the purchasing process.

CONCLUSION

55. The opposition under section 5(2)(b) of the Act has been successful. Subject to any successful appeal against my decision, the application will be refused.

COSTS

56. The Opponent has been successful and is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award the Applicant the sum of £600 as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Official fee for opposition form	£100

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

Filing a notice of opposition and considering the Applicant's counterstatement	£250
Preparing and filing written submissions in lieu	£350
Total	**£700**

57. I therefore order **Angie Moxham** to pay **Zeno Group, Inc.** the sum of £700. 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 18th of July 2024

E REES
For the Registrar