

O/0792/26

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 4022779

BY COLOMBO INTERNATIONAL CONSTRUCTIONS LTD

TO REGISTER:

LOOP EARPLUGS QUIET

AS A TRADE MARK IN CLASSES 9 & 10

AND

IN THE MATTER OF THE OPPOSITION THERETO

UNDER NO. 447647 BY

LOOP BV

BACKGROUND AND PLEADINGS

1. On 6 March 2024, Colombo International Constructions Ltd (“the applicant”) applied to register **LOOP EARPLUGS QUIET** as a trade mark in the United Kingdom in respect of the following goods:

Class 9

Headphones; Ear pads for headphones; Noise cancelling headphones; Earphones; Earbuds; In-ear headphones; Two-way plugs for headphones; Music headphones; Wireless headphones; Stereo headphones; Ear plugs for divers; Cases for headphones; Microphone plugs; Ear phones; Goggles; Earphones for smartphones; Headgear being protective helmets; Protective goggles; Headsets; Headphones for smart phones; Anti-fogging safety goggles; Clip-on sunglasses; Silicone nose pads for eyeglasses; Binaural microphones; Noise gate devices; Safety goggles; Anti-dust plugs for earphone jacks; Cords for sunglasses; Noise filters; Dust protective goggles; Headphone amplifiers; Diaphragms [acoustics]; Wireless headsets; Wireless headsets for cellphones; Horns for loudspeakers; Acoustic sound alarms; Acoustic [sound] alarms; Loud speakers; Safety headgear; Protective glasses; Protective helmets; Helmets (Protective -); Adapter cables for headphones; Dust goggles; Visors for helmets; Ear buds; Dust proof plugs for earphone jacks; Acoustic alarms; Cases for spectacles and sunglasses; Audio noise reducers; Earphones for cellular telephones; Scuba goggles; Batteries for use in hearing aids; Megaphones.

Class 10

Ear plugs for soundproofing (other than for medical use); Ear plugs for sleeping; Ear plugs [hearing protection devices]; Ear plugs for protection against noise; Noise reduction ear plugs; Protective ear plugs; Ear adaptors for hearing aids; Ear plugs; Ear protectors; Noise protection means in the form of deformable ear plugs; Ear trumpets; Protective nose masks for dental use; Acoustic amplifiers [hearing aids] for partially deaf persons; Ear plugs for medical purposes; Hearing aids for the deaf [acoustic aids]; Hearing protection devices; Protective nose masks for veterinary use; Protective visors for dental use; Pads for inhibiting snoring; Pillows for orthopedic use; Protective nose masks for medical use;

Protective mouth masks for dental use; Anti-nausea wristbands; Ear thermometers; Hearing protectors.

2. The application was accepted and published for opposition purposes on 22 March 2024.

3. On 22 May 2024, the application was opposed by Loop BV (“the opponent”). The opposition is based on sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”) and concerns all the goods in the application.

4. Under sections 5(2)(b) and 5(3), the opponent relies on the following marks:

UKTM No. 915088693 (“the 693 mark”)

LOOP

Filing date: 9 February 2016

Registration date: 24 May 2016

Class 9

In-ear headphones; Headsets; Headsets for mobile telephones; Wireless headsets for smartphones; Headsets for use with computers; Wireless headphones; Headphone-microphone combinations.

Class 10

Ear plugs [ear protection devices]; Ear plugs for sleeping; Ear plugs for protection against noise; Noise protection means in the form of deformable ear plugs; Ear plugs for medical purposes.

IR No. 1760890 (“the 890 mark”)

LOOP SWITCH

Priority date: 3 April 2023¹

¹ Priority is claimed from EU Trade Mark (“EUTM”) No 018857602.

International registration date: 21 September 2023

Designation date: 21 September 2023

Date protection granted in the UK: 10 April 2024

Class 9

In-ear headphones; headsets; headsets for mobile telephones; wireless headsets for smartphones; headsets for use with computers; wireless headphones; headphone-microphone combinations.

Class 10

Ear plugs [hearing protection devices]; ear plugs for sleeping; ear plugs for protection against noise; noise protection means in the form of deformable ear plugs; ear plugs for medical purposes.

IR No. 1785732 ("the 732 mark")

LOOP QUIET

Priority date: 21 September 2023²

International registration date: 14 March 2024

Designation date: 14 March 2024

Date protection granted in the UK: 4 July 2024

Class 9

In-ear headphones; headsets; headsets for mobile telephones; wireless headsets for smartphones; headsets for use with computers; wireless headphones; headphone-microphone combinations.

Class 10

Ear plugs [hearing protection devices]; ear plugs for sleeping; ear plugs for protection against noise; noise protection means in the form of deformable ear plugs; ear plugs for medical purposes.

² Priority is claimed from EUTM No. 018928205.

UKTM No. 40443396 (“the 396 mark”)

LOOP

Priority date: 27 October 2023³

Filing date: 26 April 2024

Registration date: 6 December 2024

Class 9

Carrying cases for in-ear headphones, headsets and wireless headphones; connector cords for in-ear headphones, headsets and wireless headphones.

Class 10

Carrying cases for protective ear plugs and ear plugs for sleeping; connector cords for protective ear plugs and ear plugs for sleeping.

Class 35

Retail and wholesale services in relation to ear plugs, in-ear headphones, headsets, headsets for mobile telephones, wireless headsets for smartphones, headsets for use with computers, wireless headphones, headphone-microphone combinations, ear care preparations, carrying cases for in-ear headphones, carrying cases for headsets, carrying cases for wireless headphones, connector cords for in-ear headphones, connector cords for headsets, connector cords for wireless headphones, carrying cases for ear plugs, connector cords for ear plugs.

5. Under section 5(2)(b), the opponent claims that “LOOP” is the dominant and distinctive element of the contested mark and that the other words, “EARPLUGS” and “QUIET”, are non-distinctive, being, respectively, references to the goods covered by the application or a characteristic of those goods. Consequently, it asserts that the marks are identical in terms of their dominant and distinctive elements. The opponent

³ Priority is claimed from EUTM No. 018942988.

also claims that the parties' goods are identical or highly similar. As a result, there is a likelihood of confusion on the part of the public, including a likelihood of association.

6. Under section 5(3), the opponent claims that it has developed a reputation in its earlier marks in relation to all the goods and services for which they stand registered. It claims that there will be a link between the marks and the similarity between them is such that the relevant public will believe that they are used by the same undertaking, or that there is an economic connection between the users of the marks. In addition, the opponent claims that use of the contested mark by the applicant would, without due cause, take unfair advantage of the distinctive character or repute of the earlier marks as there could be an undeserved transfer to the contested mark of the qualities that the public associates with the earlier marks. It asserts that *"Due to the investment of the Opponent in building its reputation in its Earlier Marks, the 'calling to mind' of the Earlier Marks is sufficient for a finding of unfair advantage."*⁴ The applicant would gain an unfair and undeserved boost to its business. The opponent also claims that use of the contested mark would be detrimental to the distinctive character and/or the repute of the earlier marks.

7. Under section 5(4)(a), the opponent claims to have used the signs **LOOP** and **LOOP QUIET** throughout the UK since January 2019 for the following goods:

In-ear headphones; Headsets; Headsets for mobile telephones; Wireless headsets for smartphones; Headsets for use with computers; Wireless headphones; Headphone-microphone combinations.

Ear plugs; Ear plugs for sleeping; Ear plugs for protection against noise; Noise protection means in the form of deformable ear plugs; Ear plugs for medical purposes.

In addition, the opponent claims to have used the sign **LOOP** for the following services:

Retail and wholesale services in relation to ear plugs, in-ear headphones, headsets, headsets for mobile telephones, wireless headsets for smartphones, headsets for use with computers, wireless headphones, headphone-microphone combinations, ear care preparations, carrying cases for in-ear headphones,

⁴ Statement of Grounds, paragraph 14.

carrying cases for headsets, carrying cases for wireless headphones, connector cords for in-ear headphones, connector cords for headsets, connector cords for wireless headphones, carrying cases for ear plugs, connector cords for ear plugs.

8. The opponent claims to have acquired goodwill under the signs. According to the opponent, use of the contested mark would constitute a misrepresentation to the public that would damage the goodwill in its business. Consequently, use of the contested marks would be contrary to the law of passing off.

9. The applicant filed a defence and counterstatement in response to the opposition. It makes the following claims:

a) that “LOOP” is *“a generic word commonly used to describe a circular or curved shape and is not specifically distinctive of any particular product or service”*;

b) that the additional “distinctive” elements “EARPLUGS” and “QUIET” make the contested mark sufficiently distinctive compared to the earlier marks;

c) that the opponent has not provided sufficient evidence to demonstrate that its marks containing the allegedly generic term “LOOP” have acquired a distinctive reputation in the UK;

d) that the use of the contested mark would not take unfair advantage of the opponent’s marks or harm their distinctive character or reputation;

e) that the application was made in good faith and does not create confusion among the public. The use of the allegedly generic term “LOOP” does not constitute a valid basis for a passing off action;

f) that the opposition is an attempt to block competition and is a clear violation of UK competition law, specifically the Competition Act 1998, and could also be considered an unfair trading practice under the Consumer Protection from Unfair Trading Regulations 2008;

g) that the opponent has following the opposition attempted to register additional marks containing the word LOOP in an attempt to block the applicant’s legitimate use of its mark. The applicant submits that this is a pattern of behaviour and is a

delaying tactic aimed at causing damage to the applicant and hindering its business operations;

h) that the 890 and 732 marks are not registered in the UK, but are merely designations of International Registrations and that the 396 mark was only filed on 26 April 2024, i.e. after the filing date of the contested mark;

i) that the opposition was filed with malicious intent and the applicant is suffering significant economic damage;

j) that the opponent is based in the Netherlands and has no significant presence in the UK market. The lack of presence undermines any claims of reputation and distinctiveness in the UK; and

k) that the opponent sent a “cease and desist” letter to the applicant demanding that it withdraw its application and threatening legal action and future costs and that this represents an attempt to intimidate and coerce the applicant.

The applicant did not put the opponent to proof of use of the 693 mark.

EVIDENCE & SUBMISSIONS

10. Only the opponent filed evidence. This comes from Olga Preda, Intellectual Property Counsel employed by the opponent. Her witness statement is dated 27 January 2025 and is accompanied by nine exhibits that go to the claimed reputation and goodwill.

11. Neither side requested a hearing. The opponent filed written submissions in lieu of the same on 24 May 2025. The applicant did not file any submissions.

REPRESENTATION

12. In these proceedings, the opponent is represented by Stobbs and the applicant represents itself.

RELEVANCE OF EU LAW

13. 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 ISSUES

14. The applicant's counterstatement is wide ranging and covers a number of issues that I will not be dealing with in this decision. The first of these is the criticism of the validity of the opponent's "LOOP" marks on the grounds that this is a generic word with no distinctive character. The Tribunal does not provide any mechanism to include counterclaims against an opponent's earlier trade marks. Any challenge to the validity of an earlier trade mark needs to be brought separately.⁵ In the absence of such a challenge, I must assume that the earlier marks have at least some level of distinctive character.

15. The applicant claims that the opposition is in violation of UK competition law. A registered proprietor is entitled to oppose an application for a trade mark that it considers to be confusingly similar to its own mark(s) or that it believes would take unfair advantage of, or cause detriment to, the reputation or distinctive character of its mark(s). Consequently, the mere act of bringing an opposition is not in breach of competition law. I shall say no more about this point.

16. The next point is that the applicant has made allegations concerning the motive of the opponent. The applicant has not substantiated its allegation that the intent behind the opposition was malicious. The "cease and desist" letter referred to by the applicant may well have been a standard letter before action. In any case, the applicant has not filed a copy of that letter in evidence. The motives of the opponent are not relevant to my consideration of the claims brought in this matter.

17. I shall deal with the remaining issues raised in the counterstatement at the appropriate part of my decision.

⁵ See Tribunal Practice Notice No. 4/2009, "Trade mark opposition and invalidation proceedings – defences".

DECISION

Section 5(2)(b)

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

“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.”

19. An “earlier trade mark” is defined in section 6(1) of the Act as:

“(a) a registered trade mark or international trade mark (UK) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(aa) a comparable trade mark (EU) or a trade mark registered pursuant to an application made under paragraph 25 of Schedule 2A which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired,

(ab) a comparable trade mark (IR) or a trade mark registered pursuant to an application made under paragraph 28, 29 or 33 of Schedule 2B which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired,

[(b) Repealed]

(ba) a registered trade mark or international trade mark (UK) which—

(i) prior to IP completion day has been converted from a European Union trade mark or international trade mark (EC) which itself had a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired, and

(ii) accordingly has the same claim to seniority, or

(c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark.”

20. The opponent may therefore rely on the 890 and 732 as international trade marks (UK). It may also rely on the 396 mark, despite the fact that it has a later application date than that of the contested mark. This is because priority is claimed from an earlier EU Trade Mark and so the opponent may, under the provisions of the Paris Convention for the Protection of Industrial Property, claim the EU filing date of 27 October 2023.

21. The 693 mark was registered more than five years before the application date of the contested mark. It is therefore caught by the use provisions of section 6A of the Act. The opponent made a statement to the effect that it had used the mark for all the goods relied upon. As I have already noted, the applicant did not request that the opponent provide proof of such use. This means that the opponent’s statement of use is accepted and it may rely on all the goods in respect of which the 693 mark stands registered.

22. 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 they have kept in their 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.

Procedural issue

23. The opponent submits that the applicant has not denied the claims that there is a likelihood of confusion, that the goods are either identical or highly similar to goods or services covered by the opponent's marks, or that the contested mark is similar to the earlier marks. On 19 July 2024, the Registry had written to the applicant following its filing of the TM8 and counterstatement. The letter said:

"The purpose of the Form TM8 and counter-statement is to admit (agree) or deny (disagree) with the claims made by the opponent in the Form TM7 and provide reasons for doing so. In this case, the opponent has made claims under a number of grounds, including Section 5(2)(b). In this instance the Registry does not consider that you have provided this information for Section 5(2)(b). Following the decision in *SkyClub* O/044/21 you are required to particularise your defence in relation to each of the opponents' pleaded claims.

Although you have commented on the identity and similarity of the marks, you have not made comment on the goods and services. Please could you therefore admit or deny the alleged identity and similarity of the marks and goods or services under Section 5(2)(b)."

24. The applicant was given a deadline of 9 August 2024 to file an amended counterstatement and was informed that if it chose not to do so, the Registry may move to strike out any parts of the defence that are not adequately particularised. The applicant requested additional time and a further TM8 was filed on 13 November 2024. This was served on the opponent on 27 November 2024.

25. I have compared the two TM8s and can see no difference in them. I agree with the opponent that the applicant has not explicitly denied the claims that the marks are similar and that the goods and services are identical or highly similar. However, I note that in point 4 of its counterstatement the applicant claims that "*The presence of*

‘descriptive terms ‘EARPLUGS’ and ‘QUIET’ ensures that the public can clearly identify the applicant’s products without confusing them with those of the opponent.’ I shall therefore proceed on the basis that the applicant has denied that there is a likelihood of confusion under section 5(2)(b), even though the heading for point 4 is *“No Unfair Advantage or Detriment”*, which is, of course, an issue under section 5(3). The opponent is put to no disadvantage by this approach as it has filed written submissions covering the likelihood of confusion and all the elements that go into the global assessment.

Comparison of goods and services

26. It is settled case law that I must make my comparison of the goods and services on the basis of all relevant factors. These include the nature of the goods and services, their purpose, their users and method of use, the trade channels through which they reach the market, and whether they are in competition with each other or are complementary: see *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, paragraph 23, and *British Sugar Plc v James Robertson & Sons Limited (TREAT Trade Mark)* [1996] RPC 281 at [296]. As the General Court (“GC”) said in *Boston Scientific Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, goods and services are complementary when

“82. ... 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.”

27. Goods and services may be considered identical where the goods in the specification of one party are included in a broader term from the other party’s specification: see *Gérard Meric v OHIM*, Case T-133/05, paragraph 29.

28. I find that the following contested goods are identical to goods in the opponent’s specifications, either self-evidently or per *Meric*:

Class 9

Contested Goods	Identical Earlier Goods
<i>Headphones; Noise cancelling headphones; Earphones; Earbuds; In-ear headphones; Music headphones; Wireless headphones; Stereo headphones; Ear phones; Ear phones for smartphones; Headphones for smart phones; Ear buds; Earphones for cellular telephones</i>	<i>In-ear headphones</i>
<i>Cases for headphones</i>	<i>Carrying cases for in-ear headphones, headsets and wireless headphones</i>
<i>Headsets; Wireless headsets; Wireless headsets for cellphones</i>	<i>Headsets</i>
<i>Adapter cables for headphones</i>	<i>Connector cords for in-ear headphones</i>

Class 10

Contested Goods	Identical Earlier Goods
<i>Ear plugs for soundproofing (other than for medical use); Ear plugs for sleeping; Ear plugs [hearing protection devices]; Ear plugs for protection against noise; Noise reduction ear plugs; Protective ear plugs; Ear plugs; Ear protectors; Noise protection means in the form of deformable ear plugs; Ear plugs for</i>	<i>Ear plugs [ear protection devices]</i>

Contested Goods	Identical Earlier Goods
<i>medical purposes; Hearing protection devices; Hearing protectors.</i>	

29. Given that the applicant has not denied that the goods and services are identical or highly similar, I shall proceed on the basis that the remaining contested goods are highly similar to the opponent's goods and services.

Average Consumer and the Purchasing Process

30. In *Iconix*, 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:

“16. First, the average consumer is both a legal construct and a normative benchmark. They are a legal construct in that consumers who are ill-informed or careless and consumers with specialised knowledge or who are excessively careful are excluded from consideration. They are a normative benchmark in that they provide a standard which enables the courts to strike a balance between the various competing interests involved, including the interests of trade mark owners, their competitors and customers.

17. Secondly, the average consumer is neither a single hypothetical person nor some form of mathematical average, nor does assessment from the perspective of the average consumer involve a statistical test. They represent consumers who have a spectrum of attributes such as gender, age, ethnicity and social group. ... It follows that assessment from the perspective of the average consumer does not involve the imposition of a single meaning rule akin to that applied in defamation law (but not malicious falsehood). ... 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, then a finding of infringement may properly be made.

18. Thirdly, assessing from the perspective of the average consumer is designed 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. ...

19. Fourthly, the average consumer's level of attention varies according to the category of goods or services in question.

20. Fifthly, 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. In my view, the average consumer of the majority of the goods at issue is a member of the general public. The opponent submits that there is no specialist or professional public to be considered. However, in my view the following goods are not likely to be directed towards the general public: *Binaural microphones; Noise gate devices; Noise filters; Diaphragms [acoustics]; Horns for loudspeakers; Audio noise reducers* (all in Class 9); *Protective nose masks for dental use; Protective nose masks for veterinary use; Protective visors for dental use; Protective mouth masks for dental use* (all in Class 10). I understand that *binaural microphones* are specialist equipment used in recording to create a more immersive sound experience for the listener. *Noise gate devices; Noise filters* and *audio noise reducers* are equipment or software that can be used to remove noise from an audio signal. *Diaphragms [acoustics]* and *Horns for loudspeakers* are components of audio equipment. The aforementioned Class 10 goods are self-explanatory.

32. I shall deal first with those goods for which the average consumer is a member of the general public. These goods are likely to be purchased from bricks-and-mortar retailers, websites or catalogues. In some instances, the consumer may have read reviews or seen advertisements. The purchasing process is therefore likely to be largely visual. However, I do not discount the possibility of the consumer seeking advice from sales staff or receiving word-of-mouth recommendations from third parties, so aural considerations still play a part in this process. The price of the goods

will vary but I do not consider it to be so low and the purchasing so very frequent that the average consumer will be paying only a low degree of attention. In my view, the degree of attention paid is medium.

33. I now come to the remaining goods and shall start with *Binaural microphones; Noise gate devices; Noise filters; Diaphragms [acoustics]; Horns for loudspeakers; Audio noise reducers*. As I have already said, I consider that these goods would be purchased by specialists, either manufacturers of audio equipment or professionals using such equipment to make sound recordings. They will make their purchases after having browsed printed and/or online promotional material, including websites, and will pay attention to the technical functions of the goods and compatibility with other equipment. I have nothing to tell me whether these goods would be expensive. Given the role of these goods in the consumer's business, and their likely impact on the quality of the end-product, I find that the average consumer would pay a higher than medium degree of attention.

34. The final goods are protective goods used in dental and veterinary settings. I have not included *Protective nose masks for medical use* in this group, as it seems to me that it is possible that these goods could be purchased by members of the general public, for example, to use if recovering from surgery. The dental and veterinary goods are likely to be fairly frequent purchases and be relatively inexpensive. I find that the level of attention is likely to be medium. Again, I consider that the purchasing process is likely to be visual, as the average consumer will buy the goods from websites or catalogues, although aural considerations cannot be completely discounted.

Comparison of marks

35. It is clear from *SABEL BV v Puma AG*, Case C-251/95, that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details: see, in particular, paragraph 23 of that judgment. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo SA v OHIM*, Case C-519/12 P, that:

“34. ... it is necessary to ascertain in each individual case, the overall impression made on the target public by the sign for which the 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.”

36. Artificial dissection of the marks would therefore be wrong, although it is necessary for me to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

37. The respective marks are shown below:

Contested mark	Earlier marks
LOOP EARPLUGS QUIET	The 693 and 396 marks: LOOP The 890 mark: LOOP SWITCH The 732 mark: LOOP QUIET

38. The contested mark consists of three words. Were the mark to be used for earplugs, the second of these words would plainly be descriptive and the third word alludes to the results to be gained from using the products. For these goods, the word “LOOP” is the dominant and distinctive element of the mark. The word “QUIET” is allusive in respect of other goods that are connected with sound, particularly with reducing their impact. “EARPLUGS” may be slightly allusive. For these goods, the greatest contribution to the overall impression of the mark is made by the word “LOOP”. “EARPLUGS” will play a smaller role, with the part played by “QUIET” smaller still.

39. For goods that are not earplugs or associated with sound, the word “EARPLUGS” makes a contribution to the overall impression of the mark that is less than “LOOP”, but greater than “QUIET”. The weight to be attached to the second and third words is greater for these goods than for the second group of goods (those connected with sound).

40. The 693 and 396 marks consist of the single word “LOOP” and the overall impression of the mark must therefore be found in that word alone.

41. The 890 mark begins with the word “LOOP”. In my view, “SWITCH” is neither descriptive nor allusive and both words contribute equally to the overall impression of the mark.

42. Turning now to the 732 mark, I consider that the word “QUIET” alludes to the goods for which it is registered. The word “LOOP” makes the greater contribution to the overall impression of this mark.

43. As the goods covered by the 693, 890 and 732 marks are identical, I shall carry out my comparison on the basis of the 693, 396 and 732 marks only. The 890 mark does not add anything to my assessment, particularly as there is no claim to a family of marks.

Comparison with the 693 and 396 marks

44. The first of the three words in the contested mark is the single word of the 693 and 396 marks. It is therefore identical at the start, but the additional two words provide a point of difference. That said, it is the first word that makes the greatest contribution to the overall impression of the mark (or, in the case of some of the goods, is the dominant and distinctive element of the earlier mark). I find that the marks are visually similar to a medium degree.

45. The words in both marks are common English words and would be pronounced in the usual way. If the contested mark were to be used for earplugs or wearable noise reduction devices, I consider that the average consumer is likely to articulate the first word only, resulting in the marks being aurally identical. In making this finding, I bear

in mind the decision of the GC in *Pensa Pharma v OHIM*, Case T-544/12, in particular the following paragraph:

“107. ... the relevant public generally pays greater attention to the beginning of a sign than to the end. In those circumstances, that public will focus its attention on the element ‘pensa’ in the contested mark and not on the element ‘pharma’ in that mark. It may be presumed that that public, which generally tends to contract long marks consisting of two words into a single word, will not pronounce the word ‘pharma’, inasmuch as that word is superfluous because of the nature of the goods and services covered by the contested mark, namely pharmaceutical goods and services.”

46. For the remaining goods, where “EARPLUGS” is not descriptive, it is my view that the average consumer would articulate the mark in full, or at least say “LOOPS EARPLUGS”. I find that the marks are aurally similar to a medium degree.

47. The applicant submits that the word “LOOP” would be understood as meaning “a circular or curved shape”. I agree. In my view, it would be perceived in the same way in both marks. The contested mark contains additional conceptual meaning with “EARPLUGS” and “QUIET”. I find that the marks are conceptually similar to no more than a medium degree.

Comparison with the 732 mark

48. The 732 mark consists of two words, both of which are present in the contested mark, albeit separated by the word “EARPLUGS”. I find that the marks are visually and aurally highly similar.

49. The only conceptual difference between the marks comes from the word “EARPLUGS” in the contested mark. Keeping in mind the relative contributions of each of the words to the overall impressions of the marks, I find that the marks are conceptually highly similar.

Distinctive character of the earlier marks

50. Distinctive character is a measure of how strongly a mark distinguishes the goods or services of one undertaking from those of others. The factors that I must take into

account in assessing the level of distinctive character were set out by the CJEU in *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV*, Case C-39/97:

“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).”

51. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, 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 the mark can be enhanced by the use that has been made of it.

52. The opponent submits that the earlier marks have at least a medium, or even a fairly high, degree of inherent distinctive character. It refers me to the judgment of Arnold J (as he then was) in *Virgin Enterprises Limited v Virginic LLC* [2019] EWHC 672. In paragraph 8, the judge accepts Virgin’s submission that a word does not have to be invented for it to have a high degree of distinctive character, and found that the distinctiveness of “VIRGIN” was “*fairly high*”. Distinctiveness is a spectrum and there are instances in which a recognised English word could, indeed, have a fairly high degree of inherent distinctive character. In the case cited, the Hearing Officer’s finding that the word “VIRGIN” was arbitrary for the goods relied upon was not challenged on appeal. It seems to me that a standard English word is likely to have a higher degree of inherent distinctive character if it is unexpected or incongruous. I found that “LOOP” would be understood as referring to a shape. In my view, the inherent distinctive character of the 693 and 396 marks is at a medium level. I do not consider that the additional word “QUIET” in the 732 marks increases the degree of inherent distinctiveness.

53. I shall now consider whether the inherent distinctive character of these marks has been enhanced through the use made of them. Ms Preda does not tell me when the marks were first used in the UK, although I note that the claim for the section 5(4)(a) ground is that the unregistered signs relied on, **LOOP** and **LOOP QUIET**, were first used in the UK in 2019. The table below is taken from Ms Preda’s witness statement and shows UK unit sales for 2019-2024. She confirms that “*All products are sold under, and all packaging bears, the LOOP brand.*”⁶

Name	2019	2020	2021	2022	2023	2024
Product	Units	Units	Units	Units	Units	Units
Bundles				365		
Carry Case			286	8,748	11,853	4,892
Carry Cord				1,563	1	
Dream						32,053
Engage				11,204	76,969	121,087
Engage Kids					8,897	32,314
Engage Plus				6,552	42,190	58,351
Experience	493	1,642	19,159	55,830	102,145	181,079
Experience Plus			4,867	32,682	36,951	53,091
Foam Eartips	1	3	131	886	899	874
Link					15,974	46,420
Mute			375	3,616	6,265	10,401
Quiet		410	25,518	117,916	320,957	391,696
Quiet Plus						42,324
Silicone Eartips Dream						198
Silicone Eartips Multicolor						218
Silicone Eartips Quiet 1		3	369	1,836	4,376	1,668
Silicone Eartips Quiet 2						194
Silicone Eartips Quiet Plus						413
Silicone Eartips Switch 2						31
Sticker				2,694	2	
Switch					16,115	81,309
Total	498	2,058	50,713	249,399	643,606	1,059,534

54. I understand from elsewhere in the evidence that “Dream”, “Engage”, “Experience”, “Quiet” and “Switch” are all models of earplugs. As the relevant date for these proceedings is 6 March 2024, the table below contains data from the years up to 2023, as it is likely that only a small proportion of the sales from 2024 were made before this date. The totals for the relevant goods are shown below and are likely to be somewhat higher than recorded here:

Goods	Units sold
Carry cases	20,887
Engage	88,173
Engage Kids	8,897
Engage Plus	48,742
Experience	179,269

⁶ Paragraph 5.

Goods	Units sold
Experience Plus	74,500
Quiet	464,801
Switch	16,115
TOTAL FOR EARPLUGS	901,384

55. I have been provided with no evidence going to the size of the market for these goods and so am unable to make any findings on the market share enjoyed by the opponent's goods sold under the earlier marks. However, I consider that it is worth bearing in mind that the opponent's earplugs are not disposable items and so do not need to be replaced unless they are lost or damaged. Consequently, it would be expected that fewer units are sold than would be the case with disposable earplugs.

56. The opponent's goods are sold on the Amazon marketplace. Exhibit OP2 contains an example sales invoice dated 27 February 2024, showing the sale of 4650 units of the Engage Kids and Quiet earplugs. The pages taken from the Amazon website that show the goods on sale are undated, although there is one review for Loop Quiet that begins *"2 years in, and I still love them"*. It is not clear where the reviewer was based.⁷ Ms Preda states that goods are also sold through the shop on the opponent's website, but I have no dated evidence of this.

57. Exhibit OP3 contains print-outs from the opponent's social media channels, including Facebook, TikTok, Pinterest, Instagram and YouTube. The majority of the information is undated, or dated after the relevant date. Some YouTube videos were published two years before the date of printing (in 2025) and there are some Instagram posts from before the relevant date. An example dated 16 January 2024 is reproduced below:

⁷ Exhibit OP2, page 22.



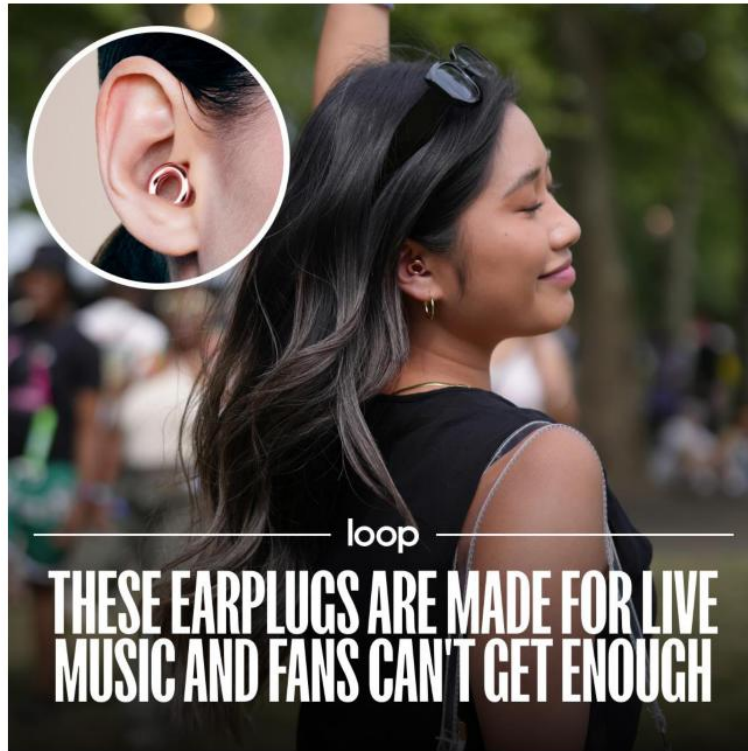
There is nothing to tell me how many of the followers of these accounts were in the UK.

58. Ms Preda states that between 2022 and 2025, the opponent spent over €4.6 million on UK-facing advertising on Meta (Facebook and Instagram) and that this is reported to have reached over 33 million users. Some of this expenditure is likely to have been incurred after the relevant period. However, Ms Preda gives the examples of January 2023 and January 2024 where sums of over €57,000 and over €150,000 respectively were spent on Meta advertising. These generated over 3 million and 5 million UK visitors to the website. She also states that advertising on Google in March 2023 generated over 19,000 new UK-based visitors to the website.⁸ She does not say which of the particular models featured in this advertising, so I consider that this evidence only supports a finding of enhanced distinctive character with respect to the 693 mark.

59. I reproduce below two examples of Meta advertising. Ms Preda does not give the dates of these advertisements, but confirms that they were used before the relevant date.⁹

⁸ Witness statement, paragraph 9.

⁹ Exhibit OP6, pages 5 and 8.



60. All the advertisements in the exhibit show earplugs and use the word “Loop” on its own or with the name of the particular model, such as “Quiet”, “Engage” or “Switch”.

61. Exhibit OP7 contains a selection of articles and website extracts about the opponent's earplugs. Most of these were published after the relevant date. Those that were published before 6 March 2024 are listed below:

- a) "Struggles with sleep: my sleep essentials and Loop Quiet Earplug review", *The Little Pomegranate* website, 4 March 2023;
- b) "Loop Earplugs review: Here's why we wear these stylish noise reduction earplugs every day", *The Independent*, 27 June 2023 (the article discusses the Loop Experience earplugs); and
- c) "10 best earplugs for concerts and festivals to protect your hearing", *The Independent*, 27 June 2022 (Loop Experience earplugs were reviewed as being best for style).

62. The Loop Engage earplugs won a Red Dot design award in 2023. The following year, the Loop Switch earplugs also won a Red Dot design award. It is not clear whether the award for 2024 was given before or after the relevant date.¹⁰

63. On the basis of the evidence provided, I consider that the distinctive character of the 693 mark has been enhanced to a medium to high degree for the following goods: *Ear plugs [ear protection devices]; Ear plugs for sleeping; Ear plugs for protection against noise*. I do not consider that it has been enhanced for *Noise protection means in the form of deformable ear plugs* and *Ear plugs for medical purposes*. In the case of the former, this is because I consider that deformable earplugs are ones that can be squeezed or bent into a different shape and the opponent's earplugs do not have this quality. In the case of the latter, there is no evidence that the opponent's goods are used for medical purposes.

64. I turn now to the 732 mark (**LOOP QUIET**). The goods have been on sale in the UK since 2020. Up to the relevant date, 464,801 units had been sold. This is just over half of the sets of earplugs sold. However, there is no specific information on the extent of any advertising of goods bearing this mark and the single article mentioning the mark appears on *The Little Pomegranate* website, for which no viewing figures have

¹⁰ Exhibit OP9.

been provided. I do not consider that the evidence is sufficient to show that the inherent distinctive character of this mark has been enhanced through use.

Conclusions on likelihood of confusion

65. Making an assessment of the likelihood of confusion is a matter of considering the relevant factors from the viewpoint of the average consumer of the goods at issue and determining whether they are likely to be confused. When doing this, I am required to bear in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely on the imperfect picture of them that they have in their mind. The courts have not said what weight should be attached to each of the factors or provided a formula that can be applied to any set of circumstances. Because this is a global assessment, there is some interdependence between the factors and so a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods or vice versa.

66. There are two types of confusion: direct and indirect. In *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10, Mr Iain Purvis QC, 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 recognised that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but analysed in formal terms, is something along the following lines: ‘The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI', etc.)

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)."

67. In *Liverpool Gin Distillery Limited & Ors v Sazerac Brands LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ commented that:

"12. This is a helpful explanation of the concept of indirect confusion, which has frequently been cited subsequently, but as Mr Purvis made clear it was not intended to be an exhaustive definition.

13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/291/16) at [16] 'a finding of 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."

68. The applicant is deemed to have admitted that all the contested goods are identical or highly similar to the opponent's goods and services. The attention paid by the average consumer is medium, except in the case of a small number of specialist goods, where the attention paid would be higher than medium. The closest earlier mark in terms of similarity is the 732 mark (**LOOP QUIET**) which I found to be visually, aurally and conceptually highly similar to the contested mark. In my view, this mark has a medium degree of inherent distinctive character. The word "LOOP" makes the greatest contribution to the overall impression of both parties' marks, and is the dominant and distinctive element of the contested mark were it to be used for earplugs. It is also at the beginning of the marks and, given that the English-speaking consumer reads from left to right, the beginnings of marks tend to attract greater attention than the middles or ends. I consider that will be the case here. Even where the average consumer is a specialist paying a higher than medium degree of attention, I consider that imperfect recollection will come into play and the average consumer will be directly confused.

69. The opposition is wholly successful under section 5(2)(b). I shall deal with the other grounds for the sake of completeness.

Section 5(3)

70. Section 5(3) of the Act is as follows:

"A trade mark which—

(a) is identical with or similar to an earlier trade mark,

[...]

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark."

71. The conditions of section 5(3) are cumulative. First, the marks at issue must be identical or similar. Secondly, the opponent must satisfy me that the earlier mark has achieved a level of knowledge/reputation amongst a significant part of the relevant public. Thirdly, it must be established that the level of reputation and the similarities

between the marks will cause the public to make a link between them, in the sense of the earlier mark being brought to mind by the application. Fourthly, assuming that the first three conditions have been met, section 5(3) requires that one or more of the three types of damage claimed will occur. It is unnecessary for the purposes of section 5(3) that the goods and/or services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

72. I have already found that the contested mark is similar to the opponent's marks: see paragraphs 35-49 above.

Reputation

73. In *General Motors Corp v Yplon SA*, Case C-375/97, the CJEU held that:

“24. The public amongst which the earlier trade mark must have acquired a reputation is that concerned by that trade mark, that is to say, depending on the product or services marketed, either the public at large or a more specialised public, for example traders in a specific sector.

25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation ‘in the Member State’. In the absence of any definition of the Community provision in this respect, a trade

mark cannot be required to have a reputation ‘throughout’ the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

74. The 693 mark is a comparable mark, created from an EU Trade Mark (“EUTM”) pursuant to Article 54 of the Withdrawal Agreement. Paragraph 10 of Part 1 of Schedule 2A of the Act states that when considering the reputation of a comparable mark, the relevant territory for the period up to IP completion day (31 December 2020) is the EU. Thereafter, it is the UK.

75. Earlier in my decision, I found that the evidence was sufficient to show that the distinctive character of this mark (**LOOP**) had been enhanced from a medium to a medium to high degree through the use that had been shown. While enhanced distinctiveness and reputation are not the same thing, the factors that are relevant are the same. I note that the evidence solely concerns the UK. The period from IP completion day to the relevant date amounts to 3 years and just over 2 months. The table reproduced in paragraph 53 above shows fairly low levels of sales in 2019 and 2020, increasing significantly over the following years. I am satisfied that, on the basis of the evidence shown, the 693 mark had a moderate reputation for *Ear plugs [ear protection devices]; Ear plugs for sleeping; Ear plugs for protection against noise*. I do not find that the other earlier marks have a reputation.

Link

76. In assessing whether the public will make the required mental link between the marks, I must take account of all relevant factors, which were identified by the CJEU at paragraph 42 of its judgment in *Intel Corporation Inc v CPM United Kingdom Ltd*, Case C-252/07. I shall consider each of them in turn:

The degree of similarity between the conflicting marks

I found the contested mark and the 693 mark to be visually similar to a medium degree, aurally identical or similar to a medium degree, and conceptually similar to no more than a medium degree.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

Although the applicant is deemed to have admitted under section 5(2)(b) that the parties' goods and services are identical or highly similar, I consider that this admission cannot be transferred to section 5(3). This is because there is a significantly smaller number of goods that the opponent can rely on under this ground.

The contested goods can conveniently be divided into a number of groups. The first consists of ear plugs and wearable hearing protectors. The goods in this group are: *Ear plugs for soundproofing (other than for medical use); Ear plugs for sleeping; Ear plugs [hearing protection devices]; Ear plugs for protection against noise; Noise reduction ear plugs; Protective ear plugs; Ear plugs; Ear protectors; Noise protection means in the form of deformable ear plugs; Ear plugs for medical purposes; Hearing protection devices; Hearing protectors; Ear plugs for divers.* These are identical to the goods for which the 693 mark has a reputation or, in the case of *Ear plugs for divers*, similar to a medium degree. I make this latter finding for the following reasons. I understand that the purpose of the applicant's goods is to prevent water from entering the inner ear, while the purpose of the opponent's goods is to protect the ears from excess noise and so prevent, or reduce, hearing loss. The purpose is therefore different. There is an overlap in user, but only in so far as the users are members of the general public. There is likely to be some similarity in physical nature and the goods share the same method of use, in that both are inserted into the ear. I do not consider that they would be sold through the same trade channels, as the applicant's *Ear plugs for divers* are likely to be sold by specialist diving retailers. I have no information to say whether the goods are substitutable for each other, and therefore in competition, but it seems likely to me that the manufacturers of *Ear plugs for divers* will need to give consideration to the effect of pressure under water. I do not consider that the goods are complementary. Taking these factors into account, I find that *Ear plugs for divers* and *Ear plugs [ear protection devices]* are similar to a medium degree.

The next group of goods are related to sound. They include headphones and headsets, loudspeakers, components for audio equipment, aids for people with impaired hearing, devices for managing ambient noise, and accessories that the public would expect to come from the producers of those goods. There is some distance between these goods and those for which the 693 mark has a reputation, but all are connected with the recording, reproduction, amplification or reduction of sound. The relevant public for the components for audio equipment consists of manufacturers or specialists constructing their own equipment, while the relevant public for the remaining goods are the general public. This group consists of the following:

Class 9

Headphones; Ear pads for headphones; Noise cancelling headphones; Earphones; Earbuds; In-ear headphones; Two-way plugs for headphones; Music headphones; Wireless headphones; Stereo headphones; Cases for headphones; Microphone plugs; Ear phones; Earphones for smartphones; Headsets; Headphones for smartphones; Binaural microphones; Noise gate devices; Anti-dust plugs for earphone jacks; Noise filters; Headphone amplifiers; Diaphragms [acoustics]; Wireless headsets; Wireless headsets for cellphones; Horns for loudspeakers; Loud speakers; Adapter cables for headphones; Ear buds; Dust proof plugs for earphone jacks; Audio noise reducers; Earphones for cellular telephones; Batteries for use in hearing aids; Megaphones.

Class 10

Ear adaptors for hearing aids; Ear trumpets; Acoustic amplifiers [hearing aids] for partially deaf persons; Hearing aids for the deaf [acoustic aids].

The applicant's *Pads for inhibiting snoring* are different in nature and method of use from the opponent's earplugs, but both products may be purchased and used to improve the quality of sleep. There are likely to be some shared trade channels and the relevant public for both parties' goods is the general public.

The remaining goods consist of various types of protective equipment, accessories to be used with spectacles or sunglasses, orthopedic pillows, anti-

nausea wristbands and ear thermometers. There is a greater distance between these goods and the opponent's earplugs. They do not overlap in nature, method of use or trade channels. Some of the protective equipment is directed towards veterinary and dental surgeries, while the rest are used by the general public.

The strength of the earlier mark's reputation

I have found that the earlier mark has a moderate reputation.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use

I found that the 693 mark had a medium to high degree of distinctive character for the goods for which it has a reputation.

Whether there is a likelihood of confusion

My findings under section 5(2)(b) were based on a wider range of earlier goods. Here, I only have *Ear plugs [ear protection devices]; Ear plugs for sleeping; Ear plugs for protection against noise* to consider as earlier goods. In my view, there would be a likelihood of confusion if the mark were used for the following contested goods: *Ear plugs for soundproofing (other than for medical use); Ear plugs for sleeping; Ear plugs [hearing protection devices]; Ear plugs for protection against noise; Noise reduction ear plugs; Protective ear plugs; Ear plugs; Ear protectors; Noise protection means in the form of deformable ear plugs; Ear plugs for medical purposes; Hearing protection devices; Hearing protectors; Ear plugs for divers.*

Section 5(3) provides additional protection for those marks with a reputation. It acknowledges that some marks are so highly distinctive and well known that there is likely to be some confusion almost irrespective of the goods or services in relation to which they are used. I do not consider that the 693 mark meets these criteria, given the moderate level of reputation and the medium to high degree of distinctive character.

77. Given the inclusion of the word “EARPLUGS” in the contested mark, it is my view that a link will be created in the mind of the public with the 693 mark if the contested mark were to be used for any of the goods for which registration is sought.

Damage

78. I shall deal first with **unfair advantage**. This means that consumers are more likely to buy the goods of the applicant than they would otherwise have been if they had not been reminded of the earlier marks. Where there is a likelihood of confusion, there will be an unfair advantage. Consequently, damage is made out for the following goods:

Class 9

Ear plugs for divers.

Class 10

Ear plugs for soundproofing (other than for medical use); Ear plugs for sleeping; Ear plugs [hearing protection devices]; Ear plugs for protection against noise; Noise reduction ear plugs; Protective ear plugs; Ear plugs; Ear protectors; Noise protection means in the form of deformable ear plugs; Ear plugs for medical purposes; Hearing protection devices; Hearing protectors.

79. Unfair advantage may also be taken of an earlier mark where there is no likelihood of confusion between it and the later mark. In these circumstances, the unfair advantage is usually the result of the transfer of the image of the earlier mark, or of the characteristics it projects, to the goods identified by the later mark: see *L’Oréal SA & Ors v Bellure & Ors*, Case C-487/07, paragraph 41.

80. The image of the earlier mark is one of products that are both functional and stylish, looking good when they are worn. The author of the article from *The Independent* dated 27 June 2023 says, “After I saw my best pal wearing them and loved the look of their stylish jewellery-like design, I decided to order some.”¹¹ The earplugs were also reviewed as being “Best: For style” in an earlier article from the same source: “As we really couldn’t fault the quality provided by the Fender earplugs, these had to be our best buy. But if you’re up for something a little more funky, we highly recommend the

¹¹ Exhibit OP7, page 62.

Loop earplugs.¹² Furthermore, the Red Dot design award celebrates and rewards good design. I consider that this would be a desirable quality for the following goods, which are all worn on the person:

Class 9

Headphones; Ear pads for headphones; Noise cancelling headphones; Earphones; Earbuds; In-ear headphones; Music headphones; Wireless headphones; Stereo headphones; Ear phones; Earphones for smartphones; Wireless headsets; Wireless headsets for cellphones; Ear buds; Earphones for cellular telephones.

Class 10

Ear adaptors for hearing aids; Acoustic amplifiers [hearing aids] for partially deaf persons; Hearing aids for the deaf [acoustic aids].

81. In my view, the moderate level of reputation is not sufficient for there to be an image transfer in respect of any of the remaining goods, given the distance between them.

82. The opponent also claims that use of the contested mark would be **detrimental to the distinctive character** of the 693 mark. This means that the earlier mark's ability to distinguish the goods and services of one undertaking from those of another is weakened. In *Environmental Manufacturing LLP v OHIM*, Case C-383/12 P, the CJEU stated that:

"34. According to the Court's case-law, proof that the use of the later mark is, or would be, detrimental to the distinctive character of the earlier mark requires evidence of a change in the economic behaviour of the average consumer of the goods or services for which the earlier mark was registered, consequent on the use of the later mark, or a serious likelihood that such a change will occur in the future (*Intel Corporation*, paragraphs 77 and 81, and also paragraph 6 of the operative part of the judgment).

35. Admittedly, paragraph 77 of the *Intel Corporation* judgment, which begins with the words '[i]t follows that', immediately follows the assessment

¹² Ibid, page 76.

of the weakening of the ability to identify and the dispersion of the identity of the earlier mark; it could thus be considered to be merely an explanation of the previous paragraph. However, the same wording, reproduced in paragraph 81, and in the operative part of that judgment, is autonomous. The fact that it appears in the operative part of the judgment makes its importance clear.

36. The wording of the above case-law is explicit. It follows that, without adducing evidence that that condition is met, the detriment or the risk of detriment to the distinctive character of the earlier mark provided for in Article 8(5) of Regulation No 207/2009 cannot be established.

37. The concept of ‘change in the economic behaviour of the average consumer’ lays down an objective condition. That change cannot be deduced solely from subjective elements such as consumers’ perceptions. The mere fact that consumers note the presence of a new sign similar to an earlier sign is not sufficient of itself to establish the existence of a detriment or a risk of detriment to the distinctive character of the earlier mark within the meaning of Article 8(5) of Regulation No 207/2009, in as much as that similarity does not cause any confusion in their minds.

38. The General Court, at paragraph 53 of the judgment under appeal, dismissed the assessment of the condition laid down by the *Intel Corporation* judgment, and, consequently, erred in law.

39. The General Court found, at paragraph 62 of the judgment under appeal, that ‘the fact that competitors use somewhat similar signs for identical or similar goods compromises the immediate connection that the relevant public makes between the signs and the goods at issue, which is likely to undermine the earlier mark’s ability to identify the goods for which it is registered as coming from the proprietor of that mark’.

40. However, in its judgment in *Intel Corporation*, the Court clearly indicated that it was necessary to demand a higher standard of proof in order to find detriment or the risk of detriment to the distinctive character of the earlier mark, within the meaning of Article 8(5) of Regulation No 207/2009.

41. Accepting the criterion put forward by the General Court could, in addition, lead to a situation in which economic operators improperly appropriate certain signs, which could damage competition.

42. Admittedly, Regulation No. 207/2009 and the Court's case-law do not require evidence to be adduced of actual detriment, but also admit the serious risk of such detriment, allowing the use of logical deductions.

43. None the less, such deductions must not be the result of mere suppositions but, as the General Court itself noted at paragraph 52 of the judgment under appeal, in citing an earlier judgment of the General Court, must be founded on 'an analysis of the probabilities and by taking account of the normal practice in the relevant commercial sector as well as all the other circumstances of the case'."

83. The opponent submits that the economic behaviour of the relevant public would be altered. They may mistakenly purchase goods from the applicant, transfer their custom to the applicant or not make any purchase at all. A change in customer's behaviour may be inferred from the inherent probabilities of the situation: see *32Red Plc v WHG (International) Limited & Ors* [2011] EWHC 665 (Ch), paragraph 133. Mistakenly purchasing goods from the applicant would occur because the customer is confused about the origin of those goods. I have already considered the instances in which there will be a likelihood of confusion. I do not see that the average consumer of the opponent's earplugs would transfer their custom to the applicant to buy goods that are not earplugs. The opponent has not explained the scenario in which no purchase is made at all. I find that the claim to damage to distinctive character has not been made out.

84. Finally, the opponent claims that there will be **damage to the reputation** of the 693 mark through use of the contested mark for goods that have not been subject to the quality control of the opponent. The reputation of the earlier mark would be damaged if the quality of the goods were to be poor.

85. In *L'Oréal*, the CJEU said:

“40. As regards detriment to the repute of the mark, also referred to as ‘tarnishment’ or ‘degradation’, such detriment is caused when the goods or services for which the identical or similar sign is used by the third party may be perceived by the public in such a way that the trade mark’s power of attraction is reduced. The likelihood of such detriment may arise in particular from the fact that the goods or services offered by the third party possess a characteristic or a quality which is liable to have a negative impact on the image of the mark.”

86. In the light of this case law, I consider that the mere risk of the use of the contested mark on sub-standard goods is not sufficient for a claim of damage to reputation to succeed. I am required to take account of how the particular goods and services are likely to be perceived by the public, focusing in particular on their characteristics and qualities.

87. The opponent submits that the applicant has not claimed that it has due cause to use the contested mark. I agree. The applicant has claimed that it made the application in good faith, but this is not the same thing as having due cause. For the benefit of the applicant as a litigant in person, I shall briefly explain why. In *Leidseplein Beheer v Red Bull GmbH*, Case C-65/12, the CJEU held the concept of “due cause” was intended to strike a balance between the interests of the proprietor of a mark with a reputation and a third party that had been using a sign similar to that mark. There is no evidence that the applicant has used the contested mark prior to the application.

Outcome of the section 5(3) claim

88. The opposition succeeds under section 5(3) in respect of the following goods:

Class 9

Headphones; Ear pads for headphones; Noise cancelling headphones; Earphones; Earbuds; In-ear headphones; Music headphones; Wireless headphones; Stereo headphones; Ear plugs for divers. Ear phones; Earphones for smartphones; Wireless headsets; Wireless headsets for cellphones; Ear buds; Earphones for cellular telephones.

Class 10

Ear plugs for soundproofing (other than for medical use); Ear plugs for sleeping; Ear plugs [hearing protection devices]; Ear plugs for protection against noise; Noise reduction ear plugs; Protective ear plugs; Ear adaptors for hearing aids; Ear plugs; Ear protectors; Noise protection means in the form of deformable ear plugs; Acoustic amplifiers [hearing aids] for partially deaf persons; Ear plugs for medical purposes; Hearing aids for the deaf [acoustic aids]; Hearing protection devices; Hearing protectors.

Section 5(4)(a)

89. Section 5(4)(a) of the Act states that:

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented—

(a) by virtue of any rule or law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection 4(A) is met

...”

90. Subsection 4(A) is as follows:

“The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

91. In *Reckitt & Colman Products Limited v Borden Inc. & Ors* [1990] RPC 341, HL, Lord Oliver of Aylmerton described the ‘classical trinity’ that must be proved in order to reach a finding of passing off at [406]:

“First, he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying ‘get-up’ (whether it consists simply of a brand name or a trade description, or the individual features of labelling or

packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by him are the goods or services of the plaintiff. Thirdly, he must demonstrate that he suffers or, in a quia timet action, that he is likely to suffer damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff."

92. *Halsbury's Laws of England* Vol. 97A (2021 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 636 it is noted (with footnotes omitted) that:

"Establishing a likelihood of deception generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other indicium which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

The question whether deception is likely is one for the court, which will have regard to:

- (a) the nature and extent of the reputation relied upon,
- (b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the claimant;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged are likely to be deceived and all other surrounding circumstances.

In assessing whether deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

Relevant Date

93. In *Maier & Anor v ASOS plc & Anor* [2015] EWCA Civ 220, Kitchin LJ (as he then was) said:

“165. ... Under the English law of passing off, the relevant date for determining whether a claimant has established the necessary reputation or goodwill is the date of the commencement of the conduct complained of (see, for example, *Cadbury-Schweppes Pty Ltd v The Pub Squash Co Ltd* [1981] RPC 429). The jurisprudence of the General Court and that of OHIM is not entirely clear as to how this should be taken into consideration under Article 8(4) (compare, for example, T-114/07 and T-115/07 *Last Minute Network Ltd* and Case R 784/2010-2 *Sun Capital Partners Inc*). In my judgment the matter should be addressed in the following way. The party opposing the application or the registration must show that, as at the date of application (or the priority date, if earlier), a normal and fair use of the [contested] trade mark would have amounted to passing off. But if the [contested] trade mark has in fact been used from an earlier date then that is a matter which must be taken into account, for the opponent must show that he had the necessary goodwill and reputation to render that use actionable on the date that it began.”

94. There is no evidence that the applicant has used the contested mark. Therefore, the relevant date for the purposes of this section is 6 March 2024.

Goodwill

95. The concept of goodwill was considered by the House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 at [224]:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantages of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start. The goodwill of a business must emanate from a particular centre or source. However widely extended or diffused its influence may be, goodwill is worth nothing unless it has the power of attraction sufficient to bring customers home to the source from which it emanates.”

96. The opponent claims to have used the signs **LOOP** and **LOOP QUIET** for headphones and headsets and earplugs. The full list of the goods can be seen in paragraph 7 above. There is no evidence that the opponent has used either of the signs for headphones and headsets or all of the specific types of earplugs. For example, there is no evidence of deformable earplugs, for the reasons I have already discussed. The opponent also claims that the **LOOP** sign has been used for retail and wholesale services, but I see no evidence of use for these services. Selling products on one's own website is not in itself the same thing as providing retail or wholesale services. I find that the signs **LOOP** and **LOOP QUIET** have been used for *Ear plugs; Ear plugs for sleeping; Ear plugs for protection against noise*. 901,384 units of **LOOP** earplugs were sold in the UK between 2019 and 2023, and there are likely to have been some further sales up to the relevant date of 6 March 2024. 464,801 units of **LOOP QUIET** earplugs were sold in the UK between 2020 and 2023, and, as with the **LOOP** earplugs, there are likely to have been some further sales up to 6 March 2024. These goods have also been advertised on Meta platforms and covered in newspaper articles and websites, although I note that there is a relatively small number of articles

dating from before the relevant date. I am satisfied that the opponent has a protectable goodwill in the signs for the goods listed above.

Misrepresentation

97. The relevant test was set out by Morritt LJ in *Neutrogena Corporation & Anor v Golden Limited & Anor* [1996] RPC 473 at [493]:

“There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd v Borden Inc* [1990] RPC 341 at page 407 the question on the issue of deception or confusion is:

‘is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants’ [product] in the belief that it is the respondents’ [product].’

The same proposition is stated in Halsbury’s Laws of England 4th Edition Vol. 48 para. 148. The necessity for a substantial number is brought out also in *Saville Perfumery Ltd v June Perfect Ltd* (1941) 58 RPC 147 at page 175; and *Re Smith Hayden’s Application* (1945) 63 RPC 97 at page 101.”

98. Although the test for misrepresentation is different from that for likelihood of confusion in that it entails “deception of a substantial number of members of the public” rather than “confusion of the average consumer”, it is unlikely, in the light of the Court of Appeal’s decision in *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, that the difference between the legal tests will produce different outcomes. I believe that to be the case here. The contested goods for which I found a likelihood of confusion (based on a comparison with the goods in respect of which the opponent enjoys a protectable goodwill) are as follows:

Class 9

Ear plugs for divers.

Class 10

Ear plugs for soundproofing (other than for medical use); Ear plugs for sleeping; Ear plugs [hearing protection devices]; Ear plugs for protection against noise; Noise reduction ear plugs; Protective ear plugs; Ear adaptors for hearing aids; Ear plugs; Ear protectors; Noise protection means in the form of deformable ear plugs; Ear trumpets; Acoustic amplifiers [hearing aids] for partially deaf persons; Ear plugs for medical purposes; Hearing aids for the deaf [acoustic aids]; Hearing protection devices; Hearing protectors.

99. Turning now to the remaining contested goods, I remind myself that it is not necessary for the parties to operate in a common field of activity, but Millett LJ held in *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA) that in such circumstances the burden of establishing misrepresentation and damage was a heavy one. I also take into account that “mere wondering” is not sufficient and that consumers must be deceived: see *Phones 4U Ltd v Phone4U.co.uk Internet Ltd* [2007] RPC 5 at [16]-[17]. In my view, the differences between the fields of activity between the opponent’s earplugs and the remaining contested goods are sufficient to avoid a substantial number of the relevant public from being misled into believing that the applicant’s goods are the goods of the opponent or an entity linked to it.

Damage

100. In *Harrods*, Millett LJ described the requirements for damage in passing off cases at [715]:

“In the classic case of passing off, where the defendant represents his goods or business as the goods or business of the plaintiff, there is an obvious risk of damage to the plaintiff’s business by substitution. Customers and potential customers will be lost to the plaintiff if they transfer their custom to the defendant in the belief that they are dealing with the plaintiff. But this is not the only kind of damage which may be caused to the plaintiff’s goodwill by the deception of the public. Where the parties are not in competition with each other, the plaintiff’s reputation and goodwill may be damaged without any corresponding gain to the defendant. In the *Lego* case, for example, a customer who was dissatisfied with the defendant’s

plastic irrigation equipment might be dissuaded from buying one of the plaintiff's plastic toy construction kits for his children if he believed that it was made by the defendant. The danger in such a case is that the plaintiff loses control over his own reputation."

101. In my view, damage is likely to occur through substitution, where the contested goods are ear plugs for general use (as opposed to, for example, those worn during diving). For the remaining goods listed in paragraph 98 above, damage is likely to occur through injurious association, which was described in the following way by Warrington LJ in *Ewing v Buttercup Margarine Company Limited* [1917] 2 Ch 1 (COA):

"To induce the belief that my business is a branch of another man's business may do that other man damage in various ways. The quality of goods I sell, the kind of business I do, the credit or otherwise which I enjoy are all things which may injure the other man who is assumed wrongly to be associated with me."

102. I find that damage is made out, and the section 5(4)(a) ground succeeds, for the goods listed in paragraph 98 above.

OUTCOME

103. The opposition is successful and, subject to a successful appeal, Application No. 4022779 is refused registration.

COSTS

104. The opponent has been successful and is entitled to a contribution towards its costs in line with the scale set out in Tribunal Practice Notice No. 1/2023. My award is calculated as follows:

£350 for preparing a statement and considering the other side's statement;

£750 for preparing evidence;

£400 for filing written submissions in lieu of a hearing;

£200 for official fees

£1700 in total

105. I therefore order Colombo International Constructions Ltd to pay Loop BV the sum of £1700. 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 if the appeal is unsuccessful.

Dated this 30th day of August 2026

Clare Boucher
For the Registrar