o/0894/24

TRADE MARKS ACT 1994

IN THE MATTER OF
TRADE MARK APPLICATON NO. 3927380
BY SKATEWAREHOUSE LIMITED TO REGISTER AS A TRADE MARK:

Icarus Eyewear

IN CLASS 09

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NO. 600003014
BY INDUSTRIAS DE OPTICA PRATS, S.L

BACKGROUND AND PLEADINGS

1. On 27 June 2023, Skatewarehouse Limited ("the applicant") applied to register the trade mark displayed on the cover page of this decision, under number 3927380 ("the application"). It was accepted and published in the Trade Marks Journal on 14 July 2023 in respect of the following goods:

> Class 09:
> Sun glasses; Glasses; Lenses for glasses; Eye glasses; Glasses, sunglasses and contact lenses; Frames for eye glasses; Optical glasses; Glasses frames; Frames for glasses; Protective glasses; Magnifying glasses [optics]; Sunglasses; 3D eye glasses; Replacement lenses for glasses; Lenses for sunglasses; Dustproof glasses; Sports glasses; Glasses for sports; Ski glasses; Antiglare glasses (anti-glare); Optical lenses for sunglasses; Optical lenses for use with sunglasses; Lenses for eyeglasses; Sunglasses frames; Frames for sunglasses; Prescription sunglasses; Colour blindness correction glasses; Chains for spectacles and sunglasses; Chains for spectacles and for sunglasses; Eyeglasses; Optical lenses for eyeglasses; Cases for eyeglasses and sunglasses; Color blindness correction glasses; Cyclists' glasses; Lenses for spectacles; Sports' glasses; Cases for spectacles and sunglasses; Sunglass lenses; Glasses cases; Goggles; Magnifying lenses; Optical lenses for spectacles; Glass ophthalmic lenses; Clip-on sunglasses; Frames for spectacles and sunglasses; Fashion sunglasses; Straps for sunglasses; Covers for sunglasses; Cords for sunglasses; Cases for sunglasses; Eyewear; Fashion eyeglasses; Eyeglasses for sports; Anti-glare glasses; Boxes [cases] for sunglasses; Eyewear pouches; Sports eyewear; Sunglass cases; Goggles for use in sports; Goggles for sports; Sports goggles; Sports training eyeglasses.

2. On 07 September 2023, the application was opposed by INDUSTRIAS DE OPTICA PRATS, S.L ("the opponent") by way of the fast track opposition procedure. The opposition is brought under section 5(2)(b) of the Trade Marks Act 1994 ("the Act") and is directed against all of the goods specified in the application.

3. The opponent relies upon the following trade mark:

IKARUS

Comparable UK trade mark (EU) registration no. UK00917951336.[1]
Filing date 07 September 2018; Registration date 22 January 2019.
Relying upon all of the goods for which its mark is registered, namely:

Class 09: Ophthalmic lenses; Optical lenses; Spectacle lenses.

4. The opponent's mark is an earlier mark, in accordance with Section 6 of the Act. However, as it has not been protected for five years or more at the filing date of the application, it is not subject to the proof of use requirements specified within Section 6A of the Act.

5. The opponent submits that the marks at issue are visually, aurally, and conceptually highly similar, and that the applicant's goods are all identical or highly similar to its own goods. As such, it submits that the application should be refused in its entirety and that an award of costs be made in their favour.

6. On 25 September 2023 the applicant submitted a form TM21B to restrict the specification of the applied for mark. This was subsequently actioned on 26 October 2023 leaving the following goods only:

[1] Following the end of the transition period of the UK's withdrawal from the EU, all EU trade marks ("EUTM") registered before 1 January 2021 were recorded as comparable trade marks in the UK trade mark register (and as a consequence, have the same legal status as if they had been applied for and registered under UK law). A 'comparable trade mark (EU)' retains the same filing date, priority date (if applicable) and registration date of the EUTM from which it derives.

Class 09: Sun glasses; Cases for eyeglasses and sunglasses; Goggles; Fashion sunglasses; Cases for sunglasses; Sports eyewear; Sunglass cases; Goggles for use in sports; Goggles for sports.

7. On 27 October 2023 the opponent confirmed that, despite the restriction to the specification, the opposition was maintained.

8. The applicant filed a counterstatement denying the claims.

9. 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."

10. 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 in respect of these proceedings.

11. The opponent is represented by Lara Grant of Grant IP, and the applicant is unrepresented. 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. A hearing was neither requested nor considered necessary and I note that neither party filed written submissions in lieu.

RELEVANCE OF EU LAW

12. 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.

Decision

Section 5(2)(b): legislation and case law

13. The opposition is based upon section 5(2)(b) of the Act which reads 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"

14. Section 5A of the Act states as follows:

> "Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only."

15. 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:

The principles:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent

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

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

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

Comparison of goods

16. Section 60A of the Act provides:

"(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the “Nice Classification” means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1979.”

17. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

> “In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

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

> (a) The respective uses of the respective goods or services;
>
> (b) The respective users of the respective goods or services;
>
> (c) The physical nature of the goods or acts of service;
>
> (d) The respective trade channels through which the goods or services reach the market;
>
> (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

19. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

> "… Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question".

20. In *Avnet Incorporated v Isoact Limited,* [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

> "In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase."

21. For the purposes of considering the issue of similarity of goods and 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 (see *Albingia SA v Axis Bank Limited,* BL O/253/18, a decision of the Appointed Person, Professor Phillip Johnson, at paragraph 42).

22. The goods to be compared are:

The opponent's goods	The applicant's goods
Class 09 Ophthalmic lenses; Optical lenses; Spectacle lenses.	**Class 09** Sun glasses; Cases for eyeglasses and sunglasses; Goggles; Fashion sunglasses; Cases for sunglasses; Sports eyewear; Sunglass cases; Goggles for use in sports; Goggles for sports.

23. The opponent, prior to the specification restriction, contended that the applicant's goods consist mainly of ophthalmic, optical and spectacle lenses which are identical to the earlier goods, as well as glasses and other glasses accessories which are highly similar to the earlier mark's goods since all the claimed glasses contain lenses for spectacles. Additionally, the opponent submitted that there is an undeniable complementarity between the respective goods given that all glasses contain lenses which are designed to improve a person's vision or protect their eyes from the sun or other hazards while practicing a sport and are usually manufactured by the same companies. Further, the opponent claimed that glasses accessories, namely chains and cases for all sorts of glasses and sunglasses, are similar to a high to medium degree as they are complementary to glasses. They go on to state that covers and chains are primarily sold together with glasses and lenses, share the same users and are manufactured by the same companies and distributed and sold in the same outlets, such as optician's or other specialist shops.

24. Following the opposition, the applicant restricted the specification and, as a result, denies that the applied for goods are similar to the opponent's goods and that they would not be in direct competition with one another. In their

counterstatement the applicant states that they have no intention of trading in direct competition with the opponent's goods. Whilst this is noted, it is important to state that the applicant's intention is not relevant, and I must consider a notional assessment of the terms as presented before me.

##. Before proceeding to consider the assessment of the goods at issue, I will state at the outset that ophthalmic lenses (being a term in the opponent's specification) are a type of prescription lens for glasses. Regardless of the applicant's term consisting of sunglasses or goggles, they can all be said to cover prescription versions of those goods too.

Sun glasses; Fashion sunglasses.

25. In general, the primary purpose of the contested goods is to be worn to protect the eyes from sunlight or glare. Whilst the goods share the same user, namely the general public, there is a difference in nature. The opponent's goods are all types of lenses which are typically made from plastic or glass and are primarily used to correct vision in a person with visual impairments. On the other hand, as stated above, the applicant's goods are complete goods made up of a frame, arms, and tinted lenses used to protect the consumer's eyes from sunlight or glare. Both sets of goods share the same trade channels, being sold through specialist eyewear retailers, as well as online. However, the applicant's goods may also be sold through fashion retailers and their respective websites. In my view, whilst there is no direct competition between the goods, I agree with the opponent's submission that the goods have a complementary relationship. I say this because in the context of prescription sunglasses being sought, the ophthalmic lens will be important to the same. This relationship is such that consumers will believe that the goods are from the same company.[2] Bearing all of the above in mind, I find that the goods are similar to a medium degree.

Goggles; Goggles for use in sports; Goggles for sports; Sports eyewear

[2] *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

26. In general, goggles are recognised as *'special glasses that fit close to the face to protect the eyes from chemicals, wind, water, etc'* [3]. I also consider that 'Goggles' at large includes sports goggles. Sports eyewear also helps to prevent injuries and allows players to continue to play their chosen sport even where they require corrective eyewear. Whilst the goods share the same user, namely the general public, there is a difference in nature. The opponent's goods are all types of lenses which are typically made from plastic or glass and are primarily used to correct vision in a person with visual impairments. On the other hand, as stated above, the applicant's goods are complete goods made up of close-fitting frames that usually enclose or protect the area surrounding the eye in order to prevent particulates, water or chemicals from harming the eyes. Additionally, sports goggles and eyewear prioritise safety and provide comprehensive eye protection during sporting activities. Both sets of goods share the same trade channels, being sold through specialist eyewear retailers, as well as online. However, the applicant's goods may also be sold through retailers specialising in protective eyewear, as well as via sporting goods retailers. In my view, whilst there is no direct competition between the goods, I agree with the opponent's submission that the goods have a complementary relationship. I say this on a similar basis to the reasons given in respect of complementarity in the preceding paragraph. Bearing all of the above in mind, I find that the goods are similar to a medium degree.

Cases for eyeglasses and sunglasses; Cases for sunglasses; Sunglass cases.

27. In general, the primary purpose of the contested goods is to store and/or protect eyeglasses and sunglasses. Whilst the goods share the same user, namely the general public, there is a clear difference in nature. Both sets of goods share some of the same trade channels, being sold through specialist eyewear retailers, as well as online. It is also considered common that when a user purchases prescription sunglasses (which contain ophthalmic lenses), they will be provided with a case. However, the applicant's goods may also be sold

[3] https://dictionary.cambridge.org/dictionary/english/goggles

through conventional retailers and their respective websites, as well as online e-commerce sites. In my view there is no direct competition between the goods, nor do they have a complementary relationship.[4] Bearing all of the above in mind, I find that the goods are similar to a low degree.

The average consumer and the nature of the purchasing act

28. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question (see *Lloyd Schuhfabrik Meyer,* Case C-342/97).

29. 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:

> "60. 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."

30. The applied for goods are ordinary consumer goods that will be selected by members of the general public at large. The goods will likely be sold through a range of retailers and their online equivalents. In physical retailers, the goods

[4] On this point, I appreciate that the case may be important to the prescription sunglasses themselves, however, the assessment here relates to the lenses. As such, the connection between the goods is not as obvious so as to suggest complementary.

at issue will be displayed on racks, where they will be viewed and self-selected by the consumer. A similar process will apply to online sales, where the consumer will select the goods having viewed an image displayed on a webpage. The selection of the goods at issue will, therefore, be primarily visual. That being said, I do not discount aural considerations in the form of advice sought from sales assistants or word of mouth recommendations. In my view the average consumer will pay a medium level of attention when purchasing the goods due to the importance of selecting the correct prescription, as well as choosing a style that they prefer.

Comparison of trade marks

31. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union ("CJEU") stated at paragraph 34 of its judgement 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".

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

33. The trade marks to be compared are as follows:

Earlier trade mark	Contested trade mark
IKARUS	**Icarus Eyewear**

34. The opponent submits that the marks at issue are visually, phonetically, and conceptually highly similar. They state that the only difference in the marks is the second letter of the first word, and the addition of the descriptive word 'Eyewear' in the applicant's mark, which has no distinctive character in respect of the goods concerned. Further, they argue that from a visual point of view, the signs coincide almost identically in their main word element Icarus/IKARUS which is placed at the beginning and consists of the most dominant and distinctive element. The opponent states that both of these elements consist of six letters and three syllables, and that they would both be pronounced identically given that the 'C' and the 'K' are pronounced identically when followed by the vowel 'A'. Additionally, the opponent submits that the marks are conceptually identical for those consumers who are familiar with Greek mythology, with Icarus being a well-known figure, who, to escape imprisonment, flies by means of artificial wings but falls into the sea and drowns when the wax of his wings melts as he flies too near the sun. They go on to state that for those consumers not familiar with Greek mythology they will consider the marks as an invented man's name.

35. The applicant simply submits that the two marks will not be confused because they are significantly different enough.

Overall Impression

36. The opponent's mark consists of the single word 'IKARUS'. There are no other elements in the mark to contribute to its overall impression, which lies in the word itself.

37. The applicant's mark consists of two words, namely, 'Icarus Eyewear'. There are no other elements in the mark to contribute to its overall impression, which lies in the words themselves. However, it is considered that the word "Eyewear" is entirely descriptive of the goods concerned and thus makes a lesser contribution.

Visual Comparison

38. The opponent's mark consists of the single, six-letter word 'IKARUS', whereas the applicant's mark consists of two words, the first being made up of six letters, and the second being the word 'Eyewear'. The first word in the applicant's mark contains five of the letters that are present in the opponent's mark however, the second letter is 'C' instead of 'K'. This, plus the additional word 'Eyewear' in the applicant's mark, creates a visual point of difference between the marks. Taking all of this into account and bearing in mind the overall impressions of the marks, I consider the marks to be visually similar to between a medium to high degree.

Aural Comparison

39. Aurally, the opponent's mark will be articulated as ICK-UH-RUS, as would the first word in the applicant's mark. I agree with the opponent that the first word will be pronounced the same regardless of whether the second letter is 'C' or 'K'. For some consumers, the descriptive nature of the word 'Eyewear' will mean that they will not articulate it. In this case, both marks are aurally identical. However, I also consider that some consumers may articulate the word 'Eyewear', which would result in the marks being aurally similar to a medium degree.

Conceptual Comparison

40. Conceptually, regardless of the spelling of the word, I consider that the opponent's mark would bring to mind the Greek mythological figure Icarus. In Greek mythology, Icarus is known as son of the inventor Daedalus, and who perished by flying too near the Sun with waxen wings. The applicant's mark would also bring to mind the same concept of the Greek mythological figure, given that the word is correctly spelt. The additional word element 'Eyewear' is a point of conceptual difference, although not a distinctive one as it directly describes the goods concerned. In my view, the marks are conceptually similar to a high degree.

Distinctive character of the opponent's mark

41. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

> "22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *WindsurfingChiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).
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> 23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and

industry or other trade and professional associations (see Windsurfing Chiemsee, paragraph 51)."

42. Registered trade marks possess 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 distinctive character of a mark can be enhanced by virtue of the use that has been made of it. The opponent has not claimed that its mark has acquired an enhanced degree of distinctiveness and did not request leave to file any evidence to that effect. As such, I have only the inherent position to consider.

43. The earlier mark consists of the plain word IKARUS without any additional stylisation or figurative elements. As such, the inherent distinctive character rests solely in the word itself. Whilst the mark consists of a word that is essentially made up (there is no dictionary definition for the word spelt with a letter 'K') it would still be seen as referring to the figure in Greek mythology which does possess a dictionary definition. While the opponent's mark is not descriptive or allusive to the goods upon which the opponent relies, I do not consider that the obvious reference to a Greek mythological figure is that remarkable from a trade mark perspective. That being said, I am of the view that the inherent distinctiveness of the mark lies at a slightly above medium degree.

Likelihood of confusion

44. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related.

45. 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 (see *Sabel*, C-251/95, para 22). 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 (see *Canon*, C-39/97, para 17). It is necessary for me to keep in mind the distinctive character of the earlier marks, the average consumer for the goods, and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

46. Whilst conducting a global assessment of the likelihood of confusion I must be aware of the fact that not all aspects of the respective marks will necessarily have the same impact. For example, the importance of the respective visual, aural and conceptual aspects will be dependent on factors such as the way the goods at issue are marketed, and in which type of store/platform they are made available.

47. Throughout the course of this decision, I have determined that:

- The respective goods range from being similar to between a low and medium degree, depending on the goods.

- The average consumers are members of the general public at large who will demonstrate a medium level of attention during the purchasing process.

- The purchasing process for the goods and services will be primarily visual in nature, though aural considerations have not been excluded.

- The opponent's mark possesses between a medium and high degree of inherent distinctive character.

- The marks at issue are visually similar to between a medium and high degree. The marks are aurally identical if the descriptive word ‘Eyewear’ is not articulated, or aurally similar to a medium degree if it is. The marks are conceptually similar to a high degree.

48. The applicant, in their counterstatement, stated that based on their own research, ‘the opponent’s trade mark is largely unknown in the UK and unknown in the sunglasses category’. I again note this submission however the assessment of likelihood of confusion is a notional assessment based on the factors before me and while enhanced distinctiveness is a consideration (which can stem from a mark being known to UK consumers), the lack of any enhanced distinctiveness is not necessarily fatal to an opposition brought under section 5(2)(b). In the present case, the inherent position as to the opponent's mark's distinctiveness is not low to the point of the shared use of ICARUS (regardless of spelling) would be viewed as coincidental.

49. The opponent’s mark consists exclusively of the word ‘IKARUS’, with no additional stylisation or figurative elements. The applicant’s mark contains the dominant distinctive element ‘Icarus’. As indicated in *Kurt Geiger v A-List Corporate Limited* BL O-075-13, the likelihood of confusion is increased if the distinctive character resides in the element of the marks that are identical or similar. Thus, considering the overall levels of visual and aural similarity between the competing marks, as well as the conceptual similarity being a reference to a Greek mythological figure, I am of the view that the differences created by the descriptive word ‘Eyewear’ as well as the minor visual difference of a different second letter (‘C’ instead of ‘K’) of an otherwise identical word are likely to be overlooked by average consumers, particularly given that the point of difference between ‘IKARUS’ and ‘ICARUS’ are subsumed into the body of those two words. Such differences are likely to be insufficient to distinguish the applicant’s goods from those of the opponent. Considering the principle of imperfect recollection, it is entirely foreseeable that the average consumer, even when demonstrating a medium level of attention during the purchasing process, will not recall the respective marks with sufficient accuracy in order to

differentiate between them. Consequently, I find that there is a likelihood of direct confusion. While the distinctive character of the opponent's mark is not outright high, it is at an above medium degree. Further, the fact that consumers will overlook the differences between 'IKARUS' (being the sole element of the opponent's mark) and 'Icarus' (being the dominant element of the applicant's mark), I consider that this finding applies even in circumstances where the marks are viewed on goods that are only similar to a low degree.

50. I turn now to consider a likelihood of indirect confusion. In respect of such, I remind myself of the case of *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, wherein Mr Iain Purvis Q.C., as the Appointed Person, explained that:

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

(a) 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)".

51. Indirect confusion does not require an assessment on the basis that all differences are noticed. In the present case, I am of the view that regardless of whether the average consumer is able to recall the additional word element of the applicant's mark,[5] there is at least a significant proportion of them who are still likely to overlook the difference between 'IKARUS' and 'Icarus'. As such, I am of the view that the differences that will be noticed are those that are likely to be considered logical indicators of sub-brand or brand extensions. For example, when considering the applicant's mark, the average consumer may consider it a brand extension of the opponent's mark on the basis that it is logical for a company producing spectacle lenses for to create an extension that focuses on producing eyewear. Consequently, I consider that there is a likelihood of indirect confusion. For the same reasons discussed when considering direct confusion above, I find that this applies even in circumstances where consumers view the marks on goods that are only similar to a low degree.

Conclusion

[5] To the point that it avoids direct confusion.

52. The opposition under Section 5(2)(b) of the Act has succeeded. Subject to any successful appeal, the application will be refused.

Costs

53. The opponent has been successful in its opposition and is entitled to a contribution towards its costs. The relevant Tribunal Practice Notice for these proceedings is TPN 1/2023, which states that costs in an opposition brought under the fast-track procedure are capped at £600 (excluding official fees). Accordingly, I award costs to the opponent on the following basis:

Preparing the notice of opposition and considering the counter statement	£250
Official Fee	£100
Total	£350

54. I therefore order **Skatewarehouse Limited** to pay **INDUSTRIAS DE OPTICA PRATS, S.L** the sum of £350. 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 13th day of September 2024

Oliver Rose'Meyer
For the Registrar