

O/0928/24

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003871963

IN THE NAME OF SCHMIDT SPIELE GMBH

FOR THE FOLLOWING TRADE MARK:



IN CLASSES 9, 16 AND 28

AND IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 440741

BY NINGBO BLACKDOG OUTDOOR PRODUCTS CO., LTD.

BACKGROUND AND PLEADINGS

1. On 27 January 2023, Schmidt Spiele GmbH (“the applicant”) applied to register the trade mark on the cover page of this decision in the UK, under number UK00003871963 (“the contested mark”). The application was published for opposition purposes on 17 February 2023. Registration is sought for the following goods:

Class 9: Game software; Mobile apps; Web application software; Computer application software with games; Downloadable game software; Downloadable game software for smartphones; Downloadable programs for electronic games; Downloadable information relating to games; Downloadable and recorded data.

Class 16: Printed matter, stationery and teaching and instructional material; printed books, magazines, newspapers and other media in paper form; booklets; books relating to games; information sheets relating to games; magazines relating to games; brochures relating to games; rule books for conducting games.

Class 28: Toys, games, playthings; playing cards; board games; card games; electronic games; chess games; puzzles; parlor games; electronic toys; playing dice, playing figures; dice games; dice cups.

2. On 10 May 2023, the application was opposed by Ningbo Blackdog Outdoor Products Co., Ltd. (“the opponent”) based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against all the goods in classes 9 and 28 listed above.

3. The opponent relies upon the following mark:

BLACKDOG

UK trade mark number: UK00003846941

Filing date: 8 November 2022

Registration date: 26 January 2024

("the opponent's mark")

The opponent's mark is registered for goods and services in classes 6, 9, 11, 12, 18, 20, 21, 22, 24, 25, 28 and 35, however, for the purposes of this opposition the opponent relies upon the following goods in classes 9 and 28 only:

Class 9: Computer peripheral devices; Pedometers; Scales; Measures; Flashing lights [luminous signals]; Signs, luminous; Speaking tubes; Cabinets for loudspeakers; Navigational instruments; Telescopes; Protection devices for personal use against accidents; Eyeglasses; Batteries, electric; Fire extinguishing apparatus; Diving suits; Bells [warning devices]; Padlocks, electronic; Accumulators, electric; Temperature indicators; Electronic notice boards.

Class 28: Games; Toys; Chess games; Playing cards; Rackets; Balls for games; Body-training apparatus; Archery implements; Machines for physical exercises; Swimming pools [play articles]; Knee guards [sports articles]; Elbow guards [sports articles]; Shin guards [sports articles]; Swimming belts; Snowshoes; Ornaments for Christmas trees; Fishing tackle; Leg guards for athletic use; Inflatable swimming floats; Swimming kickboards.

4. Given the respective filing dates, the opponent's mark is an earlier mark, in accordance with section 6 of the Act. As it had not been registered for five years or more at the filing date of the contested mark, it is not subject to the proof of use requirements specified within section 6A of the Act. Therefore, the opponent can rely on all of the goods identified.
5. The opponent argues that the competing trade marks are similar as they share the words "BLACK DOG", and that the competing goods are similar. It is these factors that the opponent contends give rise to a likelihood of confusion.

6. The applicant filed a counterstatement stating:

“We admit that the opposing signs are identical as far as the word component in both marks is concerned. We also admit that the goods in the respective classes 9 and 28 are at least similar, if not identical.

At the same time, we deny that the applicant has better rights in the sense of 5(2)(b) TMA.

Trade mark application UK00003846941 “Blackdog (fig.)” for classes 9 and 28 is under opposition itself and likely not to be registered in view of prior registered trademark UK00801189752 “Dog (fig.)”¹

I will address these claims in more detail below.

7. The opponent is professionally represented by IPEY. The applicant is professionally represented by Fortmann Tegethoff Intellectual Property Attorneys. Neither party filed admissible evidence, which I discuss below. Neither party asked to be heard and neither party filed written submissions in lieu. However, the applicant filed written submissions during the evidence rounds. This decision is taken following careful consideration of all the papers before me.

RELEVANCE OF EU LAW

8. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-assimilated national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are assimilated from EU Law and, therefore, this decision continues to refer to the trade mark case law of the EU courts.

¹ Form TM8, Q5.

PRELIMINARY ISSUE

9. As can be seen from the paragraphs of the applicant's counterstatement set out above at paragraph 6, at the time of the filing of this opposition, the opponent's mark was subject to an ongoing opposition brought by the applicant.² In those proceedings, the applicant relied upon its comparable UK trade mark number UK00801189752, which was subject to the proof of use requirements.
10. In those proceedings, on the 24 August 2023, the Tribunal wrote to the parties informing them that the opposition was to be consolidated with the present opposition and that the parties each had until 24 October 2023 to file their evidence in chief. On the day of the deadline, the applicant submitted written submissions, an affidavit, and supporting evidence.
11. On 31 October 2023, the Tribunal wrote to the applicant's representatives. The relevant sections of the letter are replicated below:

"I acknowledge receipt of your evidence and submissions received on 24 October 2023. The evidence comprises:

Affidavit

Axel Kaldenhoven

Written submissions dated 24 October 2023.

However, I must advise you that the Registry is unable to accept your evidence and submissions.

Written Submissions

Please amend the written submissions where you erroneously refer to Section 5(2)(a) opposition grounds at paragraph 8 and 28.

² Under opposition number 440530.

Exhibits

The Registry notes that you have filed excerpts to show genuine use which you refer to at paragraph 7 of the written submissions.

If you wish the Registrar to consider this evidence, please file it in the appropriate format i.e. included in or as an exhibit to a witness statement, statutory declaration or affidavit, which should be headed to refer to the case details for these proceedings and the Trade Marks Act 1994. Within the body of the Witness Statement/Statutory Declaration/Affidavit, reference should be made to any evidence you have filed, known as exhibits.

Each exhibit must be accompanied by a header sheet as its top document, and must refer to the case details for these proceedings. For example, the header sheets should include the trade mark application number and the opposition number for your case. Each exhibit header sheet should also be identified e.g. This is exhibit JS1 as referred to in the Witness Statement of John Smith.

Your attention is drawn to the Registry's Tribunal Practice Notice (TPN 5/2008) regarding page numbering of evidence in inter partes proceedings in trademarks and designs cases. This means that if one of the exhibits is over four pages, the exhibits should be page numbered.

Should you wish to file this evidence, you will also be required to file a retrospective extension of time, to enable the Registry to grant you extra time in which to put the evidence in order. An extension of time is filed on a Form TM9R and requires a £100.00 fee. The Form TM9R requires that you state how much time you think you will need to collate and submit your evidence, and also to provide reasons for why the extension of time is needed.

[...]

Affidavit

The affidavit you have filed is not in the correct format. Instructions as to the correct form of an affidavit can be found in Part 32 Practice Direction 32 paragraph 2 et seq of the Civil Procedure Rules, which can be found on the website of the Ministry of Justice at

https://www.justice.gov.uk/courts/procedure-rules/civil/rules/part32/pd_part32

*Please file your amended evidence on, or before, **14 November 2023**, ensuring a copy is also sent to the other party.” (Original emphasis)*

12. On 7 November 2023, the applicant’s representatives filed a retrospective extension of time request via a Form TM9R which stated the following:

“We filed our evidence and submissions by the due date and now need more time to confer with our client to bring the evidence and submissions into conformity with the objections as raised in the UKIPO’s official letter dated 31 October 2023.”

13. The Tribunal considered the request and wrote to the parties on 8 November 2023. The Tribunal explained:

“The TM9R filed on 7 November 2023 requested an extension of time to file amended evidence of two months.

*The Registry’s preliminary view is that the extension of time request should only be granted until **30 November 2023**, i.e. one month from the office letter dated 31 October 2023.*

In making this view the Registry has taken into consideration the reasons provided in support of the request. However, in this instance, the Registry is not satisfied that the reasons and information provided enable the Registrar to exercise its discretion and allow the full two months extension of time that has been requested.

The Registry would expect the parties to adhere to the following timetable below:

Filing of Party A (Schmidt Spiele GmbH)'s evidence/submissions: 30 November 2023.

[...]

*If either party disagrees with the preliminary view they should request a hearing within 14 days from the date of this letter, that is on or before **22 November 2023.***

If no response is received within the time allowed, the preliminary view will automatically be confirmed.” (Original emphasis)

14. The applicant did not file amended evidence to satisfy the admissibility requirements, nor was any objection raised to the Tribunal's decision to grant a reduced extension of time until 30 November 2023. As a result, the Tribunal wrote to the parties on 7 December 2023 in relation to the opposition against the opponent's mark stating:

“The official letter dated 8 November 2023 granted a retrospective extension of time to file your amended evidence and submissions in support of your opposition by 30 November 2023.

As you have neither filed the amended evidence or requested further additional time within which to file it, your opposition based upon section 5(2)(b) of the Trade Marks Act will shortly be deemed withdrawn in accordance with 20(3)(b) of the Trade Marks Rules 2008.

*If either party disagrees with the preliminary view, they should request a hearing within 14 days from the date of this letter that is on, or before, **21 December 2023.***

If no response is received within the time allowed, the preliminary view will automatically be confirmed, and your opposition based upon section 5(2)(b) of the Trade Marks Act will be deemed withdrawn.” (Original emphasis)

15. Again, no objection was raised. On 16 January 2024, the Tribunal wrote to the parties confirming that, because no response had been received within the time allowed, the opposition against the opponent’s mark was deemed withdrawn.

16. For clarity, this was because the applicant’s comparable mark was subject to the proof of use requirements; the applicant’s failure to provide admissible evidence automatically resulted in the 5(2)(b) ground being struck out. As this was the only ground relied upon, the opposition was withdrawn.

17. As the opposition against the opponent’s mark has been withdrawn, the only matter that I have to decide is the opponent’s 5(2)(b) ground against the contested mark. Any submissions regarding the applicant’s (withdrawn) opposition will not be considered for the purposes of this decision.

DECISION

Legislation

18. Sections 5(2)(b) and 5A of the Act read 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”.

“5A 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.”

Case law

19. I am guided by the following principles which are gleaned from the decisions of the Court of Justice of the European Union (“CJEU”) in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

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

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

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

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by

the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

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

(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

20. I note that, as set out in paragraph 6 above, the applicant accepts within its counterstatement that the goods are at least similar, if not identical. As such, I will proceed on the basis that there is at least some level of similarity between the competing goods.

The average consumer and the nature of the purchasing act

21. As indicated in the caselaw cited above, it is necessary to decide who the average consumer is for the parties' goods and how they purchase them. "Average consumer" in the context of trade mark law means the "typical consumer."³ 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 in question.⁴

22. Due to the nature of the goods at issue, I find that the average consumer would be a member of the general public.

23. The cost of purchase is likely to range from relatively low for goods such as mobile apps, to increasingly expensive for telescopes and certain computer devices, however, overall, it is likely to be moderate. The frequency with which the goods are purchased will also vary depending on the type of goods at issue. For example, mobile apps or certain toys are likely to be purchased more frequently than telescopes or computer devices which are likely to be more occasional purchases. Whilst some goods may be more considered, occasional purchases, even for goods which are less expensive, or more frequently purchased, consumers will still consider various factors, such as aesthetics, durability, safety and suitability for

³ *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).

⁴ *Lloyd Schuhfabrik Meyer*, Case C-342/97.

particular age groups. Consequently, I consider that, overall, a medium degree of attention will be paid during the purchasing process.

24. Depending on the type of goods, they are likely to be obtained by self-selection from the shelves of either specialist retail stores (such as, for example, tech, or games stores), general retail outlets, or their online equivalents. Alternatively, the goods may be purchased following perusal of advertisements or inspection of a catalogue. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount that there may also be an aural component to the purchase through advice sought from sales assistants or word of-mouth recommendations.

Distinctive character of the opponent's mark

25. The distinctive character of a trade mark can be measured only, first, by reference to the goods in respect of which registration is sought and, second, by reference to the way it is perceived by the relevant public. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section

of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

26. 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. Dictionary words which do not allude to the goods will be somewhere in between. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion: the more distinctive the earlier mark, the greater the likelihood of confusion.
27. Further, although the distinctiveness of a mark can be enhanced by virtue of the use that has been made of it, the opponent has not filed any evidence of use (nor was it required to do so). Consequently, I have only the inherent position to consider.
28. The opponent’s mark is a figurative mark that consists of the word “BLACKDOG” in bold, upper-case font with a stylised letter “A”. The mark is presented in the colour black. It is my view that “BLACKDOG” will be instantly understood as comprising the two ordinary dictionary words “BLACK” and “DOG”.⁵ The mark is not obviously descriptive or allusive of the goods relied on under the opponent’s mark. In my view, the stylisation is not particularly striking; whilst I acknowledge that it does contribute to the overall distinctiveness of the mark, it does not have the effect of materially elevating it above that which is produced by the verbal element. Consequently, I find that the opponent’s earlier mark possesses a medium degree of inherent distinctive character.

⁵ *Usinor SA v OHIM*, Case T-189/05, consumers tend to naturally break down trade marks into elements which they can identify and understand.


Comparison of the marks

29. It is clear from *Sabel BV v. Puma AG*,⁶ 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 them, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo SA v OHIM*, Case C-591/12P, that:

“34. [...] 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.”

30. It would therefore be wrong to artificially dissect the trade marks, although it is necessary 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 they create.

31. The respective trade marks are shown below:

Applicant's mark	Opponent's mark
	

Overall impressions

32. The competing marks are both figurative marks.

⁶ Case C-251/95, paragraph 23

33. The opponent's earlier mark is described above at paragraph 28. The overall impression of the mark is dominated by the word "BLACKDOG" with the stylisation providing a much lesser contribution.

34. As for the contested mark, it includes the words "BLACK" and "DOG" separated by a device of a dog. Both words are in bold uppercase letters, with the word "BLACK" in black and the word "DOG" in red. Each word is outlined in the corresponding colour. The gaps in the letters "A" and "O" are shaped like a paw print. In my view, although the eye is naturally drawn to elements of marks that can be read, the overall impression is dominated by the words and the dog device in roughly equal measure. This is because of the size and positioning of the device. The stylisation and colour provide a smaller contribution.

Visual comparison

35. The competing marks are similar to the extent that both contain the words "BLACK" and "DOG" albeit the words are conjoined in the opponent's mark. However, the words appear in different fonts (although both are in bold uppercase letters), and the word "DOG" in the contested mark appears in a different colour. The respective marks also differ in the presence of the dog device which is absent from the opponent's mark. Taking into account the overall impressions, I find that the competing marks are visually similar to a medium degree.

Aural comparison

36. Given that consumers will not attempt to articulate device elements or stylisation, it follows that both the competing mark and the opponent's mark comprise two identical syllables, i.e. "BLACK-DOG". Consequently, I find that the competing marks are aurally identical.

Conceptual comparison

37. The words "BLACK" and "DOG" will be understood by the average consumer within both marks in accordance with their ordinary meanings; in combination,

referring to a dog that is black. The dog device element in the applicant's mark reinforces this message as do the paw prints within the letters "A" and "O". Consequently, the goods are conceptually identical.

Likelihood of confusion

35. 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 down to the responsible undertaking being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's mark, the average consumer for the goods and the nature of the purchasing act. In doing so, I must be alive to the fact that the average consumer rarely has an 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.

36. I have proceeded on the basis of the applicant's concession that there is at least some level of similarity between the competing goods. I have found that the average consumer of the goods will be the general public who will pay a medium level of attention. I have found that the purchasing process will be predominantly visual, however, I have not discounted aural considerations. The competing marks are visually similar to a medium degree, and aurally and conceptually identical. The opponent's mark is inherently distinctive to a medium level.

37. The marks coincide in the shared words "BLACK" and "DOG" albeit these are conjoined within the opponent's mark. The marks differ in the stylisation, colours used, and the device of a dog present in the middle of the words within the

contested mark, all of which create a noticeable visual difference. In my view, the visual differences are not overcome by the aural and conceptual identity. In my judgement, consumers paying a medium level of attention during the purchasing process would not mistake or misremember the marks for one another due to the clear visual differences. This is so even taking into account imperfect recollection and the interdependency principle. Consequently, I do not find that there is a likelihood of direct confusion, even where the parties' goods are identical.

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

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

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

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

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

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

39. These three categories are not exhaustive; rather, they were intended to be illustrative of the general approach, as has been confirmed by the Court of Appeal.⁷ I recognise that a finding of indirect confusion should not be made merely because the competing marks share a common element. In this connection, it is not sufficient that a mark merely calls to mind another mark: this is mere association not indirect confusion.⁸

40. Furthermore, in *Liverpool Gin*,⁹ Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

41. Although consumers will recognise the differences between the competing marks, they will also identify the identical shared word(s) “BLACK DOG”/“BLACKDOG”. Whether consciously or unconsciously, this will lead the average consumer through the mental process described in *L.A. Sugar*. With this in mind, it is my view that the difference in colour, stylisation and the dog device will be perceived as a plausible brand extension or brand variant. For example, the opponent’s mark being viewed as a more basic variation with minimal stylisation, and the applicant’s mark perceived as a more eye-catching variation with additional figurative decoration in

⁷ *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207

⁸ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

⁹ *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207

the dog device and the stylisation, both of which are logical variant use. As such, I am satisfied that consumers will not conclude that the use of the identical words “BLACK” and “DOG” are merely coincidental, but instead believe that the competing marks originate from the same or economically linked undertakings due to a shared distinctive and dominant element that is aurally and conceptually identical. Consequently, I consider there to be a likelihood of indirect confusion. This finding remains the same regardless of the level of similarity between the goods as I consider any level of similarity is enough to lead to a likelihood of indirect confusion.

Conclusion

38. The partial opposition under section 5(2)(b) of the Act has been successful. Therefore, subject to any successful appeal against my decision, the application will be refused registration for the applied-for goods in classes 9 and 28. The application will proceed to registration for the applied-for goods in class 16 which were not opposed.

Costs

39. As the opponent has been successful, it is entitled to a contribution towards its costs. The relevant scale is that published in Tribunal Practice Notice 1 of 2023.¹⁰ In the circumstances, I award the opponent the sum of **£350**, which is calculated as follows:

Official fee:	£100
Preparing the notice of opposition and considering the applicant's counterstatement:	£250

¹⁰ As the opposition was brought after 1 February 2023.

Total:

£350¹¹

40. Accordingly, I hereby order Schmidt Spiele GmbH to pay Ningbo Blackdog Outdoor Products Co., Ltd. the sum of **£350**. This sum is to be paid within twenty-one days of the expiry of the appeal period, or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 24th day of September 2024

Sarah Wallace

For the Registrar

¹¹ No award has been made for consideration of the applicant's submissions (that were filed during the evidence rounds), this is because the opponent did not engage in proceedings after they were filed and chose not to file a response to them, or file written submissions of its own in lieu of a hearing.