O/0945/25

TRADE MARKS ACT 1994

IN THE MATTER OF
TRADE MARK APPLICATION NO. 3961124
IN THE NAME OF KODAMA SHOTEN CO., LTD.
TO REGISTER AS A TRADE MARK

Toto&Pal

IN CLASS 18

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 446392
BY ESSENTIAL EXPORT, LIMITADA

BACKGROUND AND PLEADINGS

1. On 26 September 2023, KODAMA SHOTEN CO., LTD. ("the applicant") applied to register the trade mark "Toto&Pal" in the United Kingdom. The application was accepted and published for opposition purposes on 15 December 2023, in respect of goods in class 18, as listed in the table under paragraph 18 of this decision.

2. The application is opposed by Essential Export, Limitada ("the opponent"). The opposition was filed on 15 March 2024 and is based upon section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opposition is directed against all of the goods in the application. The opponent relies upon the following series of two marks:

UK trade mark registration number 3694923
Filing date: 15 September 2021
Priority date: 10 September 2021[1]
Registration date: 17 December 2021
Registered in Classes 6, 9, 14, 16, 18, 20, 21, 25 and 35
Relying on some goods only in class 18, as listed in the table under paragraph 18 of this decision.

3. The above series of marks qualifies as an earlier mark under section 6(1) of the Act. As it had not completed its registration procedure more than five years before the application date for the contested mark, it is not subject to the use provisions contained in section 6A of the Act.

[1] Priority claimed from European Union Intellectual Property Office Trade Mark (EUTM) number 018555967.

4. The opponent submits that its earlier mark is visually, phonetically and conceptually similar to the contested mark and that the opposed goods are identical, similar and or complementary to those protected by class 18 of the opponent's earlier mark. As such, it submits that there exists a likelihood of confusion, which includes a likelihood of association, between the marks before the relevant consumers. The opponent submits that the application should be refused under section 5(2)(b) of the Act, and it requests an award of costs be made in the opponent's favour.

5. The applicant filed a counterstatement denying each of the claims. It requests that the contested mark be allowed to proceed to registration for all of the goods for which protection is sought, and it requests an award of costs in the applicant's favour.

6. Both parties elected to file evidence; only the opponent filed written submissions during the evidence rounds. Neither party requested a hearing; only the applicant filed written submissions in lieu of a hearing. This decision is taken following careful consideration of the papers on file.

7. In these proceedings, the opponent is represented by Keltie LLP and the applicant is represented by Reddie & Grose LLP.

EVIDENCE AND SUBMISSIONS

The Opponent's evidence

8. The opponent filed evidence in support of the opposition in the form of the witness statement of Manuela Macchi, dated 22 July 2024. Ms Macchi is a Chartered Trade Mark Attorney of the representative to the opponent. The witness statement is accompanied by two exhibits, labelled Exhibit MM1 and Exhibit MM2.

9. The opponent filed written submissions dated 23 July 2024, as well as filing further written submissions on 21 November 2024, in reply to the applicant's evidence.

The Applicant's evidence

10.The applicant filed evidence in support of the defence in the form of the witness statement of Georgina Rose Tanner, dated 23 September 2024. Ms Tanner is a trainee Trade Mark Attorney of the representative to the applicant. The witness statement is accompanied by four exhibits, labelled Exhibit GRT01 to Exhibit GRT04.

11. The applicant filed written submissions in lieu of a hearing, dated 21 January 2025.

12. I have taken the evidence and submissions of both parties into account in reaching my decision and I will refer to them in the decision to the extent I consider necessary.

DECISION

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.

Section 5(2)(b)

14. Section 5(2)(b) is relied on and reads as follows:

> "5(2) A trade mark shall not be registered if because -
>
> (a) …
>
> (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark".

15. Section 5A states:

> "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."

16. I am guided by the following principles which 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 Office for Harmonisation in the Internal Market (Trade Marks and Designs) ("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 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 to mind the earlier mark, 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

17. Pursuant to section 60A of the Act, the goods are not to be automatically regarded as being similar to each other on the ground that they appear in the same class.

18. The goods to be compared are:

Opponent's goods	**Applicant's goods**
Class 18 *Leather trimmings for furniture; animal skins; bag frames; handbag frames and frames for handbags; harnesses; harness trimmings; leather shoulder straps; travel trunks; luggage trunks; wallets; camp bags; empty leather tool bags; mountaineering bags; beach bags; shopping net bags; shopping wheel bags; travel bags; bags, shopping bags; hand bags; tote bags; travel bags; school bags; school satchels; leather girths; leather lanyards; harness straps; leather straps; artificial leather; leather bandoliers; leather goods; leather goods; travel cases; Suitcases other than for wiping; suitcases; briefcases; document cases; backpacks; school backpacks; leather baby backpacks; imitation leather backpacks; coin purses; mesh purses; lunch bags; hunting backpacks; wheeled backpacks; school backpacks; school briefcases; school briefcases, suit cases; leather furniture coverings; leather hat cases; suitcases, handbags, leather valves, leather goods, tulas; pet collars; pet leashes, pet walking leashes; Pet harnesses, specialized*	Class 18 *Leather; imitation of leather; leather straps; animal skins and hides; fake fur; fur; clothing for domestic pets; pet jackets; pet jumper; coats for pets; clothing for dogs; dog shoes; pet boots or footwear; collars for animals; leather collars; capes for pets; dog bellybands; pet accessories including leads; pet leads; pet leashes; leather leads; leather leashes; harnesses for animals; hats for pets; raincoats for pet dogs; bags for carrying pets; bags; handbags; sport bags; briefcases; shopping bags; travel bags; boston bags; backpacks; wallets; pouches; tote bags; shoulder bags.*

leashes; muzzles; pet backpacks; pet carriers; pet carriers; pet carrier bags; pet clothing, pet coats, pet vests, pet jackets; pet scarves; pet paw pads.	

19. Where the goods in the specification of one party are included in a broader term from the other party's specification, those goods are considered to be identical: See *Gérard Meric v OHIM,* Case T-133/05 at [29].

20. In the counterstatement, the applicant denied that all of the class 18 goods relied upon under the earlier mark were identical, similar or complementary to the contested goods of the application.[2] However, in its written submissions in lieu of a hearing, the applicant acknowledges that "there exists some levels of identity and similarity between most of the goods covered by the Application and the Earlier Registered Mark".[3]

21. Some of the contested goods are self-evidently identical to those of the opponent, or are encompassed within the broader term, rendering them identical as per the principle outlined in *Meric*. For example, the term "*handbags"* are identically included in the class 18 specification of both parties, while the applicant's "*clothing for dogs"* is encompassed by the opponent's broad term *"pet clothing"*.

22. Given the aforementioned admissions of the applicant, I do not intend to undertake a full comparison of the competing goods at this stage of the decision, but I will instead proceed on the basis that at least some of the contested goods are identical to those covered by the earlier series of marks. If the opposition fails even where the goods are identical, it follows that the opposition will also fail where goods are only similar. However, if a likelihood of confusion is found, I will proceed to assess the goods at issue in full.

[2] At point 7.
[3] At point 15.

The average consumer and the nature of the purchasing act

23. The average consumer is a legal construct, deemed to be reasonably well informed and reasonably circumspect: see *Hearst Holdings Inc & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), paragraph 60. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97, at [26].

24. The opponent submits that the average consumer's degree of attention in purchasing the goods in question will, for the most part, be no greater than average.[4] In its written submissions in lieu of a hearing, the applicant submits that the average consumer of the goods, and specifically those in relation to pet products, will be the general public who will pay an elevated degree of attention. It further submits that the average consumer is likely to purchase and examine the goods in person, rather than online, and would therefore pay a high degree of attention to the visual elements of the mark during the purchasing process.

25. I agree that the average consumer for the competing goods will most likely be the general public. I acknowledge the applicant's submissions that pet clothing is likely to be purchased in person, however, in my view they will be purchased from physical stores, from catalogues, and via the internet, where in each instance they will be viewed and self-selected by the consumer. I therefore consider the selection of the goods will be by predominantly visual means, although I do not discount aural considerations, such as word-of-mouth recommendations.

26. During the selection of the goods, factors such as the size/fit of the goods (in relation to pet clothing), functionality (particularly in respect of the various types of bags at issue), and the quality and material from which the goods are made, will all play a part, as will the "look" of the goods, the cost, and their suitability for the consumer or end-user's specific needs. Overall, I consider that a medium level of attention will be paid during the purchase of the goods at hand.

[4] See the opponent's written submissions dated 23 July 2024.

Comparison of marks

27. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The 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."

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

29. The respective trade marks are shown below:

Opponent's trade marks	**Applicant's trade mark**
<u>Series of 2</u>   	**Toto&Pal**

30. The opponent submits that the contested mark contains the word "TOTO" which is incorporated in its entirety in the earlier mark "TOTTO". It continues that the omission of the second "T" is a negligible difference in view of the stylisation of the double "T" in the earlier mark, such that the two letters seem to merge into one. Further, that whilst the contested mark contains the additional words "& PAL", it is the "TOTO" element which will catch the consumers eye, and is the dominant and distinctive element of the applicant's mark.[5] The applicant submits that the contested mark is the word mark "Toto&Pal", and that neither the words "Toto" nor "Pal" would be recognised as descriptive in relation to the applied-for goods. It therefore submits that both words are equally dominant and descriptive.[6] The applicant further submits that the figurative nature of the earlier mark is such that the two "T" letters are joined together evoking the image of two human figures embracing, which is enhanced by the two circular elements placed above the letters which creates the appearance of two human heads.[7]

Overall impression

31. The opponent's mark has been registered as a series of two marks, pursuant to section 41(2) of the Act. They each comprise identical elements, being the word "TOTTO" presented in stylised capital letters which are double-outlined in black.[8] The double "T" elements overlap and a small circle is situated directly above each letter "T". The only difference between the marks in the series is that the circles above the "T" elements are presented in the colours red and yellow in the first mark of the series, whilst in the second mark of the series, there is no use of colour. For convenience, I will from this point refer to the series in the singular, though my comments should be taken as referring equally to both marks in the series, unless expressed otherwise.

[5] See the opponent's written submissions dated 23 July 2024.
[6] See the applicant's written submissions in lieu of a hearing, at [18].
[7] Ibid, at [21].
[8] I note that on filing the original trade mark application, where the opponent was asked to input the word elements of the mark, it was recorded as "TOTTO" on the Form TM3. I note that the opponent has referred to its mark as "TOTTO" throughout the submissions and evidence provided in support of the opposition. I further note that the applicant also submits that the consumer would recognise the earlier mark as "TOTTO" in its figurative style.

32. Following on from the above description of the opponent's mark, due to the presentation of the overlapping letters "T" and the small circles directly above them, I consider that at first glance, a not insignificant proportion of the average consumer will perceive the mark as "TOTIO", while an equally significant proportion would see the mark as representing the word "TOTTO". I also accept that there will be some consumers who, as suggested by the applicant and described above in paragraph 30, will perceive the stylisation of the conjoined letters "T" as representing two human figures. To my mind, the overall impression conveyed by the mark rests in both the stylisation and the combination of the letters within the mark as presented.

33. The applicant's mark consists of the conjoined characters "Toto&Pal" presented in a standard black typeface. In my view, there is a natural break between the word element "Toto", the ampersand ("&"), and the word element "Pal", which would lead the average consumer to read it as three separate words, "Toto and Pal". In *Usinor SA v OHIM*, Case T-189/05, the General Court ("GC") found that:

> "62. … it must be noted that while the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (Lloyd Schuhfabrik Meyer, paragraph 25), he will nevertheless, perceiving a verbal sign, break it down into verbal elements which, for him, suggest a concrete meaning or which resemble words known to him (Case T-356/02 Vitakraft-Werke Wührmann v OHIM – Krafft (VITAKRAFT) [2004] ECR II-3445, paragraph 51, and Case T-256/04 Mundipharma v OHIM – Altana Pharma (RESPICUR) [2007] ECR II-0000, paragraph 57)."

I do not consider that any of the individual elements dominate, and as the mark contains no other elements, the overall impression therefore rests in the combined (conjoined) elements which make up the whole.

Visual and Aural comparison

34. In *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, the General Court ("GC") noted that the beginning of words tend to have more visual and aural impact than the ends, however, I accept that this is not always the case.

35. Visually, the opponent's mark contains five letters, presented as described above, while the applicant's mark contains eight characters. They have in common the first three letters, TOT, placed in the same position within each mark. However, the endings of the respective marks differ, and along with the additional "&Pal" elements present only in the applicant's mark, and the stylisation of the opponent's mark, this serves to create a visual disparity between them. For the avoidance of doubt, I do not consider the difference in capitalisation/title case to be relevant to the visual impact, as the registration of a word mark gives protection irrespective of capitalisation: see *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17. Whilst taking into account the position of the identical letters "TOT", overall, I consider the marks to be visually similar to a low degree. I find this even where the consumer does not see the stylisation of the opponent's mark as evoking the human element referred to above.

36. While I note the opponent's submissions on the pronunciation of the marks,[9] to my mind, the opponent's mark will be pronounced as either two syllables "TOT-OH" or as three syllables "TOT-EE-OH", dependent on whether the consumer perceives the fourth letter as the letter "T" or the letter "I". The applicant's mark will most likely be articulated as four syllables, "TOE-TOE-AND-PAL". Overall, in whichever way the opponent's mark is pronounced, I consider the opposing marks to be aurally similar to a low degree.

Conceptual comparison

37. For a conceptual message to be relevant, it must be capable of immediate grasp by the average consumer - Case C-361/04 P *Ruiz-Picasso and others v OHIM* [2006].[10]

38. The parties agree that the words TOTTO" and "TOTO" have no dictionary or discernible meaning to English speakers in the UK and therefore there is no conceptual meaning conveyed by the marks to that effect. I note that in its written

[9] See the written submissions dated 23 July 2024.
[10] Paragraph 56.

submissions in lieu of a hearing,[11] the applicant disagrees with the opponent's submissions that given that some of the contested goods relate to pets, which are often referred to as "man's best friend", the words "& PAL" are non-distinctive.[12]

39. I agree that the words "TOTTO" or "TOTIO" are likely to be perceived as conceptually neutral, invented words with no allusive qualities. However, whilst to the best of my knowledge the word "TOTO" in the applicant's mark is also an invented word, I do not consider that it would be taken in isolation and would not be seen as playing an independent, distinctive role within the mark as a whole.[13] In my view, the applicant's mark "Toto&Pal" would be considered as a unit, with the word "Pal" referring to the friend of someone or something named Toto. I therefore consider that a significant proportion of the average consumer would perceive the mark as a whole as referring to a pair of fictional friends, be that in human or animal form, one of whom is called Toto. Given that the opponent's mark holds no clearly recognisable semantic content, the marks are conceptually dissimilar. That being said, to those consumers who agree with the applicant's submissions on the figurative nature of the earlier mark as being evocative of two human figures embracing, I consider the marks as a whole to be conceptually similar to a low degree.

Distinctive character of the earlier marks

40. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. The factors 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-342/97:

> "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

[11] At [31].
[12] See the written submissions dated 21 November 2024.
[13] See *Whyte and Mackay Ltd v Origin Wine UK Ltd*, where Arnold J. (as he was then) considered the impact of the CJEU's judgment in *Bimbo,* Case C-591/12P, on the court's earlier judgment in *Medion v Thomson.*

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)."

41. Registered trade marks possess varying degrees of inherent distinctive character, being lower where they are allusive or suggestive of a characteristic of the goods and services, ranging up to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it. The opponent has not expressly claimed that its mark has enhanced distinctiveness, however (some) evidence of use has been filed. While I note the applicant's submissions that the opponent "has unnecessarily submitted evidence of use", and that "the Examiner must only consider how the Opponent's mark appears on the register and its inherent distinctiveness"[14], this is not strictly the case. In *China Construction Bank Corp. v EUIPO*, Case T-665/17[15], the GC held that evidence showing that part of the earlier mark has acquired an enhanced degree of distinctive character through use may be relevant to the assessment of the distinctiveness of that element within the earlier mark. Such enhanced distinctiveness may affect the likelihood of confusion between that mark (as a whole) and a later mark including the same, or a similar, element. As the case for enhanced distinctiveness does not need to be expressly pleaded, I may assess the evidence provided in relation to whether the mark enjoys enhanced distinctiveness in the UK market.

42. I will begin by assessing the level of inherent distinctive character of the earlier mark. Earlier in my decision, I found that the opponent's mark would be perceived as an invented word by a significant proportion of the relevant consumer. Even where the stylisation gives rise to the perception of two figures embracing, I do not consider

[14] At point 41 of the written submissions in lieu of a hearing.
[15] At [52].

the mark to be allusive of the goods at issue. Consequently, I find the earlier mark to be inherently distinctive to a high degree.

43. Turning to the assessment of enhanced distinctiveness of the earlier mark, given that I have already found the mark to be inherently distinctive to a high degree, it is unlikely that any finding of enhanced distinctiveness would greatly improve the opponent's already strong position on this front. I do not therefore intend to consider the evidence further.

Likelihood of confusion

44. There is no simple formula for determining whether there is a likelihood of confusion. It is clear that I must make a global assessment of the competing factors (*Sabel* at [22]), keeping in mind the interdependency between them i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa (*Canon* at [17]). I must consider the various factors from the perspective of the average consumer, bearing in mind 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 he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

45. There are two types of possible confusion: direct, where the average consumer mistakes one mark for the other, or indirect, where the average consumer recognises that the marks are different, but assumes that the goods and/or services are the responsibility of the same or connected undertakings. The distinction between these was explained by Mr Iain Purvis Q.C. (as he then was), sitting as the Appointed Person, in *L.A. Sugar Limited v Back Beat Inc*, Case BL-O/375/10. He said:

> "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).”

46. The above are examples only which are intended to be illustrative of the general approach. These examples are not exhaustive but provide helpful focus.

47. Earlier in this decision, I indicated that as the applicant had admitted to at least some degree of similarity between most of the contested goods and those goods relied upon by the opponent, that I would proceed on the basis that the goods at issue were similar (to some degree), and that as such, a full comparison of the competing goods would not be made. I found that the general public as the average consumer would pay a medium level of attention to the selection of the goods. I considered that the

selection of the goods would be by predominantly visual means, although I did not discount aural considerations.

48. I found there to be a low degree of visual and aural similarity between the marks. I considered the marks to be conceptually dissimilar where the opponent's mark was seen purely as an invented word, and conceptually similar to a low degree where the opponent's mark was seen as including a representation of two people embracing. I considered the earlier mark to be inherently distinctive to a high degree.

49. The applicant's exhibits GRT01 and GRT02 comprise copies of two earlier decisions of the UKIPO, being case numbers BL O/0610/23 and O/293/21 respectively. In both cases, the opponent is the same as the opponent in the case before me, with the earlier series of two marks relied upon being the same in BL O/610/23 as in these proceedings.[16] I note that neither the applicant nor the contested marks concerned in either of these earlier decisions are the same as those in the case before me. Neither are the contested goods on all fours with the contested goods of these proceedings. In its written submissions in lieu of a hearing, the applicant submits that in the decision of case O/0610/23, neither direct nor indirect confusion was found when comparing the earlier marks in the series with the mark "Toto the Pom", despite the presence of identical goods. It submits that the line of reasoning in that decision will extend to the additional "&Pal" of the application at hand as it did to the additional "the Pom".[17] In the written submissions dated 21 November 2024, the opponent submits that given the differing facts and circumstances, the earlier decisions should be disregarded, and it reminds me that I am not bound by the previous findings of this Tribunal. I concur that each decision before the Hearing Officer turns on the relevant factors specific to the individual case to be heard, and that each case is to be decided on its own merits. In reaching my decision, I will undertake a multi-factorial assessment of the various considerations in play. That being said, I consider the applicant's submissions on the analogous nature of the earlier O/0610/23 case compared with the case before me to be not without some merit.

[16] The earlier mark relied upon by the opponent in BL O/293/21 is for the stylised word "TOTTO", however, the presentation is distinct from the series of two marks relied upon in these proceedings.
[17] At point 45.

50. I have made a multi-factorial assessment of the various considerations in play. While allowing that the average consumer is unlikely to see the marks side-by-side and will therefore be reliant on the imperfect picture of them they have kept in their mind, I consider it unlikely that they would mistake one mark for the other. In my view, the average consumer will notice and recall the visual, aural and conceptual differences between the marks. I do not consider there is any likelihood of direct confusion as the differences between the marks are too great for confusion to arise, particularly in light of the conceptual message conveyed by the applicant's mark which will prompt the consumer to accurately recall it. I consider this to be the case even where consumers perceive the stylisation of the earlier mark as representing two people embracing within the mark as a whole. My overall finding of no likelihood of confusion between the marks is despite the high degree of inherent distinctive character of the earlier mark, and even where the respective goods are considered identical, which offsets a lesser degree of similarity between the marks.

51. Taking into account the previously outlined guidance of Mr Iain Purvis Q.C. (as he then was), in *L.A. Sugar*, I will now consider whether there might be a likelihood of indirect confusion. In *Duebros Limited v Heirler Cenovis GmbH,* BL O/547/17, Mr James Mellor Q.C. (as he then was), as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

52. In *Liverpool Gin Distillery Ltd and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207, Lord Justice Arnold 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". Lord Justice Arnold added that there must be "a proper basis" for concluding that there is a likelihood of indirect confusion when there is no likelihood of direct confusion.

53. Keeping in mind the global assessment of the competing factors in my decision, and in particular the low degree of visual and aural similarity found between the marks,

and the conceptual dissimilarity/low degree of similarity, it is my view that it is unlikely that the average consumer would assume that there is a connection between the parties. I acknowledge the opponent's submissions that "the Applicant's Mark is likely to be mistaken for a sub-brand of the Opponent" and that "the public may well assume that "TOTO& PAL" is new collection of dog accessories and bags from the designers and manufacturers of the Opponent's company" (sic).[18] I note that the categories listed by Mr Iain Purvis Q.C. (as he then was) are not exhaustive, however, although consumers may consider that the marks coincidentally begin with the same three letters "TOT", I do not see anything which would lead the average consumer into believing that one mark is a sub-brand of the other, or assume that there is an economic connection between the undertakings. I therefore find no likelihood of indirect confusion.

54. For the avoidance of doubt, bearing in mind the overall finding of a low degree of similarity between the marks and the interdependency principle, I would have reached the same conclusion even had I made a full comparison of the applicant's goods against the goods relied upon by the opponent and found them all to be identical or highly similar. In light of my findings of no likelihood of confusion, it is unnecessary for me to return to undertake a full comparison of the goods as this would not improve the opponent's position.

55. The opposition under section 5(2)(b) of the Act fails in its entirety.

CONCLUSION

56. The applicant has been successful. Subject to any successful appeal, the application by KODAMA SHOTEN CO., LTD. may proceed to registration.

COSTS

57. The applicant has been successful, and is therefore entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice ("TPN")

[18] See the opponent's written submissions dated 23 July 2024.

1/2023. I do not consider that the evidence submitted by the applicant in support of its defence had any positive bearing on my decision. Therefore, I have made a reduction to the award of costs to reflect this. Applying the guidance in the TPN, I consider the following to be fair:

Considering the notice of opposition and filing a counterstatement:	£300
Considering the opponent's evidence and submissions:	£600
Preparing and filing written submissions in lieu of a hearing:	£400
Total:	**£1,300**

58. I therefore order Essential Export, Limitada to pay KODAMA SHOTEN CO., LTD. the sum of £1,300. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 6th day of October 2025

Suzanne Hitchings
For the Registrar,
the Comptroller-General