

O/1177/24

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. UK3936103
BY QATAR FOUNDATION FOR EDUCATION, SCIENCE
AND COMMUNITY DEVELOPMENT
TO REGISTER THE TRADE MARK:**

ARD

IN CLASSES 35, 36, 41, 42 & 45

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 600003095
BY ARD SA**

Background and pleadings

1. On 20 July 2023, Qatar Foundation for Education, Science and Community Development (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 4 August 2023. The services applied for are as follows:

Class 35: Business research relating to green and climate technologies and energy transition; business research consultation; business consultation in the fields of green and climate technologies and energy transition; business evaluations; business advice in the fields of green and climate technologies and energy transition; business development services, namely, providing start-up support for businesses of others; business support services, namely, business consulting to potential, start-up, early stage, and existing businesses and non-profits; business administration services; business accelerator and incubation services, namely, services to potential, start-up, early stage, and existing businesses and non-profits with investment and funding resources; business accelerator and incubation services, namely, business consulting and assisting third parties in launching and growing products or services in the fields of green and climate technologies and energy transition; business accelerator and incubation services, namely, providing offices, work spaces, and collaborative spaces containing business support services and business and technology equipment to potential, start-up, and early stage businesses and non-profits; business services, namely, assisting the owners of intellectual property and intangible assets in finding investors; assistance in business management and technology commercialization; promoting public awareness of green and climate technologies and energy transition; all of the aforesaid services in respect of green technology, climate technology and/or energy transition.

Class 36: Capital investment; capital investment services; providing venture capital, development capital, private equity and investment funding; providing working capital; business accelerator and incubation services, namely, providing funding to potential, start-up, and early stage businesses and non-

profits; providing grants for projects in the fields of green and climate technologies and energy transition.

Class 41: Conducting training programs in the fields of science, technology, entrepreneurship, and business development; providing educational mentoring services in the fields of science, technology, entrepreneurship, and business development; providing business accelerator and incubator services in the nature of classes, seminars, workshops and educational conferences in the fields of science, technology, entrepreneurship, and business development; all of the aforesaid services in respect of green technology, climate technology and/or energy transition.

Class 42: Research and development in the field of energy transition; technology consultation and research in the field of energy transition.

Class 45: Licensing of intellectual property rights; consulting in the field of intellectual property licensing.

2. The application was opposed by Ard SA (“the opponent”) on 1 November 2023. The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and is against all services in classes 35, 41, 42 and 45.

3. The opponent relies on the following trade mark:

WO01536915

ARD
EVERYDAY CREATIVE



International registration and designation date 13 March 2020
Date of protection in the UK: 23 March 2021

Swiss Priority date: 13 September 2019

Relying upon all services for which the earlier mark is protected, namely:

Class 35: Development of advertising concepts; marketing services for market introduction and maintenance of trademarks for goods and services (branding); trademark creation services; marketing research services; product marketing services; development and implementation of marketing strategies for others.

Class 42: Packaging design services; graphic arts designing; product design; design and development of virtual reality software; graphic design of promotional material; graphic design; graphic arts designing.

4. The opponent claims that the marks are similar as the applied for mark is wholly contained within the earlier mark. They also claim that the applicant's services are either identical or similar to their own. As a result, the opponent's position is that there is a likelihood of confusion between the marks.

5. Within its counterstatement the applicant states that there is a low level of similarity between the respective marks and a low level of similarity (at best) between the services at issue and that there is no likelihood of confusion.

6. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 No. 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.”

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

8. 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. The applicant requested a hearing however, the request was denied. Both parties provided written submissions in lieu. This decision is taken following a careful consideration of the papers.

9. The applicant is represented by Jones Day and the opponent is represented by Trademark Tonic Limited.

10. 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

11. Section 5(2)(b) is being relied upon and is as follows:

“5(2) A trade mark shall not be registered if because-

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

12. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6. (1) In this Act an “earlier trade mark” means -

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

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered”.

13. In these proceedings, the opponent is relying upon the IR shown in paragraph 3, above, which qualifies as an earlier trade mark under the above provisions. As this IR had not completed its registration process more than 5 years before the filing date of the application in suit, it is not subject to proof of use, as per section 6A of the Act. The opponent can, as a consequence, rely upon all of the services it has identified.

Case law

14. 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 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 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 Services

15. Within the applicant's Form TM8 and at paragraph 30 of their counterstatement they claim that:

“Overall, there is a low level of similarity between the respective services. In most cases, there is no meaningful level of similarity at all.”

It is not clear what a “meaningful level of similarity” is. Nonetheless, the applicant has clearly admitted that there is a low level of similarity between the respective services. Therefore, I must find at least this level of similarity within my comparison below.

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 1975.”

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 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. For the purposes of considering the issue of similarity of goods, 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 *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

20. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the GC stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

21. The services to be compared are shown in the table below:

Contested services	Opponent’s services
<p>Class 35: Business research relating to green and climate technologies and energy transition; business research consultation; business consultation in the fields of green and climate technologies and energy transition; business evaluations; business advice in the fields of green and climate technologies and energy transition; business development services, namely, providing start-up support for businesses of others; business support services, namely, business consulting to potential, start-up, early stage, and existing businesses and non-profits; business administration services; business accelerator and incubation services, namely, services to potential, start-up,</p>	<p>Class 35: Development of advertising concepts; marketing services for market introduction and maintenance of trademarks for goods and services (branding); trademark creation services; marketing research services; product marketing services; development and implementation of marketing strategies for others.</p> <p>Class 42: Packaging design services; graphic arts designing; product design; design and development of virtual reality software; graphic design of promotional material; graphic design; graphic arts designing.</p>

early stage, and existing businesses and non-profits with investment and funding resources; business accelerator and incubation services, namely, business consulting and assisting third parties in launching and growing products or services in the fields of green and climate technologies and energy transition; business accelerator and incubation services, namely, providing offices, work spaces, and collaborative spaces containing business support services and business and technology equipment to potential, start-up, and early stage businesses and non-profits; business services, namely, assisting the owners of intellectual property and intangible assets in finding investors; assistance in business management and technology commercialization; promoting public awareness of green and climate technologies and energy transition; all of the aforesaid services in respect of green technology, climate technology and/or energy transition.

Class 41: Conducting training programs in the fields of science, technology, entrepreneurship, and business development; providing educational mentoring services in the fields of science, technology, entrepreneurship, and business development; providing

business accelerator and incubator services in the nature of classes, seminars, workshops and educational conferences in the fields of science, technology, entrepreneurship, and business development; all of the aforesaid services in respect of green technology, climate technology and/or energy transition.

Class 42: Research and development in the field of energy transition; technology consultation and research in the field of energy transition.

Class 45: Licensing of intellectual property rights; consulting in the field of intellectual property licensing.

22. The opponent has not specified its best case from their specification against the applicant's specification and has provided very broad submissions comparing class against class. Therefore, I have had to determine what I consider to be the best case in each comparison.

Class 35

23. I note that the applicant's class 35 specification contains the limitation 'all of the aforesaid services in respect of green technology, climate technology and/or energy transition'. I will refer to this as necessary but have considered it as required in my comparison.

*Business research relating to green and climate technologies and energy transition;
business research consultation;*

24. The applicant and opponent seem to be in agreement within their submissions that the class 35 services are all directed towards businesses and therefore, they overlap in user. I consider the opponent's best case here to be 'marketing research services' which overlaps in nature in so far as there is research being carried out relation to business matters. There might be an overlap in trade channels. They are not in competition nor are they complementary and therefore I consider them to be similar to a medium degree.

Business consultation in the fields of green and climate technologies and energy transition; business evaluations; business advice in the fields of green and climate technologies and energy transition;

25. I consider the same findings as paragraph 24 apply here also, save the nature of the services is a step further away due to these services of the applicant's not being research based. I therefore find them to be similar to a low degree.

Business development services, namely, providing start-up support for businesses of others; business support services, namely, business consulting to potential, start-up, early stage, and existing businesses and non-profits; business accelerator and incubation services, namely, services to potential, start-up, early stage, and existing businesses and non-profits with investment and funding resources; business accelerator and incubation services, namely, business consulting and assisting third parties in launching and growing products or services in the fields of green and climate technologies and energy transition;

26. As per the Trade Marks Manual, Classification Addendum, specifications including "namely" should be interpreted as only covering the named services, that is, the specification is limited to those services. I consider there to be an overlap in users, being business including start up with the opponent's 'development and implementation of marketing strategies for others'. There might further be an overlap in nature and purpose as marketing forms part of starting up a business/launching new products and services. Further, there is likely an overlap in trade channels. They are not complementary nor are they in competition. I therefore find them to be similar to a medium degree.

Business accelerator and incubation services, namely, providing offices, work spaces, and collaborative spaces containing business support services and business and technology equipment to potential, start-up, and early stage businesses and non-profits; business services, namely, assisting the owners of intellectual property and intangible assets in finding investors;

27. Although there is an overlap in user with the opponent's services, this on its own is not enough to support a finding of similarity and I cannot see any other overlap in the *Treat* criteria. However, as the applicant has stated the level of similarity is low, I find them to be similar to a low degree.

Business administration services;

28. I consider the above term to be very broad (even when taking into account the limitation on the applicant's class 35 specification). I therefore believe there will be an overlap of users with the opponent's 'product marketing services; development and implementation of marketing strategies for others' together with an overlap in trade channels. I do not see an overlap in nature or purpose. They are not in competition nor are they complementary. I therefore find them to be similar to between a low and a medium degree.

Assistance in business management and technology commercialization;

29. I believe that technology commercialization is the process of bringing technology to the marketplace from its development. I therefore consider that there is an overlap in user, nature and purpose with the opponent's 'marketing services for market introduction and maintenance of trademarks for goods and services (branding)'. There could also be an overlap in trade channels. They are not complementary nor are they in competition and I therefore consider them to be similar to a medium degree.

Promoting public awareness of green and climate technologies and energy transition;

30. I do not consider there to be any overlap of the *Treat* criteria between these services and those of the opponent's. However, as the applicant has stated the level of similarity is low, I find them to be similar to a low degree.

Class 41

Conducting training programs in the fields of science, technology, entrepreneurship, and business development; providing educational mentoring services in the fields of science, technology, entrepreneurship, and business development; providing business accelerator and incubator services in the nature of classes, seminars, workshops and educational conferences in the fields of science, technology, entrepreneurship, and business development; all of the aforesaid services in respect of green technology, climate technology and/or energy transition.

31. I consider that the only overlap of the *Treat* criteria that I can see with the opponent's specification and the above services are that they might all be aimed at businesses. Whilst this is usually not enough on its own to support a finding of similarity, the applicant has accepted a low level of similarity, and thus it is my finding also.

Class 42

Research and development in the field of energy transition; technology consultation and research in the field of energy transition.

32. The opponent's class 42 services relate to packaging and graphic art/design and therefore, I can see no overlap of the *Treat* criteria with the above services. However, the applicant has accepted a low level of similarity and therefore, I find them similar to a low degree.

Class 45

Licensing of intellectual property rights; consulting in the field of intellectual property licensing.

33. I consider that there might be an overlap in users with the opponent's 'marketing services for market introduction and maintenance of trademarks for goods and services (branding); trademark creation services' as both lots of services relate to IP matters and so it is likely to be businesses looking to protect their IP that engage these services. The nature will differ but they share an overlap in purpose and trade channels. I do not believe they are in competition nor are they complementary. I therefore find them similar to between a low and medium degree.

Average consumer and the purchasing act

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

35. 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. (as he then was) 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 word "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

36. The services at issue comprise a range of business services from marketing related to graphic design. I find that the average consumer for these services would most likely be a professional or business (although I do not discount there might be some individual consumers). The selection of such services is most likely to be a visual process, either online, via websites or printed marketing material, with the possibility of aural conversations with salespersons and other advisors and word of mouth recommendations.

37. All of the services at issue are likely to be a fairly regular consideration for a professional consumer or business (although I do note some of them are aimed at start-up businesses and so will focus on that period of time), but I feel such selections will generally invite a higher level of attention than casual purchases, due to the higher cost of such services and their impact on the profitability of the business. I therefore consider the average consumer will pay a higher than average level of attention in the selection and purchase of these services.

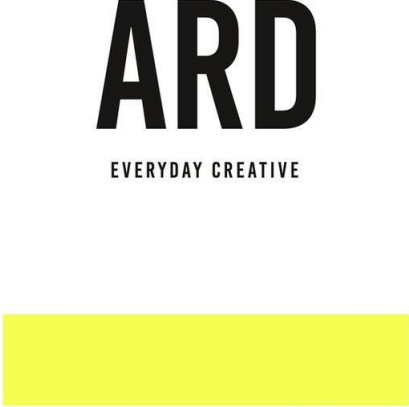
Comparison of the marks

38. 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 at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

39. 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.

40. The respective trade marks are shown below:

Contested mark	Earlier mark
<p style="text-align: center;">ARD</p>	

41. The contested mark is a singular word mark and that is where the overall impression lies. The earlier mark consists of the word 'ARD' at the top in large bold standard capitalised typeface, together with the words 'Everyday Creative' presented much smaller underneath it and then a yellow rectangle along the bottom of the mark beneath the wording. I consider that due to the sizing and placement, 'ARD' will be the dominant and distinctive component. The 'everyday creative' element and yellow rectangle will play much smaller roles.

42. Visually, contested 'ARD' mark is wholly contained within the earlier mark. The earlier mark contains further elements that the contested mark does not- being the 'everyday creative' wording and the yellow rectangle. I therefore find the marks to be visually similar to a medium degree.

43. Aurally, the contested mark is likely to be pronounced one of two ways: being letter by letter or as one word. In either case, the 'ARD' element of the earlier mark will be pronounced identically with the 'ARD' element of the earlier mark. Given the sizing and placement of the 'everyday creative' element of the earlier mark, I believe a

significant proportion of consumers would view it as a strapline and therefore will not articulate it. In this instance, the marks are aurally identical. For those consumers who do not view it as a strapline, or who articulate it in any case, I consider that the beginning of the marks are aurally identical but then follows two further words with no replication in the contested mark. These words are four and three syllables consecutively. The yellow box will not be articulated. For these consumers, the marks are aurally similar to no more than a medium degree.

44. Next, I will turn to the conceptual comparison of the marks. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] E.C.R.-I-643; [2006] E.T.M.R 29. I agree with the opponent's submissions that the 'ARD' element has no specific meaning and will be seen as an invented term (or collection of letters) and therefore, that element of both marks is conceptually neutral. However, the earlier mark has the further word element of 'everyday creative' which is made up of two ordinary dictionary terms. This serves as a point of difference conceptually between the marks. The yellow rectangle does not add a conceptual message.

Distinctive Character of the Earlier Mark

45. 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).”

46. 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/or 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. However, I have not been provided with any evidence of use and, consequently, I have only the inherent position to consider.

47. In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

48. The earlier mark is comprised of the 'ARD', 'everyday creative' and yellow rectangle elements. 'ARD' is an invented term or collection of letters with no particular meaning. There does not appear to be any association to the services registered. Therefore, I consider that this element is highly distinctive and when combined with the further elements, means that the mark is inherently distinctive to a high degree.

Likelihood of confusion

49. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa. It is necessary for me to keep in mind the distinctive character of the earlier marks, the average consumer for the services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

50. The following factors must be considered to determine if a likelihood of confusion can be established:

- I have found 'ARD' is the dominant and distinctive element of the earlier mark, with the device element and further wording playing much smaller roles. With the contested mark, the overall impression lies in 'ARD' as that is the only element.
- I have found the marks to be visually similar to a medium degree.

- I have found the marks to be aurally identical for some consumers or similar to no more than a medium degree for other consumers.
- The marks are conceptually neutral with the 'everyday creative' element being a point of conceptual difference.
- I have found the earlier mark to be inherently distinctive to a high degree.
- I have identified the average consumer for the goods and services to be professionals/businesses. The purchasing process is likely to be predominantly visual.
- I have concluded that a higher level of attention will be paid during the purchasing process.
- The services at issue range from a low to a medium degree of similarity.

51. Given I have found that the contested mark is wholly replicated within the earlier mark, together with the aural identity (for at least some consumers) I am satisfied that the average consumer is unlikely to recall the marks accurately and may not remember that one of them includes a strapline and yellow rectangle by way of imperfect recollection. They are likely to mistake one mark for the other even where the level of similarity between the goods is low, due to the interdependency principle. Consequently, I find there to be a likelihood of direct confusion between the marks.

52. In the event that I am wrong in finding there to be a likelihood of direct confusion, I will now go on to consider whether there could be indirect confusion. Mr Iain Purvis Q.C. (as he then was) said further in *L.A. Sugar Limited v Back Beat Inc*:

“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).”

53. These examples are not exhaustive but provide helpful focus, as was confirmed by Arnold LJ in *Liverpool Gin Distillery Limited & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207:

“This is a helpful explanation of the concept of indirect confusion, which has frequently been cited subsequently, but as Mr Purvis made clear it was not intended to be an exhaustive definition.”¹

54. In the case of indirect confusion, the average consumer has noticed the differences between the marks but still believes them to be linked. The differences that the average consumer might notice are the inclusion of the ‘everyday creative’ strapline and the yellow rectangle. As previously mentioned, I have found the strapline and yellow rectangle elements to not be a highly distinctive element of the mark, and they play a smaller role in the overall impression of the earlier mark. The addition of these elements are natural and logical brand extensions in my mind and therefore, fall within category A of the *LA Sugar* examples above. Therefore, I find that indirect confusion is likely to occur.

Conclusion

55. The opposition is successful in its entirety, subject to any appeal.

¹ Paragraph 12

Costs

56. The opponent has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023 as these proceedings commenced after 1 February 2023.² I award the opponent the sum of **£400**, calculated as follows:

Official fee	£100
Preparing the Notice of opposition and considering the counterstatement	£150
Filing written submissions	£150
Total	£400

57. I therefore order Qatar Foundation for Education, Science and Community Development to pay Ard SA the sum of £400. This sum should 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 December 2024

L Nicholas
For the Registrar

² Paragraph 13 relates to fast track proceedings