O/1180/24

TRADE MARKS ACT 1994

IN THE MATTER OF
TRADE MARK APPLICATON NO. 3895967
BY EXCITE AGENCY LTD TO REGISTER AS A TRADE MARK:

Excite Agency

IN CLASS 35

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NO. 442096
BY ET GLOBAL GmbH

BACKGROUND AND PLEADINGS

1. On 31 March 2023, Excite Agency Ltd ("the applicant") applied to register the trade mark displayed on the cover page of this decision, under number 3895967 ("the applicant's mark"). It was accepted and published in the Trade Marks Journal on 21 April 2023 in respect of the following services:

> Class 35: Advertising; Advertising and marketing; Leasing of advertising billboards; Advertising agencies; Digital advertising services.

2. On 21 July 2023, the applicant's mark was opposed by ET GLOBAL GmbH ("the opponent"). The opposition is brought under section 5(2)(b) of the Trade Marks Act 1994 ("the Act") and is directed against all of the services specified in the application.

3. The opponent relies upon the following registrations:

Mark 1

ET Global Exhibit Group

EXCITE

UK trade mark registration number UK00917932461
Filing date: 19 July 2018
Registration date: 17 November 2018
Relying on the following services:

Class 35: Rental of trade fair and exhibition stands and buildings and/or goods presentation and decoration units; Marketing, advertising and promotion services.

Class 37: Trade fair, exhibition, shop, counter and interior design, including the associated skilled services; Maintenance, repair and rental of trade fair and exhibition stands and buildings and/or goods presentation and decoration equipment.

Class 42: Design services; Design of trade fair and exhibition stands and structures and/or goods presentation and decoration units.

Mark 2

UK trade mark registration number UK00917932463
Filing date: 19 July 2018
Registration date: 17 November 2018
Relying on the following services:

Class 35: Rental of trade fair and exhibition stands and buildings and/or goods presentation and decoration units; Marketing, advertising and promotion services.

Class 37: Trade fair, exhibition, shop, counter and interior design, including the associated skilled services; Maintenance, repair and rental of trade fair and exhibition stands and

buildings and/or goods presentation and decoration equipment.

Class 42: Design services; Design of trade fair and exhibition stands and structures and/or goods presentation and decoration units.

4. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing registered EUTM or International Trade Mark designating the EU. As a result, the opponent's mark was converted into a comparable UK trade mark. Comparable UK marks are now recorded in the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and the original filing dates remain the same.[1]

5. The opponent's marks are earlier marks in accordance with Section 6 of the Act. However, as they had not been protected for five years or more at the filing date of the application, they are not subject to the proof of use requirements specified within Section 6A of the Act.

6. In its notice of opposition, the opponent submits that the marks covered by its registrations are highly similar to the applicant's mark and protect identical/highly similar services which, accordingly, leads to a likelihood of confusion on the part of the relevant public. They go on to state that the applicant's mark consists of the words Excite Agency and that the word Excite is the dominant and distinctive element due to the non-distinctive nature of Agency in relation to applied for services. Further, that the opponent's marks contain, in a prominent rectangle shape, the word EXCITE, in a bold font. The word EXCITE is emphasised by its larger typeface when compared to the other typographical elements, and, as a result the word EXCITE is the dominant and distinctive component of the opponent's marks and plays an independent and distinctive role.

[1] See also Tribunal Practice Notice ("TPN") 2/2020 End of Transition Period – impact on tribunal proceedings

7. The applicant filed a counterstatement denying that the marks are visually, phonetically, or conceptually similar to the opponent's marks. However, they do accept that the contested services are identical and/or similar to those covered by the opponent's registrations. Notwithstanding that, the applicant denies that there exists a likelihood of confusion on the part of the relevant consumer and requests that the opposition be rejected in its entirety and costs be awarded in its favour.

8. The opponent is represented by Appleyard Lees IP LLP, and the applicant is represented by Sonder & Clay. Neither party requested a hearing and only the applicant filed submissions in lieu. I therefore make this decision having taken full account of all the papers, referring to them as necessary.

RELEVANCE OF EU LAW

9. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

DECISION

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

10 The opposition is based upon section 5(2)(b) of the Act which reads as follows:

> "5 (2) A trade mark shall not be registered if because –
>
> […]

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

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

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

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

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

(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

13. Section 60A of the Act provides:

> "(1) For the purpose of this Act goods and services-
>
> (a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.
>
> (b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.
>
> (2) In subsection (1), the "Nice Classification" means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1979."

14. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court ("GC") stated that:

> "29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut for Lernsysterne v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark."

15. I note that the services relied upon by the opponent are the same in both of its registrations. The services to be compared are:

The opponent's services	The applicant's services
Class 35: Rental of trade fair and exhibition stands and buildings and/or goods presentation and decoration units; Marketing, advertising and promotion services. **Class 37:** Trade fair, exhibition, shop, counter and interior design, including the associated skilled services; Maintenance, repair and rental of trade fair and exhibition stands and buildings and/or goods presentation and decoration equipment. **Class 42:** Design services; Design of trade fair and exhibition stands and structures and/or goods presentation and decoration units.	**Class 35:** Advertising; Advertising and marketing; Leasing of advertising billboards; Advertising agencies; Digital advertising services.

16. As previously stated, I note the applicant's concession in relation to 'identity and/or similarity' and while the applicant has not specified which services it considers identical and which it considers similar (or to what degree), it is my view that the services are plainly identical, and it is on this basis that I will proceed.

Advertising; Advertising and marketing;

17. These terms appear in both the applicant's and the opponent's specification and are therefore clearly identical.

Leasing of advertising billboards; Advertising agencies; Digital advertising services.

18. I consider the opponent's term 'Marketing, advertising and promotion services' broad enough to cover the above services of the applicant. It is my view that the applicant's terms would be included in the more general category 'advertising services' contained within the opponent's specification, and therefore, bearing in mind the principals of *Meric,* are considered identical.

The average consumer and the nature of the purchasing act

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

20. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited,* [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

> "60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

21. The applicant contends that the relevant consumer of the services is likely to be business professionals who will pay careful consideration when selecting the services, thus paying a high level of attention.

22. In my view, the consumer of the contested services will be a business requiring advertising services; however, I do not discount that the services may also be sought by a member of the general public. The cost of the services in question is likely to vary, as will the frequency of purchase. The average consumer will take various factors into consideration such as the nature of the services, cost, the reputational standing of the provider and the suitability of the services for their specific needs. Where the average consumer is a business, they are likely to pay a higher degree of attention due to the potential impact of the service on their company's reputation. Consequently, the level of attention paid during the purchasing process for the services will be a medium degree where the average consumer is a member of the general public, and between a medium and high degree where the average consumer is a business. The services are likely to be obtained by visiting the service provider's physical premises or by visiting their website. Therefore, visual considerations are likely to dominate the selection process. However, I do not discount that there may also be an aural component to the purchase of services through advice sought from a sales assistant or representative, and word-of-mouth recommendations.

Comparison of trade marks

23. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgement in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

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

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

The opponent's marks	The applicant's mark
Mark 1: UK00917932461  **Mark 2: UK00917932463** 	UK00003895967 **Excite Agency**

26. The applicant claims that the marks are visually dissimilar, stating that the opponent's marks consist of the letters 'ET' in an orange circle followed by the words 'Global Exhibit Group', with the word 'EXCITE' presented underneath in a rectangle box. Whereas its mark is not stylised and consists of the two words 'Excite Agency'. The applicant accepts that both marks contain the word 'Excite' but that the position and visual impact of this element is very different. They go on to argue the first line of both of the opponent's marks clearly contains the logo and name of the undertaking and will be visually distinctive for the consumer. Whilst the term 'Excite' is in a larger font in the mark of the

opponent its position is such that the consumer will recognise it as a merely laudatory term qualified by the first line of the mark, namely that the ‘ET Global Exhibit Group’ will 'excite' their customers. On the other hand, they state that the term ‘Excite’ in their mark is positioned in such a manner, qualified by the term ‘Agency’, to clearly demonstrate the name of the undertaking, thus creating a different visual impression.

27. The applicant also submits that the marks are phonetically dissimilar, stating that the applicant’s mark consists of the syllables ‘EX-SI-T-AY-GEN-SEE’, whereas the opponent’s marks consist of the syllables ‘EEE-TEE-GLO- BAL-GROO-P- EX-SI-T’. They add that whilst there are some syllables in common, the opponent’s marks have significant additional material at the start of them where it will make the greatest visual impression on the consumer. Consequently, the phonetic differences far outweigh any minor similarity.

28. Finally, the applicant argues that the marks are conceptually dissimilar, stating that whilst they share the term 'Excite', the manner of use creates a very different concept. They submit that the applicant’s mark contains the term 'Agency' which clearly conveys the message that the name is that of an agency called 'Excite,' whereas the use of the term 'Excite' in the opponent’s marks are a laudatory descriptor given that it follows the name and logo of the opponent.

Overall Impression

29. The opponent’s marks are figurative marks that consists of letters ‘ET’ in an orange circle followed by the words ‘Global Exhibit Group’, with the word ‘EXCITE’ presented underneath in a rectangle box. The first mark is presented on a white background, with black writing, whereas the second mark is presented on a black background, with white writing. The word ‘EXCITE’ appears in a larger font than that of the ‘ET Global Exhibit Group’ element, and as a result, I find that it dominates the mark, with one’s eye being more drawn to it initially. On the other hand, the applicant’s mark consists solely of the words ‘Excite Agency’. There are no other elements in the mark to contribute to its overall impression, which lies in the words themselves. I do however find that

due to the descriptive nature of the word ‘Agency’, the word ‘Excite’ is considered to be the dominant element of the mark.

Visual Comparison

30. The opponent’s mark consists of five word elements, namely the letters ‘ET’ appearing in an orange circle, the words ‘Global Exhibit Group’, and the word ‘EXCITE’ being presented below in a rectangle box. The applicant’s mark consists of the two words ‘Excite Agency’ with no additional stylisation. The marks only coincide in one of the elements, albeit the dominant one,’ and as such I consider the marks to be visually similar to between a low and medium degree.

Aural Comparison

31. Aurally, the opponent’s marks contain ten syllables. The ‘ET’ element would be pronounced as two individual letters ‘E’ and ‘T’ and the rest of the verbal elements would all be pronounced according to their dictionary definitions. None of the words contained within the marks are so obscure that they would not be understood or given their natural pronunciations by the consumer. The stylistic elements, namely, the orange circle and rectangle in the opponent’s marks would not be articulated. Moving to the applicant’s mark, it contains five syllables, again with both words being pronounced in accordance with their readily understood dictionary definitions. As stated above, due to the size and prominence of the word EXCITE in the opponent’s mark, some consumers may pronounce this word before verbalising the other elements of the mark. Additionally, it is considered that some consumers may not verbalise the ‘Agency’ element of the applicant’s mark due to its non-distinctive/descriptive connotations. Taking all of the above into consideration and bearing in mind that the common element of the marks ‘Excite’ will be pronounced identically in both the applicant’s and opponent’s marks, it is my view that the marks are aurally similar to no more than a medium degree.

Conceptual Comparison

32. The letters ‘ET’ in the opponent’s marks do not convey a concept. I consider that the relevant average UK consumer will ascribe no meaning to them as they and they convey no immediate message. The words ‘Global Exhibit Group’ would be understood as a reference to a group of companies that manage all aspects related to exhibitions, provided around the world. The word ‘EXCITE’ would be perceived in accordance with its dictionary definition namely, to make someone have strong feelings of happiness and enthusiasm.[2] In my view the overall concept conveyed by the mark is that a global exhibit group will in some way ignite feelings of excitement. Now considering the applicant’s mark it is my view that the concept evoked from it would be that of an agency that again would trigger feelings of enthusiasm and excitement in some way. In that regard I consider the marks to be conceptually similar to a medium to high degree.

Distinctive character of the opponent’s mark

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

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

[2] https://dictionary.cambridge.org/dictionary/english/excite

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)."

34. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctive character of a mark can be enhanced by virtue of the use that has been made of it. The opponent has not claimed that its mark has acquired an enhanced degree of distinctiveness and has not filed any evidence to that effect. As such, I have only the inherent position to consider.

35. The opponent's mark features the verbal elements 'ET,' 'Global Exhibit Group,' and 'EXCITE'. As previously stated, the letters ET appear to have no immediate apparent meaning. They are not descriptive or allusive to the services at issue and therefore, I consider them to be inherently distinctive to a medium degree. The words 'Global Exhibit Group' are considered to be low in distinctive character as they essentially describe a company that provides exhibition services globally. Additionally, the word 'EXCITE' does not appear to have an immediate relationship to the relevant services, however it does convey potentially laudatory connotations and is therefore considered to possess between a low and medium degree of distinctive character. Finally, the stylistic elements i.e., the colour and presentation of the mark, add very little distinctive character to the mark as a whole. It is considered that these elements would be perceived as a decorative feature of the mark, rather than indicating the trade origin of the services. Considering the mark in totality, I find that it possesses between a low and medium degree of distinctive character.

Likelihood of confusion

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

37. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind (see *Sabel*, C-251/95, para 22). The first is the interdependency principle i.e., a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa (see *Canon*, C-39/97, para 17). It is necessary for me to keep in mind the distinctive character of the earlier marks, the average consumer for the goods and 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.

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

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

- The respective services are identical.

- The average consumers are both professional businesses, who will demonstrate between a medium and high level of attention during the

purchasing process, and the general public, who will demonstrate a medium degree of attention during the purchasing process.

- The purchasing process for the goods would be a combination of visual and aural.

- The opponent's mark possesses between a low and medium degree of inherent distinctive character. While this may be a factor in favour of the applicant, I remind myself that a weak distinctive character does not always preclude a likelihood of confusion.[3]

- The marks at issue are visually similar to between a low and medium degree. The marks are aurally similar to a medium degree. The marks are conceptually similar to a medium to high degree.

40. I acknowledge that the competing marks coincide in their shared use of the word 'Excite/EXCITE'. This is a dominant element in both marks. Nevertheless, the opponent's mark contains additional elements, namely the letters 'ET,' the words 'Global Exhibit Group,' the colours and presentation. Although some of these elements play lesser roles in the opponent's mark, they are not negligible and are unlikely to be overlooked by the average consumer. Taking the above into account, it is my view that the differences between the competing marks are likely to be sufficient for the consumer, paying between a medium and high degree of attention, to distinguish between them and avoid mistaking one for the other. As such, notwithstanding the principles of imperfect recollection and interdependency, I find that there is no likelihood of direct confusion.

41. 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:

[3] *L'Oréal SA v OHIM*, Case C-235/05 P

“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).”

42. These three categories are not exhaustive. Rather, they were intended to be illustrative of the general approach.[4]

43. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J (as he then was) considered the impact of the CJEU's judgment in *Bimbo*, Case C-591/12P, on the court's earlier judgment in *Medion v Thomson.* The judge said:

> "18. The judgment in Bimbo confirms that the principle established in Medion v Thomson is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.
>
> 19. The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks – visually, aurally and conceptually – as a whole. In Medion v Thomson and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.
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> 20. The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the

[4] As was confirmed by the Court of Appeal in *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207, paragraph 12.

meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21. The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors."

44. I recognise that indirect confusion has its limits and that such a finding 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.[5] It has also been emphasised that, where there is no direct confusion, there must be a proper basis for finding indirect confusion.[6] The average consumer tends to perceive trade marks as wholes and I am conscious not to artificially dissect the opponent's mark. However, the word 'EXCITE' plays an independent distinctive role within the opponent's mark, i.e., it has a distinctive significance which is independent of the significance of the whole. The same is true of the applicant's mark due to the descriptive nature of the word 'Agency'. It is a dominant element of the opponent's mark and is identically reproduced in the applicant's mark. In my view the differences between the competing marks may appear consistent with a co-branding or collaborative exercise between the parties, or that they are such that they would be considered a subsidiary company or agency. Taking all of the above into account, I am satisfied that the average consumer would assume a commercial association between the parties due to the identical element 'Excite'. Consequently, I find that there is a likelihood of indirect confusion.

Conclusion

[5] *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17
[6] See the Court of Appeal's comments in *Liverpool Gin Distillery*, paragraph 13.

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

Costs

46. As the opponent has been successful, it is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice ("TPN") 1/2023[7]. In the circumstances, I award the opponent the sum of £450. The sum is calculated as follows:

Official Fee	£100
Preparing the notice of opposition and considering the counterstatement	£350
Total	£450

47. I therefore order **Excite Agency Ltd** to pay **ET GLOBAL GmbH** the sum of £450. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 16th day of December 2024

Oliver Rose'Meyer
For the Registrar

[7] As the proceedings were commenced after 01 February 2023