

BL O/0423/23

TRADE MARKS ACT 1994

**IN THE MATTER OF
TRADE MARK APPLICATION NO. 3768737
BY SPACE NK LIMITED**

TO REGISTER THE TRADE MARK:

SPACE NK

IN CLASSES 9, 35 and 44

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 60002551
BY DUF LTD**

Background and pleadings

1. On 22 March 2022, Space NK Limited (“the applicant”) filed trade mark application number 3768737 (“the contested mark”) for the mark shown on the cover page of this decision. The application was accepted and published in the Trade Marks Journal for opposition purposes on 17 June 2022, in respect of goods and services in Classes 9, 35 and 44 (see “Annex” for the full list of goods and services).

2. On 13 September 2022, Duf Ltd (“the opponent”) filed a Fast Track opposition. The opposition is brought under Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and is directed at some of the goods and services in Classes 9 and 35 of the application.¹

3. The opponent relies upon its United Kingdom trade mark number 3495303, ‘SPACE’ and ‘space’ (series of two marks). The earlier mark was filed on 31 May 2020, and became registered on 15 October 2021, in respect of goods in Classes 9 and 14. For the purpose of these proceedings, the opponent relies upon all the goods registered under the mark.²

4. In its notice of opposition, the opponent claims that the respective marks and the goods and services at issue are sufficiently similar resulting in a likelihood of confusion. The applicant filed a counterstatement in which it accepts that the marks are similar but denies that the respective goods and services are sufficiently similar for confusion to be caused.

5. Given the respective filing dates, the opponent’s mark is an earlier mark, in accordance with section 6 of the Act. However, as it had not been registered for five years or more at the filing date of the application, it is not subject to the proof of use requirements specified within section 6A of the Act. As a consequence, the opponent may rely upon all of the goods for which the earlier mark is registered without having to establish genuine use.

¹ See goods and services comparison.

² See goods and services comparison.

6. Rules 20(1)-(3) of the Trade Marks Rules (the provisions which provide for the filing of evidence) do not apply in fast track oppositions but Rule 20(4) does. It reads:

“The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

7. The effect of the above is to require parties to seek leave in order to file evidence in fast track oppositions. No leave was sought 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. A hearing was neither requested nor considered necessary.

9. The applicant is represented by Carpmaels & Ransford LLP, whereas the opponent represents itself. Neither party chose to file written submissions in lieu of a hearing. This decision is taken following a careful review of the papers before me, keeping all submissions in mind.

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

DECISION

Section 5(2)(b)

11. Sections 5(2)(b) and 5A of the Act read as follows:

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

[...]

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

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

[...]

5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

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

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

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

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

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

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

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

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

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

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

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

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

Comparison of goods and 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 1975.”

14. In comparing the respective specifications, all relevant factors should be considered, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* where the CJEU stated at paragraph 23 of its judgment:

“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.”

15. In *Kurt Hesse v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case C-50/15 P, the CJEU stated that complementarity is capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the General Court (“GC”) stated that “complementary” means:

“82 ... there is a close connection between [the goods], 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...”.

16. Additionally, the criteria identified in *British Sugar Plc v James Robertson & Sons Limited* (“*Treat*”) [1996] R.P.C. 281 for assessing similarity between goods and services also include an assessment of the channels of trade of the respective goods or services.

17. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) at [12] Floyd J said:

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

18. For the purposes of considering the issue of similarity of goods or services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10), Mr Geoffrey Hobbs QC (as he then was), sitting as the Appointed Person, and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

19. The competing goods and services are as follows:

Opponent's goods	Applicant's goods and services
<p>Class 9 Optical apparatus and instruments; optical goods; spectacle and sunglass frames; spectacle and sunglass lenses; contact lenses; spectacle cases; spectacle cords and chains, including spectacles for cycling; goggles, lenses or goggles, all being in the nature of protective eyewear; face masks and face shields; helmets, including cycle helmets; protective eyewear, headgear and bodywear; protective clothing for cycling.</p> <p>Class 14 Precious metals and their alloys; jewellery; ornaments; rings, earrings, ear clips, brooches, chokers, necklaces, pendants, chains, bracelets; precious stones, pearls; horological and chronometric instruments, in particular small clocks, wrist watches, parts for clocks and watches, clock faces, housing for clocks and watches, clockworks, parts for clockworks; parts and fittings for the aforesaid goods, included in class 14.</p>	<p>Class 9 Computer software and computer software applications for electronic devices and handheld mobile devices for trying on fashion items including clothing, headgear, footwear, bags, jewellery, watches, glasses and sunglasses; downloadable software for trying on fashion items including clothing, headgear, footwear, bags, jewellery, watches, glasses and sunglasses; simulation software and apparatus for trying on fashion items including clothing, headgear, footwear, bags, jewellery, watches, glasses and sunglasses; downloadable software for providing advice and assistance in relation to fashion items including clothing, headgear, footwear, bags, jewellery, watches, glasses and sunglasses.</p> <p>Class 35 Virtual retail services and virtual department store retail services connected with the sale of eyewear and sunglasses.</p>

20. With regard to the similarity of the goods and services, in its statement of grounds the opponent states the following:

“Computer software, computer applications, simulation and virtual services for trying on or retail, would display SPACE.NK on a screen with the items I am protected for. This would confuse my customers as my trade mark SPACE displays these items and other associated digital media representations for my protected items displayed on screen, be they physical or digital representations of the items, that are sold via the internet or in shops.”

21. With regard to the similarity of the goods and services, in its counterstatement the applicant states the following:

“The Applicant denies that the goods covered by the Application are similar to the goods of the earlier mark pursuant to section 5(2)(b) of the Trades Marks Act 1994. The goods covered by the earlier mark in Classes 9 and 14 are dissimilar to the opposed goods and services in Classes 9 and 35 of the Application, taking account of their nature, their intended purpose, their method of use and whether they are in competition with each other or complementary.”

Class 9 of the contested application

Computer software and computer software applications for electronic devices and handheld mobile devices for trying on fashion items including clothing, headgear, footwear, bags, jewellery, watches, glasses and sunglasses; downloadable software for trying on fashion items including clothing, headgear, footwear, bags, jewellery, watches, glasses and sunglasses; simulation software and apparatus for trying on fashion items including clothing, headgear, footwear, bags, jewellery, watches, glasses and sunglasses; downloadable software for providing advice and assistance in relation to fashion items including clothing, headgear, footwear, bags, jewellery, watches, glasses and sunglasses

22. The above goods are all various types of software and simulation apparatus specifically concerned with *trying on fashion items including clothing, headgear, footwear, bags, jewellery, watches, glasses and sunglasses*, for example, in a virtual environment, and *for providing advice and assistance in relation to fashion items including clothing, headgear, footwear, bags, jewellery, watches, glasses and sunglasses*. Whilst it is noted that the opponent's Class 9 goods do not include software or simulation apparatus, it does however include *optical goods; spectacle and sunglass frames; spectacle and sunglass lenses, helmets, including cycle helmets; headgear and bodywear; and protective clothing for cycling*. Furthermore, Class 14 of the opponent's goods include *jewellery* and wrist *watches*. Accordingly, I find that the opponent's said goods in Classes 9 and 14 have a certain connection to the contested goods, either because they are specifically mentioned or because

they are closely related 'fashion items', that will share the same users and trade channels, such as *clothing* versus *footwear* and *bags*. When buying online a consumer of the goods at issue, may for example, want to upload a photograph of themselves via the applicant's software to see how these goods will look on them, and seek advice and assistance in relation to such items. Therefore, I find that there is a degree of complementarity between these goods. Whilst it is acknowledged that the nature and uses of the goods at issue differ, the end users and trade channels can overlap. Consequently, I find that the opponent's *optical goods; spectacle and sunglass frames; spectacle and sunglass lenses, helmets, including cycle helmets; headgear and bodywear; and protective clothing for cycling*, in Class 9, and its *jewellery and wrist watches* in Class 14 are similar to a low degree to all the applicant's Class 9 goods listed above.

Class 35 of the contested application

23. In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the General Court held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

Virtual retail services and virtual department store retail services connected with the sale of eyewear and sunglasses

24. Taking account of the guidance outlined above in *Oakley*, I am unable to find the above services identical to any of the opponent's goods on the basis that goods and services differ in nature because goods are tangible items, whereas services are intangible. However, I do find a degree of similarity in relation to the applicant's services and some of the opponent's goods in Class 9. The applicant's services are those that enable consumers to virtually view and purchase goods, namely *eyewear and sunglasses*. The terms *virtual retail services* and *virtual department store retail services* refers to e-commerce services that allow consumers to browse and purchase items online as they normally would do in-store. The opponent's Class 9 goods include various types of eyewear related goods including sunglasses, *namely optical goods; spectacle and sunglass frames; spectacle and sunglass lenses;*

goggles, lenses for goggles, all being in the nature of protective eyewear; and protective eyewear. Accordingly, while I find that the purpose, method of use and nature of the goods and the services differ and they are not in competition with one another, the users may overlap, for example, those who wish to purchase eyewear products such as spectacles and sunglasses, are likely to use the services which offer those goods. Moreover, the goods and services at issue are complementary in that they are important for one another, resulting in the consumer seeing a connection between the two and believing that the responsibility for both lies with the same undertaking. In addition, the goods and services may be distributed through the same trade channels. Further, it is my understanding that it is also common in the trade for department stores and online retailers to not only offer third party brands for sale but to also offer for sale their own branded goods. I consider that the average consumer will be aware of this and is, therefore, likely to believe that the responsibility of the goods and services lies with the same undertaking, regardless of whether those services are provided in person or online. Accordingly, I find there to be a medium degree of similarity between the applicant's *virtual retail services and virtual department store retail services connected with the sale of eyewear and sunglasses*, and the opponent's *optical goods; spectacle and sunglass frames; spectacle and sunglass lenses; goggles, lenses for goggles, all being in the nature of protective eyewear; and protective eyewear* in Class 9.

The average consumer and the nature of the purchasing act

25. 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).

26. 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 words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

27. The average consumer of the goods and services at issue is likely to include members of the general public as well as a more specialised commercial customer or business. For example, *optical goods* in Class 9 are likely to be bought by members of the general public as well as a commercial customer specialising in *optical goods*. The goods and services will mainly be available via retailers, being both general retailers and more specialist ones, and their online equivalents. As the goods in Class 9 are most likely to be the subject of self-selection from traditional retail outlets on the high street, catalogues and websites, visual considerations are likely to dominate the selection process. Visual considerations will also dominate the selection of the associated retail services in Class 35. However, I do not discount an aural component playing a part given that orders may be placed by telephone or that word-of-mouth recommendations and advice may be received from sales assistants. Whilst my own experience tells me that the cost of, for example, spectacles and sunglasses can vary widely, the need for the consumer to ensure they choose the correct size, material, shape and colour of even relatively inexpensive spectacles or sunglasses is likely to result in at least a medium level of attention being paid to their selection by both the average consumer as well as a more specialised commercial customer; a similar level of attention will also be paid to the selection of a retailer specialising in such goods.

Comparison of the marks

28. It is clear from *Sabel BV v. Puma AG* that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created

by them, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo SA v OHIM*, 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.”

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

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

Opponent's mark (series of 2)	Applicant's mark
SPACE space	SPACE NK

31. With regard to the similarity of the applicant's mark, in its statement of grounds the opponent states the following:

“My customers will be confused that this is similar or identical to my previously registered trade mark and brand identity in the associated goods.”

32. With regard to the similarity of the marks, in its counterstatement the applicant states the following:

“The Applicant admits that the mark applied for and the earlier mark both contain the word SPACE. The Applicant denies that this shared element necessarily makes the marks similar overall. The NK element of the mark

applied for cannot be disregarded entirely in the overall comparison of the marks. The NK element is distinctive for all the goods and services applied for, in particular (but not limited to) the various virtual glasses, sunglasses and virtual department store services in the goods and services applied for. The Applicant denies that the Opponent's customers will be confused that the applied for mark is similar or identical to the earlier mark."

Overall impression

33. The opponent's word marks comprise the word 'SPACE' presented in upper-case letters, and the word 'space' presented in lower-case letters. There is no stylisation present in the marks. There are no other elements that contribute to the overall impression of the marks which lies in the word itself.

34. The applicant's word mark comprises two elements, namely 'SPACE' and 'NK' presented in upper-case letters with no additional stylisation. 'SPACE' is at the beginning of the mark and is the longer of the two elements. Accordingly, due to its position and length I find that 'SPACE' will be noticed first, and subsequently I consider that this word plays a greater role in the overall impression of the applicant's mark, with the element 'NK' playing a slightly lesser role. However, this element still contributes to the overall impression of the mark.

Visual comparison

35. Visually the marks coincide insofar as they identically share the same first five-letter word 'SPACE / space / SPACE'. This similarity appears at the beginning of the respective marks, being where consumers tend to focus³ as this position is generally considered to have more impact due to consumers in the UK reading from left to right. Accordingly, this is the element that will be read first in the applicant's mark and is the only element of the opponent's marks. In making my visual comparison of the marks, I bear in mind that notional and fair use of the marks would include use in both upper and lower case,⁴ so letter case is irrelevant to the comparison.

³ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

⁴ *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17

36. The competing marks are visually different in that the applicant's mark contains the additional element 'NK'. This difference appears at the end of the mark and renders the marks different in length. I find the competing marks visually similar to at least a medium degree.

Aural comparison

37. Aurally, the opponent's marks will be pronounced as the dictionary word 'space'. The applicant's mark will also be pronounced as the dictionary word 'space' along with the letters 'N' and 'K', namely 'SPACE-N-K'. Accordingly, the applicant's mark has three syllables compared to the opponent's single syllable. The first syllable in the applicant's mark is identical to the only syllable in the opponent's marks. I find that the marks are aurally similar to a medium degree.

Conceptual comparison

38. 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. The assessment must, therefore, be made from the point of view of the average consumer.

39. The opponent's marks, consisting solely of the word 'SPACE / space', will be widely understood according to its ordinary dictionary meaning, namely as reference to *an area that is empty or available*, or as reference to *the area beyond the Earth's atmosphere where the stars and planets are*.⁵ Accordingly, the word *space* has no obvious connection to the goods in the opponent's specification. As for the applicant's mark, the same meaning will be applied to its own 'SPACE' element, which again, will have no obvious connection to the applied for goods and services. The addition of the letters 'NK' at the end of the mark, does not appear to be a known acronym or abbreviation in relation to the applicant's goods and services and therefore are likely to be perceived as *the fourteenth (N) and eleventh (K) letters of*

⁵ www.collinsdictionary.com/dictionary/English/space

the English alphabet,⁶ having no clear meaning or obvious connection to the applied goods and services. When viewed as a whole, I find that this 'NK' element will only contribute as a slight point of conceptual difference between the marks. Taking all of this into account, I am of the view that the marks are conceptually similar to at least a medium degree.

Distinctive character of the earlier trade marks

40. The distinctive character of a trade mark can be measured only, first, by reference to the goods or services in respect of which registration is sought and, second, by reference to the way it is perceived by the relevant public. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, 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).”

⁶ www.collinsdictionary.com/dictionary/English/n / www.collinsdictionary.com/dictionary/English/k

41. 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 or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark, the greater the likelihood of confusion.

42. Neither party has made any specific comments on the distinctiveness of the earlier mark. Although the distinctiveness of a mark can be enhanced by virtue of the use that has been made of it, the opponent has not filed any evidence of use. Consequently, I have only the inherent position to consider.

43. The earlier mark (series of two) comprises the words 'SPACE' and 'space'. Whilst this word will be understood as reference to *an area that is empty or available*, or as reference *to the area beyond the Earth's atmosphere where the stars and planets are*,⁷ it has no obvious connection with the goods for which the opponent's mark is registered. On this basis, I find that the series of two marks are inherently distinctive to a medium degree.

Likelihood of confusion

44. 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. One such factor 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 goods and services, and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier trade mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be mindful 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 they have retained in their mind.

⁷ www.collinsdictionary.com/dictionary/English/space

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

46. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis QC (as he then was), as the Appointed Person, explained that:

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

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

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

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand

or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

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

47. These examples are not exhaustive but provide helpful focus.

48. Further, in *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (BL O/219/16), where he said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

49. Earlier in the decision I concluded that the respective marks are visually and conceptually similar to at least a medium degree, and aurally similar to a medium degree. I have found the opponent’s mark to be inherently distinctive to a medium degree. I concluded that the parties’ goods and services range from similar to a low degree to similar to a medium degree. Furthermore, I have identified the average consumer to be a member of the general public as well as a specialist customer and business, who will pay at least a medium degree of attention during the selection of the goods and services at issue. I am of the view that the purchasing process for the goods and services would be predominantly visual in nature, though I have not discounted aural considerations.

50. Given that the word ‘SPACE’ is identically present in the competing marks, I consider that the marks are likely to be mistakenly recalled or misremembered as each other when used on the goods and services at issue. I am of this view given the degree of visual similarity is at least medium and that the purchasing process is predominantly visual. Furthermore, this element is visually, aurally and conceptually

identical in both marks and is independently distinctive of the 'NK' element. Furthermore, I keep in mind that the beginnings of marks tend to make more of an impact than the ends. Accordingly, as the marks identically share the same beginnings resulting in the earlier mark being fully encompassed in the contested mark where the only difference between the marks is in the letters 'NK', at the end of the contested mark, it is my view that this difference will be easily overlooked by the average consumer. I also consider that, in the absence of a strong conceptual hook in relation to 'NK', the average consumer will not have a strong conceptual message to assist them in differentiating between the marks. Accordingly, taking all of this into account, when used on the goods and services at issue, I consider there to be a likelihood of direct confusion, even for goods that are similar only to a low degree.

Conclusion

51. The partial opposition under Section 5(2)(b) of the Act has succeeded. Subject to any successful appeal, the application will be refused for the following goods and services:

Class 9 Computer software and computer software applications for electronic devices and handheld mobile devices for trying on fashion items including clothing, headgear, footwear, bags, jewellery, watches, glasses and sunglasses; downloadable software for trying on fashion items including clothing, headgear, footwear, bags, jewellery, watches, glasses and sunglasses; simulation software and apparatus for trying on fashion items including clothing, headgear, footwear, bags, jewellery, watches, glasses and sunglasses; downloadable software for providing advice and assistance in relation to fashion items including clothing, headgear, footwear, bags, jewellery, watches, glasses and sunglasses.

Class 35 Virtual retail services and virtual department store retail services connected with the sale of eyewear and sunglasses.

Costs

52. The opponent has been successful and is entitled to an award of costs in line with the scale published in Tribunal Practice Notice (“TPN”) 2/2016. For Fast Track opposition proceedings, costs are capped at £500, excluding the official fee. As the opponent is unrepresented, on 13 February 2023 it filed a costs pro-forma, claiming it had spent the following amount of time on these proceedings:

Notice of opposition	3 hours
Considering forms filed by the other party	1 hour
Preparing evidence/written submissions and commenting on the other side’s evidence/written submissions	2 hours
Total	6 hours

53. I consider the time spent completing the notice of opposition and considering forms filed by the applicant to be reasonable. However, I note that the opponent has included time spent (2 hours) preparing evidence and/or written submissions and commenting on the other side’s evidence and/or written submissions. However, it is noted that neither party filed evidence nor written submissions and as such, I am not able to award costs in respect of these matters. It is important to note that only costs which have been incurred during, and as part of, these proceedings are relevant, such as filing official forms, evidence, written submissions etc.

54. Accordingly, bearing the above in mind and reminding myself that The Litigants in Person (Costs and Expenses) Act 1975, the Civil Procedure Rules Part 46 and the associated Practice Direction, set the amount payable to litigants in person at £19 per hour, I award costs to the opponent on the following basis:

TM7F (Official filing fee)	£100
Preparing the notice of opposition (3 hours)	£57

Considering forms filed by the other party (1 hour) £19

Total £176

55. I therefore order Space NK Limited to pay Duf Ltd the sum of £176. 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 5th day of May 2023

**Sam Congreve
For the Registrar**

Annex

Applicant's goods and services

Class 9 Downloadable virtual goods, namely, computer programs featuring preparations and substances for the conditioning, care and appearance of the skin, body, face, eyes, hair, scalp, teeth and nails, perfumed or fragranced articles, soaps, personal cleansing preparations, shower gels, bath gels, bath preparations, perfumery, eau de parfum, toilet waters, deodorant preparations for personal use, anti-perspirants, cosmetics, colour cosmetics, eye cosmetics, nail cosmetics, lip cosmetics, make up removers, cosmetic scented tissues, shampoos, hair conditioners, preparations for the hair, hair lotions, dentifrices, sun tanning preparations, sun-screening preparations; downloadable virtual goods, namely, shaving preparations, after shave and pre shave lotions and oils, depilatory preparations, essential oils, oils for toilet purposes, pomanders, potpourris, perfumed drawer liners, fragranced sachets for drawers, incense, aromatic plant extracts, illuminants, lamp oils, candles, scented candles, candle making kits and wicks, eyewear and sunglasses; downloadable virtual goods, namely, leather goods, leather accessories, leather boxes, leather coasters, leather pouches, leather cases and leather bags, kitchen utensils and containers, cookware and tableware, glassware, porcelain and earthenware, printed matter, photographs, stationery, notebooks, gift cards, calendars and wrapping paper, textiles and textile goods; downloadable virtual goods, namely, apparatus for recording, transmission or reproduction of sound or images; computer software and computer software applications for electronic devices and handheld mobile devices for assessing skin condition, facial mapping, skin mapping, producing simulations of makeup application, producing animations and visual and special effects in the field of makeup and beauty, skin care and fashion, analysing and recording skin condition, for use in relation to facial care and the cosmetic field; downloadable software for assessing skin condition, facial mapping, skin mapping, producing simulations of makeup application, analysing and recording skin condition, for use in relation to facial care and the cosmetic field; simulation software and apparatus for assessing skin condition, facial mapping, skin mapping, producing simulations of makeup

application, analysing and recording skin condition; downloadable software for providing advice and assistance in relation to makeup, skin condition and beauty care and for producing simulation imagery; computer software for use with mirrors; mirrors with video cameras and touch screens containing software for assessing skin condition, facial mapping, skin mapping, producing simulations of makeup application, analysing and recording skin condition; computer software and computer software applications for electronic devices and handheld mobile devices for trying on makeup, fashion items including clothing, headgear, footwear, bags, jewellery, watches, glasses and sunglasses and producing simulations of outfits; downloadable software for trying on makeup fashion items including clothing, headgear, footwear, bags, jewellery, watches, glasses and sunglasses and producing simulations of outfits; simulation software and apparatus for trying on makeup, fashion items including clothing, headgear, footwear, bags, jewellery, watches, glasses and sunglasses and producing simulations of outfits; computer software for providing advice and assistance in relation to fashion, perfumery, makeup, skin condition and beauty care and for producing simulation imagery; computer software for measuring and displaying information relating to customised skincare recommendations; software and applications allowing users to virtually try on cosmetics, clothing, footwear and/or fashion accessories; computer software for the evaluation and visualisation of information for personalised recommendations in relation to fashion, skin care, makeup, perfumery and beauty; computer software for creating digital images, animations and special effects for use in the cosmetic, beauty and skincare fields; computer application software for use in implementing the Internet of Things [IoT]; Internet of Things [IoT] gateways; downloadable software for providing advice and assistance in relation to fashion items including clothing, headgear, footwear, bags, jewellery, watches, glasses and sunglasses and producing simulation imagery; holograms; computer software for creating digital images, animations and special effects for use in the field of fashion; skins for use in virtual reality games; artificial intelligence software, apparatus and instruments; computer games software; computer games programmes; augmented reality software; augmented reality games software; virtual reality software; virtual reality games software; wearable measuring devices comprising of sensors for measuring skin condition; multifunctional electronic devices for tracking and managing personal health and fitness information; facial recognition devices, apparatus and software;

scanners for capturing images for analysis for use in the cosmetic, beauty and skincare fields; Internet of Things [IoT] sensors; wearable digital electronic devices; wearable computer peripherals.

Class 35 Virtual retail services and virtual department store retail services connected with the sale of preparations and substances for the conditioning, care and appearance of the skin, body, face, eyes, hair, scalp, teeth and nails, perfumed or fragranced articles, soaps, personal cleansing preparations, shower gels, bath gels, bath preparations, perfumery, eau de parfum, toilet waters, deodorant preparations for personal use, anti-perspirants; virtual retail services and virtual department store retail services connected with the sale of cosmetics, colour cosmetics, eye cosmetics, nail cosmetics, lip cosmetics and make up removers; virtual retail services and virtual department store retail services connected with the sale of cosmetic impregnated tissues; shampoos, hair conditioners, preparations for the hair, hair lotions, dentifrices, sun tanning preparations, sun-screening preparations, shaving preparations, after shave and pre shave lotions and oils, depilatory preparations, essential oils, oils for toilet purposes, pomanders, potpourris, perfumed drawer liners, fragranced sachets for drawers, incense, aromatic plant extracts; virtual retail services and virtual department store retail services connected with the sale of illuminants, lamp oils, candles, scented candles, candle making kits and wicks, eyewear and sunglasses, leather goods, leather accessories, leather boxes, leather coasters, leather pouches, leather cases and leather bags, kitchen utensils and containers, cookware and tableware, glassware, porcelain and earthenware; virtual retail services and virtual department store retail services connected with the sale of printed matter, photographs, stationery, notebooks, gift cards, calendars and wrapping paper, textiles and textile goods; virtual retail services and virtual department store retail services connected with the sale of handheld mobile devices for assessing skin condition, facial mapping, skin mapping and producing simulations of makeup application, tailor-made cosmetic and care products; virtual retail services and virtual department store retail services connected with the sale of wearable digital electronic devices capable of providing access to the internet, for sending, receiving and storing of telephone calls, electronic mail, and other digital data, smartphones, wearable measuring devices comprising of sensors for assessing skin condition.

Class 44 Virtual provision of beauty treatments, perfumery and beauty salon services, cosmetology services and fashion and beauty consultation services.