



# Trade Marks Law & Practice: Shaping New Developments into Solution-Focused Advice for your Clients White Paper conferences 2023



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# How do you distinguish and differentiate in 'indirect confusion' cases, and what evidence will get you over the line?

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*Victoria Jones*

## LA Sugar - What is indirect confusion?

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- 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 recognised that the later mark is different from the earlier mark but **taking account of the common element in the context of the later mark as a whole**, the consumer concludes that it is another brand of the owner of the earlier mark.

## LA Sugar - the examples

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### The 3 examples:

- ✓ Where the common element is so **strikingly distinctive**
- ✓ Where the later mark simply **adds a non-distinctive element** to the earlier mark
- ✓ Where the earlier mark comprises a number of elements and a change of one element appears entirely **logical and consistent with a brand extension**

## Liverpool Gin Distillery Ltd v Sazerac Brands LLC

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- LA Sugar is not an exhaustive definition
- Another category of indirect confusion = co-branding (through a merger, acquisition or licensing)
- *“Trade mark law is all about consumers’ unwitting assumptions, not what they can find out if they think to check”*

## Cheeky Italian – it's not a consolation prize!

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- Where there is no direct confusion you need a reasonably special set of circumstances for a finding of a likelihood of indirect confusion
- Need to be specific as to the mental process involved on the part of the average consumer

## Independent distinctive character

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### Lionsgate Entertainment Inc v Telegraph Media Group:

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*Essentially Medion [2006] E.T.M.R. 13 is a very structured way of addressing whether the use of the composite mark would cause ‘indirect confusion’ in the mind of the average consumer*

– **Phillip Johnson, Appointed Person**

”

## The Common Element – Distinctive component?

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- ✓ Word Class
- ✓ Word position
- ✓ Word meaning
- ✓ Inherent distinctiveness
- ✓ Use/promotion of the common element by C or others
- ✓ The relevant market
- ✗ Evidence of other marks on the register
- ✗ Opinion evidence

## The Common Element – Distinctive component?

### EAGLE RARE

*“The mark Eagle Rare self-evidently comprises two separate words, one of which is a **strong substantive** and the other an **adjective**, in the nature of a **qualification or description**.”*

*“...given the inherently distinctive character of the Trade Marks, in that **no other bourbon whiskey in the UK had a name that included the word ‘eagle’**...”*

## Don't forget the other components

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- **EAGLE RARE/AMERICAN RARE**

*“use of ‘rare’ in this way is common in the aged spirits market and would be recognised as such by the average consumer of bourbon”*

- **SKY/GENTING SKYWORLDS**

*“in the context of theme park and amusement park services the **WORLDS** element is entirely descriptive”*

## When it doesn't work out

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### **RED BULL**

*“The words in the...mark also form a unit and would be understood as referring to a male bovine animal that is red in colour. **The distinctive character of the mark lies in the combination of the words, i.e. the mark as a whole.**”*

## The Common Element – Distinctive component?

### MATCH.COM

*“What the history does show is that, throughout Match’s trading in the UK ... **the branding of Match’s services has generally involved some level of emphasis on the ‘match’ element of the Match marks**”*

*“the evidence shows that...**many people were referring to the business simply as ‘Match’**”*

## Nature of indirect confusion

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### **EAGLE RARE/AMERICAN EAGLE**

*“it was a very common pattern in the whisky and bourbon market to have many different expressions under the same branding, including plays on the brand name.”*

### **SKY/GENTING SKYWORLDS**

*“the evidence submitted by the Respondent includes examples of co-branding, including with Netflix and WWF”*

## When it doesn't work out

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**RAINBOW/RAINBOW RANGERS**

**RANGERS/RAINBOW RANGERS**

*“...the distinctive character of [RAINBOW RANGERS] is in the combination of the words...with no word dominating....”*

*“the combination of the words RAINBOW and RANGERS give the Application a different impression from the RAINBOW marks and the RANGERS mark...”*

## Indirect confusion - Stylised marks

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*“Although the stylised aspects of each mark are not very remarkable, the fact remains that these aspects are entirely different.”*

## Indirect confusion - Stylised marks

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WeFix



*“there would be indirect confusion in this instance because consumers would think that the contested mark represented an updated version or variant of the earlier logo, or vice versa.”*

## Evidence of actual confusion

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- Indirect confusion is inherently less likely to come to light than direct confusion
- Requiring extensive searches in every case will not necessarily result in a finding of no likelihood of confusion if the Judge is of the view that such confusion would not have been detected
- Use of social media makes it easier than it used to be for instances of confusion to be publicised

## Take away points

### **CLAIMANT**

- Distinctiveness of the common element
- The relevant market: Market share/brands/habits/trends
- Branding activities & nature of indirect confusion

### **DEFENDANT**

- Composite whole/unit/combinations
- Additional elements/stylisation
- Why would confusion come to light in this case?

A man in a blue suit is seen from behind, standing with his hands on his hips and one hand scratching his head. He is looking at a dark blue wall covered in various styles of question marks. The scene is lit from the side, creating a soft glow on the wall.

It's time for *Questions & Answers*

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Questions welcome

# 3PB Barristers

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