

**O-235-18**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3250531**

**BY HARRIETT HARLAND**

**TO REGISTER IN CLASS 25 THE FOLLOWING TRADE MARK:**

**This Is Me**

**AND IN THE MATTER OF OPPOSITION THERETO**

**UNDER NO. 60000753**

**BY WE BRAND S.A.R.L**

## **Background and pleadings**

1. On 15 August 2017, Harriett Harland applied to register the trade mark **This Is Me** for the following goods:

Class 25      Mock turtleneck shirts; Snap crotch shirts for infants and toddlers; Tennis shirts; Turtleneck shirts.

2. The application was published for opposition purposes on 1 September 2017. It is opposed by WE Brand S.a.r.l (“the opponent”) under the fast-track opposition procedure. The opposition, which is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), is directed against all of the goods in the application.

3. The opponent relies upon its International (EU) trade mark registration number 1243721 for the following trade mark:



4. The opponent’s trade mark has an international registration date of 9 January 2015, with the EU designated on the same date. The mark was granted protection in the EU on 25 February 2016. A priority date of 22 October 2014 is claimed. The mark is protected for a range of goods in classes 9, 25 and 35; for the purposes of this opposition, the opponent relies upon the following goods:

Class 25      Clothing, footwear, headgear, namely woollen hats, hats and caps; belts.

5. Given its date of filing, the opponent’s mark qualifies as an earlier trade mark under the provisions in s. 6(1) of the Act. As the earlier mark had not been registered for five years or more at the publication date of the opposed application, it is not subject to the

proof of use provisions contained in section 6A of the Act. The opponent can, as a consequence, rely upon all of the goods it has identified.

6. The opponent claims that the marks are visually, phonetically and conceptually very similar and that there is “a high risk of confusion”, which is increased because the goods are identical.

7. Ms Harland filed a counterstatement denying the grounds of opposition. As I have no other comments from Ms Harland, her comments are reproduced in full below:

“This is me and We is me are in completely different countries.

This is me is a charity helping bullied children which we sell one t shirt with the logo on to support the charity.

We is me is a large clothing operation there would be no confusion over this as I am not going to be advertising or aiming the charity at anywhere but the UK and we is me would not come up in the uk as it doesn't make sense to us.

We are both completely different enteries the meaning behind this is me is because I'm telling kids to be who they are after being bullied so not having this is me will just ruin the whole concept of the charity.

I am never going to be selling any clothing other then the t shirts and we won't be selling them on a website so I don't understand how we are such a treat to the trademark” [all sic].

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

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

9. The effect of the above is to require the parties to seek leave in order to file evidence (other than the proof of use evidence which is filed with the notice of opposition) in fast track oppositions. Neither party sought leave to file evidence.

10. 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. Only the opponent filed written submissions, which I will bear in mind. This decision is taken following a careful reading of the papers.

11. Ms Harland is a litigant in person. The opponent has been represented throughout by Nucleus IP Limited.

### **Preliminary issue**

12. Ms Harland has made a number of comments in her counterstatement relating to the differences between the countries in which the marks are used, the different entities themselves and the way in which she intends to advertise and sell her goods. Whilst these submissions are understandable, they will have no effect on my decision. That is because a trade mark is essentially a claim to legal property. Every registered trade mark is entitled to legal protection against the use or registration of the same or similar trade marks for the same or similar goods and services, if there is a likelihood of confusion. As the opponent's mark had not been registered for five years at the date of publication of Ms Harland's mark, the opponent can rely upon all of the goods it has identified, without showing any evidence of use of the trade mark. My decision will therefore be made on the basis of the 'notional' use of the earlier mark for all of the

goods upon which the opponent relies. This concept of notional use was explained by Laddie J in *Compass Publishing BV v Compass Logistics Ltd* ([2004] RPC 41) like this:

"22. [...] It must be borne in mind that the provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to be a finding of infringement. Similarly, even when the proprietor of a registered mark uses it, he may well not use it throughout the whole width of the registration or he may use it on a scale which is very small compared with the sector of trade in which the mark is registered and the alleged infringer's use may be very limited also. In the former situation, the court must consider notional use extended to the full width of the classification of goods or services. In the latter it must consider notional use on a scale where direct competition between the proprietor and the alleged infringer could take place".

13. The matter of the countries in which the marks are used is not relevant, as the opponent's mark is entitled to protection throughout the EU. It may be relied upon to oppose a UK application (the UK being part of the EU), whether or not it is currently in use in the UK. The use which Ms Harland has made or intends to make of her trade mark is also not relevant. In *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited* (Case C-533/06), the Court of Justice of the European Union ("CJEU") stated at paragraph 66 of its judgment that, when assessing the likelihood of confusion in the context of registering a new trade mark, it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered. As a consequence, despite Ms Harland's statements about the way in which she will use the mark, my assessment must only take into account the applied-for mark (and its specification) and any potential conflict with the earlier trade mark. Any differences between the parties

themselves or their trading styles are not relevant unless they are apparent from the applied-for and registered marks.

### **Section 5(2)(b)**

14. 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”.

15. 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. The principles are:

(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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### **Comparison of goods**

16. 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 fur Lernsysteme 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”.

17. Registration is sought for “mock turtleneck shirts; snap crotch shirts for infants and toddlers; tennis shirts; turtleneck shirts”, all of which are articles of clothing and are therefore included within the unlimited term “clothing” in the earlier specification. The goods are identical on the principle outlined in *Merica*.

### **The average consumer and the nature of the purchasing act**

18. 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 in question: *Lloyd Schuhfabrik*. 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”.

19. The parties have not commented on the average consumer, nor on the purchasing process.

20. The average consumer of the goods at issue, which are general consumer goods, is a member of the general public. The average consumer will wish to ensure that the goods are, for example, the desired fit, colour or style. Consequently, an average degree of attention will be paid to their selection. The goods at issue are generally sold through bricks and mortar retail premises (such as shops on the high street, or in supermarkets) and online. The goods will normally be chosen via self-selection from a shelf or a website, or perhaps from a catalogue. In *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03, the General Court (“GC”) stated that:

“50. [...] Generally in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly the visual aspect plays a greater role in the global assessment of the likelihood of confusion”.

21. Consequently, while I do not rule out that there may be an aural component (advice may, for example, be sought from a shop assistant), when considered overall, the selection process will be mainly visual.


### **Comparison of trade marks**

22. It is clear from *Sabel* (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 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”.

23. It would be wrong, therefore, artificially to 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 marks.

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

Opponent's trade mark	Ms Harland's trade mark
	<p data-bbox="1045 415 1195 445">This Is Me</p>

25. The opponent asserts in its written submissions that the marks have a high degree of visual similarity because they coincide in two out of three words and that the consumer will focus on the word elements of the earlier mark, rather than any stylisation it contains. It submits that they are aurally similar.

26. The earlier mark consists of the words “WE IS ME”, presented in capital letters in a very slightly stylised typeface. The words are in white and are placed one below the other on a rectangular black background. None of the words dominates the others. The overall impression is dominated by the words. The stacked presentation, stylised typeface and the black background play weaker roles.

27. The applied-for mark consists of the words “This Is Me”, presented in title case. The words form a complete and grammatically correct phrase, in which the overall impression and distinctiveness of the mark rest.

28. An obvious point of similarity between the marks is that their second and third words (“IS ME” and “Is Me”) are the same: the difference in casing is not material, as notional and fair use would extend to, at least, the application being presented in capital letters. There is a visual difference because of the differing first words in the marks, i.e. “WE” and “This”, and because of the particular presentation of the earlier mark. Taking all of

these factors into account, I consider that the marks are visually similar to a medium degree.

29. The presentational differences between the marks will have no bearing on the aural comparison. Both marks will be articulated entirely conventionally. They are both three words (and syllables) long, with a different first word and identical second and third words. Given that the point of difference is at the beginning of the marks, where its impact is more noticeable, there is a medium degree of aural similarity.

30. Although the opponent submits that the words in the earlier mark “create a unit (the meaning of which is different from the individual words of which it is composed)” and that it will be “understood by the average consumer as the phrase “WE IS ME””, it does not specify what meaning will be given to this unified whole. For my part, I am not able to identify a clear concept to be attached to the phrase.<sup>1</sup> The mark applied for, in contrast, is a statement of an individual’s identity. Any conceptual similarity is based on the “is me” idea in the marks. I consider that the conceptual similarity between the marks is of a lower than medium degree.

### **Distinctive character of the earlier trade mark**

31. The distinctive character of a trade mark must be assessed. This is because, the more distinctive a trade mark, either inherently or because of the use made of it, the greater the likelihood of confusion (see *Sabel* at [24]). In *Lloyd Schuhfabrik*, 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

---

<sup>1</sup> For a conceptual message to be relevant, it must be capable of immediate grasp by the average consumer (see Case C-361/04 P *Ruiz-Picasso and Others v OHIM* [2006] ECR I-00643; [2006] E.T.M.R. 29).

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-2779, 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)".

32. There are no submissions from the parties regarding the distinctive character of the earlier mark. As no evidence of enhanced distinctiveness has been filed, I have only the inherent position to consider. Invented words normally have a high degree of inherent distinctive character, whilst words which are highly allusive of the goods would normally have the lowest. The earlier mark in these proceedings consists of three dictionary words which are neither allusive nor descriptive in relation to the goods at issue. The mark has a medium degree of inherent distinctive character.

### **Likelihood of confusion**

33. The factors considered above have a degree of interdependency (*Canon* at [17]), so that a higher degree of similarity between the goods may be offset by a lower degree of similarity between the marks, and vice versa. I must make a global assessment of the competing factors (*Sabel* at [22]), considering them from the perspective of the average consumer and deciding whether the average consumer is likely to be confused. In

making my assessment, I must keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

34. Confusion can be direct or indirect. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., sitting as the Appointed Person, explained these types of confusion as follows:

“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”).

35. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made simply because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

36. I also note Mr Mellor’s comments in *Ashish Sutaria v Cheeky Italian Limited* (BL O/219/16), where, again sitting as the Appointed Person, he pointed out at [16] that:

“if [...] the differences between the marks are such that there is no likelihood of direct confusion, one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion”,

and that:

“it is necessary to be specific as to the mental process involved on the part of the average consumer. Whilst the categories of case where indirect confusion may be found is not closed, Mr Purvis’ three categories are distinct, each reflecting a slightly different thought process on the part of the average consumer”.

37. Turning first to the question of direct confusion, it seems to me that, notwithstanding the concept of imperfect recollection, and while keeping in mind that identical goods are

at issue, the visual, aural and conceptual differences between the marks are such that there is no likelihood of one mark being mistaken for the other. As for indirect confusion, whilst I note the opponent's submission that "the public will perceive trade marks used in the fashion industry that have elements in common as originating from the same companies", it is clear from the case law cited above that it is by no means inevitable that a common element in the marks will cause the consumer to believe that goods emanate from economically connected undertakings. I do not consider that the instant case falls in any of the categories identified by Mr Purvis. The common element does not, in my view, possess such a level of distinctive character that it would lead the average consumer to assume that there is an economic connection between the marks, nor is it simply a matter of a non-distinctive element being added. The strongest point would be that the applied-for marks constitutes a brand extension or variant mark but I can see no logical process which would lead the average consumer to assume that the substitution of a demonstrative pronoun for a personal pronoun is a brand extension, nor that the meaningless "WE IS ME" mark, with its stylisation, is related to the applied-for "THIS IS ME" mark, which has a distinct concept. Despite the common word elements, and notwithstanding the dominance of the words over the stylisation in the earlier mark, I do not consider that there is a likelihood of indirect confusion.

## **Conclusion**

38. The opposition fails and, subject to appeal, the application will proceed to registration.

## **Costs**

39. Ms Harland has been successful and is entitled to a contribution towards her costs. Awards of costs in fast-track proceedings are governed by Tribunal Practice Notice ("TPN") 2 of 2015. Bearing that TPN in mind, I award costs to Ms Harland on the following basis:



Considering the notice of opposition  
and preparing the counterstatement £200

Total: £200

40. I order WE Brand S.a.r.l to pay Harriett Harland the sum of **£200**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 16<sup>th</sup> day of April 2018**

**Heather Harrison**  
**For the Registrar**