

O/754/18

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003260189 BY  
LANCE JOHNSTON  
TO REGISTER THE FOLLOWING SERIES OF MARKS IN CLASS 25:

**LifeWear Clothing**

AND

**LIFEWEAR CLOTHING**

AND

IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 411359 BY  
FAST RETAILING CO., LTD

## BACKGROUND AND PLEADINGS

1. On 29 September 2017, Mr Lance Johnston (“the applicant”) applied to register the series of marks shown on the cover page of this decision in the UK. The application was published for opposition purposes on 13 October 2017. The applicant seeks to register its marks for the following goods:

Class 25      Clothing and headwear.

2. The application was opposed by Fast Retailing Co., Ltd (“the opponent”). The opposition is based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”).

3. The opponent relies on the following earlier UK Trade Mark registration no. 3000123 for its opposition under sections 5(2)(b) and 5(3):



LifeWear

4. The opponent’s mark has an application date of 2 April 2013 and a registration date of 16 August 2013. The opponent relies on (and claims it has a reputation in respect of) all goods for which the earlier mark is registered, namely:

Class 25      Clothing; coats; sweaters; shirts; layettes [clothing]; waterproof clothing; wedding dresses; trousers; jogging pants; sweat pants; swimwear; night gowns; negligees; Japanese sleeping robes [Nemaki]; pajamas; bathrobes; underwear; undershirts; corsets [underclothing]; combinations [clothing]; chemises; drawers and underpants; slips; panties, shorts and briefs; brassieres; petticoats; hosiery; camisoles; tee-shirts; gloves and mittens [clothing]; scarves [scarfs]; headgear;

garters; sock suspenders; suspenders [braces]; waist belts; belts; footwear; sports shoes; masquerade costumes; clothes for sports; football shoes.

Class 35 Advertising; business management; business administration; office functions; marketing; retail and whole sale services connected with the sale of woven fabrics, beddings, towels, clothing, footwear, headgear, bags, pouches, purses, and personal articles; organising fashion shows for advertising and sales; organising exhibitions and trade fairs for advertising and sales.

5. Under section 5(2)(b) the opponent claims there is a likelihood of confusion because the respective goods and services are identical or similar and the marks are similar.

6. Under section 5(3) the opponent claims that the earlier mark has a reputation in respect of all goods and services for which it is registered and that use of the applicant's mark would, without due cause, take unfair advantage of, or be detrimental to, the distinctive character and/or repute of the earlier mark.

7. The opponent further relies on section 5(4)(a) of the Act and claims that the same sign as shown in paragraph 3 above and the sign **LIFE WEAR** have been used throughout the UK since September 2013 in respect of the goods and services listed in paragraph 4 above.

8. The applicant has filed a counterstatement denying the grounds of opposition.

9. The opponent is represented by Maucher Jenkins and the applicant is unrepresented. The opponent filed evidence in the form of the witness statement of Rika Yamazaki dated 22 June 2018 and the witness statement of John Parsons dated 13 July 2018. The opponent's evidence was accompanied by written submissions dated 13 July 2018. No evidence was filed by the applicant. No hearing was requested and neither party filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

## **EVIDENCE**

10. As noted above, the opponent's evidence consists of the witness statement of Rika Yamazaki dated 22 June 2018, with 24 exhibits, and the witness statement of John Parsons dated 13 July 2018, with 5 exhibits. The opponent's evidence was also accompanied by written submissions. Whilst I do not propose to summarise those submissions here, I have taken them into consideration and will refer to them below as appropriate.

### **Ms Yamazaki's Evidence**

11. Ms Yamazaki is an Associate at Kubota Law and has acted on behalf of the opponent since 2012. Ms Yamazaki states that the opponent is a well-known fashion retailer and clothing apparel company. She states that the opponent was founded in 1963, opened its first store in 1984 and now has around 3,000 stores worldwide. Ms Yamazaki states that the opponent now has 11 stores in the UK, with its first being opened in London on 28 September 2001.

12. Exhibit RY1 to Ms Yamazaki's statement is a printout of an online article from the website [www.telegraph.co.uk](http://www.telegraph.co.uk) dated 28 September 2001, which states:

“Uniqlo, Japan's top-selling casualwear retailer, opened its first four British stores yesterday in Knightsbridge, Wimbledon, Romford and Uxbridge.”

13. Exhibit RY2 to Ms Yamazaki's statement is a printout from the opponent's website which provides information about the opponent's presence in the EU market. The page confirms that the opponent has stores in France, Russia, Germany, Belgium and Spain and is due to open stores in Sweden and the Netherlands.

14. It states that the first store in the UK was opened on 28 September 2001 and confirms that the opponent has 11 stores across the UK. The print date displayed is 18 May 2018 and the article states that it was last updated on 2 May 2018. The “UK” section of the webpage has links to three articles which all relate to the opponent's

“flagship” store in London. The opponent’s mark is not displayed but the first of these articles states: “311 Oxford Street store to offer best possible customer experience, including special floor to showcase LifeWear concept...”.

15. Exhibit RY3 to Ms Yamazaki’s statement consists of a number of articles which covered the re-launch of the opponent’s flagship store in London in 2016. The first is from the website [www.drapersonline.com](http://www.drapersonline.com). The article is dated 15 February 2016 and is entitled “Uniqlo to reopen expanded flagship”. It states that the store will “house a new “conceptual sales area” for its LifeWear range”. The second is from the website [www.retailgazette.co.uk](http://www.retailgazette.co.uk). The article is dated 15 February 2016 and is entitled “UNIQLO to reopen Oxford Street flagship store”. It states that the new store presents an opportunity to “showcase LifeWear”. The third is from the website [www.theretailbulletin.com](http://www.theretailbulletin.com) and is dated 18 March 2016. It is entitled “Uniqlo reopens refurbished London flagship” and states that it will include special areas “devoted to the brand’s LifeWear concept”. The final article is from the website [www.standard.co.uk](http://www.standard.co.uk) and is dated 15 March 2016. It is entitled “Uniqlo reopens its flagship store, discover how the brand turned wardrobe staples into a success story”. The final article makes no reference to “LifeWear”.

16. Ms Yamazaki states that the opponent is “ranked in the top 5 global apparel manufacturer and retail businesses”. The first page of Exhibit RY4 to Ms Yamazaki’s statement lists “FAST RETAILING (UNIQLO)” as the third major global apparel manufacturer and retailer, with sales of 17.34billion dollars for the year ending August 2017. The second page shows a graph which lists “FAST RETAILING (UNIQLO)” as the second global apparel manufacturer and retailer when ranked by market capitalization. This is dated 28 February 2018.

17. Ms Yamazaki states that in 2016 the opponent was listed in the top 100 most valuable brands by Forbes. Exhibit RY5 to Ms Yamazaki’s statement consists of a print out from the Forbes’ website which lists Uniqlo as number 91 in the list of the world’s most valuable brands as of May 2016. The second print out in Exhibit RY5 is an article from [apparelresources.com](http://apparelresources.com) and is entitled “Uniqlo commits to increase sourcing from India” and is dated 16 December 2014. Exhibit RY6 is a printout from

Fashion United dated 13 March 2017 which lists “Uniqlo” as one of the top 50 most valuable brands for 2017.

18. Ms Yamazaki states that the opponent has “created a brand concept whereby it creates comfortable, high-quality, fashionable clothing at prices that everyone can afford” which the opponent has called “LifeWear”. Exhibit RY7 to Ms Yamazaki’s statement consists of various publications produced by the opponent which explain the brand concept behind LifeWear.

19. Exhibit RY8 to Ms Yamazaki’s statement consists of articles which reference LifeWear. The first is from [www.fashionbeans.co.uk](http://www.fashionbeans.co.uk) and is dated 18 December 2015. The second is from [www.forbes.com](http://www.forbes.com) and is dated 14 September 2016. The third is from [www.highsnobiety.com](http://www.highsnobiety.com) and is dated 7 June 2016. They all mention the words “LifeWear” in their text.

20. Exhibit RY9 to Ms Yamazaki’s statement consists of undated print outs from the opponent’s website which show a “LifeWear” tab and a page displaying the earlier mark.

21. Ms Yamazaki states:

“The LifeWear Mark has been used since March 2013 and is used extensively in the marketing and promotion of the Opponent’s business.”

22. Exhibit RY10 is a photo of a catalogue called “The LifeWear Book” that Ms Yamazaki states was offered to customers in one of the opponent’s stores. No information is provided as to which store this is available from. Exhibit RY11 also consists of examples of the LifeWear book which Ms Yamazaki states have been distributed in the UK in 2015 and 2016. These appear to be collections of personal stories about individuals combined with examples of clothing items sold by the opponent. The goods are all priced in dollars. The words “UNIQLO LIFEWEAR” appears in the footer of most double-page spreads and the earlier mark is displayed on the brochures. The stores listed at the back of the brochures are all based in the United States.

23. Exhibit RY12 shows the use of the opponent's mark on its website. The printout is undated and displays the goods for sale in pounds sterling.

24. Exhibit RY13 consists of examples of the opponent's mark being used in its stores. Ms Yamazaki states that the provided examples are taken from the opponent's "Westfield London White City and Regent Street stores" and from use in digital media marketing. Exhibit RY14 shows use of the opponent's mark on a sign stating: "Men's Collection". It also shows the opponent's mark used on a poster, although this is not in English and so is presumably not displayed in a store in the UK. The former is presumably the one that Ms Yamazaki states is taken from the opponent's store on Oxford Street. None of the examples are dated.

25. Exhibit RY15 is an example of the opponent's mark used on the store front in Oxford Street. Exhibit RY16 shows the opponent's mark used in black on tags attached to various items of clothing. None of the examples are dated.

26. Exhibit RY17 consists of screenshots from the opponent's YouTube channel and shows the opponent's mark being used. A video entitled "UNIQLO The Science of Lifewear/ Knitwear" is stated to have been viewed 1,471 times. It is dated 15 September 2016, but no print date is given. Exhibit RY18 consists of a number of screen shots taken from YouTube videos which show the opponent's mark being used. The videos were published between 18 August 2014 and 5 June 2017. They have between 1,230 and 94,634 views. No information is provided as to the location of the viewers.

27. Exhibit RY19 consist of examples from the opponent's 2016 Christmas marketing campaign and examples of advertisements used on the London Underground tube carriages and stations, which display the opponent's mark.

28. Ms Yamazaki states that the opponent sponsors various sports stars to enhance its reputation. Exhibit RY20 consists of a list of stars sponsored by the opponent taken from its website. It also contains an article taken from BBC News dated 16 January

2015, which discusses the opponent's involvement with various sports stars including a picture which shows "UNIQLO" on Djokovic's tennis clothing.

29. Ms Yamazaki states that the opponent has recently partnered with the Tate gallery in London to support its late night exhibition and has sponsored the Guardian's fashion webpage. Exhibit RY21 to Ms Yamazaki's statement consists of two articles which make reference to the opponent's partnership with the Tate. The first is undated and calls the event "UNIQLO TATE LATES". It also displays the opponent's mark under the words "IN PARTNERSHIP WITH". This event took place in May 2018. The second article is dated 10 March 2016 and is entitled "Uniqlo partners with Tate Modern as part of global store relaunch campaign". No reference is made to the opponent's mark.

30. Exhibit RY22 consists of a number of examples of collaboration with designers. The pages show the name of the designer in combination with the graphic elements of the opponent's mark to distinguish between these different ventures. It also consists of two articles which discuss the collaborations and which are both dated in 2018.

31. Exhibit RY23 to Ms Yamazaki's statement consists of press articles from across the EU which refer to the opponent, specifically:

a) An article from the Telegraph dated 12 March 2016 which references UNIQLO and LifeWear.

b) An article from Fashion Network dated 26 October 2017 which references UNIQLO and LifeWear.

c) An article from Cosmopolitan dated 1 July 2015 which references UNIQLO.

d) An article from the Independent dated 16 March 2016 which references UNIQLO and LifeWear.

e) An article from the Guardian dated 16 April 2015 which references UNIQLO and LifeWear.



f) An article from Vogue dated 10 December 2015 which references UNIQLO and LifeWear.

g) An article from Vogue dated 19 March 2018 which references UNIQLO.

32. Ms Yamazaki states that the opponent makes active use of social media and uses the hashtag - #uniqlolifewear – so that customers can follow its new products and trends. Exhibit RY24 to Ms Yamazaki’s statement consists of examples of the opponent’s use of social media. The first print out is an example of the UNIQLO account using the above hashtag in relation to pictures of its clothing. These are dated from 20 December 2017 to 10 May 2018. The second print out is taken from Instagram and shows various photographs that have been posted using the above hashtag. One of the pictures displays the opponent’s mark. None of the posts are dated. The third print out shows the UNIQLO UK Facebook account. This was established in 2009 and has 31,900 followers and 3,009 ‘likes’. None of the posts shown relate to the LifeWear brand or display the opponent’s mark.

33. Ms Yamazaki states that significant amounts have been spent on developing and promoting the LifeWear mark in the UK and the EU. She states that the following sales figures are attributable to the LifeWear mark in the past three years (although it is not specified whether this is in relation to the UK only):

Date Period	Sales Figures
September 2015 – August 2016	£132,223,986
September 2016 – August 2017	£155,668,047
September 2017 – August 2018	£138,318,765

### **Mr Parsons’ Evidence**

34. Mr Parsons is an Associate Solicitor at Maucher Jenkins, the opponent’s representatives in these proceedings.

35. Mr Parsons states that the website [www.lifewearclothing.co.uk](http://www.lifewearclothing.co.uk) sells clothing in the form of t-shirts, jumpers, hats and hoodies. Mr Parsons states that Exhibit RP1 shows a selection of printouts from that website. The print outs are undated and display the following mark:



36. Exhibit RP2 is a print out from whois.net which provides details of the ownership of the domain name [www.lifewearclothing.co.uk](http://www.lifewearclothing.co.uk).

37. Exhibit RP3 consists of a selection of print-outs from the social media pages linked to the above website. The twitter account for LifewearClothing has 133 followers. The LifeWear Clothing Facebook page has 793 'likes' and 771 followers. The account's posts date back to 2016. I understand from the opponent's written submissions that these three exhibits have been provided because the opponent believes that the website [www.lifewearclothing.co.uk](http://www.lifewearclothing.co.uk) is the applicant's website.

38. Exhibit RP4 consists of a selection of articles which discuss the opponent's profit and ranking in the 2016 Forbes list. Exhibit RP5 is a print out which discusses the opponent's position in the retail sector. This talks about Uniqlo but does not reference the earlier mark.

## **PRELIMINARY ISSUES**

39. In his counterstatement, the applicant has stated that the way in which his mark is presented in practice is very different to the opponent's because it is stylised and is accompanied by a logo. The opponent has provided pictures of what it states is the applicant's website. However, the stylisation and/or logo referred to do not form part

of the application which is the subject of these proceedings. For the avoidance of doubt, it is the marks as applied for/registered which are relevant to this decision.

40. In its written submissions, the opponent states:

“23. Moreover, it is apparent from the attached evidence that the Opponent has used LifeWear in a variety of ways. Through these activities, the relevant public and trade have come to associate LifeWear, and variations thereof, with the Opponent. Where there is a consistent use of trade marks, there is the potential for a likelihood of confusion resulting from the consumer being mistaken as to the provenance or origin of goods or services covered by the trade mark applied for because he considers erroneously that it is part of the family of marks which contain a consistent element with which he is already familiar (Case C-234/06 P., *Il Ponte Finanziaria SpA v PHIM*, para. 63).”

41. The ‘family of marks’ argument to which the opponent refers arises in circumstances where a party owns a number of registered marks which are all present on the market and which share a common element, with the result that use of another mark, which shares that common element, creates a likelihood of confusion because the average consumer considers that mark to be part of the other party’s ‘family’ of marks. The opponent has relied upon only one registered mark for the purpose of this opposition and several would be needed to demonstrate a family of marks. In any event, if the opponent wanted to rely on this argument it should have been pleaded in its Notice of Opposition. The argument cannot succeed and I will disregard the opponent’s ‘family of marks’ argument in reaching my decision.

## **DECISION**

42. Section 5(2)(b) of the Act reads as follows:

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

(a)...

(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.”

43. Section 5(3) of the Act states:

“5(3) A trade mark which -

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.”

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

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

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

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if

registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b) subject to its being so registered.”

45. The opponent’s mark qualifies as an earlier trade mark under the above provisions. In his counterstatement, the applicant requested that the opponent prove use of its earlier mark. However, as the earlier mark had not completed its registration process more than 5 years before the publication date of the application in issue in these proceedings, it is not subject to proof of use pursuant to section 6A of the Act. The opponent can, therefore, rely upon all of the goods and services it has identified.

46. Section 5(4)(a) of the Act states:

“5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

b) ...

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark”.

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

47. 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:

(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 to mind the earlier mark, 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**

48. In its Notice of Opposition, the opponent confirms that it wishes to rely on all goods and services for which the earlier mark is registered. However, in my view, it is the opponent's class 25 goods which contain the strongest comparison with the applicant's goods. I have, therefore, only reproduced those goods in the table below:

<b>Opponent's goods</b>	<b>Applicant's goods</b>
<u>Class 25</u> Clothing; coats; sweaters; shirts; layettes [clothing]; waterproof clothing; wedding dresses; trousers; jogging pants; sweat pants; swimwear; night gowns; negligees; Japanese sleeping robes [Nemaki]; pajamas; bathrobes; underwear; undershirts; corsets [underclothing]; combinations [clothing]; chemises; drawers and underpants;	<u>Class 25</u> Clothing and headwear.

slips; panties, shorts and briefs; brassieres; petticoats; hosiery; camisoles; tee-shirts; gloves and mittens [clothing]; scarves [scarfs]; headgear; garters; sock suspenders; suspenders [braces]; waist belts; belts; footwear; sports shoes; masquerade costumes; clothes for sports; football shoes.	
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49. I have no submissions from the applicant on the similarity of the goods. In its Notice of Opposition, the opponent states:

“9. The goods claimed under the Application in Class 25 are identical to the goods for which the Earlier Mark is protected.”

50. “Clothing” appears in both the applicant’s specification and the opponent’s specification. These are self-evidently identical. “Headwear” in the applicant’s specification is plainly identical to “headgear” in the opponent’s specification.

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

51. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods. I must then determine the manner in which these goods are likely to be selected by the average consumer. 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.”

52. I have no submissions from either party on the identity of the average consumer or the purchasing process for the goods in issue. The average consumer for the goods will be a member of the general public. The level of attention paid by the average consumer will vary depending on the nature of the item being purchased. Similarly, the frequency and cost of the purchase will vary depending on the nature of the item. Overall, the level of attention paid by the average consumer during the purchasing process is likely to be at least average.

53. The goods are, in my experience, most likely to be obtained by self-selection from the shelves of a retail outlet or from an online or catalogue equivalent. Consequently, visual considerations are likely to dominate the selection process. However, I do not discount that there may be an aural component to the purchase of the goods, given that advice may be sought from a sales assistant.


### **Comparison of trade marks**

54. 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 Court of Justice of the European Union (“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.”

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

56. The respective trade marks are shown below:

Applicant's trade marks	Opponent's trade mark
LifeWear Clothing  LIFEWEAR CLOTHING	 LifeWear

57. I have submissions from both parties on the similarity of the marks. Whilst I do not propose to reproduce those here, I have taken them all into consideration in reaching my decision.

58. The applicant's marks consist of the conjoined words LIFEWEAR and the word CLOTHING. The word CLOTHING in the applicant's marks is descriptive of the goods to which it relates. In my view, the conjoined words LIFEWEAR play a greater role in the overall impression of the mark, with the word CLOTHING playing a lesser role. The opponent's mark also contains the conjoined words LIFEWEAR which are presented below two red squares. The first square contains, what appears to be, four white symbols. The second square contains the letters U, N, I, Q, L and O, in white font. The overall impression is contained in the combination of the wording and these graphic elements, with the wording and the graphic elements playing equal roles.

59. Visually, the conjoined words LIFEWEAR in both the first mark in the applicant's series and the opponent's mark are presented in lower case with the first and fifth letters in uppercase. The second mark in the applicant's series is presented all in uppercase. As notional and fair use means that the applicant's marks could be used

in any standard typeface, differences created by the capitalisation are not relevant. The similarity lies in the use of these conjoined words across all of the marks. The differences are created by the addition of the word CLOTHING in the applicant's marks and the graphic elements in the opponent's mark. I consider there to be a medium degree of visual similarity between the marks.

60. Aurally, the words LIFE and WEAR, although conjoined, will be given their ordinary English pronunciation. CLOTHING in the applicant's marks will also be given its ordinary English pronunciation. Clearly, the symbols in the opponent's mark will not be pronounced. I also do not consider that the letters U, N, I, Q, L and O in the second red square in the opponent's mark will be pronounced by the average consumer. Their presentation with the first three letters above the last three does not give the appearance of a word, particularly as the letters when combined create a made-up word that will not convey any recognisable meaning to the consumer and the other red square contains symbols which will also have no apparent meaning for the average consumer. I, consequently, consider there to be a high degree of aural similarity between the marks. If I am wrong in my finding, and the letters in the second red square would be pronounced, then there will be a medium degree of aural similarity between the marks.

61. Conceptually, the words LIFE and WEAR create the impression of something that is to be worn by the purchaser for life. That is, something that is long-lasting and/or versatile. The conceptual message created by these conjoined words will be identical for both the applicant's marks and the opponent's mark. The use of the word CLOTHING in the applicant's marks is descriptive of the goods being sold. I do not consider that any conceptual message will be conveyed by the red squares in the opponent's mark and the symbols and letters within them. Even if the letters in the opponent's mark are recognised as being a made-up word this will still not convey any meaning to the consumer. I therefore consider there to be a high degree of conceptual similarity between the marks.

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

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-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).”

63. 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.

64. I have no substantive submissions from either party on the distinctive character of the earlier mark. I must first make an assessment of the inherent distinctiveness of the earlier mark as a whole. The conjoined words LIFEWEAR in the opponent’s mark are allusive to goods that are to be worn. The distinctiveness of the earlier mark lies in the

combination of these conjoined words and the graphic element presented above them. In my view, the earlier mark has a medium level of inherent distinctive character.

65. The opponent has filed evidence to demonstrate that its mark's distinctiveness has been enhanced through use. The opponent has given some examples of its mark being displayed in stores and on product packaging. Various examples are also given of "LifeWear" being referenced in publications. The opponent has achieved a fairly high number of views on its YouTube channel, although the location of the viewers is not known. A number of the exhibits relied upon relate to the success and value of the opponent and its UNIQLO brand, rather than its LIFEWEAR brand. Whilst the sales figures provided are not insignificant, they are relatively low given what is, undoubtedly, a market of significant size. Mr Parsons' evidence mainly focuses on the applicant's use of its mark and does not take the opponent any further in demonstrating enhanced distinctive character. Whilst the opponent's evidence demonstrates that it has used its mark, I am not convinced that it goes far enough so as to demonstrate that the distinctive character of the earlier mark has been enhanced by use.

### **Likelihood of confusion**

66. 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 that 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. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade mark, the average consumer for the goods 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.

67. I have found the marks to be visually similar to a medium degree and conceptually similar to a high degree. If the letters UNIQLO in the opponent's mark are not pronounced then the marks will be aurally highly similar. If they are pronounced then the marks will be aurally similar to a medium degree. I will proceed on the basis that they are aurally similar to a medium degree as if there is a likelihood of confusion in these circumstances, it follows that there will also be a likelihood of confusion if the marks are aurally similar to a high degree. I have found the earlier mark to have a medium degree of inherent distinctive character. I have identified the average consumer to be a member of the general public who will select the goods primarily by visual means (although I do not discount an aural component). I have concluded that at least an average degree of attention will be paid during the purchasing process. I have found the parties goods to be identical. Notwithstanding the principle of imperfect recollection, it is my view that the average consumer will recognise the absence of the graphic elements from the applicant's marks and will not, therefore, mistake one mark for the other. I am satisfied, therefore, that there is no likelihood of direct confusion.

68. I will now consider whether there is a likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

“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.”

69. Bearing in mind my conclusions listed at paragraph 67 above and the interdependency principle, I consider that the use of the conjoined words “LIFEWEAR” in both the applicant’s marks and the opponent’s mark on identical goods will create an expectation on the part of the consumer that the goods at issue come from the same or economically linked undertakings. In *José Alejandro SL v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, case T-129/01, the General Court noted that “it is common in the clothing sector for the same mark to be configured in various different ways according to the type of product which it designates”. In my view, that is the case here. The consumer will view the marks as different configurations of the same mark which are being used by a single undertaking. There is, therefore, a likelihood of indirect confusion.

### **Final Remarks**

70. As the opposition has been successful in its entirety under section 5(2)(b) there is no need to consider the remaining grounds as they do not materially improve the opponent’s position.

### **CONCLUSION**

71. The opposition has been successful and the application is refused.

### **COSTS**

72. The opponent has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the opponent the sum of **£1,100** as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Preparing a statement and considering the applicant’s statement	£200
Preparing evidence and submissions	£700

Official Fee £200

**TOTAL £1,100**

73. I therefore order Mr Lance Johnston to pay Fast Retailing Co., Ltd the sum of £1,100. This sum should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

**Dated this 26<sup>th</sup> day of November 2018**

**S WILSON**

**For the Registrar**