

**o/751/21**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. UK00003351107**

**BY YE JIANJUN**

**FOR THE FOLLOWING TRADE MARK:**

**Suprcrne**

**IN CLASS 18**

**AND**

**AN APPLICATION FOR A DECLARATION OF INVALIDITY**

**UNDER NO. 503036**

**BY CHAPTER 4 CORP D.B.A. SUPREME**

## BACKGROUND AND PLEADINGS

1. Ye Jianjun (“the proprietor”) applied to register the trade mark shown on the cover page of this decision (“the Contested Mark”) in the UK on 6 November 2018. It was registered on 25 January 2019 for the following goods:

Class 18      Animal harnesses; Animal hides; Animal leashes; Athletic bags; Back packs; Cat o' nine tails; Clothes for animals; Clothing for dogs; Clothing for domestic pets; Clothing for pets; Coats for cats; Coats for dogs; Collars for animals; Collars for pets; Costumes for animals; Dog apparel; Dog bellybands; Dog parkas; Dog shoes; Harness for animals; Make-up bags; Pet clothing; Pet hair bows; Wallets; Wheeled bags.

2. On 17 February 2020, Chapter 4 Corp d.b.a. Supreme (“the applicant”) applied to have the Contested Mark declared invalid under section 47 of the Trade Marks Act 1994 (“the Act”). The application was originally based upon sections 5(2)(b), 5(3), 5(4)(a), 3(6) and 56. However, as neither party filed evidence or requested additional time to file in accordance with Rule 42(4) of the Trade Marks Rules 2008, the application was deemed withdrawn in respect of sections 5(3), 5(4)(a), 3(6) and 56 on 6 January 2021. The application, therefore, proceeds on the basis of section 5(2)(b) only. The applicant relies on the following trade marks:



UK registration no. UK00003011437

Filing date 25 June 2013; registration date 22 November 2013.

Number of marks in series: 2

**(“the 437 Mark”)**



UK registration no. UK00003011586

Filing date 26 June 2013; registration date 27 November 2015.

Number of marks in series: 2

**(“the 586 Mark”)**



European Union trade mark no. 016815763<sup>1</sup>

Filing date 7 June 2017; registration date 25 August 2020.

**(“the 763 Mark”)**

3. The applicant relies on some of the goods and services for which its marks are registered, as underlined in the Annex to this decision. Under section 5(2)(b) the applicant claims that there is a likelihood of confusion because of the similarity of the marks and the goods and services.

4. The proprietor filed a counterstatement denying the claims made.

5. The applicant, at the beginning of the proceedings, was represented by Bear & Wolf IP LLP. However, following the filing of a Form TM33P, the representative was changed to Kemp Little LLP, who were subsequently acquired by Deloitte LLP, the cancellation applicant’s current representatives. The proprietor is represented by The

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<sup>1</sup> Although the UK has left the EU and the transition period has now expired, EUTMs, and International Marks which have designated the EU for protection, are still relevant in these proceedings given the impact of the transitional provisions of The Trade Marks (Amendment etc.) (EU Exit) Regulations 2019 – please see Tribunal Practice Notice 2/2020 for further information.

Trade Marks Bureau. Neither party filed evidence nor requested a hearing, but both parties filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

## **PRELIMINARY ISSUES**

6. Firstly, as noted above, no evidence was filed. However, a document, which was an undated screenshot from The Trade Marks Bureau of the “Buy/Sell Trade Marks” page, was filed by the applicant with written submissions during the evidence rounds on 23 November 2020.

7. On 11 December 2020, the Tribunal replied with the following:

“ [...]

### Applicant’s submissions

I refer to the submissions and annex filed by the cancellation applicant. The registry is unable to accept the documents as filed.

Written submissions should be used to provide legal argument. Any evidence of fact should be provided in a witness statement and any exhibits being provided should be accompanied by a witness statement, in which they should be referred.

[...]

In view of the above the registry will allow a period of 21 days from the date of this letter that is on or before **4 January 2021** has been allowed for the following:

- [...]

- The cancellation applicant to file a Form TM9r (no fee required) to request additional time for the evidence to be filed in an appropriate format.”

8. On 22 December 2020, the applicant refiled only its submissions along with a Form TM9r. It did not refile the amended evidence in relation to which the Form TM9r was needed. On 6 January 2021, the Tribunal wrote out as follows:

“I acknowledge receipt of the amended submissions from which you now have removed reference to the annex. The amended submissions can now be accepted into the proceedings.

The TM9r indicates that it was filed as time was needed to amend the submissions. As a TM9r is not required to file submissions it has not been considered.

I refer to the paragraph in my letter advising that in line with Rule 42(4) of the Trade Mark Rules 2008, evidence would be required for the claims under Section 3, 5(4)(a) and 56 to continue.

As you have neither filed evidence or requested additional time within which to file it, your application will, in accordance to rule 42(4) of the Trade Mark Rules 2008, shortly be deemed withdrawn in respect of grounds other than Section 5(2) of the Trade Marks Act 1994.

The proceedings will therefore continue under section 5(2) only.

If you wish to put forward reasons why this action should not be taken, please ensure that the Registry receives your written comments or a request for a hearing under Rule 63(1) on or before **20 January 2021**.”

9. The applicant did not reply to the Tribunal, nor did they request a hearing. Subsequently, the proceedings have continued under section 5(2) only.

9. Secondly, in the Form TM26(I), the applicant sought to rely upon the above three earlier marks to invalidate the proprietor's mark under section 47 of the Act. However, under its Grounds of Invalidation attached to the Form TM26(I), the applicant listed four earlier marks which it claimed it was relying upon. The fourth earlier mark was the following:



UK registration no. UK00003380415

Filing date 16 July 2018; registration date 22 November 2019.

**(“the 415 Mark”)**

Registered for the following services:

Class 34     Lighters for smokers.

10. Consequently, as the 415 Mark was not contained within the Form TM26(I), it will not be taken into consideration during these proceedings. However, even if it was allowed to proceed, the goods are dissimilar to all of the proprietor's goods and therefore it would not have strengthened the applicant's position.

11. Lastly, in the Form TM26(I), the applicant also submitted that under section 5(2)(b) it was seeking to invalidate some of the proprietor's goods which were listed under schedule 1 and 2. “Pet clothing” was the only part of the specification which was not listed and therefore not subject to the invalidation action. However, in the applicant's later submissions dated 26 May 2021, all of the proprietor's goods were listed as being subject to invalidation.

12. On 18 August 2021, a letter was sent to the applicant asking whether they were applying to amend their statement of grounds to invalidate all of the proprietor's goods. On 31 August 2021, the applicant confirmed that their intention was to invalidate all goods, including “pet clothing”.

13. On the 14 September 2021, the Tribunal wrote out to the proprietor as follows:

“As you have been notified in the letter dated 18 August 2021, in preparing the case for consideration by a Hearing Officer, an inconsistency was noticed in the cancellation applicant’s pleadings. We asked the cancellation applicant to confirm whether they were applying to amend their statement of grounds to invalidate all of the proprietor’s goods.

The cancellation applicant has confirmed that their intention is to invalidate all of your goods applied for including “pet clothing”.

If you have any comment on the matter, you have within the next 7 days, that is until **21 September 2021** to respond to the Tribunal.”

14. The Tribunal did not receive any response from the proprietor; no objection has been raised to the applicant’s pleadings being amended to allow the case to proceed on the basis that all goods for which the contested mark is registered are subject to challenge. I consider that as the applicant was already opposing “clothing for pets” in the proprietor’s specification, this does not unfairly widen the scope of the opposition. Consequently, I will proceed on the basis that all of the proprietor’s goods are being opposed by the applicant.

## **DECISION**

15. Section 5(2)(b) of the Act has application in invalidation proceedings pursuant to section 47 of the Act. Section 47 reads as follows:

“47(1) [...]

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground –

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) [...]

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2ZA) [...]

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if –

(a) the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with their consent in relation to the goods or services for which it is registered –

(i) within the period of 5 years ending with the date of application for the declaration; and

(ii) within the period of 5 years ending with the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application where, at that date, the five year period within which



the earlier trade mark should have been put to genuine use as provided section 46(1)(a) has expired, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) [...]

(2D) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection 2B or 2C to the United Kingdom shall be construed as a reference to the European Union.

(2DA) [...]

(2E) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c).

[...]

(5) Where the grounds of invalidity exists in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) [...]

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall be deemed never to have been made.

Provided that this shall not affect transactions past and closed.”

16. 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 on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

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

17. Section 5(2)(b) 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.”

18. By virtue of their earlier filing dates, all of the applicant’s earlier marks qualify as earlier trade marks pursuant to section 6 of the Act. The 586 and 763 Marks had not completed their registration process more than 5 years before the date of the application for invalidation and, consequently, are not subject to proof of use. As the 437 mark had completed its registration process more than 5 years before the date of the application for invalidity, it is subject to proof of use pursuant to the provisions of section 47. However, as the proprietor did not request that the applicant prove use of its marks, it is entitled to rely upon all of the goods and services identified.

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

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

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive

role in a composite mark, without necessarily constituting a dominant element of that mark;

- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### **Comparison of goods and services**

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

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut for 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.”

21. Guidance on this issue has come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and, in particular, whether they are or are likely to be found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance, whether market research companies, who of course act for industry, put the goods or services in the same or different sectors

22. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“... 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.”

23. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

“I should add that I see no reason to give the word “cosmetics” and “toilet preparations”... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context.”

24. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as the then was) stated that:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

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

“... there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think the responsibility for those goods lies with the same undertaking.”

26. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. chicken against transport services for chickens. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected

undertakings. As Mr Daniel Alexander Q.C. noted, as the Appointed Person, *in Sandra Amelia Mary Elliot v LRC Holdings Limited*, BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense – but it does not follow that wine and glassware are similar goods for trade mark purposes.” Whilst on the other hand: “... it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

Whilst on the other hand:

“... it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

27. In its counterstatement, the proprietor admits that “athletic bags, back packs, make-up bags, wallets and wheeled bags are identical and similar to the goods covered by the Earlier Marks”. However, as the proprietor hasn’t identified specifically which terms are identical and which terms are similar, I will still undertake a full comparison of the proprietor’s goods and the applicant’s goods and services.

#### *Animal leashes; Collars for animals; Collars for pets*

28. I consider that the proprietor’s above goods are dissimilar to all of the applicant’s goods and services. In the applicant’s grounds of invalidation, under schedule 2, it compares the above to leather goods such as “leather purses” and “leather jackets”. The applicant also relies on two EUIPO decisions; *STUSSY V STUZZY* (Opposition No. B002431552) and *ULANKA V MULANKA* (Opposition No. B002861360) to establish similarity on the basis that all of the above goods can be made from leather. Whilst useful, this Tribunal is not bound by decisions of the EUIPO. In my view, although the proprietor’s goods can be made from leather, this is not sufficient in itself to establish similarity. All of the applicant’s goods and services do not overlap in nature, purpose or method of use with the proprietor’s goods. Collars are used for identification of an animal and are used in conjunction with leads in order to walk them.

The applicant's goods are either worn or used as accessories by the general public. Its retail services are also targeted at the general public. Consequently, there may be an overlap in user to the extent that both may be purchased by members of the general public. I do not consider that there is an overlap in trade channels. They are not in competition, nor complementary because the goods and services are not important or indispensable for each other. Taking the above into account, I consider the proprietor's goods to be dissimilar to the applicant's goods and services.

*Animal harnesses; Harness for animals*

29. The proprietor's above goods are also compared to the applicant's leather goods under schedule 2. As previously established, this will not be sufficient to conclude similarity. The proprietor's goods are worn by animals such as dogs, in order to take the animal out for a walk. Overall, I do not consider there to be an overlap in nature, method of use, purpose or trade channels with the applicant's goods and services which are all in relation to clothing, footwear, headgear, accessories and retail services in connection with such goods, which would be used by the general public. I recognise that both may be purchased by members of the general public, but this is not enough on its own to establish similarity. They are not in competition, nor complementary. Consequently, I consider the proprietor's goods to be dissimilar to the applicant's goods and services.

*Clothes for animals; Clothing for dogs; Clothing for domestic pets; Clothing for pets; Pet Clothing; Coats for cats; Coats for dogs; Dog parkas; Dog apparel; Costumes for animals; Dog shoes; Pet hair bows*

30. I consider that the proprietor's above goods are dissimilar to all of the applicant's goods and services. Although the applicant's marks cover clothing, footwear, headgear and accessories, these items are to be worn by members of the general public, normally out of necessity, and tailored to the human body. The proprietor's goods are tailored for animals and pets meaning that they come in different shapes and sizes to fit different breeds, and different types of animals. I do not consider that there is an overlap in method of use and any overlap in purpose is limited. I recognise that there may be some limited overlap in nature to the extent that the same materials



may be used for both. I do not consider there to be an overlap in trade channels, and whilst both may be sold in some more general stores, they would be sold in different aisles. I do not consider the goods and services to be in competition, however, the applicant submits that these goods are complementary. I disagree. The proprietor's goods and the applicant's goods and services are not important nor indispensable because they are not used together. The average consumer would also not assume that all of the goods and services would be provided by the same undertaking. Consequently, complementarity cannot be established. Taking the above into account, I consider the proprietor's goods to be dissimilar to the applicant's goods and services. However, if I am wrong in this finding, then they will be similar to only a low degree.

### *Dog bellybands*

31. My understanding is that dog bellybands act as nappies which are used either for dogs who suffer from incontinence or they are used to stop dogs from marking. Consequently, there is no overlap in trade channels, nature, method of use and purpose with any of the applicant's goods, which are clothing, footwear and headgear and accessories, and the applicant's retail services, for the sale of such goods. They are not in competition nor complementary. I recognise that both may be purchased by members of the general public, but that is not enough on its own for a finding of similarity. Overall, I consider the proprietor's goods to be dissimilar to the applicant's goods and services.

### *Animal hides*

32. Animal hides are animal skins which can be used as rugs or decorative pieces for households. They are fundamentally different in nature, method of use and purpose to all of the applicant's goods and services. They do not overlap in trade channels, nor are they in competition or complementary. There may be an overlap in user, however, this is not enough on its own for a finding of similarity. Overall, I consider the proprietor's goods to be dissimilar to the applicant's goods and services.

### *Cat o' nine tails*

33. The cat o'nine tails is a type of whip. The applicant again relies on the argument that there is an overlap between their goods and the proprietor's on the basis that they both can be made from leather. As demonstrated above, this is not enough to establish similarity. The applicant's goods and services are all in relation to clothing, footwear, headgear and accessories such as bags and wallets. Its services are in relation to the sale of these goods. Therefore, I do not consider there to be an overlap in trade channels, nature, purpose or method of use. Any overlap in user is not enough on its own to establish similarity. I do not consider that they would be in competition or complementary. Overall, I consider the proprietor's goods to be dissimilar to the applicant's goods and services.

### *Make-up bags*

34. I consider that "cosmetic cases and bags sold empty" in the 586 Mark's specification is self-evidently identical to the proprietor's above specification.

### *Wallets*

35. "Wallets" appears identically in both the proprietor's specification and the 586 and 763 Mark's specifications.

### *Wheeled bags*

36. "Wheeled bags" appears identically in both the proprietor's specification and the 763 Mark's specification.

### *Athletic bags*

37. I consider that "all-purpose sports and athletic bags" in the 586 and 763 Mark's specifications are self-evidently identical to "athletic bags" in the proprietor's specification.

## *Back packs*

38. I consider that “backpacks” in the 586 and 763 Mark’s specification is self-evidently identical to “back packs” in the proprietor’s specification.

39. It is a prerequisite of section 5(2)(b) that the goods be identical or at least similar. The opposition will, therefore, fail in respect of the goods that I have found to be dissimilar.

40. The opposition under section 5(2)(b) fails for the following goods:

Class 18     Animal harnesses; Animal hides; Animal leashes; Cat o' nine tails; Collars for animals; Collars for pets; Dog bellybands; Harness for animals; Pet hair bows.

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

41. 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 the 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.”

42. The average consumer for the goods will be members of the general public. The price of the goods is likely to vary and they are likely to be a reasonably frequent

purchase. However, even where the cost is low, various factors will be taken into consideration such as durability, aesthetic, and material. Taking all of this into consideration, I consider it likely that a medium degree of attention will be paid during the purchasing process.

43. The goods are likely to be purchased by self-selection from the shelves of a retail outlet or an online equivalent. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount that there will also be an aural component to the purchase given that advice may be sought from retail assistants.




### **Comparison of the trade marks**

44. 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.”

45. 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.

46. The respective trade marks are shown below:

Applicant's trade marks	Proprietor's trade mark
  (The 437 and 586 Marks)   (The 763 Mark)	<p style="text-align: center;"><b>Suprcrne</b></p>

Overall Impression

47. The 437 and 586 Marks have 2 marks in their series. Both marks consist of the word 'Supreme' in white italic text against either a black or red rectangular background. I consider the word 'Supreme' to play a greater role in the overall impression of the mark, with the background and stylisation playing a lesser role.

48. The 763 Mark consists of the word 'Supreme' in white italic text against a red rectangular background. I consider the word 'Supreme' to play a greater role in the overall impression of the mark, with the background and stylisation playing a lesser role.

49. Consequently, as all the above marks are the same, and the only variation lies in the coloured background, I will deal with the marks collectively. The difference in colour of the background will make no impact on my assessment as registration of a mark in black and white covers use in any colour.

50. The proprietor's mark consists of the word 'Suprcrne'. There are no other elements to contribute to the overall impression which lies in the word itself.

### Visual Comparison

51. Visually, the marks coincide in the presence of the letters S, U, P and R at the beginning of the marks. They also coincide in the presence of the letter E at the end of the marks. These all act as visual points of similarity. However, the applicant's marks have the letters E and M in the middle of the marks, whereas the proprietor's mark has the letters C, R and N in the middle of the mark. These act as visual points of difference.

52. I recognise that all the marks are in lower-case. I recognise that the letter 'c' in the proprietor's mark shares some visual similarity to the letter 'e' in the applicant's marks. Similarly, the lower-case 'rn' in its totality in the proprietor's mark shares some visual similarity to the letter 'm' in the applicant's marks.

53. The applicant's marks also have a red or black rectangular background. These act as another point of visual difference. Taking the above into account, I consider the marks to be visually similar to no more than a medium degree.

### Aural Comparison

54. Aurally, the applicant's mark, 'Supreme', will be given its ordinary English pronunciation in all of its earlier marks. The applicant submits that as the proprietor's mark is not an English word it is incapable of "sensible pronunciation". The proprietor also submits that the 'crne' element of their mark does not have an obvious pronunciation. I accept that, as an invented word, the pronunciation may be more difficult and varied. However, I consider that the average consumer will still attempt to pronounce the proprietor's mark. I consider that the proprietor's mark is likely to be pronounced as SUE-PR-K-URN or SUE-PER-KURN. Consequently, the marks only share the beginning syllable. Overall, I consider the marks to be aurally similar to a low degree.

## Conceptual Comparison

55. The word 'Supreme' in the applicant's mark will be given its ordinary dictionary meaning of something which is of the highest status, quality or importance.<sup>2</sup> If something is supreme it is better than the rest.

56. The proprietor's word 'Suprcrne' is likely to be viewed as an invented word which would be attributed no particular meaning. Taking the above into account, I consider the marks to be conceptually dissimilar.

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

57. 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 C108/97 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 promotion of 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

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<sup>2</sup> <https://www.collinsdictionary.com/dictionary/english/supreme>

chambers of commerce and industry or other trade and professional associations (see Windsurfing Chiemsee, paragraph 51).”

58. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

59. As the applicant has not filed any evidence to show that the distinctiveness of its earlier marks have been enhanced through use, I only have the inherent position to consider.

60. The word supreme will be known to the average consumer as something that is better than the rest. I therefore consider that the word may be seen as laudatory i.e. that they reign supreme, that they are the best, or their goods are the best in that industry. I do not consider that the stylisation/background contribute significantly to the marks’ distinctiveness. Taking the above into account, I consider the applicant’s marks to be inherently distinctive to between a low and medium degree.

### **Likelihood of confusion**

61. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and goods 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 vice versa. It is necessary for me to keep in mind the distinctive character of the earlier marks, 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.

62. The following factors must be considered to determine if a likelihood of confusion can be established:

- I have found the marks to be visually similar to no more than a medium degree.
- I have found the marks to be aurally similar to a low degree.
- I have found the marks to be conceptually dissimilar.
- I have found the earlier marks to be inherently distinctive to between a low and medium degree.
- I have identified the average consumer as members 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 a medium degree of attention will be paid during the purchasing process.
- I have found the parties goods to vary from being similar to a low degree to identical (except for those that I have found to be dissimilar which I have already discussed above).

63. Taking all of the factors listed in paragraph 62 into account, particularly the visual, aural and conceptual differences between the marks, I am satisfied that the marks are unlikely to be mistakenly recalled or misremembered as each other. I do not consider that the average consumer would overlook the differing letters in the middle of the marks, especially as the effect is to change an invented word to a dictionary word (or vice versa) which creates a clear conceptual difference. Consequently, I do not consider there to be a likelihood of direct confusion.

64. It now falls to me to consider the 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.”

65. Having noticed that the competing trade marks are different, I see no reason why the average consumer would assume that they come from the same or economically linked undertakings. I do not consider that the average consumer would think the applicant’s trade marks were connected with the proprietor or vice versa. They are not natural variants or brand extensions of each other. Consequently, I consider there is no likelihood of indirect confusion.

## **CONCLUSION**

66. The application for a declaration of invalidity has failed in its entirety and the proprietor’s trade mark will remain registered.

## **COSTS**

67. The proprietor 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 applicant the sum of **£550** as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Considering the Notice of opposition and preparing a Counterstatement	£200
Preparing and filing written submissions	£350
<b>Total</b>	<b>£550</b>

68. I therefore order Chapter 4 Corp d.b.a. Supreme to pay Ye Jianjun the sum of £550. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

**Dated this 11<sup>th</sup> day of October 2021**

**L FAYTER**

**For the Registrar**

## ANNEX

### The 437 Mark

#### Class 25

Clothing, footwear, headgear; clothing, namely, shirts, t-shirts, long-sleeved shirts, under shirts, polo shirts, rugby shirts, jerseys, dress shirts, denim jeans, hooded sweat shirts, warm-up suits, snow suits, parkas, cardigans, pants, jean jackets, cargo pants, shorts, boxer shorts, tops, tank tops, sweat shirts, sweat jackets, sweat shorts, sweat pants, sweaters, vests, fleece vests, pullovers, jackets, coats, blazers, suits, turtlenecks, reversible jackets, wind-resistant jackets, shell jackets, sports jackets, golf and ski jackets, heavy coats, over coats, top coats, swimwear, beachwear, visors, headbands, ear muffs, thermal underwear, long underwear, underclothes, caps, hats, knit caps, headwear, scarves, bandanas, belts, neckwear, ties, robes, gloves, boots, rainwear, footwear, shoes and sneakers; women's, children's and infant's wear, namely shirts, t-shirts, long-sleeved shirts, under shirts, jerseys, dress shirts, denim jeans, hooded sweat shirts, wraps, warm-up suits, parkas, cardigans, pants, jean jackets, shorts, tops, tank tops, sweat shirts, sweat jackets, sweat shorts, sweat pants, sweaters, vests, pullovers, jackets, coats, reversible jackets, wind-resistant jackets, shell jackets, sports jackets, golf and ski jackets, heavy coats, over coats, top coats, swimwear, beachwear, visors, headbands, ear muffs, thermal underwear, long underwear, underclothes, caps, hats, headwear, scarves, bandanas, belts, pajamas, sleepwear, gloves, boots, rainwear, footwear, shoes and sneakers; dresses; skirts; blouses; robes; children's and infant's polo shirts; children's and infant's rugby shirts; children's and infant's snow suits; children's and infant's cargo pants; infant body suits.

### The 586 Mark

#### Class 18

All-purpose sports and athletic bags; beach, book, carry-on, duffel, diaper, gym, leather shopping, shoulder, tote and travel bags; fanny packs and waist packs; backpacks; knapsacks; purses; garment bags for travel; satchels; luggage; luggage tags; trunks; suitcases; hat boxes for travel not of paper or cardboard; cosmetic cases and bags sold empty; toiletry and vanity cases sold empty; tool bags sold empty; attaché cases; briefcases; briefcase-type portfolios; document cases; men's clutches;

business cases; business card cases; calling and credit card cases; key cases; leather key chains; wallets; bank note holders; billfolds.

#### Class 28

Skateboard decks.

#### Class 35

Retail services connected with the sale of all-purpose sports and athletic bags, beach bags, book bags, carry-on bags, duffel bags, diaper bags, gym bags, leather shopping bags, shoulder bags, tote and travel bags, fanny packs and waist packs, backpacks, knapsacks, purses, garment bags for travel, satchels, luggage, luggage tags, trunks, suitcases, hat boxes for travel not of paper or cardboard, cosmetic cases and bags sold empty, toiletry and vanity cases sold empty, tool bags sold empty, attaché cases, briefcases, briefcase-type portfolios, document cases, men's clutches, business cases, business card cases, calling and credit card cases, key cases, leather key chains, wallets, bank note holders, billfolds, skateboard decks, clothing, footwear, headgear, clothing, namely, shirts, t-shirts, long-sleeved shirts, under shirts, polo shirts, rugby shirts, jerseys, dress shirts, denim jeans, hooded sweat shirts, warm-up suits, snow suits, parkas, cardigans, pants, jean jackets, cargo pants, shorts, boxer shorts, tops, tank tops, sweat shirts, sweat jackets, sweat shorts, sweat pants, sweaters, vests, fleece vests, pullovers, jackets, coats, blazers, suits, turtlenecks, reversible jackets, wind-resistant jackets, shell jackets, sports jackets, golf and ski jackets, heavy coats, over coats, top coats, swimwear, beachwear, visors, headbands, ear muffs, thermal underwear, long underwear, underclothes, caps, hats, knit caps, headwear, scarves, bandanas, belts, neckwear, ties, robes, gloves, boots, rainwear, footwear, shoes and sneakers, women's, children's and infant's wear, namely shirts, t-shirts, long-sleeved shirts, under shirts, jerseys, dress shirts, denim jeans, hooded sweat shirts, wraps, warm-up suits, parkas, cardigans, pants, jean jackets, shorts, tops, tank tops, sweat shirts, sweat jackets, sweat shorts, sweat pants, sweaters, vests, pullovers, jackets, coats, reversible jackets, wind-resistant jackets, shell jackets, sports jackets, golf and ski jackets, heavy coats, over coats, top coats, swimwear, beachwear, visors, headbands, ear muffs, thermal underwear, long underwear, underclothes, caps, hats, headwear, scarves, bandanas, belts, pajamas, sleepwear, gloves, boots, rainwear, footwear, shoes and sneakers, dresses, skirts,

blouses, robes, children's and infant's polo shirts, children's and infant's rugby shirts, children's and infant's snow suits, children's and infant's cargo pants and infant body suits.

## **The 763 Mark**

### Class 18

Casual bags; Handbags; Beach bags; Book bags; Carrying bags; Gym bags; Grocery tote bags; Roll bags; Diplomatic bags; Souvenir bags, Slings for carrying infants; Nappy bags; Casual bags; Waterproof bags; All-purpose carrying bags; Bags (Game -) [hunting accessories]; Travel bags of canvas and of leather; Hiking bags; Bags for campers; Weekend bags; Flight bags; Chain mesh purses; Sport bags; Gym bags; Canvas bags; Evening handbags; Briefcases [leather goods]; Bags made of imitation leather; Shoe bags; Work bags; Garment carriers; Garment carriers; Garment bags for travel; Towelling bags; Handbags; Wheeled bags; Shoulder bags; Bags sold empty; Tool pouches sold empty; Sling bags (empty); Ladies' handbags; Evening handbags; Clutch bags; Small clutch purses; Handbags made of leather; Handbags made of imitations leather; Travelling sets [leatherware]; Gentlemen's handbags; Purses for men; Purses; Multi-purpose purses; Hipsacks; Leather purses; Cosmetic purses; Key bags; Key cases; Key fobs made of leather; Wallets; Banknote holders; Purses; Satchels; Suitcases; Luggage tags; Trunks [luggage]; Luggage; Vanity cases, not fitted; Attaché cases; Briefcases; Envelopes; Portfolio cases [briefcases]; Business card cases; Credit-card holders; Hat boxes for travel; Cosmetic containers sold empty; All-purpose sports and athletic bags; Haversacks; Large shoulder bags; Belt bags and hip bags; Shoulder belts; Backpacks.

### Class 25

Clothing, in particular shirts; Tee-shirts; Long-sleeved shirts; Polo shirts; Long sleeved polo shirts; Rugby tops; Jerseys; Sleeveless jerseys; baseball shirts; Hooded baseball jerseys; Dress shirts; Denim jeans; jean shirts; Denim aprons; Hooded sweatshirts; Buttoned sweatshirts; Hooded zip-ups; Crew-neck sweatshirts; Thermal wear; Parkas; Sweaters; Cardigans; Trousers; Cargo pants; Trousers shorts; Boxer shorts; Tops [clothing]; Tank tops; Sweat shirts; Sweat jackets; Fleece shorts; Tracksuit bottoms; Waistcoats; Fleece vests; Sweaters; Half-zip pullovers; Jackets [clothing]; Coats; Blazers; Men's wearing apparel; Reversible jackets; Wind resistant jackets; Cagoules;

Sports jackets; golf and ski jackets; Heavy coats; Topcoats; Trench coats; Jackets of shearling wool; Heavy jackets; Car coats; Ski jackets; Snowboard jackets; Rainproof jackets; Suede jackets; Long jackets; Bushjackets; Warm-up jackets; Light-reflecting jackets; Camouflage jackets; Bed jackets; Down jackets; Fishermen's jackets; Denim jackets; Leather jackets; Fur jackets; Lumberjackets; Riding jackets; Sheepskin coats; Motorcycle jackets; Knit jackets; Sleeveless jackets; Safari jackets; Quilted jackets; Hunting jackets; Sleeved jackets; Parkas; Men's waistcoats; Swimming costumes; Beachwear; Visors; Hair wraps; Mouth masks; Costumes; Ear muffs [clothing]; Thermal underwear; Tights; Underwear; Berets; Hats; Knitted caps; military caps; Baseball caps; Cloche hats; Headgear; Sashes for wear; Bandanas [neckerchiefs]; Waist belts; Neck gaiters; Neckties; Gloves [clothing]; Boots; Mackintoshes; Shoes; Gymnastic shoes; Shawls; Pyjamas; Nightwear; womens clothes; Skirts; Chemisettes; Women's waistcoats; Robes; children's polo shirts; Rugby shirts for children; Ski suits for children; Cargo pants for children; Leotards for children.

### Class 35

Retail outlets, online ordering and retailing, retail outlets available via IT communications, in relation to clothing, in particular shirts, t-shirts, long-sleeve shirts, polo shirts, long-sleeve polo shirts, rugby shirts, jerseys, sleeveless jerseys, baseball jerseys, hooded baseball jerseys, dress shirts, jeans, denim shirts, denim aprons; Retail outlets, online ordering and retailing, retail outlets available via IT communications, in relation to clothing, in particular hooded sweatshirts,. buttoned sweatshirts, hooded sweatshirts with a zip, crewneck sweatshirts, thermal clothing, parkas, cardigans, trousers, military trousers, shorts, boxer shorts, tops, tank tops, sweatshirts, fleece jackets, fleece shorts, fleece trousers, waistcoats, fleece gilets; Retail outlets, online ordering and retailing, retail outlets available via IT communications, in relation to clothing, in particular pullovers, half-zip pullovers, jackets (clothing), coats, blazers, suits for men, reversible jackets, wind-resistant jackets, windcheaters, sports jackets, golf jackets and ski jackets, heavy coats, coats, top coats, trench coats, jackets of shearling wool, heavy jackets, sailor coats; Retail outlets, online ordering and retailing, retail outlets available via IT communications, in relation to clothing, in particular ski jackets, snowboard jackets, waterproof jackets, chamois jackets, long jackets, safari jackets, thermal jackets, light-reflecting jackets, reversible jackets, camouflage jackets, bed jackets, down jackets, fishing jackets,

fleece jackets, denim jackets; Retail outlets, online ordering and retailing, retail outlets available via IT communications, in relation to clothing, in particular leather jackets, fur jackets, lumberjackets, riding jackets, sheepskin jackets, motorcycling jackets, knitted jackets, leather jackets, sleeveless jackets, safari jackets, quilted jackets, hunting jackets, jackets with sleeves; Retail outlets, online ordering and retailing, retail outlets available via IT communications, in relation to clothing, in particular hooded windcheaters, men's waistcoats, bathing suits, beach clothes, cap peaks, hairbands, half-masks, masks, ear muffs, thermal underwear, leotards, underclothing, berets, hats, knitted berets, military caps, baseball caps, cloche hats; Retail outlets, online ordering and retailing, retail outlets available via IT communications, in relation to clothing, in particular headwear, scarves, bandanas, belts for wear, neck warmers, neckties, gloves, boots, waterproof clothing, shoes, gym shoes, shawls, pyjamas, nightwear; Retail outlets, online ordering and retailing, retail outlets available via IT communications, in relation to clothing, in particular clothing for women, skirts, blouses, women's waistcoats, dressing gowns, polo shirts for children, rugby shirts for children, ski suits for children, military trousers for children, leotards for children; Retail stores, online ordering and retailing, retail stores available via computer communications, of bags, handbags, beach bags, book bags, carrying bags, gym bags, shopping bags, roll bags, diplomatic bags, souvenir bags, baby carriers worn on the body, nappy bags, bags, waterproof bags, all-purpose carrying bags, game bags [hunting accessories], travel baggage of canvas and of leather; Retail outlets, online ordering and retailing, retail outlets available via IT communications, in relation to hiking bags, camping bags, weekend bags, flight bags, knitted bags, sports bags, gym bags, canvas bags, evening bags, leather bags, bags of artificial leather, boot bags, work bags, cloth bags, garment bags, garment bags for travel, towel bags, handbags; Retail outlets, online ordering and retailing, retail outlets available via IT communications, in relation to wheeled bags, shoulder bags, bags, sold empty, tool bags, sold empty, tool cases, sold empty, ladies' handbags, evening handbags, drawstring handbags, small clutch bags, leather handbags, handbags of artificial leather, travelling sets (leatherware), men's handbags, men's purses, purses; Retail outlets, online ordering and retailing, retail outlets available via IT communications, in relation to multi-purpose purses, belt pouches, leather purses, make-up bags, key bags, key cases, key cases of leather, pocket wallets, banknote holders, coin purses, briefcases, valises, label tags for luggage, trunks, luggage, vanity cases, sold empty,



suitcases, document holders, bags; Retail stores, online ordering and retailing, retail stores available via computer communications, of portfolio cases [briefcases], business card cases, credit card cases, hat boxes for travel, vanity cases sold empty, all-purpose sports and athletic bags, haversacks, shoulder holdalls, belt bags and hip bags, shoulder belts, rucksacks.