

O-0094-23

**TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK APPLICATION NO 3635709
BY ERHAN YILDIRIM
TO REGISTER**

Buffgang

**AS A TRADE MARK IN CLASSES 24 & 25
AND
OPPOSITION THERETO (UNDER NO. 426568)
BY
ORIGINAL BUFF, S.A.**

BACKGROUND

1) On 01 May 2021, Erhan Yildirim ('the applicant') applied to register the trade mark, Buffgang in respect of the following goods:

Class 24: Cloth fabric.

Class 25: Clothing items.

2) The application was published in the Trade Marks Journal on 07 July 2021 and notice of opposition was later filed by Original Buff, S.A. ('the opponent'). The opponent claims that the trade mark application offends under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ('the Act'). It relies upon the following trade mark registrations under the first of those grounds:

- **TM No: WO1171927 ('27)**



Class 25: Ready-made clothing for external and internal use; handkerchiefs (not included in other classes), caps, footwear (except orthopedic footwear) and headgear.

Designation date: 05 September 2017

Date of protection in the UK: 20 March 2018

- **TM No: WO1370544 ('44)**

BUFF

Class 25: Ready-made clothing for external and internal use; handkerchiefs (not included in other classes); caps; footwear (except orthopedic footwear) and headgear.

Designation date: 11 August 2017

Date of protection in the UK: 04 October 2018

- **TM No: UK917137019 ('19)**



Class 25: Clothing, footwear, headgear; Visors.

Filing date: 22 August 2017

Date of entry in the register: 21 April 2018

- **TM No: UK915955751 ('51)**



Class 24: Textiles and substitutes for textiles; Bed covers; Bath linen, except clothing; Laminated textile piece goods having insulating properties; Fleece made from copolymers; Fleece made from polyester; Fleece made from polypropylene; Fabric linings for clothing; Linings [textile]; Foulard [fabric]; Textile fabric piece goods for use in the manufacture of clothing; Textile piece goods for making-up into towels; Textile fabrics in the piece; Materials for soft furnishings; Materials for use in making clothes; Heat formable non-woven textile materials; Textile material; Textile piece goods for use in the manufacture of protective clothing; Textiles for making up into articles of clothing; Woven cloth with breathable polyurethane coating for water proof garments; Fibre fabrics for use in the manufacture of articles of clothing; Coated fabrics; Waterproof textile fabrics; Breathable waterproof fabrics; Fabric for footwear; Linings [textile]; Textile fabrics for use in the manufacture of sportswear; Cloth; Fibre fabrics for use in the manufacture of linings of shoes; Fabrics of man-made fibres being textile goods in piece form; Textile linings in the piece; Coated fabrics for use in the manufacture of rainwear; Woven fabrics for making up into articles of clothing; Textile fabrics for use in the manufacture of towels; Textile fabrics for the manufacture of clothing; Textile used as lining for clothing; Bed blankets; Quilts; Quilts; Quilt covers; Quilts; Cot covers; Quilts; Duvets; Sleeping bag liners; Bed blankets; Travelling rugs [lap robes]; Blankets for household pets; Blankets for outdoor use; Children's blankets; Textile goods for use as bedding; Bath linen, except clothing; Towelling [textile]; Towelling [textile]; Towels of textile.

Filing date: 20 October 2016

Date of entry in the register: 14 February 2017

- **TM No: UK918244310 ('10)**



Class 35: Wholesaling and retailing in shops and via global computer networks of, Ready-made clothing, Sports clothing, Footwear, Sports footwear, boots (ski -), Sports hats and caps, other than helmets, Sports jerseys and sports trousers, Athletic tights, sweatshirts, Boyshorts, Ski suits, Ski gloves, sweatsocks, Sports jerseys, Jackets being sports clothing; Wholesaling and retailing in shops and via global computer networks of, Arm warmers [clothing], thermal neck warmers, Neck gaiters, Neck (scarves -), Bandanas [neckerchiefs], balaclavas; Wholesaling and retailing in shops and via global computer networks of, Insulating fabrics, Quilted wadding articles for insulation, Thermal insulating articles, Compositions to prevent the radiation of heat, Heat insulating materials, Quilted insulation blankets, thermal insulating materials, Heat resistant fabrics [for insulation]; Wholesaling and retailing in shops and via global computer networks of, Bedlinen, Bed blankets, Blankets for pets, quilt covers, Duvets, Swimwear, Except clothing, Towels, Textile fabrics for use in the manufacture of towels; Wholesaling and retailing in shops and via global computer networks of, Materials for soft furnishings, Materials for use in making clothes, Laminated textile piece articles, With insulating properties, Linings [textile], Lining fabrics, Textile piece goods; Wholesaling and retailing in shops and via global computer networks of, Heat formable non-woven textile materials, Materials for soft furnishings, Textile piece goods for use in the manufacture of protective clothing, Textile piece materials for making clothing, woven fabrics for making up into articles of clothing; Wholesaling and retailing in shops and via global computer networks of, Waterproof fabrics, Breathable waterproof fabrics, Woven clothe with breathable polyurethane coating for waterproof garments, coated fabrics for use in the manufacture of rainwear, Fabrics of

fibre for use in the manufacture of clothing; Wholesaling and retailing in shops and via global computer networks of, Furnishing fabrics, Fabric for footwear, Textile fabrics for the use in the manufacture of sportswear, fabrics for use in the manufacture of clothing, fibre fabrics for use in the manufacture of linings of shoes, Fabrics of man-made fibres being textile goods in piece form, Textile linings in the piece, woven fabrics for making up into articles of clothing; Wholesaling and retailing in shops and via global computer networks of, Sleeping bags, Sleeping bag liners.

Filing date: 26 May 2020

Date of entry in the register: 19 November 2020

3) It is claimed that the respective goods and services are either identical or similar and the respective marks are similar such that there exists a likelihood of confusion under section 5(2)(b) of the Act.

4) The first three of the opponent's marks listed above ('27, '44 and '19) are also relied upon under section 5(3) of the Act. It is claimed that those earlier marks enjoy a reputation in the UK in respect of all the goods relied upon (the same goods and services as relied upon for the purposes of Section 5(2)(b)) and that use of the contested mark will take unfair advantage of, or be detrimental to, the reputation and/or distinctive character of the earlier marks.

5) The trade marks relied upon by the opponent are earlier marks, in accordance with section 6 of the Act. As none of them had been registered for more than five years at the date the application was filed, they are not subject to the proof of use conditions as per Section 6A of the Act.

6) Under section 5(4)(a) of the Act, the opponent relies upon use of the sign BUFF, throughout the UK, since 1996 in relation to 'Clothing, headwear and headgear including scarves and caps'. It is claimed that use of the applicant's mark, in respect of the goods applied for, will lead to misrepresentation and damage to the opponent's goodwill associated with its earlier sign.

7) The applicant, who is without legal representation, filed a counterstatement stating the following:

The opponent has said that we have an identical name which i disagree. Our brand name is Buffgang which is one word, not 2 seperate words. We are based in london so the word Buffgang is a slang word we use here. They are based in Spain so it probably has a different meaning. We do not sell similar stuff as they have claimed. They sell sportswear, like neckwear and headwear while we sell streetwear clothing. Furthermore all our products have our logo onit which has nothing to do with the word Buff or Buffgang, we do not use the word buff in any of our products. They said it might cause confusion for customers to think we are related which i can put on our website that we have no partnership with any other company.

UK00003635709 Mark: Buffgang

Our brand is called Buffgang which we have the trademark for. It is a single word and is not to be seperated, so we deny that we are identical or similar to the opponent. Our brands are completly different as we sell street wear whilst the opponent sell sports and lifestyle accessories. As mentioned before we do not use the word Buff or Buffgang on any of our products, rather we use our distinct Logo. I will attach a link to our websites so you can check all of our products. you will clearly see that there is no word BUFF or BUFFGANG used.

<https://www.buffgangldn.com> . Therefore We deny all grounds set by the opponent 5(3), 5(4)A

8) Before going any further, it is necessary, for the benefit of the unrepresented applicant, to explain why the comments it makes in the counterstatement about the actual kind of goods it provides being different to those of the opponent do not assist it. This is because I am required to make the assessment of the likelihood of confusion notionally and objectively based on the applicant's goods, as applied for, and the opponent's goods, as registered (since proof of use of the latter is not applicable), in accordance with the relevant case law. For example, in *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C- 533/06, the CJEU stated at paragraph 66 of its judgment that when assessing the likelihood of confusion under section 5(2) it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered. Further, in *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P, the CJEU stated:

“59. As regards the fact that the particular circumstances in which the goods in question were marketed were not taken into account, the Court of First Instance was fully entitled to hold that, since these may vary in time and depending on the wishes of the proprietors of the opposing marks, it is inappropriate to take those circumstances into account in the prospective analysis of the likelihood of confusion between those marks.” It follows that

the actual services which either party may currently be providing in the marketplace is irrelevant to the assessment of the likelihood of confusion.

The applicant also states that it does not actually use the mark Buffgang on its products. However, it has made a trade mark application for that mark in respect of the goods applied for. That is the mark which must therefore form the basis of my considerations and no other.

9) The opponent is represented by ip21 Limited. The applicant, as noted above, is without legal representation. The opponent's evidence consists of a witness statement in the name of Harald Kouwijzer, dated 03 June 2022, and exhibits HK1-HK11 thereto. The opponent also filed written submissions dated 30 May 2022. The applicant has filed nothing beyond the counterstatement. Neither party requested to be heard nor filed submissions in lieu. I now make this decision after careful consideration of all the papers before me.

DECISION

Approach

10) Given the number of marks relied upon by the opponent, the nature of its evidence (which shows use in relation to certain goods in class 25 only) and the obvious identity between the applicant's goods and those covered by earlier marks '27, '44, '19 and '51, I see no need to take into account earlier mark '10 in my assessment of sections 5(2)(b) and 5(3). If the opponent does not succeed based upon marks '27, '44, '19 or '51, it cannot succeed based upon mark '10. I will proceed accordingly.

Section 5(2)(b)

11) Section 5(2)(b) of the Act states:

“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.

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

Case law

12) The leading authorities which guide me are from the Court of Justice of the European Union ('CJEU'): *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 the earlier mark to mind, is not sufficient;

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

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

13) 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 case law of EU courts.

Comparison of goods

14) I note the decision in *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM Case T-133/05) ('Merica')*, where the General Court held 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 the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

15) The applicant's 'Clothing items' in class 25 are identical to the goods in class 25 covered by the opponent's '27, '44 and '19 marks, as per *Merica*.

16) Turning to class 24 of the application, the applicant's 'Cloth fabric' is self-evidently identical to the opponent's 'cloth' covered by its '51 mark. (The applicant's

goods also fall within the opponent's broad term 'textiles' covered by the same earlier mark).

Average consumer and the purchasing process

17) It is necessary to determine who the average consumer is for the respective goods and the manner in which they are likely to be selected. 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.”

18) The average consumer for the goods at issue in classes 24 and 25 is the general public. The purchasing act will be primarily visual due to the goods being commonly purchased based on their aesthetic appeal; they are likely to be selected after perusal of racks/shelves in retail establishments, or from photographs on Internet websites or in catalogues. That is not to say though that the aural aspect should be ignored since the goods may sometimes be the subject of discussions with retail staff, for example. The cost of the goods is likely to vary. However, factors such as size, material, eye-appeal, warmth and suitability for purpose are likely to be taken account of by the consumer in relation to all the goods, even those at the more inexpensive end of the spectrum. Generally speaking, I would expect a medium degree of attention to be paid during the purchase.



Comparison of marks

19) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a 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 marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

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

20) The marks to be compared are:

Opponent's marks	Applicant's mark
<p data-bbox="204 376 343 414"><u>'27 & '51:</u></p>  <p data-bbox="204 869 263 907"><u>'44:</u></p> <p data-bbox="209 987 391 1048">BUFF</p> <p data-bbox="204 1205 263 1243"><u>'19:</u></p> 	<p data-bbox="962 443 1236 510">Buffgang</p>

Overall impression

21) I will first consider the overall impression of the opponent's marks. Marks '27, '51 and '19 consist of the word 'Buff' presented in a slightly stylised font within a circular border/black circular background. The word 'Buff' overwhelmingly dominates the overall impression of each of those marks as wholes; the stylisation and circular border/black background play a more than negligible, but much lesser role. Mark '44 consists of the word BUFF in plain block capitals, absent any further stylisation or embellishments; its overall impression lies solely in that word.

22) Turning to the applicant's mark, although this is presented as a single word, Buffgang, I consider it likely that the average consumer will immediately recognise that it consists of two very well-known English words which have been conjoined i.e. 'Buff' and 'gang'. The two words will be read through instantly together, with both having roughly equal weight in the overall impression.

Comparison

23) Visually, the point of coincidence between each of the earlier marks and the applicant's mark is the word Buff. The applicant's mark also contains the word 'gang' which is absent from each earlier mark. Earlier marks '27, '51 and '19 also contain a circular border/black circular background which is absent from the applicant's mark. Overall, I find a medium degree of visual similarity between each earlier mark and the applicant's mark.

24) Aurally, each earlier mark will be pronounced in entirely predictable fashion i.e. as B-UFF. The applicant's mark will be pronounced as B-UFF-G-ANG. The applicant's mark therefore consists of two syllables, the second of which is absent from the earlier marks but the first of which is identical to the earlier marks. I find a medium degree of aural similarity between each earlier mark and the applicant's mark.

25) Turning to the conceptual comparison, I will first consider the likely meaning that will be grasped by the average consumer upon encountering the earlier marks. The word 'Buff' is a well-known English word and, as such, is one with which the average consumer is likely to be familiar. As a word with a number of well-known possible meanings, it may be perceived in any one of the following ways: i) 'to polish', ii) a person in good physical shape with well-developed muscles or iii) as a synonym for nudity or nakedness. It is one, or all, of those possible meanings that will be evoked in the mind of the average consumer when faced with the earlier marks. As regards the applicant's mark, I consider it likely that the average consumer will immediately break the mark down in an attempt to make sense of it, into the two immediately recognisable words 'Buff' and 'gang'. 'Buff' in the applicant's mark will be perceived in the same way as in the earlier marks. 'Gang' is a well-known word used to refer to a group of people. It follows that the applicant's mark therefore shares the 'Buff' concept with the earlier marks but has the added concept of a group of people. I find a medium degree of conceptual similarity between each earlier mark and the applicant's mark.

Distinctive character of the earlier mark

26) The distinctive character of the earlier marks must be considered. The more distinctive each is, either by inherent nature or by use, the greater the likelihood of confusion is with the contested mark (*Sabel BV v Puma AG*). 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-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

27) As I have already noted, BUFF is a well-known dictionary word with a variety of meanings. However, none of the meanings which are likely to be perceived by the average consumer have, in my view, any descriptive or allusive significance in the context of the opponent’s goods. I find each earlier mark to be possessed of a normal (average) degree of inherent distinctive character (I do not consider that the stylisation of the word ‘Buff’ or the black circular background/circular border in marks ’27, ’51 and ’19 elevates the inherent distinctiveness of those marks to any higher degree).

28) Turning to the question of whether the distinctiveness of the earlier marks has been enhanced through the use made of them, the evidence shows fairly substantial sales of goods in the UK consistently for around twenty-five years prior to the filing date of the applicant’s mark (averaging around 2,000,000 Euros per annum since 2010)¹. The invoices² (to the opponent’s distributor), together with the nature of the advertisements³ and promotional material and photographs of goods/packaging⁴ indicates that the overwhelming majority of those goods consisted of head and neckwear such as tubular scarves and hats. There are some examples of exposure of the earlier marks in widely circulated UK publications such as ‘The Telegraph Online’ during 2016 - 2017⁵ and through sponsorship of various UK events in the

¹ witness statement of Mr Kouwijzer, [5]

² HK6

³ HK9, for example

⁴ HK1, HK3, for example

⁵ HK8

years leading up to the relevant date⁶. Marketing expenditure in the UK between 2014 -2016 was fairly significant (in the region of 250,000 Euros) but then decreased somewhat in the years leading up to the filing date of the contested mark, from 2018 – 2021 (being in the region of 60,000 Euros)⁷. Taking the evidence in the round, I find that each of the earlier marks enjoyed an above-average degree of distinctiveness, consequent upon the use made of them in the UK, in relation to head and neckwear. As to the other goods covered by the opponent's specifications, there is no evidence of use in relation to any of the earlier goods covered by class 24. Further, whilst there is some evidence before me to show that the marks have been put to use in relation to other items of clothing such as tops and shorts⁸, it falls short of satisfying me that the earlier mark enjoys enhanced distinctiveness in relation to any of them.

Likelihood of confusion

29) I must now feed all of my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors: i) the interdependency principle, whereby a lesser degree of similarity between the goods may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*); ii) the principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*), and; iii) the factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*).

30) I will first consider the likelihood of direct confusion. The fact that there is identity between the parties' goods is a strong factor weighing in the opponent's favour as is the above-average degree of distinctiveness of the earlier marks consequent upon the use made of them, at least insofar as head and neckwear is concerned. For the rest of the goods relied upon, the earlier marks have a normal level of distinctiveness. As to the similarity between the respective marks, each of the earlier

⁶ HK10, for example

⁷ witness statement of Mr Kouwijzer, [14]

⁸ HK1 and HK2, for example

marks is visually, aurally and conceptually similar to the applicant's mark to a medium degree. The degree of visual similarity is a particularly important factor given that the purchase is likely to be mainly visual⁹. Taking all these factors together, I find that an average consumer, paying a medium degree of attention, is unlikely to mistake any of the earlier marks for the applicant's mark (or vice versa), notwithstanding the potential for imperfect recollection; there is no likelihood of direct confusion.

31) I now turn to consider whether there is a likelihood of indirect confusion. In this connection I note that in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10¹⁰, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

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

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

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

⁹ See the judgment of the General Court in *New Look Ltd v OHIM*, T-117/03 to T-119/03 and T-171/03, [49].

¹⁰ The opponent's submissions in lieu, at paragraph 36.

distinctive in their own right ('26 RED TESCO' would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).

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

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

33) Furthermore, it is not sufficient that a mark merely calls to mind another mark: *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17. This is mere association not indirect confusion.

34) Weighing all relevant factors, I come to the view that, when faced with the applicant's mark on identical goods to those covered by the earlier marks, the average consumer is likely to put the medium degree of visual, aural and conceptual similarity between them down to the applicant's mark being another brand belonging to the owner of each earlier mark. It seems to me, bearing in mind that 'gang' simply refers to a 'group of people', that the addition of that word to the word 'Buff' in the contested mark is likely to be perceived as being logical and consistent with a brand extension of each earlier 'Buff' mark i.e. that the contested mark belongs to the same group of people (i.e. the same undertaking) as each of the earlier marks. For the avoidance of doubt, I reach this conclusion in respect of each of the earlier marks, and even where the relevant mark possesses only a normal degree of inherent distinctiveness (e.g. for the earlier goods in class 24).

35) **The opposition under section 5(2)(b) of the Act succeeds in classes 24 and 25.**

Section 5(3)

36) Section 5(3) of the Act provides:

“(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 the repute of the earlier trade mark.”

Reputation

37) Bearing in mind my earlier comments regarding the use that has been made of the earlier marks for head and neckwear in the UK, I accept that each of the marks relied upon under this ground (marks '27, '44 and '19) had a reasonable reputation at the relevant date, as per Case C-375/97, *General Motors* [1999] ETMR 950, for those type of goods. I find no reputation for any of the earlier marks in relation to any of the other goods relied upon.

Link and damage

38) Whether the public will make the required mental 'link' between each of the opponent's marks and the contested must take account of all relevant factors. The relevant factors identified in Case C-252/07, *Intel* [2009] ETMR 13 are:

i) *The degree of similarity between the conflicting marks*

There is a medium degree of visual, aural and conceptual similarity between each earlier mark and the contested mark.

- ii) *The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public*

The opponent's head and neckwear is identical to the applicant's goods in class 25. However, I find that head and neckwear is not similar to the applicant's 'cloth fabric' in class 24. This is because, although the respective goods may be made of the same materials, their intended purpose, nature, methods of use and trade channels are not the same. The relevant public for all the goods at issue is the general public who will pay a medium degree of attention during the purchase.

- iii) *The strength of the earlier mark's reputation*

Each earlier mark had a reasonable reputation in relation to head and neckwear at the relevant date.

- iv) *The degree of the earlier mark's distinctive character, whether inherent or acquired through use*

Each earlier mark had an above-average degree of enhanced distinctiveness in relation to head and neckwear at the relevant date consequent upon the use made of them.

- v) *Whether there is a likelihood of confusion*

There is a likelihood of confusion between each earlier mark relied upon under this ground and the applicant's mark, in respect of the applied-for goods in class 25.

39) Weighing all of the above factors, I do not consider that any of the opponent's marks would be brought to mind when faced with the contested mark on 'cloth fabric' bearing in mind, in particular, the dissimilarity between those goods and head and neckwear. The requisite link is therefore not established in relation to the contested goods in class 24. Without a link being made in respect of those goods, there can be no damage.

40) Turning to the position in relation to the contested goods in class 25, for which I have found a likelihood of indirect confusion, it is implicit in this finding that a link would be made between the respective marks. It logically follows that, if the average consumer is confused into purchasing the applicant's goods because they believe them to be those of the opponent, this constitutes an unfair advantage being gained by the applicant. Damage is therefore made out in respect of the contested goods in class 25.

41) I add here that, in the event that I am found to be wrong to have found a likelihood of indirect confusion in respect of the contested goods in class 25, I find that there would, in any event, be a link made between the respective marks in respect of those goods, given the closeness of the respective goods, the similarity between the marks and the reasonable reputation enjoyed by the earlier marks for head and neckwear. In my view, such a link, with each of the earlier marks, will cause the contested mark to appear instantly familiar. This association with each of the earlier reputed marks would make the applicant's mark more attractive to the relevant public and give the applicant more custom than it otherwise would have enjoyed and make its job of marketing its goods easier. As this would come without paying any compensation to the opponent, and without the applicant expending the money necessary to create a market for its own goods in the UK, I find that this constitutes unfair advantage.

42) The opposition under section 5(3) of the Act succeeds against class 25 only.

Section 5(4)(a)

43) Given the nature of the opponent's pleaded case under this ground, I cannot see that the opponent is in any stronger position here than under section 5(2)(b). I therefore see no reason to deal with this ground.

OUTCOME

44) **The opposition succeeds.**

COSTS

45) As the opponent has been successful, it is entitled to a contribution towards its costs. Using the guidance in Tribunal Practice Notice 2/2016, I award the opponent costs on the following basis:

Preparing a statement and considering the other side's statement	£300
Official fee (Form TM7)	£200
Preparing and filing evidence and submissions	£600
Total:	£1100

46) I order Erhan Yildirim to pay Original BUFF, S.A. the sum of **£1100**. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 1st day of February 2023

Beverley Hedley

For the Registrar, the Comptroller-General