

BL O/0386/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK3775226

BY DAREN HOADLEY & DAVID LANE

TO REGISTER THE TRADE MARK:



IN CLASSES 25, 26 & 40

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 600002357

BY ASAP PROMO LTD

Background and pleadings

1. On 7 April 2022, Daren Hoadley and David Lane (“the applicants”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 29 April 2022. The goods and services applied for are as follows:

Class 25: Clothing; Clothes; Wristbands [clothing]; Tops [clothing]; Knitted clothing; Oilskins [clothing]; Motorcyclists' clothing; Hoods [clothing]; Leisure clothing; Infant clothing; Children's clothing; Childrens' clothing; Sports clothing; Leather clothing; Gloves [clothing]; Waterproof clothing; Plush clothing; Girls' clothing; Swaddling clothes; Layettes [clothing]; Jackets [clothing]; Kerchiefs [clothing]; Chaps (clothing); Maternity clothing; Thermal clothing; Belts [clothing]; Muffs [clothing]; Capes (clothing); Motorists' clothing; Boas [clothing]; Slips [clothing]; Veils [clothing]; Wraps [clothing]; Athletic clothing; Triathlon clothing; Windproof clothing; Silk clothing; Work clothes; Woolen clothing; Ladies' clothing; Latex clothing; Knitwear [clothing]; Cloth bibs; Cyclists' clothing; Playsuits [clothing]; Slipovers [clothing]; Jerseys [clothing]; Weatherproof clothing; Casual clothing; Denims [clothing]; Combinations [clothing]; Furs [clothing]; Shorts [clothing]; Collars [clothing]; Babies' clothing; Ties [clothing]; Outer clothing; Cashmere clothing; Bandeaux [clothing]; Women's clothing; Bodies [clothing]; Embroidered clothing.

Class 26: Embroidery; Embroidery for garments; Silver embroidery for garments; Gold embroidery for garments; Gold embroidery; Festoons [embroidery]; Silver embroidery; Embroidery laces; Embroidery needles; Fancy goods [embroidery]; Laces [except embroidery laces]; Bobbins for retaining embroidery floss or wool [not parts of machines].

Class 40: Embroidery [embroidering]; Embroidery services; Printing; Digital printing; Providing information relating to embroidery services.

2. The application was opposed by ASAP PROMO LTD (“the opponent”) on 10 May 2022. The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”).

3. The opponent relies on the following trade mark:

UK3557766



Filing date: 19 November 2020

Registration date: 2 April 2021

Relying upon all goods and services for which the earlier mark is protected, namely:

Class 25: Clothing.

Class 26: Embroidery.

Class 40: Printing.

4. The opponent claims that the marks both contain a Lion and the year 1885. They also claim that the applicants are marketing to the same consumers they are currently selling to using the same goods.

5. The applicants filed a counterstatement denying the claims made although they did concede that they are looking to register for goods and services in the same classes.

6. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 No. 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20 (4) shall continue to apply. Rule 20(4) states that:

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

7. The net effect of these changes is to require the parties to seek leave in order to file evidence in fast track oppositions. No leave was sought to file any evidence in respect of these proceedings.

8. Rule 62 (5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken. A hearing was neither requested nor considered necessary; however, the opponent did file written submissions in lieu. This decision is taken following a careful consideration of the papers.

9. Both parties are unrepresented.

10. 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.

DECISION

11. Section 5(2)(b) is being relied upon and is as follows:

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

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

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

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

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered”.

13. In these proceedings, the opponent is relying upon the trade mark shown in paragraph 3, above, which qualifies as an earlier trade mark under the above provisions. As this trade mark had not completed its registration process more than 5 years before the filing date of the application in suit, it is not subject to proof of use, as per section 6A of the Act. The opponent can, as a consequence, rely upon all of the services it has identified.

Case law

14. 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 Office for Harmonisation in the Internal Market (Trade Marks and Designs) (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

15. Section 60A of the Act provides:

“(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the "Nice Classification" means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975.”

16. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

17. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (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.

18. In *Gérard Meric v OHIM* ('Meric'), Case T-133/05, the General Court ("the 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 für 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”.

19. For the purposes of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

20. In *Boston Scientific Ltd v 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 that the responsibility for those goods lies with the same undertaking”.

21. The goods and services to be compared are shown in the table below:

Opponent’s Goods & Services	Applicants’ Goods & Services
Class 25: Clothing	Class 25: Clothing; Clothes; Wristbands [clothing]; Tops [clothing]; Knitted clothing; Oilskins [clothing]; Motorcyclists' clothing; Hoods [clothing]; Leisure clothing; Infant clothing; Children's clothing; Childrens' clothing; Sports clothing; Leather clothing; Gloves [clothing]; Waterproof clothing; Plush

	<p>clothing; Girls' clothing; Swaddling clothes; Layette [clothing]; Jackets [clothing]; Kerchiefs [clothing]; Chaps (clothing); Maternity clothing; Thermal clothing; Belts [clothing]; Muffs [clothing]; Capes (clothing); Motorists' clothing; Boas [clothing]; Slips [clothing]; Veils [clothing]; Wraps [clothing]; Athletic clothing; Triathlon clothing; Windproof clothing; Silk clothing; Work clothes; Woolen clothing; Ladies' clothing; Latex clothing; Knitwear [clothing]; Cloth bibs; Cyclists' clothing; Playsuits [clothing]; Slipovers [clothing]; Jerseys [clothing]; Weatherproof clothing; Casual clothing; Denims [clothing]; Combinations [clothing]; Furs [clothing]; Shorts [clothing]; Collars [clothing]; Babies' clothing; Ties [clothing]; Outer clothing; Cashmere clothing; Bandeaux [clothing]; Women's clothing; Bodies [clothing]; Embroidered clothing.</p>
<p>Class 26: Embroidery</p>	<p>Class 26: Embroidery; Embroidery for garments; Silver embroidery for garments; Gold embroidery for garments; Gold embroidery; Festoons [embroidery]; Silver embroidery; Embroidery laces; Embroidery needles; Fancy goods [embroidery]; Laces [except embroidery laces]; Bobbins for retaining embroidery floss or wool [not parts of machines].</p>

Class 40: Printing	Class 40: Embroidery [embroidering]; Embroidery services; Printing; Digital printing; Providing information relating to embroidery services.
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22. The following goods and services are found identically within both specifications: Clothing; Embroidery; Printing.

Clothes

23. I consider that 'clothes' from the applicants' specification is identical to the opponent's 'clothing' just with slightly different wording.

Wristbands [clothing]; Tops [clothing]; Knitted clothing; Oilskins [clothing]; Motorcyclists' clothing; Hoods [clothing]; Leisure clothing; Infant clothing; Children's clothing; Childrens' clothing; Sports clothing; Leather clothing; Gloves [clothing]; Waterproof clothing; Plush clothing; Girls' clothing; Swaddling clothes; Layettes [clothing]; Jackets [clothing]; Kerchiefs [clothing]; Chaps (clothing); Maternity clothing; Thermal clothing; Belts [clothing]; Muffs [clothing]; Capes (clothing); Motorists' clothing; Boas [clothing]; Slips [clothing]; Veils [clothing]; Wraps [clothing]; Athletic clothing; Triathlon clothing; Windproof clothing; Silk clothing; Work clothes; Woolen clothing; Ladies' clothing; Latex clothing; Knitwear [clothing]; Cloth bibs; Cyclists' clothing; Playsuits [clothing]; Slipovers [clothing]; Jerseys [clothing]; Weatherproof clothing; Casual clothing; Denims [clothing]; Combinations [clothing]; Furs [clothing]; Shorts [clothing]; Collars [clothing]; Babies' clothing; Ties [clothing]; Outer clothing; Cashmere clothing; Bandeaux [clothing]; Women's clothing; Bodies [clothing]; Embroidered clothing.

24. I consider that the above goods from the applicants' specification fall within the wider category of 'clothing' from the opponent's specification and therefore I find them to be identical using the *Meriç* principles.

Cloth bibs

25. I believe that the above goods overlap in nature with the opponent's 'clothing' as they will be made from the same materials however, their purposes differ. The cloth bibs are used to protect clothing from food whereas clothing is used to dress a person however, they are both worn on the body. The users will overlap as the bibs will be worn over the person's clothes. There could also be an overlap in trade channels as I believe bibs for children can often be found next to or near children's clothing items. They are not complementary nor are they in competition. I therefore find them to be similar to at least medium (but not the highest) degree.

Embroidery for garments; Silver embroidery for garments; Gold embroidery for garments; Gold embroidery; Festoons [embroidery]; Silver embroidery; Embroidery laces; Fancy goods [embroidery];

26. I believe that the above goods from the applicant's class 26 specification fall within the wider category of the opponent's 'embroidery' and therefore I find them to be identical under the *Meric* principles.

Embroidery needles; Bobbins for retaining embroidery floss or wool [not parts of machines].

27. I consider that the above goods are different in nature to the opponent's 'embroidery' as the applicant's above goods are needles and storage bobbins compared to the embroidery itself, this also means the actual use is different. However, the users are likely to be the same as a person purchasing embroidery, they would likely also need to purchase the goods required to apply/use them. The trade channels will also overlap as the goods are likely to be found together in retail spaces. The goods are not in competition. The goods could be complementary as the opponent's goods are indispensable for the use of the applicant's goods and it would be reasonable for a consumer to expect the goods to come from the same undertakings. I therefore find the goods similar to a medium degree.

Laces [except embroidery laces];

28. Given I have not been provided with any evidence to the contrary, I believe the above goods from the applicant's specification refers to things like shoe laces as opposed to lace used in the making of clothes. On this basis, I believe that the use and user will differ to that from the opponent's 'embroidery' and the nature will also be different. There may be a slight overlap in trade channels as they may be found in haberdasheries. This slight overlap in my mind is not enough for a finding of similarity between the goods on its own. There is no competition, nor are the goods complementary. I therefore find these goods to be dissimilar.

Embroidery [embroidering]; Embroidery services;

29. I find that the above services from the applicant's specification will have some overlap in user as someone could purchase the embroidery to apply themselves or use the service of the embroidery being stitched on for them. This also means that I believe these goods and services are in competition with one another. The method of use differs as does the nature. There could be an overlap of trade channels as again the same undertaking might offer both the good and the service of embroidering items. I therefore find them to be similar to between a low and medium degree.

Digital printing;

30. I consider the above service from the applicant's specification to fall within the wider category of the opponent's 'printing' and therefore find them to be identical under the *Meric* principles.

Providing information relating to embroidery services.

31. I consider that the end users of the above services might overlap with the users of the opponent's 'embroidery' in class 26 as it would be a person interested in an embroidered product. The nature, use and purpose will differ. There may be some overlap in trade channels but these will not be in competition nor complimentary. I therefore find them similar to a low degree.

32. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

“49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.”

33. Therefore, as I have found no similarity for the applicant’s ‘Laces [except embroidery laces]’ the opposition fails in relation to them. The opposition will continue in respect of the applicant’s class 25 goods, class 40 services and ‘Embroidery; Embroidery for garments; Silver embroidery for garments; Gold embroidery for garments; Gold embroidery; Festoons [embroidery]; Silver embroidery; Embroidery laces; Embroidery needles; Fancy goods [embroidery]; Bobbins for retaining embroidery floss or wool [not parts of machines]’ in Class 26.

Average consumer and the purchasing act

34. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

35. 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. (as he then was) 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 word “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

36. The average consumer of the goods in class 25 will predominantly be the general public.

37. The selection of such goods is largely a visual process, as the average consumer will wish to physically handle the goods to ensure the correct size has been selected, whilst simultaneously appraising the overall aesthetic impact. If the consumer is buying online then I also note they will see the marks on the websites. I do not, however, ignore the potential for the marks to be spoken, for example, by sales assistants in a retail establishment or when making a purchase from a catalogue, over the telephone. However, in the latter circumstances, the consumer will have had an opportunity to view the goods, perhaps electronically via an online catalogue or website, or on paper in the traditional sense of catalogue shopping. Therefore, when considering the aural impact of the marks, the visual impression of these goods will already have played a part in the consumer’s mind.

38. Although the prices of individual items will vary greatly, I consider that the average consumer will pay at least a medium degree of attention (but not the highest level) during the purchase of the class 25 goods.

39. For the goods in class 26, I consider these to be fairly inexpensive products like embroidery, bobbins and needles but they can be quite specific to the making, renewing or tailoring of a garment and therefore, I consider that the average consumer (who would most likely be the general public although I do not discount that there might be professional buyers or businesses) will be paying a medium degree of attention during the purchasing process. I find that once again the purchasing process will be predominantly visual and the same process will apply as detailed in paragraph 37 above.

40. In respect of the class 40 services, I believe that for services related to both embroidery or printing the average consumer could be either an individual or a business. I believe that the individual pricing of the products would likely be fairly low however, the orders could be made in bulk, especially for business who perhaps want their own logo or badge printed/embroidered on merchandise. Therefore, the total price could be fairly large and the overall aesthetic impact will be considered by the consumer. I therefore find that the level of attention being paid will be at least medium. Once again, the above reasoning regarding the importance of visual considerations of the purchasing process will apply here, although I do not discount the possible aural considerations.

Comparison of the marks

41. 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.”

42. 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.

43. The respective trade marks are shown below:

Earlier mark	Contested mark
	

44. The earlier mark is a figurative mark which comprises a navy blue background with a creature which appears to be a lion in white facing left and beneath that is '1885' also in white in a standard typeface.

45. In *Metamorfoza d.o.o. v EUIPO*, Case T 70/20, EU:T:2021:253 the GC compared two figurative marks, both of which contained the words "Museum of Illusions". In holding that the words were weakly distinctive and that they were no more dominant than the figurative elements, it pointed out that:

"57 According to the case-law, the public will not generally consider a descriptive or weakly distinctive element forming part of a composite mark to be the distinctive and dominant element in the overall impression conveyed by that mark (see judgment of 5 April 2006, *Madaus v OHIM – Optima Healthcare* (ECHINAID), T 202/04, EU:T:2006:106, paragraph 54 and the case-law cited; judgment of 28 October 2009, *CureVac v OHIM – Qiagen (RNAiFect)*, T 80/08, EU:T:2009:416, paragraph 49).

58 It does not therefore automatically follow that, where a sign consists of both figurative and word elements, it is the word element which must always be considered to be dominant. In certain cases, in a composite sign, the figurative element may therefore rank at least equally with the word element (see, to that effect, judgment of 24 October 2018, *Grupo Orenes v EUIPO – Akamon Entertainment Millenium (Bingo VIVA ! Slots)*, T 63/17, not published, EU:T:2018:716, paragraph 43 and the case-law cited).”

46. I believe that the overall impression of the earlier mark is shared between the lion-like device and the ‘1885’ element. The lion-like device is the larger element within the mark however, and the above caselaw will apply as even though the ‘1885’ element will more likely be used to verbally identify the mark, it is likely to be perceived as a date of origin for the brand by the average consumer and therefore is less distinctive (although it will still play a smaller role within the mark). Therefore, I consider the lion-like device to be the dominant element.

47. I believe the above analysis also applies to the contested mark- the overall impression is shared between a lion device and the numerals ‘1885’ even though in this instance, the lion head and mane (which once again is much larger than the numbering) is in the middle of the mark and ‘18’ is to the left-hand side of the lion device and ‘85’ is to the right-hand side. Once again, I consider the lion device to be the more dominant element of the mark and once again the ‘1885’ element will be perceived as an origin date and therefore represents a less distinctive element.

48. Visually, the earlier mark comprises a navy blue rectangle with a white heraldic lion or lion rampant (that is a simplistic side profile of a lion standing on its rear legs facing left). The lion itself is stylised and not particularly life-like or representative of a real lion. I consider that not all consumers will know that the device is a particular type of drawing of a lion and therefore may simply see it as a fanciful creature. Below that in a slightly upward curve is the number ‘1885’ in a white standard typeface.

49. The contested mark is a blue outlined lion head and mane facing straight on in the middle of the mark which is highly detailed and more realistic than the lion in the earlier mark. The numbers ‘1885’ are split with two numbers on each side of the lions head.

They are also blue and in a standard typeface. Both marks therefore share the numbers '1885' albeit presented differently: presented all together within the earlier mark and split into two elements in the contested mark. Both marks also contain a lion/lion-like figure. However, I note that just because two marks may share representations of the same thing, it does not automatically result in a finding of visual similarity between them.¹ I bear in mind that the average consumer will not conduct a deep analysis into the aspects of both marks however, I do believe that the average consumer will notice the significant stylistic differences between the marks. The contested mark is a more realistic, hand drawn style of lion compared to the opponent mark which is a more stylised representation (which will not be recognised as a lion by all consumers) together with the different profile views of the devices themselves- one being a side profile of the whole lion and one being a head on view of a lion's head and mane. I do also have to consider that both marks contain '1885' and therefore bearing all this in mind, I find that the marks are visually similar to between low and medium degree.

50. Turning to the aural comparison between the marks, I consider that the average consumer will pronounce the number element of the marks and that there are three possible ways they could pronounce them, firstly as 'eighteen eighty five' (which I believe will be the most prevalent way), as 'one eight eight five' or as 'one thousand, eight hundred and eighty five'. In any event, the three possible pronunciations will be identical for both marks.

51. Next, I will look at the conceptual comparison. I believe that for both marks the number '1885' will be perceived as indicating a specific year – presumably the year that the mark/company was established or founded. I consider that some consumers might recognise both marks as being lions however, some consumers might view the device in the earlier mark as a fanciful creature and not recognise it to be a type of lion drawing. Therefore, for the former group, I consider the concepts of the marks to be identical and for those who do not recognise the device in the earlier mark to be a lion, I find that the concepts will be similar to between a low and medium degree.

¹ *The Royal Academy Of Arts v Errea Sport S.P.A.* BL O/010/16

Distinctive Character of the Earlier Marks

52. 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).”

53. The opponent made no claim and put forward no evidence relating to an enhanced level of distinctiveness of its earlier mark. I will therefore consider the position based solely on its inherent distinctiveness.

54. I consider that the use of a lion-like device is not suggestive or allusive of the goods and services covered in the specification. I believe that the type of lion or creature in the earlier mark as opposed to a realistic lion does make it slightly more fanciful, especially for those consumers who do not view the mark as a lion. However, the use of animals in trademarks is not an uncommon one. This, together with the use of a

year: '1885' which usually refers to the time a company has been established or founded is also not remarkable. I therefore consider the level of inherent distinctive character that the earlier mark enjoys to be no more than a medium degree.

Likelihood of Confusion

55. There are two types of confusion that I must consider. Firstly, direct confusion i.e. where one mark is mistaken for the other. The second is indirect confusion which is where the consumer appreciates that the marks are different, but the similarities between the marks lead the consumer to believe that the respective goods or services originate from the same or a related source.

56. In *L.A. Sugar Limited v Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C. (as he then was), 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.”

57. I have reached the following conclusions above regarding the marks:

- For both marks, the overall impression is shared between the lion/lion-like device and the number '1885' with the lion/lion-like creature being the more dominant element.

- The marks are visually similar to between a low and medium degree.
- The marks are aurally identical
- Conceptually, the marks are identical to some consumers and similar to between a low and medium degree to others.
- The earlier mark is inherently distinctive to a medium degree.
- The goods and services still in play are either identical to the opponent's goods or similar to between at least a medium and a low degree.
- The average consumer will be paying at least a medium degree of attention and the visual considerations will be more important in the purchase process than the aural considerations, but I have not discounted the impact of an aural aspect to the purchase process.

58. I have found the marks to be visually similar to between a low and medium degree due to the differences between the lion devices used within the marks and the placement of the number 1885. In *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03, the GC stated that:

“49. However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (BUDMEN, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumer choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs.”

As stated above, I believe all the goods and services in question rely more heavily on the visual purchasing process- viewing the clothing items or pieces of embroidery/tools

for embroidery to see whether they meet the requirements of the consumer and also viewing the outcomes of an embroidery/printing service before placing an order. Therefore, I do not believe the average consumer will overlook the visual differences and mistake one mark for the other, particularly the stylistic differences between the devices- one being a realistic drawing of a lion head and mane and the other being a stylised and non-realistic side profile of a lion or creature. I therefore do not believe there to be a likelihood of direct confusion.

59. I shall therefore consider whether there is a likelihood of indirect confusion. Mr Iain Purvis Q.C. (as he then was) said further in *L.A. Sugar Limited v Back Beat Inc*:

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

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

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

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

60. These examples are not exhaustive but provide helpful focus, as was confirmed by Arnold LJ in *Liverpool Gin Distillery Limited & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207:

“This is a helpful explanation of the concept of indirect confusion, which has frequently been cited subsequently, but as Mr Purvis made clear it was not intended to be an exhaustive definition.”²

61. Moving on to indirect confusion, I do not find that there is any “proper basis” why the average consumer would consider the contested mark to be another brand of the owner of the earlier mark, so no indirect confusion arises either.³ A finding of indirect confusion should not be made merely because the two marks share a common element.⁴ I have found that the lion element to be the more dominant element in both marks and their very different stylisation would not be a logical or obvious brand extension in my opinion. I do not consider that the average consumer would find it logical that the opponent, for example, would redesign their mark so significantly that it might no longer be recognisable as a clear representation of the earlier mark. In this case that would be to redesign a highly stylised/fanciful depiction of a lion (or other creature for those consumers who do not recognise the device as being a lion) that is less easy to recognise to a fairly realistic representation of a lion.

62. I have also considered the number ‘1885’ to be less distinctive as I consider the average consumer would view it as the date the brand was established/founded and therefore, this is not a distinctive enough element for the average consumer to assume that only one undertaking could use it. Due to this, I do not believe that there is any reason to expect an economic connection between the two marks. I therefore find that there would be no indirect confusion between the marks, even on goods that are identical.

Conclusion

63. The opposition under section 5(2)(b) fails in its entirety and so the contested mark will proceed to registration.

² Paragraph 12

³ See Arnold LJ at [13] of the judgement in *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207.

⁴ As noted, for instance, by James Mellor Q.C. (as he then was), as the Appointed Person in *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

Costs

64. Award of costs in Fast Track proceedings are based upon the scale as set out in Tribunal Practice Notice 2 of 2015. The applicant would normally be entitled to a contribution towards its costs.

65. However, as the applicants are unrepresented, upon receipt of the admissible form TM8 the tribunal wrote to the parties and invited them to indicate whether they intended to make a request for an award of costs. The parties were informed that, if so, they should complete a Pro Forma, providing details of their actual costs and accurate estimates of the amount of time spent on various activities associated with the proceedings. They were informed that “if the pro forma is not completed and returned, costs, other than official fees arising from the action (excluding extensions of time) may not be awarded”.

66. The applicants did not file a completed Pro Forma and paid no official fees. Therefore, I make no award of costs in this matter.

Dated this 25th day of April 2023

L Nicholas

For the Registrar