

o/0204/26

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK4106945

BY DANIEL JAMES HANSON

TO REGISTER THE TRADE MARK:

RAREFY

IN CLASSES 9, 18, 25 & 35

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 451418

BY RAJESH TALWAR

Background and pleadings

1. Daniel James Hanson (“the applicant”) applied to register the trade mark shown on the front page on 1 October 2024. The mark was published on 18 October 2024.

2. The goods and services applied for are set out in Annex 1.

3. Rajesh Talwar (“the opponent”) opposes the trade mark application. The opposition was filed on 17 December 2024. The opposition is on the basis of section 5(2)(b) of the Trade Marks Act 1994 (the Act) against some of the applied for goods and services as follows:

Class 9: Eyewear; eyewear cases; sunglasses; spectacles; frames for sunglasses and spectacles; cases for sunglasses and spectacles; cords for sunglasses and spectacles

Class 18: Bags; luggage and carrying bags; travel bags; travel cases; holdalls; back packs; rucksacks; shoulder bags; satchels; sports bags; bags of leather and imitation leather; handbags; clutch bags; brief cases; leather folios; garment bags; shoe bags; wash bags for carrying toiletries; wallets; purses; credit card cases; umbrellas

Class 25: Clothing, footwear, headwear

Class 35: Retail and wholesale services and online retail and wholesale services, all relating to clothing, footwear, headwear, clothing accessories, eyewear, eyewear cases, sunglasses, spectacles, frames for sunglasses and spectacles, cases for sunglasses and spectacles, cords for sunglasses and spectacles, jewellery, watches, cufflinks, bags, luggage and carrying bags, travel bags, travel cases, holdalls, back packs, rucksacks, shoulder bags, satchels, sports bags, bags of leather and imitation leather, handbags, clutch bags, brief cases, leather folios, garment bags, shoe bags, wash bags for carrying toiletries, wallets, purses, credit card cases, umbrellas, luggage label holders, luggage tags, luggage straps, leather straps, water bottles, badges,

face masks; provision and operation of customer loyalty card membership schemes; information, advisory and consultancy services relating to all of the aforesaid.

4. The following marks are relied upon for the oppositions:

UK2493776 (“the first earlier mark”)

RARE

Filing date: 26 July 2008

Registration date: 25 August 2013

Relying on some of the goods and services for which they are registered as follows:

Class 25: Clothing

Class 35: The bringing together, for the benefit of others, a variety of goods, enabling customers to conveniently view and purchase clothing from a retail outlet and by means of the internet

UK2588985 (“the second earlier mark”)

RARE LONDON

Filing date: 25 July 2011

Registration date: 25 August 2013

Relying on some of the goods and services for which they are registered as follows:

Class 25: Clothing

Class 35: Retail services connected with the sale of clothing

5. The opponent argues that there is visual, aural and conceptual similarity between the marks. Further they state that the goods and services are identical or similar and therefore, the overlap will lead to a likelihood of confusion.

6. The applicant filed a counterstatement denying the similarity between the marks. They do, however, agree that the goods and services are identical or similar.

7. Neither party filed evidence. No hearing was requested nor were any submissions filed in lieu. I therefore make this decision following careful consideration of the papers.

8. The applicant represents himself and the opponent is represented by Wilson Gunn.

9. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

Preliminary Issue

10. Within the applicant's Form TM8 and counterstatement, I note that they have filed some evidence regarding how they intend to use their mark (i.e. where the mark will feature on goods and the type of goods it will be used on). However, I have to carry out a notional assessment based upon the specifications before me (how the goods within the parties' specifications could be used and sold), and all the circumstances in which the marks applied for might be used if they were registered.¹

Decision

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

¹ *O2 Holdings Limited & Anor v Hutchison 3G UK Limited*, Case C-533/06, paragraph 66

“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. In these proceedings, the opponent is relying upon the trade marks shown in paragraph 4, which qualify as earlier trade marks under section 6 of the Act. Both marks completed the registration process more than 5 years before the filing date of the application in suit and as such are subject to proof of use, as per section 6A of the Act. However, the applicant has not requested that the opponent prove use of their marks and, as a consequence, the opponent can rely upon all of the goods and services they have identified.

Case law

13. The following standard summary of the principles applicable to the assessment of the likelihood of confusion was approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Paris Europe Inc & Anor*, [2025] UKSC 25:

(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

14. In the judgment of the Court of Justice of the European Union (“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”.

15. 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.

16. In *Kurt Hesse v OHIM*, Case C-50/15 P, the 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 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”.

17. In *Gérard Meric v Office for Harmonisation in the Internal Market (OHIM) (‘Meric’)*, Case T-133/05, 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”.

18. 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).

19. Although the applicant has accepted that the goods and services at issue are identical/similar, they have not provided details of the level of similarity and therefore, I must still carry out a full assessment.

20. The goods and services at issue are in Annex 2.

21. The opponent has provided a table outlining where they believe there is identity or similarity between the goods and services. I will therefore use the table to identify the opponent's best case.

Class 9

Eyewear; eyewear cases; sunglasses; spectacles; frames for sunglasses and spectacles; cases for sunglasses and spectacles; cords for sunglasses and spectacles

22. The opponent submitted that their class 25 clothing is similar to the above goods from the applicant's specification. It may be possible that some eyewear might be seen as a wearable fashion item and that some shops that sell clothing might also sell sunglasses (perhaps with a case too). However, they are different in essential purpose, nature and method of use. They are not in competition nor are they complementary. I therefore find these goods to be similar to a low degree.

Class 18

Bags; satchels; bags of leather and imitation leather; handbags; clutch bags

23. The opponent submitted that their class 25 clothing is similar to the above goods from the applicant's specification. 'Bags' is a broad term that includes handbags and clutch bags and all of the above terms could be conceived by consumers as aesthetically complementary accessories to 'clothing'. The respective goods are typically sold in the same outlets and consumers are likely to expect them to be produced by the same undertakings. They are different in essential purpose, nature and method of use. As a result, I find that there is a low degree of similarity between the respective goods.

Wallets; purses; credit card cases; luggage and carrying bags; travel bags; travel cases; holdalls; back packs; rucksacks; shoulder bags; sports bags; brief cases; leather folios; garment bags; shoe bags; wash bags for carrying toiletries;

24. It is my view that the position differs for these goods than those discussed at paragraph 23 above. Although at least some of these goods are also bags, I do not consider that they would be sought by consumers to create a coordinated look with clothing. I am not satisfied that the respective goods can be said to reach the market through the same trade channels; even when sold in the same outlets, they are likely located in different sections. Usually, I would find these goods to be dissimilar however, as the applicant has accepted that there is similarity, I find them to be similar to a low degree.

Umbrellas

25. I can see no overlap of the aforementioned factors and would usually consider these goods to be dissimilar however, in light of the applicant's acceptance of similarity, I must find them to be similar to a low degree.

Class 25

Clothing, footwear, headwear

26. The opponent's term 'clothing' falls within the above term from the applicant's specification and, therefore, I find them to be identical using the *Meric* principle.

Class 35

Retail and wholesale services and online retail and wholesale services, all relating to clothing [...]

27. The above term from the applicant's specification encompasses the opponent's 'retail services connected with the sale of clothing' and, therefore, I find them to be identical using the *Meric* principle.

Retail and wholesale services and online retail and wholesale services, all relating to [...] footwear, headwear, clothing accessories, eyewear, eyewear cases, sunglasses, spectacles, frames for sunglasses and spectacles, cases for sunglasses and

spectacles, cords for sunglasses and spectacles, jewellery, watches, cufflinks, bags, shoulder bags, satchels, bags of leather and imitation leather, handbags, clutch bags

28. The above contested services will likely overlap in trade channels, method of use, nature and user with 'retail services connected with the sale of clothing' contained in the opponent's specification. This is because the same businesses are likely to offer retail services relating to a variety of fashion items, including outfits (clothing) and bags, etc. Accordingly, the services are similar to a medium degree.

Retail and wholesale services and online retail and wholesale services, all relating to luggage and carrying bags, travel bags, travel cases, holdalls, back packs, rucksacks, sports bags, brief cases, leather folios, garment bags, shoe bags, wash bags for carrying toiletries, wallets, purses, credit card cases, umbrellas, luggage label holders, luggage tags, luggage straps, leather straps, water bottles, badges, face masks

29. It is my view that the position differs for these services than those discussed at paragraph 28 above. I do not consider that the specified goods would be sought by consumers to create a coordinated look with clothing. Usually, I would find these goods to be dissimilar however, as the applicant has accepted that there is similarity, I find them to be similar to a low degree.

Provision and operation of customer loyalty card membership schemes

30. I can see no overlap of the aforementioned factors and would usually consider these services to be dissimilar however, in light of the applicant's acceptance of similarity, I must find them to be similar to a low degree.

Information, advisory and consultancy services relating to all of the aforesaid

31. With regard to the above term in this class, to the extent that the information, advice, and consultancy relates to services where I have found there to be similarity with the opponent's specification, then there will be a degree of similarity here also. A consumer would expect a provider of a service to also be able to provide advice,

consultancy and information relating to it. I consider the level of similarity to be slightly lower than between the services themselves.

Average consumer and the purchasing act

32. 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.

33. In *Iconix Luxembourg Holdings SARL v Dream Paris Europe Inc & Anor*, [2025] UKSC 25, the Supreme Court approved the comments of Arnold LJ in *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor (Rev1)* [2024] EWCA Civ 262, where he pointed out that:

(a) Consumers who are ill-informed or careless, or consumers with specialised knowledge or who are excessively careful are excluded from consideration;

(b) The average consumer provides a standard which enables the courts to strike a balance between the competing interests involved, such as trade mark owners, their competitors and consumers;

(c) The average consumer is neither a single hypothetical person nor a mathematical average; assessment from the perspective of the average consumer does not involve a statistical test. There is no single meaning rule and if, having regard to the perceptions and expectations of the average consumer, the court considers that a significant proportion of the relevant public is likely to be confused, a finding of infringement may properly be made;

(d) Assessment from the perspective of the average consumer is intended to facilitate adjudication of trade mark disputes by providing an objective criterion, by promoting consistency of assessment and by and enabling courts and

tribunals to determine such issues so far as possible without the need for evidence;

(e) The average consumer's level of attention varies according to the category of goods or services in question; and

(f) the average consumer rarely has the opportunity to make direct comparisons between trade marks (or between trade marks and signs) and must instead rely upon the imperfect picture of the trade mark they have kept in their mind.

34. For the goods and services at issue, the average consumer will likely consist of members of the general public, not discounting that there may be professional or business consumers also (particularly for the wholesale services). The selection of such goods and services 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.

35. Although the prices of individual items will vary greatly, I consider that the average consumer will pay an average degree of attention during the purchase of the goods and services as they will be mindful of factors such as colour, size and material etc. For the services, reputation and reliability of the services are likely to be considered.

Comparison of the marks

36. 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.”

37. 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.

38. The respective trade marks are shown below:

Contested Trade Mark	Earlier Trade Marks
<p>RAREFY</p>	<p>UK2493776</p> <p style="text-align: center;">RARE</p> <p>UK2588985</p> <p style="text-align: center;">RARE LONDON</p>

39. The contested trade mark is a word mark comprising of one word and the overall impression therefore lies in that word. The same applies to the first earlier mark. For the second earlier mark, there are two words however, 'LONDON' refers simply to a geographical location, and it therefore follows that 'RARE' is the dominant and distinctive component, with 'LONDON' playing a lesser role.

40. Visually, all marks share the letters 'RARE'. Therefore, the first earlier mark is entirely encompassed within the contested trade mark. However, the contested trade mark has two further letters 'FY' which have no replica within the first earlier mark. I therefore find the first earlier mark to be visually similar to the contested trade mark to between a medium and a high degree. For the second earlier mark, it has the additional 'LONDON' element which has no replica in the contested trade mark and, therefore, makes the marks further away visually. Therefore, I find them to be visually similar to a medium degree.

41. Turning next to the aural comparison, I consider the earlier marks will be given their ordinary everyday pronunciations. I consider that the contested mark will likely be pronounced *rare/fee* or *rare/uh/fi*. In any event, the first elements will all overlap. The contested mark has the extra element 'FY' on the end which has no replica in either of the earlier marks and the second earlier mark contains the further element 'LONDON'. Therefore, I consider that the contested mark is similar to the first earlier mark to between a medium and a high degree and aurally similar to the second earlier mark to a medium degree.

42. The applicant has stated within their Form TM8 and counterstatement that "Rarefy" is a verb with a distinct dictionary meaning ("to make rare or refined").² I note that they have not stated which dictionary this definition comes from. To my mind, I do not believe that a significant proportion of consumers would understand the word to have this meaning. Whilst I note the word begins with 'RARE' as noted within the visual comparison above, simply extracting that element and its meaning from the word as a whole would amount to artificially dissecting a mark in a way that would

² Paragraph 1 of the Counterstatement

unfairly benefit the opponent. This is especially the case when the remaining letters 'FY' have no standalone meaning or use. Further, for a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM*³. I believe that a significant proportion of consumers will not immediately grasp a meaning and believe it to be an invented term.

43. The applicant also provided a comparison table which also gives the dictionary meanings of 'Rare' – being not common or frequent. These meanings are taken from the Oxford, Cambridge and Collins dictionaries and I also consider this meaning would be well known. 'London' will be viewed as referring to the city. I therefore consider that the marks will be conceptually different.

Distinctive Character of the Earlier Mark

44. 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

³ [2006] ECR I-643; [2006] E.T.M.R 29

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).”

45. Registered trade marks possess varying degrees of inherent distinctive character, being lower where they are allusive or suggestive of a characteristic of the goods and/or services, ranging up to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctive character of a mark can be enhanced by virtue of the use that has been made of it. I have been provided with no such evidence and, therefore, only have the inherent position to consider.

46. The first earlier mark is simply comprised of the word ‘RARE’ which, as discussed above, means not common. I consider that the mark is allusive in relation to the goods and services it is registered for- as it is giving the impression of scarcity of the clothing and accessories and therefore, perhaps of some value or desirability to the average consumer. Therefore, I find the mark to be inherently distinctive to a low degree.

47. The second earlier mark is ‘RARE LONDON’ and I consider that the same allusiveness I have described in the paragraph above, applies here. The addition of ‘LONDON’ is simply a geographical indicator and does not add any distinctiveness to the mark. Therefore, I also find this mark to be inherently distinctive to a low degree.

Likelihood of Confusion

48. 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 the 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 mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

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

- I have found the first earlier mark to be visually and aurally similar to the contested mark to between a medium and high degree. The second earlier mark is visually and aurally similar to a medium degree.
- I have found the marks to be conceptually different.
- The first earlier mark is a word mark comprising of a singular word and therefore, that is where the overall impression lies. For the second earlier mark, 'RARE' is the dominant and distinctive component, with 'LONDON' playing a lesser role
- The contested mark is a word mark comprising of a singular word and therefore, that is where the overall impression lies.
- I consider that the average consumer is likely to be members of the general public (not discounting professional or business users) who will select the goods and services primarily by visual means, although I do not discount an aural component.
- I have concluded that an average level of attention will be paid during the purchasing process.
- The remaining goods and services at issue are identical or similar to between a low and a medium degree.
- The earlier marks are inherently distinctive to a low degree.

50. I note that the first four letters are identical however, in *CureVac GmbH v OHIM*, T-80/08 it was determined that this was not always a decisive matter in the finding of a likelihood of confusion. Further, I note in *The Picasso Estate v OHIM*, Case C-361/04

P, the Court of Justice of the European Union found that conceptual differences observed between marks may counteract the visual and phonetic similarities between them. Remembering that it is unlikely the average consumer will come across the marks side by side in the market and taking into account both the average degree of attention paid and particularly considering the low inherent distinctiveness of the earlier marks, even where there is identity between some of the goods it will not be enough to overcome the conceptual differences and the visual differences (being the inclusion of 'FY' at the end of the contested mark). Therefore, I consider there to be no likelihood of direct confusion.

51. I will therefore turn to look at indirect confusion. Again, I take guidance from Mr Purvis in *L.A. Sugar Limited* where he stated:

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

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

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

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

52. 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.”⁴

53. Firstly, the common element between the marks are the letters ‘RARE’ which are not so highly distinctive that no other party could be using them as a trade mark at all. Secondly, the differences between the marks is an additional two letters ‘FY’ on the contested mark and the inclusion of ‘LONDON’ in the second earlier mark, (where the additional letters on the contested mark results in the it being considered a made up term versus the earlier marks mark having a clear concept) and therefore this is not likely to be a sub-brand nor a logical brand extension. I can see no other reason (nor has the opponent indicated another reason) why the average consumer would view the marks as coming from the same undertaking or indicating the same or related brands. The difference in concepts- one having a clear meaning and one being seen as a made up term would prevent the average consumer from assuming they are from the same place. It may be that the average consumer calls to mind the other mark upon seeing the shared letters however, this is mere association and not indirect confusion.⁵ Therefore, I find there to be no likelihood of indirect confusion.

Conclusion

54. The opposition fails in its entirety, subject to any successful appeal. The application may proceed to registration.

⁴ Paragraph 12

⁵ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

Costs

55. The applicant has been successful and would usually be entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023 as these proceedings commenced after 1 February 2023.

56. However, as the applicant is unrepresented, upon receipt of the admissible form TM8 the tribunal wrote to the party and invited him to indicate whether he intended to make a request for an award of costs. The party was informed that, if so, he should complete a Pro Forma, providing details of his actual costs and accurate estimates of the amount of time spent on various activities associated with the proceedings. The applicant was 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”.

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

Dated this 12th day of March 2026

**L Nicholas
For the Registrar**

ANNEX 1:

Class 9: Eyewear; eyewear cases; sunglasses; spectacles; frames for sunglasses and spectacles; cases for sunglasses and spectacles; cords for sunglasses and spectacles; goggles for sports; covers and cases for phones, smartphones, computers and tablet computers; speakers; portable speakers; earphones; headphones; parts and fittings for all of the aforesaid goods.

Class 18: Bags; luggage and carrying bags; travel bags; travel cases; holdalls; back packs; rucksacks; shoulder bags; satchels; sports bags; bags of leather and imitation leather; handbags; clutch bags; brief cases; leather folios; garment bags; shoe bags; wash bags for carrying toiletries; wallets; purses; credit card cases; umbrellas; luggage label holders; luggage tags; luggage straps; leather straps; parts and fittings for all of the aforesaid goods.

Class 25: Clothing, footwear, headwear.

Class 35: Retail and wholesale services and online retail and wholesale services, all relating to clothing, footwear, headwear, clothing accessories, eyewear, eyewear cases, sunglasses, spectacles, frames for sunglasses and spectacles, cases for sunglasses and spectacles, cords for sunglasses and spectacles, goggles for sports, covers and cases for phones, smartphones, computers and tablet computers, speakers, portable speakers, earphones, headphones, jewellery, watches, cufflinks, bags, luggage and carrying bags, travel bags, travel cases, holdalls, back packs, rucksacks, shoulder bags, satchels, sports bags, bags of leather and imitation leather, handbags, clutch bags, brief cases, leather folios, garment bags, shoe bags, wash bags for carrying toiletries, wallets, purses, credit card cases, umbrellas, luggage label holders, luggage tags, luggage straps, leather straps, water bottles, badges, face masks; provision and operation of customer loyalty card membership schemes; information, advisory and consultancy services relating to all of the aforesaid.

Annex 2:

Contested Goods and Services	Earlier Goods and Services
<p>Class 9: Eyewear; eyewear cases; sunglasses; spectacles; frames for sunglasses and spectacles; cases for sunglasses and spectacles; cords for sunglasses and spectacles</p> <p>Class 18: Bags; luggage and carrying bags; travel bags; travel cases; holdalls; back packs; rucksacks; shoulder bags; satchels; sports bags; bags of leather and imitation leather; handbags; clutch bags; brief cases; leather folios; garment bags; shoe bags; wash bags for carrying toiletries; wallets; purses; credit card cases; umbrellas</p> <p>Class 25: Clothing, footwear, headwear</p> <p>Class 35: Retail and wholesale services and online retail and wholesale services, all relating to clothing, footwear, headwear, clothing accessories, eyewear, eyewear cases, sunglasses, spectacles, frames for sunglasses and spectacles, cases for sunglasses and spectacles, cords for sunglasses and spectacles, jewellery, watches, cufflinks, bags, luggage and carrying bags, travel bags, travel cases, holdalls, back packs, rucksacks, shoulder bags, satchels, sports bags, bags of leather and imitation</p>	<p><i>The first earlier mark</i></p> <p>Class 25: Clothing</p> <p>Class 35: The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase clothing from a retail outlet and by means of the Internet.</p> <p><i>The second earlier mark</i></p> <p>Class 25: Clothing</p> <p>Class 35: Retail services connected with the sale of clothing</p>

leather, handbags, clutch bags, brief cases, leather folios, garment bags, shoe bags, wash bags for carrying toiletries, wallets, purses, credit card cases, umbrellas, luggage label holders, luggage tags, luggage straps, leather straps, water bottles, badges, face masks; provision and operation of customer loyalty card membership schemes; information, advisory and consultancy services relating to all of the aforesaid.	
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