BL o/0283/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003632025

BY KAWISH ALI SIDDIQUI

TO REGISTER THE TRADE MARK:

(SERIES OF 2)

IN CLASS 25

AND IN THE MATTER OF OPPOSITION THERETO UNDER NO. 427517

BY A.P.G. S.R.L.

AND IN THE MATTER OF AN APPEAL TO THE APPOINTED PERSON

BY THE OPPONENT

AGAINST A DECISION OF L FAYTER

DATED 30 AUGUST 2022

DECISION

Introduction

1. This is an appeal from a decision of Ms L Fayter, acting for the Registrar, dated 30 August 2022, in which she allowed UK trade mark registration number 3632025 ("the Trade Mark") applied for by Kawish Ali Siddiqui ("the Applicant") to proceed to registration for all of the goods included in the application, namely:

> **Class 25:** Clothing; Clothes; Tops [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; Knitwear [clothing]; Jerseys [clothing]; Weatherproof clothing; Casual clothing; Denims [clothing]; Combinations [clothing]; Shorts [clothing]; Collars [clothing]; Babies' clothing; Outer clothing; Women's clothing; Embroidered clothing; Jackets [clothing]; Capes (clothing); Woolen clothing; Ladies' clothing.

2. A.P.G. S.R.L. ("the Opponent" or "the Appellant") opposed the application. The opposition was based on section 5(2)(b) of the Trade Marks Act 1994 ("the Act") relying on the following trade marks:

UK registration no. UK00911858354 ("the First Earlier Mark")

International trade mark no. 1536537 ("the Second Earlier Mark").

3. The Opponent relied on the following goods for which the First Earlier Mark is registered:

> **Class 25:** Cyclists' clothing, Cyclists' shoes, Undershirts, Bicycle gloves, Salopettes, Sport stockings, Waterproof clothing.

and the following goods for which the Second Earlier Mark is registered:

> **Class 25:** Cyclists' clothing; bicycle shoes; tee-shirts; polo shirts; bicycle gloves; jumper suits; sports socks; waterproof clothing; goloshes; leggings; muffs [clothing]; bandanas [neckerchiefs]; balaclavas; leotards; underwear.

4. The Opponent filed evidence in chief, and both parties filed submissions in lieu of a hearing. The Opponent was represented by Reddie & Grose LLP, and the Applicant was unrepresented.

5. The Opponent was required to prove use of the First Earlier Mark by the Applicant under s.6A of the Act since, unlike the Second Earlier Mark, that mark had completed its registration process more than five years prior to the application date of the Trade Mark.

The Hearing Officer's Decision

6. The Hearing Officer made the following findings:

> Proof of use
>
> The Hearing Officer was satisfied that the Opponent had demonstrated genuine use of the First Earlier Mark, but only in relation to cyclists' clothing, and decided that a fair specification would therefore be "**Class 25:** Cyclists' clothing".
>
> The goods
>
> At least some of the goods covered by the Trade Mark were found to be identical to *"cyclists' clothing"* covered by the Opponent's earlier trade marks.
>
> The average consumer and the nature of the purchasing act
>
> The average consumer would be a member of the general public who would pay a medium degree of attention when selecting the goods. Visual considerations were likely to dominate, although she did not discount that there would also be an aural component to the purchase.
>
> Similarity between the marks
>
> *Visual similarity*
>
> The earlier trade marks were visually similar to the Trade Mark to a low degree.

Aural similarity

There was a medium degree of aural similarity between the First Earlier Mark and the Trade Mark, and a low degree of aural similarity between the Second Earlier Mark and the Trade Mark.

Conceptual similarity

The marks were conceptually neutral.

Distinctive character of the earlier trade marks

The First and Second Earlier Marks were inherently distinctive to a high degree, and the distinctive character of the First Earlier Mark (but not the Second) had been marginally enhanced by use.

Likelihood of confusion

There was no likelihood of direct or indirect confusion.

7. Accordingly, the Hearing Officer found that the opposition failed.

The Appeal

8. On 27 September 2022, the Opponent filed a Notice of Appeal to the Appointed Person under s.76 of the Act.

9. At the hearing before me, which was held remotely, Luke Ingleton of Reddie & Grose LLP appeared on behalf of the Appellant. The Applicant appeared in person, although I allowed him to be accompanied by Basit Mahmood, who made submissions on behalf of the Applicant to overcome communication difficulties.

Standard of review

10. It is well established that in order to interfere with the decision of the Hearing Officer I must be satisfied that there was a distinct and material error of principle in the decision or that the Hearing Officer was wrong. The relevant principles were set out in *Axogen Corporation v Aviv Scientific Limited* [2022] EQHC 95 (Ch) at [24]. An appeal is by way of review, not a rehearing. Neither surprise at a Hearing Officer's conclusion nor a belief that she or he has reached the wrong decision will justify interference. The decision of the lower court will be *"wrong"* if the judge makes an error of law, which might involve asking the wrong question, failing to take account of relevant matters or taking into account irrelevant matters. In the

absence of an error of law, the appellate court would be justified in concluding that the decision of the lower court was wrong if the judge's conclusion was *"outside the bounds within which reasonable disagreement is possible"* (*Actavis Group* at [80]). In the case of a multifactorial assessment or evaluation, involving the weighing of different factors against each other, the appeal court should show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle. Special caution is required before overturning such decisions (*TT Education v Pie Corbett Consultancy* [2017] RPC 17 at [52(iv)], *REEF Trade Mark* [2003] RPC 5 at [28] and *Fine & Country Ltd v Okotoks Ltd* [2014] FSR 11 at [50]-[51]). I have borne those principles firmly in mind.

Grounds of Appeal

11. The Appellant relied on five grounds of appeal, which I will deal with in turn.

Ground 1: Erroneous assessment of the overall impression

12. The Appellant submitted that the Hearing Officer erred in her assessment of the overall impression of the marks, starting with her assessment of their visual similarities. In paragraph 66 of the Decision, the Hearing Officer described her overall assessment of the Trade Mark in the following terms:

> *"66. The opponent submits that the applicant's marks consists* [sic] *of the word "ALEE". However, I do not agree. Firstly, the applicant's series of marks consists of two figurative marks, the first presented in a grey colour, and the second presented in an orange colour. I consider that the double "e" at the end of the mark is clear and would be recognised by the average consumer. However, I consider that the first part of the mark looks like a decorative device, which isn't an identifable* [sic] *shape or image. Therefore, I do not consider that the average consumer would attribute any meaning to this device. I do not consider that, as the opponent submits, the average consumer would recognise the letters A and L. I consider that if the opponent was correct, and a proportion of average consumers did recognise these letters within the mark, it would be so few in number that it wouldn't amount to a significant proportion. I therefore consider that the device and the stylised letters 'ee' dominate the overall impression of the mark in roughly equal measure."*

13. She then went on to consider the visual similarities of the marks, as follows:

"The First Earlier Mark and the applicant's marks

67. Visually, the marks coincide in the letter E at the end of the marks. However, I note that the letter E is in upper case in the First Earlier Mark and in lower case in the applicant's marks. The First Earlier Mark begins with the letters 'a' and 'L', whereas the applicant's marks start with the decorative device. Furthermore, the letter 'a' in the First Earlier Mark also contains a black square device. As highlighted by the opponent, it is accepted that consumers pay the most attention to the beginning of the marks. Therefore, taking the above into account, I consider that the marks are similar to a low degree.

The Second Earlier Mark and the applicant's marks

68. Visually, the marks coincide in the letter E at the end of the marks. However, the letter E at the end of the Second Earlier Mark has an accent. I also note that applicant's 'e' is in lower case. The First Earlier Mark begins with the letters 'a' and 'L', whereas the applicant's marks start with the decorative device. Consequently, I consider that the marks are similar to a low degree."

14. The Opponent submitted that the Hearing Officer had mistaken the first two characters in the Trade Mark as a decorative element, rather than perceiving them as the letters "a" and "l". All four characters were presented in the same font and in the same manner, including the same colour, with equally sized spacing between each character. The first character was identical to the third and fourth characters save that it had been rotated and inversed so that, the Opponent submitted, it formed a stylised letter "a", rather than the letter "e".

15. While the Opponent accurately described the way in which the first character differed from the third and fourth characters, assuming that the Trade Mark is perceived as being made up of four characters (as opposed to a device plus two characters), it does not follow that the average consumer would perceive the four characters to represent the letters "alee". The stems of the first and second characters both extend below the bottom line of the third and fourth characters (said to represent the letters "ee"). This makes it less likely that the first two characters would be perceived as the letters "al", which would usually sit on the same line as the letters "ee". Indeed, the first character could be perceived as the letter "g", as the tail of the letter "g" would sit below the line (this would then spell the word "glee", which also has a conceptual meaning, unlike the word "alee"). The first character could also be perceived as the letter "q", again with the tail sitting naturally below the line. The second

letter could be perceived as the letter "i" or "j", rather than the letter "l". Accordingly, if the average consumer was to perceive the Trade Mark as representing a word made up of four letters, I do not accept that the average consumer would perceive the Trade Mark to represent "alee" as opposed to one of the other possible combinations of letters I have identified.

16. Similarly, I do not accept that the average consumer could not perceive the mark as being made up of a device mark followed by the two letters "ee", as the Hearing Officer found. The fact that the part of the device element (described as the "stems" of the first two characters in the preceding paragraph) extends below the line of the bottom of the letters "ee" reinforces the impression of a single device element followed by the letters "ee".

17. Further, I do not consider that the representation of what the Opponent identifies as the first character representing the letter "a" looks particularly like a letter "a". Nevertheless, the Hearing Officer clearly considered the possibility of consumers perceiving that element as a letter "a", and that some consumers could perceive the Trade Mark as being made up of the letters "alee". However, her conclusion was that if it were correct that some consumers would perceive the Trade Mark in that way, "*it would be so few in number that it wouldn't amount to a significant proportion".* I consider that that was a finding that a reasonable tribunal could have reached and is not one that I should interfere with.

18. The Opponent also submitted that it was relevant that a search of the UKIPO's records showed the text of the Trade Mark as "ALEE", which the Opponent assumed was as a result of the Applicant having himself stated at the time of filing the application that the text within the mark represented the word "ALEE". However, the mark must be judged through the eyes of the average consumer of the goods or services in question. The average consumer in this case would not know what the Applicant was intending in choosing the Trade Mark when they came across the Trade Mark being used in respect of the goods for which it was applied. I therefore reject the criticism of the Hearing Officer that she failed to take that factor into account.

19. The Opponent further submitted that the Hearing Officer's finding of a low degree of visual similarity represented her own personal view, rather than the view from the perspective of the average consumer. The only sentence from the Decision relied on to support that contention was the following one from paragraph 66: *"I consider that the first part of the mark looks like a decorative element, which isn't an identifiable shape or image"*. However, this merely demonstrates the danger of taking a sentence out of context. It can be seen

from paragraph 66 of the Decision (set out above in paragraph 12) that the Hearing Officer referred to the average consumer four times in that one paragraph, including in the sentences immediately preceding and following the sentence relied on by the Opponent. Just because the Hearing Officer started that sentence with the words *"I consider"* did not mean that she was not assessing the overall impression through the eyes of the average consumer. I therefore reject that criticism of the Hearing Officer.

20. For the reasons set out above, the first ground of appeal therefore fails.

Ground 2: Excessive emphasis on the alleged *"low degree"* of visual similarity between the marks

21. The Appellant submitted that the Hearing Officer gave undue weight to her finding of a low degree of visual similarity when conducting the global appreciation of the relevant factors. In particular, had the Hearing Officer given sufficient weight to her finding of a medium degree of aural similarity, she would have found a likelihood of confusion.

22. In support of this contention, the Appellant relied on paragraph 83 of the Decision where the Hearing Officer said the following: *"…I am satisfied that the marks are unlikely to be mistakenly recalled or misremembered as each other. This is particularly the case given the relatively low visual similarity between the marks and the predominantly visual purchasing process.".*

23. However, as I mentioned before, this demonstrates the danger of taking sentences out of context – in this instance, from the context of the other findings that the Hearing Officer had reached. I set out the whole of paragraphs 81 to 84 of the Decision below:

> *"81. The following factors must be considered to determine if a likelihood of confusion can be established:*
>
> • *The First Earlier Mark is visually similar to the applicant's mark to a low degree.*
>
> • *The Second Earlier Mark is visually similar to the applicant's mark to a very low degree* [she had in fact only referred to a *"low degree"* in her original finding in paragraph 68 of the Decision].
>
> • *All of the marks are aurally similar to a medium degree* [again, this is not quite what she had found previously, as I explain below].
>
> • *All of the marks are conceptually neutral.*

• I have found the First Earlier Mark and Second Earlier Mark to be inherently distinctive to a high degree.

• I have found the distinctiveness of the First Earlier Mark has been marginally enhanced through use.

• I have identified the average consumer for the goods to be members of the general public, who will select the goods primarily by visual means.

• I have concluded that a medium degree of attention will be paid during the purchasing process.

• I have found the parties' goods to be identical.

82. As established above, both the First and Second Earlier marks consist of invented words which have no particular meaning and are both highly distinctive. The First Earlier Mark has also been marginally enhanced through use. The applicant's marks would also not be assigned any conceptual meaning and therefore there will be no conceptual hook to assist in differentiating between the marks. These are clearly factors in favour of the opponent.

83. However, taking all of the factors listed in paragraph 81 into account, particularly the visual differences between the marks, I am satisfied that the marks are unlikely to be mistakenly recalled or misremembered as each other. This is particularly the case given the relatively low visual similarity between the marks and the predominantly visual purchasing process.

84. I note that the only common element between the First Earlier Mark and the applicants marks is the presence of the letter E at the end of the marks. I also note that the letter E is also present in the Second Earlier Mark, however, it has an accent. I also consider that the beginnings of marks tend to make more of an impact than the ends. Consequently, I do not consider that the average consumer would overlook the beginning letters a/A and L in the First and Second Earlier marks, nor do I consider that the average consumer would overlook the decorative device at the beginning of the applicant's figurative marks. Consequently, I do not consider there to be a likelihood of direct confusion.".

24. The Hearing Officer expressly stated in paragraph 83 that she has taken all of the factors listed in paragraph 81 into account in reaching her decision.

25. One of those factors was aural similarity, on which the Hearing Officer said the follow:

> *"69. I consider that the First Earlier Mark will be pronounced as AL-EE. I consider that as the only identifiable letters in the applicant's marks is the double E, is that* [sic] *it may be pronounced as EE or EE-EE. Regardless, the marks would only overlap in the one syllable and therefore I consider that the marks are aurally similar to a medium degree.*
>
> *70. I consider that the accent on the letter É changes the pronunciation of the applicant's Second Earlier Mark. I consider that it would be pronounced as AL-EH. Therefore, because there would be minimal overlap in the "E" part of the second syllable, I consider that the marks would be aurally similar to a low degree.*

26. Since the Appellant argued that the Trade Mark would be pronounced AL-EE, because it believed that the average consumer would perceive the first two letters of the Trade Mark as the letters "a" and "l", it submitted in its Grounds of Appeal that the Hearing Officer was incorrect in finding a medium degree of aural similarity between the First Earlier Mark and the Trade Mark, and should have found them to be aurally identical. That argument fails because I have found that the Hearing Officer was entitled to find that the average consumer would perceive the mark as a device followed by the letters "ee".

27. However, I do consider that the Hearing Officer erred in finding a medium degree of aural similarity between the Trade Mark and the First Earlier Mark. She gives no reasons for concluding that the First Earlier Mark would be pronounced AL-EE. It spells the word ALE, which the average consumer would pronounce in the same way as the common word ALE referring to beer. Although there is a slight gap at the top of the letter E that could be designed to refer to the acute accent which appears on the letter E in the Second Earlier Mark, I do not consider that the average consumer would jump to that conclusion when the First Earlier Mark is seen on its own. In any event, that would still not lead to a pronunciation of AL-EE, but rather of AL-EH, as the Hearing Officer found with the Second Earlier Mark. I find that the Trade Mark is only aurally similar to the First Earlier Mark to a low degree.

28. The Appellant argued in its Grounds of Appeal that the Trade Mark was *"at least aurally similar to the Second Earlier Mark to a medium degree"* but then later submitted in the same document *"the marks are visually and aurally similar to a high degree"*. It is unfortunate that

the Decision contains two different apparent findings relating to aural similarity concerning the Second Earlier Mark – *"low"* in paragraph 70, but *"medium"* in paragraph 81. I believe that the reference to *"medium"* in paragraph 81 was a mistake, and that the Hearing Officer omitted to summarise the different findings she had reached in paragraphs 69 and 70 in her summary in paragraph 81. The reasoning she gives in paragraph 70 as to why there is only *"minimal overlap in the E part of the second syllable"* regarding the Second Earlier Mark, and the fact that paragraph 81 was designed to serve as a summary of her earlier findings, support my conclusion that she intended to find only a low degree of aural similarity regarding the Second Earlier Mark.

29. My conclusion is therefore that both the First and Second Earlier Marks have a low degree of visual and aural similarity with the Trade Mark. That only serves to reinforce the overall conclusion reached by the Hearing Officer regarding the lack of any likelihood of confusion.

30. I mentioned in paragraph 23 above that the summary of the Hearing Officer's findings regarding visual similarity also did not reflect her previous findings in paragraphs 67 and 68 of the Decision. However, I do not consider that it would have made any difference whether the Hearing Officer applied her finding of *"low"* visual similarity set out in paragraphs 67 and 68 of the Decision, or *"low"* visual similarity for the First Earlier Mark and *"very low"* visual similarity for the Second Earlier Mark, as set out in paragraph 81 of the Decision, to her overall conclusion that there was no likelihood of confusion.

31. No criticism can be made of the Hearing Officer's conclusion, given that the goods under consideration were clothing, that visual considerations were likely to dominate the selection process.

32. I therefore reject the assertion that the Hearing Officer focussed unduly on the low degree of visual similarity, so the appeal fails on this ground.

Ground 3: Overlooking the principle of independence

33. The Appellant submitted that the Hearing Officer failed sufficiently to consider the effect of the identity of the goods, which should offset the lower degree of similarity between the marks. I have already set out above how the Hearing Officer reminded herself of the need to consider all the relevant factors she listed in paragraph 81 of the Decision, and I do not consider that the Hearing Officer overlooked the principle of independence, having expressly referred to it in paragraph 52 when she summarised the relevant case law.

34. The Appellant's argument before me appeared to be that because there were identical goods in this case, that would offset a low degree of similarity such that *"it defies logic"* that there was no likelihood of confusion. Where there is a low degree of similarity, it is perfectly acceptable to conclude, having considered all of the relevant factors, that there is no likelihood of confusion even where the goods or services are identical. I therefore reject the appeal under this ground.

Ground 4: Failure to adequately consider distinctiveness of earlier marks

35. The Appellant alleged that the Hearing Officer failed to consider the effects of inherent and enhanced distinctiveness in her assessment of the likelihood of confusion.

36. I reject this ground of appeal for the same reasons given in respect of Ground 3 – the Hearing Officer considered all relevant factors, including expressly referring to the distinctive character of the earlier marks, in reaching her conclusion that there was no likelihood of confusion.

Ground 5: Global appreciation test

37. Finally, the Appellant submitted that the Hearing Officer's conclusion, having considered all of the factors set out in paragraph 81, was *"not consistent with accepted norms based on the established case law for section 5(2)(b)"*. The Appellant did not expand on that submission at the hearing before me, but merely repeated the same factors that the Hearing Officer had set out in paragraph 81 of the Decision. For the reasons given above, there is no reason for me to interfere with the Hearing Officer's conclusion having considered all of those factors.

Conclusion

38. The appeal fails and is dismissed.

Costs

39. Since the appeal has been dismissed, the Respondent is entitled to a contribution towards his costs of the appeal. As the Respondent was unrepresented I invited him to provide a breakdown of the number of hours he had spent in relation to the appeal within 21 days of the hearing before me. In response to this, he submitted a table showing the number of hours incurred on each stage of the case since 4 January 2022. Of relevance to the appeal was the following work:

- Written submissions dated 19 October 2022: 14 hours 20 minutes (extrapolated from a total figure given of £2,150 and the fact that all other calculations had been based on £150 per hour)
- Skeleton argument: 2 hours
- Hearing: 2 hours.

40. As the Respondent represented himself, he is entitled to claim £19 per hour pursuant to Rule 46.5(4)(b) of the Civil Procedure Rules and the associated Practice Direction 46 at 3.4. That would make a total of £348. In his cover email that included the table, the Respondent also asked for any costs award to be uplifted on the basis that the appeal had caused *"considerable additional work"*, deprived the Respondent of pursuing his intended business and led to the Respondent incurring *"various costs"*. However, as no evidence of any financial loss was submitted, I decline to make any additional award.

41. I will therefore make an order that the Appellant pay to the Respondent a contribution of £348 towards the costs of the appeal (no award of costs was made by the Hearing Officer), to be paid within 21 days of the date of this decision.

Simon Clark

The Appointed Person

15 March 2023

Representation:

Appellant: Luke Ingleton (Reddie & Grose LLP)

Respondent: Kawish Ali Siddiqui, accompanied by Basit Mahmood