

O/0525/26

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. UK00003995449
BY POSITIVE ROLE MODELS CIC
TO REGISTER:**



AS A TRADE MARK IN CLASSES 25 AND 41

AND

**IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 447076
BY JOSEPH BHATTI**

BACKGROUND AND PLEADINGS

1. On 24 December 2023, Positive Role Models CIC (“the applicant”) applied to register the trade mark shown on the cover page of this decision, in the UK. The application was accepted and published in the Trade Marks Journal on 19 January 2024 in respect of the following goods and services:

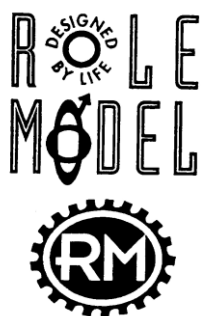
Class 25: *Clothing; Jackets [clothing]; Ready-to-wear clothing; Clothes; Jerseys [clothing]; Shorts [clothing]; Hoods [clothing]; Wristbands [clothing]; Jackets being sports clothing; Clothing for leisure wear; Ready-made clothing; Sports clothing; Leisure clothing; Athletic clothing; Clothing for children; Men's clothing.*

Class 41: *Education services relating to quality services; Education services; Entertainment services; Educational services; Training services; Educational consultancy services; Recreational services; Recreation services.*

2. On 19 April 2024, the application was opposed in its entirety by JOSEPH BHATTI (“the opponent”) based upon Sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”).

3. Under Section 5(2)(b), the opposition is partial being directed against some of the applied-for goods, namely those in class 25 with the opponent relying upon the following trade marks:

UK00001502721("the first earlier mark")



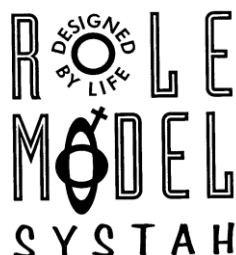
Disclaimer: Registration of this mark shall give no right to the exclusive use of the words "Designed by Life", the letters "RM" and "O" and a letter "O".

Filing date: 02 June 1992

Registration date: 10 September 1993

Class 25: *Articles of outerclothing; headgear; all included in Class 25; but not including footwear.*

UK00002136048 ("the second earlier mark")



Filing date: 17 June 1997

Registration date: 23 January 1998

Class 25: *Clothing, footwear, headgear.*

UK00003557450 ("the third earlier mark")

role model

ROLE MODEL

(series of two)

Filing date: 18 November 2020

Class 25: Aprons [clothing]; ascots; babies' pants [underwear]; bathing suits; bathing trunks; bath robes; beach clothes; belts [clothing]; bibs, bibs not of paper; boas [necklets]; bodices [lingerie]; swim wear; scuba suits; scuba shorts; scuba pants; scuba tops; wetsuits; nightwear; evening wear; towelling dress; adhesive bras; albs; leotards; jumpsuits; onesies; socks; stockings; leggings; funeral attire; chauffeurs attire; costumes; fancy dress clothing; cosplay uniforms; bondage clothing; bodysuits[underwear]; string-vests [underwear]; thermal vests [underwear]; long-johns [underwear]; boxer shorts [hosiery]; underpants [hosiery]; braces for clothing [suspenders]; brassieres; breeches for wear; camisoles; chasubles; clothing containing slimming substances; clothing for gymnastics; clothing of imitations of leather; underwear; lingerie; bikini's, mankini's; clothing of leather; coats; collars [clothing]; combinations [clothing]; military clothing; camouflage clothing; army uniforms; navy uniforms; air force uniforms; pilots uniforms; pilots jackets; airline clothing; corselets; corsets [underclothing]; cuffs; cyclists' clothing; detachable collars; dresses; dressing gowns; sleep suits; dress shields; ear muffs [clothing]; denim trousers; jeans; denim shorts; fingerless gloves; parkas; fishing vests; footmuffs, not electrically heated; furs [clothing]; fur stoles; gabardines [clothing]; gaiters; galoshes; garters; girdles; gloves [clothing]; hairdressing capes; half-boots; heelpieces for stockings; heels; hoods [clothing]; hosiery; panties; inner soles; jackets [clothing]; jerseys [clothing]; judo uniforms; jumper dresses; karate uniforms; kimonos; taekwondo uniforms; Muay Thai uniforms; kick-boxing clothing; boxing clothing; kung-fu uniforms; mixed-martial arts uniforms; MMA clothing; sports uniforms; sportswear; athletic apparel; loungewear; knitwear [clothing]; aloha shirts; socks- garters; anoraks; latex clothing; layettes [clothing]; leggings [leg warmers]; leggings [trousers]; leotards; thongs, trunks, briefs; liveries; dungarees; maniples; mantillas; masquerade costumes; miters [hats]; mittens; face masks[clothing]; money belts [clothing]; motorists' clothing; muffs [clothing]; neck gaiters; neckties outerclothing; overalls; overcoats; pyjamas; nighties; panties; paper clothing; paper hats [clothing]; parkas; pelerines; pelisses; petticoats; pockets for clothing; pocket squares; ponchos; rash guards; ready-made linings [parts of clothing]; sandals; saris; burka's; niqab's; sarongs; sashes for wear; shawls; shirt fronts; dress shirts;

blouses; shirt yokes; business shirts; ski-suits; ski gloves; gloves; mittens; skirts; skorts; smocks; thobes; shorts; sleep masks; slippers [underclothing]; socks; sock suspenders; sports jerseys; sports singlets; stockings; stocking suspenders; braces; stuff jackets [clothing]; suits; salwar suits; kameez [Indian dress]; kurta-salwar [Indian tunic & pants]; sweat-absorbent socks; sweat-absorbent stockings; sweat-absorbent underwear; sweat pants; jogging pants; sweat shorts; activewear; teddies [underclothing]; tights; tips for footwear; togas; trousers; trouser straps; pants; underpants; underwear; uniforms; bibs; tabards; veils [clothing]; vests; workwear clothing; waterproof clothing; soft shell jackets; fleeces; knitwear; welts for footwear; wet suits for water-skiing; wimples; hi-visibility jackets, hi-vis vests, hi-vis sweatshirts; hi-vis tee shirts, hi-vis trousers, hi-visibility clothing with reflective tape; hi-vis hoodies; hi-vis combat pants; scrubs; nurses tunics; hi-vis gilets; hi-vis overpants; waistcoats; cagoules; windbreakers; veterinary uniforms; vets tunics; cummerbunds; gilets; male tunics; dentists tunics; female tunics; occupational uniforms; healthcare clothing; industrial clothing; corporate clothing; security uniforms; chefs wear; bar aprons; waist aprons; chefs jackets; chefs hats; chefs caps; hospitality clothing; babies & toddler clothing; chefs pants; chefs shorts; bar & catering uniforms; health & beauty uniforms; hi-vis polo shirts, hi-vis salopettes; hi-vis coveralls; hi-vis overalls; hi-vis waistcoats; hi-vis dungarees; hi-vis bib & braces; hi-vis overpants; hi-vis fleeces; hi-vis bibs; hi-vis braces; kitchen wear; pilot shirts; nurses dresses; laboratory coats; lab tunics; hygiene coats; salonwear; salon tunics; salon trousers, beauty wear; warehouse coats; body warmers; security jumpers; clip-on ties; ties, zipper ties; dickie- bows; bow ties; blazers; snoods; cravats; overpants; school clothing; school uniforms; spa uniforms; spa & beauty clothing; thermal clothing; waterproof & weatherproof clothing; cold store & freezer clothing; boiler suits; drivers work jacket; body warmers; refrigeration uniforms; pinafores; wrap over lab coat; bandanas [neckerchiefs]; bathing caps; berets; boas [necklets]; scrub hats; scuba snoods; swimming caps; bathing caps; chefs hats; chefs caps; cap peaks; headbands [clothing]; headscarves; hijabs; turbans; sweatbands; hat frames [skeletons]; scarfs; shower caps; skull caps; scarfs; shawls; chauffeurs hats, top hats; gatsby caps; newsboy caps, flat caps; bowler hats; fedora; derby hat; ascot cap; cowboy hat; panama hat; straw hat; trilby hat; boater hat; homburg hat; pork pie hat; visors [headwear]; chefs hats; chefs caps; balaclavas; snoods; milliners hats

& caps; straw hats; durags; berets; ski-hats; tropical hat; Stockholm hat; trapper hat; Russian hat; Tyrolean hat; poorboy cap; sou'wester hat; mortar board hat; sombrero; floppy hat; cloche hat; ivy cap; derby hat; deerstalker hat; bucket hat; cocktail hat; pillbox hat; garbo hat; bonnets; military hats & caps; toque hats; knitted wool hats with ear muffs; boho beanies; pixie hats; school felt hats; legionnaires hat; sun hat; cricket sun hats; all footwear.

UK00003771035 ("the fourth earlier mark")

ROLE MODEL BE ALL YOU CAN BE

rolemodel be all you can be

Filing date: 28 March 2022

Registration date: 14 October 2022

Class 25: *Ascots; babies' pants [underwear]; bathing suits; bathing trunks; bath robes; beach clothes; belts [clothing]; bibs, bibs not of paper; boas [necklets]; bodices [lingerie]; swim wear; scuba suits; scuba shorts; scuba pants; scuba tops; wetsuits; evening wear; towelling dress; adhesive bras; albs; leotards; jumpsuits; onesies; socks; stockings; leggings; funeral attire; chauffeurs attire; costumes; fancy dress clothing; cosplay uniforms; bondage clothing; bodysuits [underwear]; string-vests [underwear]; thermal vests [underwear]; long-johns [underwear]; boxer shorts [hosiery]; underpants [hosiery]; braces for clothing [suspenders]; brassieres; breeches for wear; camisoles; chasubles; clothing containing slimming substances; clothing for gymnastics; clothing of imitations of leather; underwear; lingerie; bikini's, mankini's; clothing of leather; coats; collars [clothing]; combinations [clothing]; military clothing; camouflage clothing; army uniforms; navy uniforms; air-force uniforms; pilots uniforms; pilots jackets; airline clothing; corselets; corsets [underclothing]; cuffs; cyclist's clothing; detachable collars; dresses; dressing gowns; denim jackets; jeans; sleep suits; dress shields; ear muffs [clothing]; denim trousers; denim shorts; fingerless gloves; parkas; fishing vests; footmuffs not electrically heated; furs [clothing]; fur stoles; equestrian [clothing]; gabardines [clothing]; gaiters; galoshes; garters; girdles; gloves [clothing]; hairdressing capes; heelpieces for stockings; heels; hoods [clothing]; hosiery; panties; inner soles;*

jackets [clothing]; judo uniforms; jumper dresses; karate uniforms; kimonos; taekwondo uniforms; Muay Thai uniforms; kick-boxing clothing; boxing clothing; kung-fu uniforms; mixed-martial arts uniforms; MMA clothing; sports uniforms; knitwear [clothing]; aloha shirts; socks-garters; anoraks; latex clothing; layettes [clothing]; leggings [leg warmers]; leggings [trousers]; leotards; thongs, trunks, briefs; liveries; dungarees; maniples; mantillas; masquerade costumes; face marks [clothing]; money belts [clothing]; motorist's clothing; muffs [clothing]; neck gaiters; neckties outer clothing; overalls; overcoats; panties; paper clothing; paper hats [clothing]; parkas; pelerines; pelisses; petticoats; pockets for clothing; pocket squares; ponchos; rash guards; ready-made linings [parts of clothing]; saris; burka's; niqab's; sarongs; sashes for wear; shawls; shirt fronts; dress shirts; blouses; shirt yokes; business shirts; ski-suits; ski gloves; gloves; mittens; skirts; skorts; smocks; thobes; shorts; sleep masks; slips [underclothing]; sock suspenders; sports singlets; stockings; stocking suspenders; braces; stuff jackets [clothing]; suits; salwar suits; kameez [Indian dress]; kurta-salwar [Indian tunic and pants]; sweat-absorbent socks; sweat-absorbent stockings; sweat-absorbent underwear; sweat pants; jogging pants; sweat shorts; teddies [underclothing]; tights; tips for footwear; togas; trousers; trouser straps; pants; jodhpurs; underpants; underwear; uniforms; bibs; tabards; veils [clothing]; vests; workwear clothing; waterproof clothing; soft shell jackets; fleeces; cardigans; welts for footwear; wet suits for water-skiing; wimples; hi-visibility jackets [leisurewear], hi-vis trousers [leisurewear]; hi-vis combat pants [leisurewear]; scrubs; nurses tunics; hi-vis gilets [leisurewear]; hi-vis overpants [leisurewear]; waistcoats; cagoules; windbreakers; veterinary uniforms; vets tunics; cummerbunds; gilets; male tunics; dentists tunics; female tunics; occupational uniforms; healthcare clothing; industrial clothing; corporate clothing; security uniforms; chefs wear; bar aprons; chefs jackets; hospitality clothing; chefs pants; chefs shorts; bar and catering uniforms; health and beauty uniforms; hi-vis polo shirts [leisurewear], hi-vis salopettes [leisurewear]; hi-vis coveralls [leisurewear]; hi-vis overalls [leisurewear]; hi-vis waistcoats [leisurewear]; hi-vis dungarees [leisurewear]; hi-vis bib and braces [leisurewear]; hi-vis overpants [leisurewear]; hi-vis fleeces [leisurewear]; hi-vis bibs [leisurewear]; hi-vis braces [leisurewear]; kitchen wear; pilot shirts; nurses dresses; laboratory coats; lab tunics; hygiene coats; salonwear; salon tunics; salon trousers, formalwear; beauty wear; warehouse

coats; body warmers; security jumpers; clip-on ties; ties, zipper ties; dickie-bows; bowties; blazers; snoods; cravats; overpants; school clothing; school uniform; spa uniforms; spa and beauty clothing; thermal clothing; waterproof and weatherproof clothing; cold store and freezer clothing; boiler suits; drivers work jacket; bodywarmers; refrigeration uniforms; pinafores; wrap over lab coat; bandanas [neckerchiefs]; berets; boas [necklets]; scrub hats; scuba snoods; chefs hats; chefs caps; cap peaks; headscarves; hijabs; turbans; hat frames [skeletons]; scarfs; shower caps; skull caps; neck warmers; shawls; chauffeurs hats, top hats; Gatsby caps; newsboy caps, flat caps; bowler hats; fedora; derby hat; ascot cap; cowboy hat; panama hat; straw hat; trilby hat; boater hat; homburg hat; pork pie hat; knot hat; visors [headwear]; chefs hats; chefs caps; balaclavas; snoods; milliners hats and caps; straw hats; durags; berets; ski-hats; tropical hat; Stockholm hat; trapper hat; Russian hat; Tyrolean hat; poorboy cap; sou'wester hat; mortar board hat; sombrero; floppy hat; cloche hat; miters [hats]; ivy cap; derby hat; deerstalker hat; bucket hat; cocktail hat; pillbox hats; garbo hat; bonnets; military hats and caps; toque hats; knitted wool hats with ear muffs; boho beanies; pixie hats; school felt hats; legionnaires hat; sun hat; cricket sun hats; bucket hat; ivy cap; bakerboy cap; footwear.

4. Under Section 5(2)(b), the opponent relies upon the first and second earlier mark for all of the goods for which they are registered. In relation to the third and fourth earlier mark, the opponent says that it relies upon some of the goods for which these marks are registered, however, it then proceeds to provide a long list of goods which, it appears to me, reproduces all terms included in the registered specifications. For reasons of procedural efficiency, I will not check each term one by one (as both specifications are quite long); however, it is sufficient to say that among the goods relied upon by the opponent (in class 25 of the specification of the third and fourth earlier marks) are the following broad terms: *clothing for gymnastics; clothing of imitations of leather; clothing of leather; evening wear; sportswear; athletic apparel; loungewear; knitwear [clothing]* (of the third earlier mark) and *evening wear; clothing for gymnastics; clothing of imitations of leather; knitwear [clothing]; formalwear* (of the fourth earlier mark).

5. By virtue of their earlier filing dates, the trade marks relied upon by the opponent are all “earlier marks” in accordance with Section 6 of the Act. The opponent’s first and second earlier marks had been registered for more than five years at the filing date of the contested mark, and, as such, are subject to the use conditions under Section 6A of the Act. However, the third and fourth earlier marks are less than five years old and, as such, cannot be subject to proof of use.

6. Under Section 5(2)(b), the opponent claims that there is a likelihood of confusion because the marks are similar and the goods are identical or similar.

7. Under Section 5(3) the opponent opposes all of the goods and services in classes 25 and 41 for which the applicant seeks registration and relies upon the third and fourth earlier mark. Insofar as it is relevant for resolving the present proceedings, the opponent claims reputation for the same goods in class 25 which it has identified under Section 5(2)(b). For reasons which will become apparent, I will take the same approach as that I have outlined above, i.e. that the goods for which reputation is claimed include the broad terms I have listed above. Under this ground, the opponent claims that its business has been operating for 30 years without any name change and that there are no other ‘role model’ brands in the UK. The opponent also claims that use of the applied-for mark will take unfair advantage of, or be detrimental to, the distinctive character and reputation of the earlier marks.

8. The applicant filed a defence and counterstatement denying the claims made and put the opponent to proof of use. In particular, the applicant argues that the fundamental differences in the parties’ missions, branding, target markets, and established reputations strongly support the applicant’s position that the likelihood of consumer’s confusion is negligible. It states:

“Section 5.2 -Section 5.2 emphasises the need to assess the distinctiveness of the marks in question. Positive Role Models has developed a strong brand identity, characterised by our vibrant orange, black, and white logo. The orange colour specifically honours the basketball, our key sport, and symbolises our commitment to youth empowerment. This distinctive branding, combined with our mission driven focus, sets us apart from Role Model Clothing’s black and

white logo, which lacks the association with a social cause or community engagement. The clear differences in branding and mission serve to further distinguish our organisations in the minds of consumers.

...Section 5.3 underscores the importance of the nature of the goods and services provided. Positive Role Models targets a demographic focused on social development and empowerment, while Role Model Clothing caters to consumers in the fashion industry. This divergence in target markets reduces the likelihood of confusion among consumers. Furthermore, Positive Role Models has built a strong reputation both in London and internationally as well as social media, recognised for our impactful work, including a signed service level agreement with the Metropolitan Police to support at-risk young people and invitations to meet His Royal Highness, the Duke of Edinburgh. This established goodwill contributes to our distinct identity and reinforces the notion that consumers will not confuse our brand with that of Role Model Clothing. Role Model Clothing, has no online presence, a one page website and there is indeed, another Role Model Clothing that is not the opponent Role Model Clothing / Joseph Bhatti and have a larger visible presence and appear to be more established, and so we are confused by the opponents objection to us, 'Positive Role Models' a not for profit, with a completely different name, offering completely different services.

*****Absence of Confusion Evidence****: There have been no documented instances of consumer confusion between Positive Role Models and Role Model Clothing. Our brand's consistent messaging and community-oriented initiatives have fostered a clear understanding of our mission among stakeholders, further mitigating any potential for confusion."*

9. Both parties are private litigants acting in person.

10. Only the opponent filed evidence during these proceedings. Neither party requested a hearing, but the opponent filed written submissions in lieu of a hearing. I make this decision having taken full account of all the papers, referring to them as necessary.

Relevance of EU Law

11. 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.

EVIDENCE

12. The opponent's evidence came in the form of a witness statement from Joseph Bhatti dated 21 November 2024. Mr Bhatti's witness statement is accompanied by five exhibits being those labelled Exhibits JB1 – JB5.

13. I do not intend to summarise the evidence in full here. However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

PRELIMINARY MATTERS

14. The first preliminary issue I wish to address concerns the number of marks relied upon by the opponent. Although the opponent relies upon four earlier marks, two of them are subject to proof of use. Further, the marks which are subject to proof of use are figurative marks that contain additional figurative and verbal elements on the top of the coinciding verbal element 'Role Model/Role Models' – this means that they are less similar to the contested mark than the other two word-only marks which are not subject to proof of use. It follows that the figurative marks which are subject to proof of use do not add anything to the opponent's case and I shall say no more about them.

15. In addition, of the two earlier marks that are not subject to proof of use, clearly the third earlier mark is the closest mark because the fourth earlier mark contains additional differentiating verbal elements and does not provide a better comparison in terms of goods, the goods relied upon under both marks being more or less the same.

Hence, I will only consider the third earlier mark for the purpose of the present opposition as it represents the opponent's best case.

16. The second preliminary issue concerns some of the arguments raised by the applicant in its defence. As I have set out above, the applicant contends that the fundamental differences in the parties' missions, branding, target markets, and established reputations strongly weigh against the likelihood of confusion. However, these factors, even if established (which are not, given that the applicant did not file any evidence) do not come into play when considering the likelihood of confusion. This is because the assessment I have to conduct is a notional one based on: (a) the parties' trade marks as they are registered and applied for and (b) the parties' specifications of the goods and services as they are registered and applied for. This means that the segments of the markets in which the parties have so far chosen to trade cannot be taken into account because I must consider notional and fair use of the marks across all segments of the markets for the goods for which they are registered and applied-for.¹ In addition, the parties' missions are matters which are extraneous to the marks at issue and, as such, cannot be taken into account. Finally, whilst the applicant claims to have established a reputation and says that there is no evidence of confusion, it has filed no evidence of trading in goods in class 25 (i.e. the goods at issue under Section 5(2)(b)) – conversely, the counterstatement suggests that its main business is the provision of some kind of educational services for young people. It follows that since the facts pleaded by the applicant are not established, I do not need to go further as to why these defenses would, regardless of the lack of evidence, fail. However, for the sake of completeness, I would very briefly say that the only circumstance in which use of the application would be relevant is if the applicant had established honest concurrent use of the application in relation to the goods relied upon under Section 5(2)(b) (which it has not done).²

DECISION

Section 5(2)(b)

¹ *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06

² *Aceites del Sur-Coosur SA v OHIM*, Case C-498/07 P and *Budejovický Budvar NP v Anheuser-Busch Inc*, Case C-482/09, EU:C:2011:605

17. Section 5(2)(b) of the Act reads as follows:

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

(a) ...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

18. 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 Pairs 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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 greater 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; and

(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

19. In *Gérard Meric v Office for Harmonisation in the Internal Market*, 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 fur 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.”

20. The competing goods are as follows:

The applicant's goods and services	The opponent's goods
Class 25: <i>Clothing; Jackets [clothing]; Ready-to-wear clothing; Clothes; Jerseys [clothing]; Shorts [clothing]; Hoods [clothing]; Wristbands [clothing]; Jackets being sports clothing; Clothing for leisure wear; Ready-made clothing; Sports clothing; Leisure clothing; Athletic clothing; Clothing for children; Men's clothing.</i>	Class 25: <i>..... clothing for gymnastics; clothing of imitations of leather; clothing of leather; evening wear; sportswear; athletic apparel; loungewear; knitwear [clothing]</i>

21. All of the applied for goods are either sport clothing or are items of clothing that can be used for sport. As such they are either self-evidently identical to the opponent's *sportswear; athletic apparel; clothing for gymnastics*, or are identical on the principle outlined in *Meric*.

Average consumer

22. 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.

23. In *Iconix Luxembourg Holdings* (cited above), 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 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.

24. The average consumer of the competing goods in class 25 is a member of the general public. The goods are most likely to be the subject of self-selection from retail outlets, websites or catalogues. Visual considerations are, therefore, likely to dominate

the selection process. However, I do not discount an aural component to the purchase, particularly when advice is sought from a sales representative, or a purchase is made further to word-of-mouth recommendations.

25. The cost of the purchase is likely to vary, depending on the item of clothing, but, overall, they will be relatively inexpensive. On average, consumers are likely to purchase these goods rather frequently. I find that consideration will be given to the materials used, the fit, the aesthetic appearance and the durability of the goods. Taking the above factors into account, I find that the average consumer will demonstrate a medium level of attention in respect of these goods.

Comparison of marks

26. 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.”

27. 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. The respective marks are shown below:

The applied-for mark	The earlier mark
	role model ROLE MODEL

28. The earlier mark is a series of two word-only marks and consists of the two words 'ROLE' and 'MODEL' presented in upper case and lower-case letters. The words will be perceived as a whole meaning "*a person who someone admires and whose behaviour they try to copy*" (Cambridge English dictionary). Consequently, both words equally contribute to the overall impression.

29. The application consists of a figurative mark made up of the three words 'Positive Role Models' and placed against a circular device depicting two stylised hands holding the image of an adult and a child, in a pose which will be understood as the adult showing something to the child whilst putting their arm on the child's shoulder in a sort of protective way. Both the words and the device are presented in black and orange: the word 'Positive' and 'Models', the lower part of the circle and the image of the adult and the child are in orange, whereas the word 'Role', the image of the hands and the upper part of the circle are in black. Although the size of the device is relatively bigger compared to the size of the words, the latter are prominently displayed in the middle of the device; further, the device only reinforces the meaning of the words as it will be understood as a logo which figuratively conveys the meaning of the words by representing an adult who is a positive role model for a child. Accordingly, I consider that regardless of the size of the figurative and verbal elements, the rule of thumb that words speak louder than devices apply in this case, and consequently, I find that the words 'Positive Role Models' are the most distinctive and dominant component of the

mark, with the figurative elements still contributing to the overall impression but to a slightly lesser degree.

Visual similarity

30. Visually, the marks coincide in the words 'Role' (which is the first word of the earlier mark and the second word of the application) and in the words 'Model/Models' (which are the second word of earlier mark and the third word of the application) the only difference between the words 'Model/Models' being that the latter is the plural version of the former. Ignoring for a moment the stylisation of the letters and the colour used in the application, the verbal elements 'Positive Role Models' and 'Role Model' in the respective marks are similar to a medium to high degree; I say this because notwithstanding the fact that the non-coinciding element 'Positive' is placed at the beginning of the application where consumers' attention tend to focus, the words 'Role Model/Role Models' in the respective marks will be perceived as distinctive units having their own distinctive meaning (as shown by the dictionary definition) with the word 'Positive' being perceived as a qualifier.

31. The figurative elements of the application are points of visual difference, whose impact reduces the overall similarity between the marks to a low degree.

Aural similarity

32. Aurally, the verbal elements 'ROLE MODEL' in the earlier mark, and 'POSTIVE ROLE MODELS' in the application will be pronounced in the usual way, with 'ROLE MODEL' and 'ROLE MODELS' being pronounced nearly identically. However, the word 'Positive' in the application is a point of aural difference. Overall, I consider these marks to be aurally similar to between a medium and high degree.

Conceptual similarity

33. Conceptually, both marks will convey the idea of a role model, the only difference being that the concept conveyed by the earlier mark is that of a singular role model, whereas the concept conveyed by the application is that of multiple role models

(plural). Whilst the application also conveys the concept of the role models being positive, it is an adjective that only emphasises the intrinsic characteristics of a role model, being that of a person looked up to by others as an example to be imitated and normally used in a positive way. Consequently, insofar as the word 'Positive' will be perceived as reinforcing the natural and obvious meaning of the words 'Role Models', it does not add a strikingly different concept. Likewise, the concept conveyed by the figurative element of two hands holding an adult and a child, is subordinated to the words 'POSTIVE ROLE MODELS' and will be perceived as figuratively conveying the meaning of the words by representing the image of an adult being a positive role model for a child. Overall, I consider these marks to be similar to between a medium and high degree.

Distinctive character of the earlier mark

34. 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 *WindsurfingChiemsee 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).”

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

36. The earlier mark consists of the words ‘ROLE MODEL’ which are neither descriptive nor allusive of the clothing goods for which the earlier mark is registered, and which are relied upon by the opponent. Accordingly, I consider that the earlier mark is distinctive to a medium degree. This is the inherent position. I will now turn to consider the evidence filed by the opponent to establish if it is sufficient to demonstrate that the distinctiveness of the earlier mark has been increased to any material extent as a result of the use made.

37. Mr Bhatti states that his company has been trading for over 30 years, first as “Role Model Clothing unlimited” between 1991-2001, and then as “Role Model Clothing Ltd” after incorporation in 2001. Mr Bhatti says that his company supplies business, industrial and promotional clothing to companies and the general public, such as the NHS, public bodies(councils) and businesses and that included within the opponent’s promotional clothing is the ‘Role Model’ style brand of clothing. Mr Bhatti says that over the years the opponent has sold various “Role Model promotional clothing” online and in stores in UK and that currently the opponent sells “Role Model” clothing through its website which is in re-development at www.rolemodel.biz.

38. Mr Bhatti says that over the last 30 years the opponent has advertised ‘Role Model’ as products and services and that it has supplied prestige customers such as Leeds City Council, Wakefield Council, NHS, JCT Motor Group, Audi UK, Leeds Bradford Airport. However, it is not said when goods were sold to these customers, in particular whether it was prior to the relevant date of 24 December 2023.

39. In terms of marketing, Mr Bhatti says that over the last 30 years Role Model Clothing has spent approximately £94K in advertising and marketing its products and services. However, aside from providing the approximate figures below for the period 2020-2024, which are tiny amounting to a total of £1,850, it is not clear how the figure of £94K has been calculated, and how the marketing investment has been spread over the years:

2020: £500

2021: £300

2022: £350

2023: £400

2024: £300

40. Further, whilst Mr Bhatti exhibits examples of marketing material and products featuring the mark 'ROLE MODEL', they are all undated and, as such, are not helpful for the purpose of establishing use prior to the relevant date – this is important because in order to be relevant the use shown must precede the relevant date, i.e. the filing date of the contested mark which in this case is 24 December 2023.

41. In addition, Mr Bhatti provides the following sale figures which, he states, are those to which the opponent's Role Model trade marks are attached to the products:

2024: £6,700

2023: £5,900

2022: £4,800

2021: £5,400

2020: £7,200

42. Five sample invoices for the supply of clothing goods are also exhibited, four of which are dated prior to the relevant date and are for the following amounts: £1,255 (2020), £144 (2021), £645 (2022), £569 (May 2023) for a total of £2,613.

43. It is clear that the evidence filed by the opponent falls short of establishing enhanced distinctiveness. Enhanced distinctiveness of a trade mark means that the relevant public recognises the mark as having an enhanced ability or a high capacity to identify the goods or services for which it is registered as coming from a particular undertaking.³ Whilst the evidence relating to the turnover figures and the invoices is sufficient to show that the opponent has actually used the earlier mark 'ROLE MODEL' prior to the relevant date in order to denote the origin of clothing goods, mere use is not the same as use sufficient for the mark to acquire enhanced distinctiveness, and in this case I have no hesitation in concluding that the threshold for enhanced distinctiveness has not been met.

44. This is because the turnover figures, amounting to a total of £30,000 over a five-year period are by any means minuscule, and so are the marketing figures which amount to £1,850 over the same five-year period; in addition, some of the turnover and marketing investment relate to 2024 which is after the relevant date and do not count towards the assessment of enhanced distinctiveness which must be carried out at the relevant date. Further, many of the factors which guide the evaluation of enhanced distinctiveness as considered by the relevant case-law are unknown in the present case, including the market share held by the mark and how intensive, and geographically widespread the use of the mark has been. In this connection, whilst the opponent says that it has been using the mark for over 30 years, there is no information about how intensive the use has been; further, the turnover and marketing figures which have been provided for the most recent period, from 2020 onwards, indicate very little use. It follows that since the evidence fails to establish enhanced distinctiveness, I will proceed on the basis of the inherent position, i.e. that the earlier mark is inherently distinctive to a medium degree.

Likelihood of confusion

45. 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, including that a lesser degree of similarity between the respective

³ T-807/16, N & NF TRADING / NF ENVIRONNEMENT

marks may be offset by a greater degree of similarity between the respective goods (and services if applicable) and vice versa. I must keep in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing process. I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

46. Confusion can be direct or indirect. In *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

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

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

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

47. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ approved Mr Purvis's formulation but added:

"13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/219/16) at [16] 'a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion'. Mr Mellor went on to say that, if there is no likelihood of direct confusion, 'one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion'. I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion."

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

49. Earlier in this decision I found that:

- The marks are visually similar to low degree, and aurally and conceptually similar to between a medium and high degree.
- The parties' goods are identical.
- The average consumer is a member of the general public who will select the services mainly visually, with a medium degree of attention.

- The earlier mark is inherently distinctive to a medium degree. The evidence filed by the opponent is insufficient to establish that the distinctiveness of the earlier mark has been enhanced to any material extent.

50. The opponent does not really explain how a likelihood of confusion will occur in this case. However, this is not fatal, as the opponent has sufficiently pleaded that there is a likelihood of confusion based on the similarity of the marks and the identity or similarity of the goods. In my view, even if the figurative elements of the application are sufficient to dispel the risk of direct confusion, the presence of the coinciding distinctive whole 'ROLE MODELS' in the later mark will lead the average consumers to indirectly confuse the marks, when encountered on identical goods. This is because, the difference between the phrases 'ROLE MODEL' (singular) in the opponent's mark and 'ROLE MODELS' (plural) in the application will be easily overlooked by the average consumer bearing in mind the effect of imperfect collection. The same goes for the additional word 'POSITIVE' in the application, which is a qualifier reinforcing the intrinsic meaning of the coinciding element 'ROLE MODEL' – this means, in my view, that the average consumer is likely to notice this element without giving it too much weight or misremember it. Lastly, even if the average consumer notice the differences between the main origin identifiers 'POSITIVE ROLE MODELS' and 'ROLE MODEL' in the respective marks, the coinciding phrase 'ROLE MODEL/ROLE MODELS' is sufficiently independently distinctive in the context of the goods at issue that when used on identical goods, the average consumer is likely to believe that the goods come from the same undertaking and that the application is a variant mark used by the opponent in relation to a specific line of clothing, for example, clothing for teenagers or children.

51. Accordingly, there is a likelihood of confusion.

Section 5(3)

52. I can deal with this ground very briefly. I have already commented on the evidence filed by the opponent and I found that it comes nowhere near establishing enhanced distinctiveness, which refers to an increased recognition and capacity of a trade mark to identify the goods or services for which it is registered as coming from a particular

undertaking as a result of extensive use. Whilst reputation and enhanced distinctiveness are different concepts, they are closely related and their assessment is based on the same factors.⁴ For the same reasons as those I have outlined above, I find that the opponent's evidence does not establish that the earlier mark benefits from reputation and the ground under Section 5(3) fails at the first hurdle.

OUTCOME

53. The opponent's claims succeeds under Section 5(2)(b) and the application will be refused registration.

COSTS

54. The opponent has been successful and is therefore entitled to an award of costs. In the present case, the opponent was not legally represented and in order to claim its costs, it was required to file a costs proforma which it has duly done.

55. The opponent's costs are broken down as follows:

Task	Time spent/value
Preparing a notice of opposition:	10h 00m
Considering counter statement:	2h 00m
Preparing the evidence:	16h 00m
Drafting written submissions:	8h 00m
Total:	36h 00m

⁴ General Motors, Case C-375/97

56. The opponent also requested costs associated with “appeal hearing”, however, this is not something that is recoverable at this point in time (as no appeal has been lodged). Likewise, the opponent requested 2 hours for costs associated with CITMA advice, however, I consider these costs are already duly covered by the tasks regarding preparing a notice of opposition, considering the counterstatement and drafting submissions already claimed.

57. As regards the amount of hours claimed, I consider that the opponent’s claims as to its costs are excessive as regards (a) the written submissions which mostly copy and paste the body of Mr Bhatti’s witness statement; and (b) preparing the notice of opposition which does not even contain a statement of ground. I consider that reasonable costs for this task would be 4hours and 6hours respectively.

58. Therefore, reducing the total amount claimed in accordance with what I have said above means that the present claim covers 26 hours, with £200 recoverable via the official fee.

59. I note that the Litigants in Person (Costs and Expenses) Act 1975 (as amended) sets the minimum level of compensation for litigants in person in Court proceedings at £19.00 an hour. I see no reason to award anything other than this. I therefore calculate that, based on the above, the opponent’s costs sit at £494.00 (26 hours at £19 per hour) plus the official fee of £200.

60. I therefore order Positive Role Models CIC to pay JOSEPH BHATTI the sum of £694.00. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 24th day of June 2026

TERESA PINTO
For the Registrar