O-0647-23

TRADE MARKS ACT 1994

IN THE MATTER OF

TRADE MARK APPLICATION NO 3634719

BY A CONSCIOUS INTERRUPTION LIMITED

TO REGISTER

CUL/TURE A Conscious Interruption

AS A TRADE MARK IN CLASS 25

AND

OPPOSITION THERETO (UNDER NO. 428191)

BY

SATWANT SINGH CHEEMA

BACKGROUND

1) On 29 April 2021, A Conscious Interruption Limited ('the applicant') applied to register 'CUL/TURE A Conscious Interruption' as a trade mark in the UK in respect of the following goods:

> **Class 25:** Clothing; footwear; headgear; t-shirts; vests; hoodies; dresses; skirts; casual tops with long and short sleeves; sweatshirts; sweaters; cardigans; jackets; coats; fleece tops; knitwear; trousers; shirts; shorts; swimwear; caps; beanies; bandanas; headbands; hats; neck-wraps; scarves; gloves; mittens; ear muffs; robes; wraps; ponchos; sandals; flip flops; socks; jumpers; shirts; boots; lingerie and underwear; sleepwear; pyjamas; slippers; wetsuits; bodysuits; jeans; sarongs; parts of clothing, footwear and headgear.

2) The application was published in the Trade Marks Journal on 13 August 2021 and notice of opposition was later filed by Satwant Singh Cheema ('the opponent'). The opponent claims that the trade mark application offends under section 5(2)(b) of the Trade Marks Act 1994 ('the Act'). The opponent relies upon the following trade mark registration and certain of the goods covered by the same, as shown below:

i) **UKTM No. 3269998**

CULTURE LONDON

Class 25: Clothing, footwear, headgear; parts and fittings for all the aforementioned goods.

Filing date: 11 November 2017
Date of entry in the register: 23 February 2018

3) The trade mark relied upon by the opponent is a an 'earlier mark' in accordance with section 6 of the Act. As it had not been registered for five years or more at the

filing date of the application, it is not subject to the proof of use conditions as per Section 6A of the Act.

4) The applicant filed a counterstatement denying any similarity between the respective marks or goods.

5) The applicant is represented by Trademark Tonic Limited. The opponent is without legal representation. Both parties filed evidence. The opponent's evidence consists of a witness statement from him and four exhibits thereto. The applicant's evidence consists of a witness statement in the name of Dominique Rochel Octave, the applicant's director, and five exhibits thereto. The applicant's evidence was also accompanied by submissions[1]. Neither party requested a hearing; only the opponent filed submissions in lieu[2]. I have read all the evidence and submissions and will refer to them if, and when, it is appropriate to do so.

DECISION

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

> "5. - (2) A trade mark shall not be registered if because –
>
> (a)….
>
> (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,
>
> there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.
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> 5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the

[1] Dated 19 January 2023
[2] On 28th March 2023

trade mark is applied for, the application is to be refused in relation to those goods and services only."

Case law

7) Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. Accordingly, it is appropriate to take account of the trade mark case law of EU courts.

8) The leading authorities which guide me are from the Court of Justice of the European Union ('CJEU'): *Sabel BV v Puma AG,* Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc,* Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV,* Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH,* Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM,* Case C-334/05P and *Bimbo SA v OHIM,* Case C-591/12P.

The principles

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

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

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

Comparison of goods

9) The goods to be compared are:

Opponent's specification	Applicant's specification
Class 25: Clothing, footwear, headgear; parts and fittings for all the aforementioned goods.	**Class 25:** Clothing; footwear; headgear; t-shirts; vests; hoodies; dresses; skirts; casual tops with long and short sleeves; sweatshirts; sweaters; cardigans; jackets; coats; fleece tops; knitwear; trousers; shirts; shorts; swimwear; caps; beanies; bandanas; headbands; hats; neck-wraps; scarves; gloves; mittens; ear muffs; robes; wraps; ponchos; sandals; flip flops; socks; jumpers; shirts; boots; lingerie and underwear; sleepwear; pyjamas; slippers; wetsuits; bodysuits; jeans; sarongs; parts of clothing, footwear and headgear.

10) In *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM* Case T-133/05) ('*Meric*'), the General Court held that:

> "29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 Oberhauser v OHIM – Petit Liberto (Fifties) [2002] ECR II-4359,

> paragraphs 32 and 33; Case T-110/01 Vedial v OHIM – France Distribution (HUBERT) [2002] ECR II-5275,paragraphs 43 and 44; and Case T-10/03 Koubi v OHIM – Flabesa (CONFORFLEX) [2004] ECR II-719, paragraphs 41 and 42)."

The applicant's goods are either self-evidently identical to the opponent's goods or fall within one or more terms in the opponent's specification as per *Meric*. The respective goods are therefore identical.

Average consumer and the purchasing process

11) It is necessary to determine who the average consumer is for the respective goods and the manner in which they are likely to be selected. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

> "60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

12) The average consumer for the respective goods is the general public. The purchasing act will be primarily visual as they will be selected after perusal of racks/shelves in high-street stores or from photographs/images on Internet websites or in catalogues. That is not to say though that the aural aspect should be ignored since the goods may sometimes be the subject of discussions with sales representatives, for example. The cost of the goods is likely to vary. However, factors such as size, material, comfort/fit, aesthetics and/or suitability for purpose are likely to be taken account of by the consumer. Generally speaking, I find that a

medium degree of attention is likely to be paid during the purchase for the goods at issue.

Comparison of marks

13) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

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

14) The marks to be compared are:

CULTURE LONDON v CUL/TURE A Conscious Interruption

In terms of overall impression, the earlier mark consists of the words 'CULTURE LONDON' in plain block capitals. Although the word 'LONDON' plays a role in the overall impression, it is entirely descriptive for obvious reasons (merely indicating

that the relevant goods have been designed/manufactured in London). It is the first, and distinctive, word 'CULTURE', which strongly dominates the overall impression of the mark as a whole. Turning to the contested mark, this naturally breaks down into two elements. The first element is 'CUL/TURE' (where the letters are in plain block capitals); the second element is the words 'A Conscious Interruption' in plain text. The latter element is distinctive and takes up a relatively larger proportion of the mark than the first element. However, the distinctive 'CUL/TURE' element enjoys a relatively more prominent position at the beginning of the mark and will, therefore, be the first to impact upon the consumer's perception. I find that 'CUL/TURE' contributes more greatly to the mark's overall impression with 'A Conscious Interruption' playing an important, but lesser, role.

15) Visually, the marks coincide in that they both begin with the word CULTURE. However, the contested mark contains a forward slash in between the letters 'L' and 'T' in that word which is not present in the earlier mark, thereby creating a point of visual difference. Each mark also contains an additional word(s) which bear no resemblance to the word(s) in the other mark ('LONDON' in the earlier mark as opposed to 'A Conscious Interruption' in the contested mark). Taking all of these factors into account and bearing in mind that it is the beginning of marks which tend to have the greater impact upon the perception, I find a low-medium degree of visual similarity between the marks overall.

16) Aurally, the respective CULTURE and CUL/TURE elements are likely to be pronounced identically (I do not consider that the presence of the forward slash in the contested mark disturbs this finding). The other word(s) in the marks bear no aural resemblance to each other. Taking all of these factors into account and bearing in mind that it is the beginning of marks which tend to have the greater impact upon the ear, I find a low-medium degree of aural similarity between the marks overall.

17) Turning to how the respective marks are likely to be conceptualised, I will first consider the CUL/TURE element of the contested mark. I find that this element is, notwithstanding the presence of the forward slash, likely to be perceived immediately as the word 'CULTURE'. The respective CUL/TURE and CULTURE elements are, therefore, conceptually identical. The words 'A Conscious Interruption' in the

contested mark are self-explanatory and have no counterpart in the earlier mark. The 'LONDON' concept in the earlier mark has no counterpart in the contested mark but I bear in mind that that concept does not create a *distinctive* conceptual difference. I find a medium degree of conceptual similarity between the marks overall.

Distinctive character of the earlier mark

18) The distinctive character of the earlier mark must be considered. The more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). In *Lloyd Schuhfabrik Meyer & Co. GmbH* v *Klijsen Handel BV,* Case C-342/97 the CJEU stated that:

> "22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *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)."

Inherently, the earlier mark neither describes nor alludes to any characteristic of the earlier goods. I find it to have a normal degree of inherent distinctiveness.

19) Mr Cheema states that the earlier mark has been used since February 2018 through various retail spaces such as pop-up shops, stalls and retail outlets in London. He provides some undated photographs showing the mark on a hat, a bag and several t-shirts[3]. A 'To whom it may concern' letter is also provided by Mr Cheema from his accountant[4]. The letter states that the applicant has "sold the products of up to £50,000 approximately to date" (the letter is dated 01 November 2022). Mr Cheema also provides three invoices (one for each year from 2019 -2021) which are addressed to him from a graphic designer who is said to have developed designs and concepts for the opponent's goods[5]. Suffice it to say that such evidence falls substantially short of establishing that the distinctiveness of the earlier mark has been enhanced through use. I must therefore make the assessment of the likelihood of confusion on the basis of the inherent distinctiveness of the mark.

Likelihood of confusion

20) Ms Octave's evidence provides information about the ethos behind the applicant's brand, its future vision and the use which is said to have been made of the contested mark since February 2021. Examples of such use are provided in the exhibits[6]. The mark appears, as follows, on the applicant's website and upon items of clothing and bags (I note that this is different to the mark applied for because the forward slash intercepts the letters 'L' and 'T' in the use shown in the evidence whereas it does not in the mark that has actually been applied for).:

[3] Exhibit 1
[4] Exhibit 3
[5] Exhibit 4
[6] DR01 & DR02

Ms Octave also provides a print from the IPO database showing a number of marks containing the word 'CULTURE' which, she says, shows that they are all co-existing on the register in class 25[7].

21) The purpose of the evidence appears to be to show that the respective parties have different customer bases, as per the applicant's accompanying submissions, where it states that 'the customer of the applicant's fashion design products would be different to that of the opponent – the applicant's products attract niche customers of the fashion and faith-based community, while the opponent would be selling goods to the public at large…'[8] However, I must assess the matter before me notionally and objectively based upon the actual marks and goods before me and not upon the way that either party has actually used its mark in the marketplace to date or, indeed, how it currently intends to use it in the future[9]. That is to say, I must take into account all of the ways in which the contested mark might be used if it were registered[10]. As for the fact that there are a number of marks on the register in class 25 containing the word CULTURE, this does not mean that any of those marks are actually in use in the UK. That evidence therefore tells me nothing about the extent to which the average consumer has been exposed to such marks or their ability to differentiate between them. Accordingly, none of Ms Octave's evidence is of any assistance to the applicant.

22) I must now feed all of my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors: i) the interdependency principle, whereby a lesser degree of similarity between the goods may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*); ii) the principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*), and; iii) the factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare

[7] DR05
[8] Applicant's Written submissions dated 19 January 2023, [16]
[9] In this connection, in *Devinlec Développement Innovation Leclerc SA v OHIM,* Case C-171/06P, the CJEU stated: "59. As regards the fact that the particular circumstances in which the goods in question were marketed were not taken into account, the Court of First Instance was fully entitled to hold that, since these may vary in time and depending on the wishes of the proprietors of the opposing marks, it is inappropriate to take those circumstances into account in the prospective analysis of the likelihood of confusion between those marks."
[10] As per *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited,* Case C- 533/06, [66]

marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V).*

23) I have found that the respective goods are identical and the marks are visually similar to a low-medium degree, aurally similar to a low-medium degree and conceptually similar to a medium degree. The earlier mark also has a normal degree of distinctiveness. Taking all of these factors together, I find that an average consumer paying a medium degree of attention is unlikely to mistake one mark for the other. There is no likelihood of direct confusion. However, I must also consider whether there is a likelihood of indirect confusion. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10 (*L.A. Sugar),* Mr Iain Purvis Q.C. (as he then was), sitting 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)".

24) I also keep in mind that in *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion. Furthermore, it is not sufficient that a mark merely calls to mind another mark: *Duebros Limited v Heirler Cenovis GmbH,* BL O/547/17. This is mere association not indirect confusion.

25) The categories listed above in *L.A. Sugar* are, of course, not an exhaustive list of all the ways in which indirect confusion can occur. They are merely examples of the way in which it tends to occur. In the instant case, it seems to me that there is likely to be a significant proportion of consumers who are likely to misremember the CUL/TURE element of the contested mark as being simply the word CULTURE (without the forward slash). Bearing this in mind, I find that, when faced with the respective marks in use on identical goods, those average consumers are likely to believe that 'CULTURE LONDON' and 'CULTURE A Conscious Interruption' (i.e. where CUL/TURE has been imperfectly recalled as CULTURE) are variant marks and/or indicate different product ranges from the same or linked undertaking(s). **The opposition under Section 5(2)(b) of the Act succeeds in full.**

COSTS

26) As the opponent has been successful, he is entitled to an award of costs. The official letter of 28 February 2023 stated:

"If you intend to make a request for an award of costs you must complete and return the attached pro-forma and send a copy to the other party."

On 28 March 2023, Mr Cheema filed a completed costs pro-forma, in which he claims the following:

- 45 minutes preparing the notice of opposition.
- £100 for the official fee which accompanied the notice of opposition.
- four hours in total in relation to the gathering of evidence and the 'use of a solicitor'. No copy of the relevant bill is provided (which is said to be in the amount of £350 for 1 hour).
- 1 hour for the preparation of written submissions.
- A request for 'other expenses' totalling £450. However, this appears to be made up of the £100 for the official fee + £350 for the solicitor's fees which have already been claimed above. I will not, therefore factor these 'other expenses' into my assessment.

27) The requests made in relation to the time spent upon preparing the notice of opposition, the gathering of evidence and written submissions all appear to me to be reasonable. However, I make no award for the solicitor's fees given that the relevant bill has not been provided. The opponent is also entitled to reclaim the full cost of the official fee for filing the notice of opposition. The Litigants in Person (Costs and Expenses) Act 1975, the Civil Procedure Rules Part 46 and the associated Practice Direction, set the amount payable to litigants in person at £19 per hour. I therefore award costs to the opponent on the following basis:

Official fee (notice of opposition) = £100

Preparing the notice of opposition (45 mins) = (0.75 x £19) = £14.25

Preparing and gathering evidence (4 hours) = (4 x £19) = £76

Preparing written submissions (1 hour) = £19

Total: £209.25

28) I order A Conscious Interruption Limited to pay Satwant Singh Cheema the sum of **£209.25**. This sum is to be paid within twenty-one days of the expiry of the appeal period or, if an appeal is filed, within twenty-one days of the final determination of this case if any such appeal against this decision is unsuccessful.

Dated this 7th day of July 2023

Beverley Hedley
For the Registrar,
the Comptroller-General