O/0771/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003776697
BY KIMANE ERSKINE, KAMAL LASHLEY AND NAEEM DACOSTA BEST
TO REGISTER THE TRADE MARK:

Create.

CREATE.

(SERIES OF 2)

IN CLASS 25

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 435620
BY CREATEME TECHNOLOGIES LLC

BACKGROUND AND PLEADINGS

1. On 12 April 2022, Kimane Erskine, Kamal Lashley and Naeem Dacosta Best ("the applicants") applied to register the series of two trade marks shown on the cover page of this decision in the UK. The application was published for opposition purposes on the 27 May 2022. The applicants seek registration for the following goods:

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

2. The application was opposed by CreateMe Technologies LLC ("the opponent") on 16 August 2022. The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opponent relies upon the following trade mark:

CREATEME

UK registration no. UK00003516556

Filing date 28 July 2020; Registration date 15 January 2021.

Relying upon some of the goods for which the mark is registered, namely:

Class 25	Clothing for adults and children, namely, shirts, pants, skirts, dresses, ties, sweaters, shorts, jackets, underwear, socks hats, headwear, and coats as outerwear; shoes for adults and children.

3. The opponent claims that there is a likelihood of confusion because the goods and the marks are highly similar.

4. The applicants filed a counterstatement denying the claims made.

5. The opponent is represented by Ladas & Parry LLP and the applicants are unrepresented. A hearing was neither requested nor considered necessary, however, the opponent filed submissions in lieu of a hearing. I have taken all of the submissions into consideration in reaching my decision and will refer to it where necessary below.

RELEVANCE OF EU LAW

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

PRELIMINARY ISSUE

7. Within its Form TM8, the applicants' submit that "if the opposition's argument is valid then it would be the same case for any other companies with similar trade marks. However, registered trademarks UK00002604587 and UK0091844080 have similar if not identical trade marks, with the trade marks being the words 'CREATE' and 'Create' which are both in class classification 25 along with 'Create' and 'CreateMe'. This demonstrates that both trade marks could simultaneously live within the same class without it affecting the others business or reputation."

8. In *Zero Industry Srl v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM),* Case T-400/06 the General Court ("GC") stated that:

> "73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word 'zero', it should be pointed out that the Opposition Division found, in that regard, that '… there are no indications as to how many of such trade marks are effectively used in the market'. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word 'zero' is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T-135/04 GfK v OHIM – BUS(Online Bus) [2005] ECR II-4865, paragraph 68, and Case T-29/04 Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH) [2005] ECR II-5309, paragraph 71). "

9. This submission does not assist the applicants. This is because I have no evidence of how (if at all) these marks have been effectively used in the market. The mere fact that there are multiple marks in the UK Register that contain the word "CREATE" for class 25 goods is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned, and is therefore not relevant to my assessment.

DECISION

<u>Section 5(2)(b)</u>

10. Section 5(2)(b) 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."

11. The earlier marks had not completed their registration process more than five years before the relevant date (the registration date of the mark in issue). Accordingly, the use provisions at s.6A of the Act do not apply. The opponent may rely on all of the goods it has identified without demonstrating that it has used the marks.

Section 5(2)(b) case law

12. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG,* Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc,* Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV,* Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH,* Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM,* Case C-334/05P and *Bimbo SA v OHIM,* Case C-591/12P:

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

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

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

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

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

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

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

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

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

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

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

Comparison of goods

13. The competing goods are as follows:

Opponent's goods	**Applicants' goods**
Class 25 Clothing for adults and children, namely, shirts, pants, skirts, dresses, ties, sweaters, shorts, jackets, underwear, socks hats, headwear, and coats as outerwear; shoes for adults and children.	Class 25 Clothes; Clothing; Layettes [clothing]; Jackets [clothing]; Kerchiefs [clothing]; Chaps (clothing); Maternity clothing; Thermal clothing; Belts [clothing]; Muffs [clothing]; Capes (clothing); Motorists' clothing; Boas [clothing]; Slips [clothing]; Veils [clothing]; Wraps [clothing]; Athletic clothing; Triathlon clothing; Windproof clothing; Silk clothing; Work clothes; Woolen clothing; Ladies' clothing; Latex clothing; Wristbands [clothing]; Tops [clothing]; Knitted clothing; Oilskins [clothing]; Motorcyclists' clothing; Hoods [clothing]; Leisure clothing; Infant clothing; Children's clothing; Childrens' clothing; sports clothing; Leather clothing Gloves [clothing]; Waterproof clothing; Plush clothing; Girls' clothing; Swaddling clothes; Knitwear [clothing]; Cloth bibs; Cyclists' clothing; Playsuits [clothing]; Slipovers [clothing]; Jerseys [clothing]; Weatherproof clothing; Casual clothing; Denims [clothing]; Combinations [clothing]; Furs [clothing]; Shorts [clothing]; Collars [clothing]; Babies' clothing; Ties [clothing]; Outer clothing; Cashmere clothing; Bandeaux [clothing];

	Women's clothing; Bodies [clothing]; Embroidered clothing.

14. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

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

15. Guidance on this issue has come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and, in particular, whether they are or are likely to be found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for

instance, whether market research companies, who of course act for industry, put the goods or services in the same or different sectors

16. In *Gérard Meric v Office for Harmonisation in the Internal Market (OHIM),* Case T-133/05, the General Court ("GC") stated that:

> "29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut für Lernsysterne 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."

17. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

> "… Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR) [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

18. In making my assessment, I note that the Tribunal Section of the Trade Marks Manual[1] states that specifications which include the wording 'namely' should be

[1] https://www.gov.uk/guidance/trade-marks-manual/tribunal-section accessed 5 August 2023

interpreted as covering only the named goods within that specification. Therefore, the opponent's specification is limited to only those goods.

Clothes; Clothing; Maternity clothing; Thermal clothing; Motorists' clothing; Athletic clothing; Triathlon clothing; Windproof clothing; Silk clothing; Work clothes; Woolen clothing; Ladies' clothing; Latex clothing; Knitted clothing; Motorcyclists' clothing; Leisure clothing; Infant clothing; Children's clothing; Childrens' clothing; sports clothing; Waterproof clothing; Plush clothing; Girls' clothing; Knitwear [clothing]; *Cyclists' clothing; Weatherproof clothing; Casual clothing; Denims [clothing]; Furs [clothing]; Outer clothing; Cashmere clothing; Women's clothing; Embroidered clothing.*

19. The opponent's "clothing for adults and children, namely, shirts, pants, skirts, dresses, ties, sweaters, shorts, jackets, underwear, socks hats, headwear, and coats as outerwear", falls within the applicants' above broader categories. I consider them identical on the principle outlined in *Meric*.

Jackets [clothing].

20. The opponent's "clothing for adults and children, namely […] jackets" is self-evidently identical to the applicants' above goods.

Shorts [clothing].

21. The opponent's "clothing for adults and children, namely […] shorts" is self-evidently identical to the applicants' above goods.

Kerchiefs [clothing]; Veils [clothing]

22. A kerchief is a piece of cloth that you can wear on your head. A veil is a headpiece composed of a thin piece of material which can cover the face. Consequently, I consider that the applicants' above goods fall within the broader category of "clothing for adults and children, namely, […] headwear" in the opponent's specification. I consider them identical on the principle outlined in *Meric*.

Hoods [clothing].

23. I consider 'headwear' as goods worn on the users head, which would include hoods. Therefore, I consider that the applicants' above goods fall within the broader category of "clothing for adults and children, namely, […] headwear" in the opponent's specification. I consider them identical on the principle outlined in *Meric*.

Oilskins [clothing].

24. Oilskins "are a coat and pair of trousers made from thick waterproof cotton cloth".[2] Therefore, I consider that these goods fall within the broader category of "clothing for adults and children, namely pants, […] jackets" in the opponent's specification. I consider them identical on the principle outlined in *Meric*.

Tops [clothing]; Jerseys [clothing]; Bandeaux [clothing]; Bodies [clothing].

25. I consider that the applicants' above goods are similar to the opponent's "clothing for adults and children, namely, shirts […]". All of the goods are types of clothing, which are to be worn on the upper half of the body. Therefore, I consider that they overlap in nature, method of use, purpose and users. I also consider that there would be an overlap in distribution channels as clothing retail stores would sell all of the goods, which would be located in the same aisle. I do not consider that the goods are complementary, however, they will be in competition, as a consumer may choose to buy one instead of the other. Consequently, I consider that the goods are similar to a high degree.

Slipovers [clothing].

26. I consider that the applicants' above goods overlap with the opponent's "clothing for adults and children, namely, […] sweaters". All of the goods are types of clothing that would be worn over other items of clothing to keep the user warm, and/or for fashionable purposes. Consequently, they overlap in nature, method of use, purpose

[2] https://www.collinsdictionary.com/dictionary/english/oilskins accessed 5 August 2023

and user. However, I note that slipovers do not usually have arms/sleeves, whereas the opponent's goods would. I consider that there would be an overlap in distribution channels as clothing retail stores would sell all of the goods, which are likely to be found in close proximity. I do not consider that the goods are complementary, however, I consider that they may be, to some extent, in competition. Therefore, I consider that the goods are similar to a high degree.

Playsuits [clothing].

27. A playsuit is an outfit which is comprised of a top and shorts, which are connected. Therefore, I consider that the applicants' above goods are similar to the opponent's "clothing for adults and children, namely, shirts, […] shorts". All of the goods are types of clothing that will be worn by the user, for both practical and fashionable purposes. Therefore they overlap in method of use, user and purpose. The goods to some extent will overlap in nature as the opponent's goods either cover the top half or the bottom half of the person, whereas the applicants' playsuits cover both halves. I consider that there will be an overlap in distribution channels as all of the goods would be sold in clothing retail stores. I do not consider that the goods are complementary, however, I do consider that they would be in competition. Consequently, I consider that that the goods are similar to a medium degree.

Wraps [clothing]; Capes (clothing).

28. I consider that the applicants' above goods are similar to the opponent's "clothing for adults and children, namely […] jackets […] coats as outerwear". All of the goods are types of outerwear that will be worn by the user, for both practical and fashionable purposes. They therefore overlap in nature, user and purpose. However, the goods do not overlap in method of use as a wrap/cape is a rectangular piece of material which wraps around the users body, whereas a jacket and coat would have arms, and a body, which would do up using either a zip or buttons. I consider that there would be an overlap in distribution channels as all of the goods would be sold in clothing retail stores, in close proximity. I do not consider that the goods are complementary, however, they may be in competition because a user may choose either goods as

outerwear to keep themselves warm. Therefore, I consider that the goods are similar to a medium degree.

Combinations [clothing].

29. I note that combinations are defined as a "one-piece woollen undergarment with long sleeves and legs".[3] I consider that this clothing would be worn under other pieces of clothing to keep the user warm. Therefore, I consider the above goods are similar to the opponent's "clothing, namely, shirts, T-shirts, tank tops, hoodies, crew neck sweatshirts, jackets, shorts, pants, […] coats as outerwear". All of the goods are types of clothing, which will be worn by the average consumer. Therefore, they overlap in method of use, user and purpose. However, the specific purpose of combinations is that they are to be worn under clothing. I also consider that there may be an overlap in distribution channels as all of the goods would be sold in clothing retail stores. However, I do not consider that the goods are complementary nor in competition. Consequently, I consider that that the goods are similar to a medium degree.

Slips [clothing].

30. Slips are a type of undergarment which is used to stop underwear from showing through the woman's garment, as well as to keep the user warm. Therefore, I consider that the same comparison applies in paragraph 29 above.

Muffs [clothing]; Leather clothing Gloves [clothing].

31. I consider that the applicants' above goods are similar to the opponent's "clothing for adults and children, namely […] hats, headwear". The above goods are all accessories to be worn by the user to keep them warm and therefore overlap in nature, method of use and purpose, albeit the goods keep different parts of the users body warm (hands vs head). I consider that the goods would overlap in distribution channels being sold in the same general retail stores within the same aisle. The goods are

[3] https://www.collinsdictionary.com/dictionary/english/combinations accessed 5 August 2023

neither complementary, nor in competition. I consider that they are similar to a medium degree.

Chaps (clothing).

32. Chaps are (typically) leather trousers without a seat, as worn by a cowboy over ordinary trousers to protect the legs. I consider that the applicants' above goods are similar to the opponent's "clothing for adults and children, namely, […] pants […] shorts". I note that the goods overlap in user and method of use because they are types of clothing, to be worn on the users bottom half. Chaps are usually made of sturdier materials such as leather, and I acknowledge that pants and shorts can also be made out of this materials. Consequently, the goods overlap in nature. However, they differ in purpose because chaps are to be worn over trousers and are not joined at the crotch. I consider that there may be an overlap in trade channels as some clothing retail outlets will sell all of the goods, however, I also appreciate that there may be some undertakings which may specialise in only selling chaps. The goods are not in competition nor complementary. Thus, the goods are similar to between a low and medium degree.

Wristbands [clothing].

33. The opponent's "clothing for adults and children, namely, shirts, pants, sweaters, shorts, jackets, socks […] hats, headwear, and coats as outerwear" would include clothing which is worn for sporting purposes. I therefore consider that these goods would overlap in purpose with the applicants' "wristbands [clothing]". I also consider that there would be an overlap in trade channels as the same sporting undertakings would sell all of the above goods. The goods would also be sold within the same section of a clothing outlet. There is also an overlap in user. However, the goods do not overlap in purpose, method of use or nature as the opponent's goods, are types of clothing (including those worn for sporting purposes), whereas the applicants' goods are sports accessories. I do not consider that the goods are complementary as they are not important or indispensable to each other. Nor do I consider that the goods are in competition. Consequently, I consider that the goods are similar to a low degree.

Babies' clothing; Layettes [clothing]; Swaddling clothes; Cloth bibs.

34. I consider that swaddling clothes would be used to be wrapped around a baby. I also note that layettes is a broad term which covers body suits, pants and leggings, and even accessories such as bibs, for new-born babies. Therefore, all of the above goods are specifically clothing for babies, which would not be replicated for adults. Although the goods are technically types of clothing, and therefore overlap in nature with the opponent's "clothing for children" goods, they do not overlap in method of use, purpose or user. However, I consider that there would be an overlap in distribution channels because children's clothing and babies clothing would all be sold at a general clothing store, albeit not in the same aisle, but in close proximity. The goods are neither in competition nor complementary. The goods are similar to a low degree.

Belts [clothing]; Ties [clothing].

35. I consider that the applicants' above goods have limited overlap with the opponent's "clothing for adults and children, namely, shirts, pants, skirts, dresses, ties, sweaters, shorts, jackets, underwear, socks hats, headwear, and coats as outerwear". Belts are used hold up garments, such as a pair of trousers or a skirt, ties are worn to formal occasions, and both can also be worn purely for fashionable purposes. The opponent's goods are used to be worn and cover up the users body, but I also consider that they may also be worn for fashionable purposes. Although both goods are to be worn on the body, they are to be worn in such a different way that I do not consider that they overlap in method of use. The goods will likely be selected by the same users and sold through the same distribution channels. However, the physical nature of the goods will differ. The goods are neither in competition nor complementary. I therefore find these goods similar to a low degree.

Collars [clothing].

36. As set out in *Les Éditions Albert René v OHIM*,[4] it is clear that just because a particular good is used as a part, element or component of another, it should not result

[4] Case T-336/03

in a finding of identity/similarity between those goods. However, it does not mean that there can never be similarity between such goods where there is overlap in the factors identified in *Treat*.

37. In this instance, I consider that the applicants' collars, which are parts of clothing, do not overlap with all of the opponent's clothing goods. Albeit some of the clothing goods (such as shirts) may have collars, I do not find that the use, user or nature of the goods overlap. I also consider that there wouldn't be an overlap in trade channels as the applicants' parts of clothing would be purchased wholesale to be used in the production of the finished article, which would then be on sale to the general public. I do not consider that the goods are in competition nor complementary. Taking the above into account, I consider that the goods are dissimilar.

Boas [clothing].

38. Boas are a type of "long scarf made of feathers or short pieces of very light fabric".[5] I consider that these goods are dissimilar to the opponent's clothing goods. I consider that the applicants' above goods are accessories that are to be worn by the average consumer, most likely as a fancy dress item. Therefore, I consider that the applicants' goods are most likely to be sold through fancy dress shops. The opponent's goods are used to keep the user covered and warm, or worn for fashionable purposes. They are also likely to be sold through general clothing retail outlets. Therefore, I do not consider that the goods overlap in nature, method of use, purpose or trade channels. There may be an overlap in user, however, this is not enough on its own to establish similarity. The goods are neither complementary nor in competition. The goods are, therefore, dissimilar.

39. It is a prerequisite of section 5(2)(b) that the goods be identical or at least similar. The opposition will, therefore, fail in respect of the goods that I have found to be dissimilar.[6] The opposition under section 5(2)(b) fails for the following goods:

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[5] https://www.collinsdictionary.com/dictionary/english/boa accessed 5 August 2023
[6] *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

Class 25 Collars [clothing]; Boas [clothing].

The average consumer and the nature of the purchasing act

40. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. 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."

41. The average consumer for the goods will be members of the general public. The cost of purchase is likely to vary, and the goods will be purchased relatively frequently. However, various factors are still likely to be taken into consideration during the purchasing process, such as materials used, cut, aesthetic appearance and durability. Consequently, I consider that a medium degree of attention will be paid by the average consumer when selecting the goods.

42. The goods are likely to be obtained by self-selection from the shelves of a clothing retail outlet, online or catalogue equivalent. This means that the mark will be seen and so the visual element of the mark will be the most significant: see *New Look Limited v OHIM*, Joined cases T-117/03 to T-119/03 and T-171/03, paragraph 50. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount that there will also be an aural component to the purchase, as advice may be sought from a sales assistant or representative.

Comparison of the trade marks

43. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade 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."

44. 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.

45. The respective trade marks are shown below:

Opponent's trade marks	Applicants' trade mark
CREATEME	**Create.** **CREATE.** **(Series of 2)**

46. The opponent's mark consists of the word CREATEME, which is composed of the ordinary dictionary words CREATE and ME . There are no other elements to contribute to the overall impression which lies in the word itself.

47. The applicants' series of two trade marks consists of the words CREATE with a full stop at the end. The first mark is presented with a capital C with the rest of the letters in lower-case, and the second mark is presented all in upper-case. I consider that word CREATE plays a greater role in the overall impression of the mark, with the full stop playing a lesser role.

48. Visually, the word CREATE in the applicants' marks is wholly contained at the beginning of the opponent's mark. This acts as a visual point of similarity. However, the opponent's mark ends in the word ME, and the applicants' marks end in a full stop. These act as visual points of difference. I also bear in mind that the average consumer tends to pay more attention to the beginning of the marks.[7] Consequently, I consider that the marks are visually similar to between a medium and high degree.

49. Aurally, the opponent's mark will be pronounced as CRE-ATE-ME. The applicants' marks will be pronounced as CRE-ATE. I do not consider that the average consumer would pronounce the full stop at the end of the applicants' marks. Therefore, as the marks overlap in the pronunciation of CREATE, I consider that they are aurally similar to between a medium and high degree.

50. Conceptually, both marks share the word create, which is an ordinary dictionary word, which would be recognised by the average consumer, meaning to invent or design something. I do not consider that the full stop adds conceptually to the applicants' marks. The word ME at the end of the opponent's mark is an ordinary dictionary word. I consider that the opponent's mark as a whole would be recognised as meaning to make or design "me". Therefore, as the marks overlap in the word CREATE, I consider that they are conceptually similar to between a medium and high degree.

[7] *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

Distinctive character of the earlier trade mark

51. 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 C108/97 and C-109/97 Windsurfing Chiemsee v Huber and Attenberger [1999] ECR 1-2779, paragraph 49).
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> 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 promotion of 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)."

52. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, 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 that has been made of it.

53. As the opponent has not filed any evidence to show that the distinctiveness of its mark has been enhanced through use, I only have the inherent position to consider.

54. As highlighted above, the opponent’s mark is the word CREATEME, which is composed of two ordinary dictionary words, which conveys the concept to invent or design “me”. As the mark is being used on clothing goods, I consider that the “me” element may be understood by the average consumer as asking them to design or decorate the clothing goods, or that the clothing helps create the consumer’s outfit (can you “create me” an outfit?). I therefore consider that the mark is inherently distinctive to no more than a medium degree.

Likelihood of confusion

55. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. This includes the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. It is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

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

- I have found the marks to be visually similar to between a medium and high degree.
- I have found the marks to be aurally similar to between a medium and high degree.

- I have found the marks to be conceptually similar to between a medium and high degree.
- I have found the opponent's mark to be inherently distinctive to no more than a medium degree.
- I have identified the average consumer to be members of the general public who will select the goods primarily by visual means, although I do not discount an aural component.
- I have concluded that a medium degree of attention will be paid during the purchasing process for the goods.
- I have found most of the parties' goods to be identical, other similar in varying degrees, including to a low degree.

57. Taking all of the factors listed in paragraph 56 into account, bearing in mind the principle of imperfect recollection, I consider that the marks are likely to be mistakenly recalled or misremembered as each other. This is particularly the case given the between a medium and high degree of visual similarity between the marks and the predominantly visual purchasing process. Even where aural considerations play a greater role, the higher aural similarity (to between a medium and high degree) between the marks will have the same result. The beginnings of marks tend to make more of an impact than the ends. Therefore, I consider that because the word CREATE in the applicants' marks is fully contained at the beginning of the opponent's mark, the word ME in the opponent's mark and the full stop at the end of the applicants' marks could be overlooked by the average consumer.

58. Furthermore, I consider that in the absence of a significant conceptual hook to differentiate the marks, the average consumer will not have a strong conceptual message to assist them in differentiating between the opponent's and applicants' marks. In my view, this results in a likelihood of direct confusion, even where there is only a low degree of similarity between the goods, due to the effect of the interdependency principle.

59. In the event that I am wrong in that regard, and for the sake of completeness, I will also assess if there is a likelihood of indirect confusion. Indirect confusion was

described in the following terms by Iain Purvis Q.C. (as he was then), sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

> "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."

60. 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.

61. I consider that the shared common use of the word CREATE in both marks will lead the average consumer to conclude that the marks originate from the same or economically linked undertakings. I consider that if the average consumer notices the word ME at the end of the opponent's mark, they will perceive it as either an updated version of the same mark, and therefore indicative of re-branding, or a sub-brand mark (with CREATE. being the house brand, and CREATEME being the sub-brand, potentially for a line of clothing which is capable of individualisation by the consumer, for example, they can be creative, decorate and embellish themselves). Taking all of the above into account, I consider there to be a likelihood of indirect confusion.

CONCLUSION

62. The opposition is partially successful in respect of the following goods, for which the application is refused:

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

63. The application can proceed to registration in respect of the following goods, for which the opposition has been unsuccessful:

Class 25 Collars [clothing]; Boas [clothing].

COSTS

64. The opponent has enjoyed a greater degree of success in the opposition and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. I will make an appropriate reduction in the award of costs made to reflect the opponent’s only partial success. In the circumstances, I award the

opponent the sum of **£400** as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Filing a Notice of opposition and considering the applicant's counterstatement	£150
Preparing and filling written submissions in lieu	£150
Official Fee	£100
Total	**£400**

65. I therefore order Kimane Erskine, Kamal Lashley and Naeem Dacosta Best to pay CreateMe Technologies LLC the sum of £400. 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 11th day of August 2023

L FAYTER
For the Registrar