

**BL O/0816/23**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. UK00003722340**

**BY JUST ELEGANT LTD**

**TO REGISTER THE TRADE MARK:**

**JESSICA JOY LONDON**

**IN CLASS 25**

**AND**

**IN THE MATTER OF OPPOSITION THERETO**

**UNDER NO. 433378**

**BY JESSICA LONDON, INC.**

## **BACKGROUND AND PLEADINGS**

1. On 17 November 2021, JUST ELEGANT LTD (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 11 February 2022. The applicant seeks registration for the following goods:

Class 25      Clothing; Clothes; Tops [clothing]; Knitted clothing; Hoods [clothing]; Leisure clothing; Infant clothing; Children's clothing; Childrens' clothing; Sports clothing; Leather clothing; Gloves [clothing]; Waterproof clothing; Girls' clothing; Layettees [clothing]; Jackets [clothing]; Maternity clothing; Thermal clothing; Belts [clothing]; Muffs [clothing]; Capes (clothing); Slips [clothing]; Veils [clothing]; Wraps [clothing]; Athletic clothing; Triathlon clothing; Windproof clothing; Silk clothing; Work clothes; Woolen clothing; Ladies' clothing; Knitwear [clothing]; Playsuits [clothing]; Jerseys [clothing]; Weatherproof clothing; Casual clothing; Combinations [clothing]; Furs [clothing]; Shorts [clothing]; Collars [clothing]; Babies' clothing; Outer clothing; Bandeaux [clothing]; Women's clothing; Bodies [clothing]; Embroidered clothing.

2. The application was opposed by JESSICA LONDON, INC (“the opponent”) on 11 May 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 marks:

# JESSICA LONDON

Comparable UK trade mark (EU) registration no. UK00909952706

Filing date 9 May 2011.

Registration date 21 September 2011.

**(“The First Earlier Mark”)**

# **JESSICA LONDON**

Comparable UK trade mark (EU) registration no. UK00910254563

Filing date 9 September 2011.

Registration date 10 February 2012.

**(“The Second Earlier Mark”)**

3. The opponent relies upon all of the class 25 goods for which the First Earlier Mark is registered, and all of its class 35 services for which the Second Earlier Mark is registered.

4. The opposition is based upon both the opponent’s earlier comparable UK trade marks (EU),<sup>1</sup> claiming that there is a likelihood of confusion because of the high similarity of the respective marks and the identity and/or high similarity of the goods.

5. The applicant filed a counterstatement denying the claims made.

6. The opponent is represented by Abel & Imray LLP and the applicant does not have professional representation. Neither party requested a hearing, however, the applicant filed evidence in chief, and the opponent filed evidence in reply. The opponent also filed written submissions and submissions in lieu of a hearing.

7. I have taken all of the evidence and submissions into account in reaching this decision, referring to them as necessary.

## **RELEVANCE OF EU LAW**

8. 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.

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<sup>1</sup> Following the end of the transition period of the UK’s withdrawal from the EU, all EU trade marks (“EUTM”) registered before 1 January 2021 were recorded as comparable trade marks in the UK trade mark register (and as a consequence, have the same legal status as if they had been applied for and registered under UK law). A ‘comparable trade mark (EU)’ retains the same filing date, priority date (if applicable) and registration date of the EUTM from which it derives.

## EVIDENCE AND PRELIMINARY ISSUES

9. The applicant's evidence consists of the witness statement of Amar Afzal dated 3 March 2023. Mr Afzal is the Director of Operations for the opponent. Mr Afzal's statement was accompanied by 1 exhibit.

10. The opponent's evidence in reply consists of the witness statement of Lauren Gee dated 17 April 2023. Ms Gee is the General Counsel and Secretary for the opponent, a position she has held since 2019. Ms Gee's statement is not accompanied by any exhibits.

11. In his witness statement, Mr Afzal states the following:

"1. I would like to point out Exhibit 1 which is our branding on the hand tag. As per the exhibit it clearly shows that the emphasis is on JOY London. Further the colouration and styling of the branding is very different to the opponent and cannot see there to be any clash.

2. The product styling is very different to the said opponents as ours is more mature aimed at work wear and evening wear. From our research the website we believe is [www.jessicajoyshop.com](http://www.jessicajoyshop.com) and not Jessica Joy London. Google search also shows a website registered under [www.jessicajoylondon.com](http://www.jessicajoylondon.com)

3. Our brand is only sold through the Silk Fred website and does not have an independent retail or wholesale website.

4. We note [jessicajoyshop.com](http://jessicajoyshop.com) does not ship internationally as it looks like it is a US website and we do not ship internationally either. We believe there is no conflict of interest here.

5. We do not advertise independently therefore there is no advertising budget.

6. 2022 sales approximation of £4000 for the year."

12. Firstly, my comparison must be of the marks as registered. Therefore, the evidence contained within exhibit 1, showing the way in which the applicant's mark is used in practice, which Mr Afzal states is "very different" and does not "clash" with the opponent, does not assist the applicant.

13. Secondly, the submission that the goods have different purposes and are sold through different websites does not assist the applicant. I have to carry out a notional assessment based upon all the ways in which the goods covered by the respective specifications could be used and sold. The way in which they are used and sold in practice is not relevant to my assessment.

14. Thirdly, the applicant has not put the opponent to proof of use pursuant to section 6A of the Act. Therefore, the opponent is entitled to rely upon its full specification, and it is not required to demonstrate that it has marketed or sold its goods and services in the UK.

15. Lastly, I note that the applicant provides their approximate sales for the year 2022. Mr Afzal has not provided any further explanation as to why this information has been provided, and how it is useful or relevant in these proceedings.

16. I note that Ms Gee's statement was submitted on the basis that Mr Afzal's statement contained "incorrect statements" in regard to the opponent's business. This includes the reference to the above websites in paragraph 2, which Ms Gee confirms are not connected to opponent, and therefore Mr Afzal's statement in paragraph 4 are also "incorrect and without any substance". However, on the basis of my findings above, even if it were true, I will not be taking these submissions into consideration as they are not relevant to my assessment.

## **DECISION**

### **Section 5(2)(b)**

17. 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.”

18. The earlier marks have completed their registration process more than five years before the relevant date (the filing date of the applicant’s mark). Accordingly, the use provisions at s.6A of the Act apply. However, as the applicant did not request that the opponent prove use of its marks, it is entitled to rely upon all of its goods and services without demonstrating that it has used its marks.

### **Section 5(2)(b) case law**

19. 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 and services

20. The competing goods and services are as follows:

Opponent's goods	Applicants' goods
<p><b><u>The First Earlier Mark</u></b></p> <p><u>Class 25</u> Clothing, footwear, headgear.</p> <p><b><u>The Second Earlier Mark</u></b></p> <p><u>Class 35</u> Online retail store services featuring clothing, outerwear, footwear, handbags, jewelry, writing instruments, fragrances and accessories; mail order catalog services featuring clothing, outerwear, footwear, and accessories.</p>	<p><u>Class 25</u> Clothing; Clothes; Tops [clothing]; Knitted clothing; Hoods [clothing]; Leisure clothing; Infant clothing; Children's clothing; Childrens' clothing; Sports clothing; Leather clothing; Gloves [clothing]; Waterproof clothing; Girls' clothing; Layettes [clothing]; Jackets [clothing]; Maternity clothing; Thermal clothing; Belts [clothing]; Muffs [clothing]; Capes (clothing); Slips [clothing]; Veils [clothing]; Wraps [clothing]; Athletic clothing; Triathlon clothing; Windproof clothing; Silk clothing; Work clothes; Woolen clothing; Ladies' clothing; Knitwear [clothing]; Playsuits [clothing]; Jerseys [clothing]; Weatherproof clothing; Casual clothing; Combinations [clothing]; Furs [clothing]; Shorts [clothing]; Collars [clothing]; Babies' clothing; Outer clothing; Bandeaux [clothing]; Women's clothing; Bodies [clothing]; Embroidered clothing.</p>

21. 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.”

22. 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

23. 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 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.”

24. 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.”

### *Clothing.*

25. “Clothing” appears identically in the opponent’s First Earlier Mark’s specification and the applicant’s specification.

### *Clothes.*

26. “Clothing” in the opponent’s First Earlier Mark’s specification is self-evidently identical to “clothes” in the applicant’s specification.

*Tops [clothing]; Knitted clothing; Hoods [clothing]; Leisure clothing; Infant clothing; Children's clothing; Childrens' clothing; Sports clothing; Leather clothing; Gloves [clothing]; Waterproof clothing; Girls' clothing; Layettees [clothing]; Jackets [clothing]; Maternity clothing; Thermal clothing; Belts [clothing]; Muffs [clothing]; Capes (clothing); Slips [clothing]; Veils [clothing]; Wraps [clothing]; Athletic clothing; Triathlon clothing; Windproof clothing; Silk clothing; Work clothes; Woolen clothing; Ladies' clothing; Knitwear [clothing]; Playsuits [clothing]; Jerseys [clothing]; Weatherproof clothing; Casual clothing; Combinations [clothing]; Furs [clothing]; Shorts [clothing]; Babies' clothing; Outer clothing; Bandeaux [clothing]; Women's clothing; Bodies [clothing]; Embroidered clothing.*

27. All of the applicant's above goods fall within the broader category of "clothing" in the opponent's First Earlier Mark's specification. The goods are identical on the principle outlined in *Meric*.

*Collars [clothing].*

28. As set out in *Les Éditions Albert René v OHIM*,<sup>2</sup> it is clear that just because a particular good is used as a part, element or component of another, it should not result 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*.

29. 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' collars 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.

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<sup>2</sup> Case T-336/03

30. 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.<sup>3</sup> The opposition under section 5(2)(b) fails for the following goods:

Class 25 Collars [clothing]

31. I do not consider that the opponent's Second Earlier Mark's services would put the opponent in a better position. Therefore, on this basis, combined with the fact that the earlier marks both consist of the words "JESSICA LONDON", I will proceed with the rest of the decision relying upon the First Earlier Mark only.

### **The average consumer and the nature of the purchasing act**

32. 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."

33. 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.

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<sup>3</sup> *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

Consequently, I consider that a medium degree of attention will be paid by the average consumer when selecting the goods.

34. 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**

35. 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.”

36. 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.

37. The respective trade marks are shown below:

Opponent's First Earlier Mark	Applicant's trade mark
JESSICA LONDON	JESSICA JOY LONDON

38. The First Earlier Mark consists of the words "JESSICA LONDON", presented in a capitalised typeface. For reasons I will come to discuss in the conceptual comparison, I consider that the word "JESSICA" plays a greater role in the overall impression of the mark, with the word "LONDON" and the typeface playing a lesser role.

39. The applicant's mark consists of the words "JESSICA JOY LONDON". For reasons I will come to discuss in the conceptual comparison, I consider that the words "JESSICA JOY" play a greater role in the overall impression of the mark, with the word "LONDON" playing a lesser role.

40. Visually, the marks coincide in the word JESSICA at the beginning of the marks, which the average consumer tends to pay more attention to.<sup>4</sup> They also coincide in the word LONDON at the end of the marks. Furthermore, I note that registration of a word only mark covers use in any standard typeface. These act as visual points of similarity. However, the applicant's mark contains the word JOY in the middle of the mark. This acts as a visual point of difference. Taking all of the above into account, I consider that the marks are visually similar to between a medium and high degree.

41. Aurally, the First Earlier Mark will be pronounced as JESS-ICK-AH LON-DON. The applicant's mark will be pronounced as JESS-ICK-AH JOY LON-DON. Therefore as the beginning and the end of the marks overlap, I consider that the marks are aurally similar to between a medium and high degree.

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<sup>4</sup> *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

42. Conceptually, the word JESSICA will be recognised as an ordinary forename typically assigned to girls. This meaning would be recognised by the average consumer in both marks. The word LONDON at the end of both marks, when taken in the context of the goods, is likely to be perceived by the consumer as the location in which the clothing is produced or where the company is based.

43. The word JOY in the applicant's mark will be understood as meaning a feeling of happiness. I also consider that as it appears following the forename JESSICA, it may be recognised or perceived as Jessica's surname.

44. Regardless, as both marks share the meaning of JESSICA and LONDON, I consider that the marks are conceptually similar to between a medium and high degree.

#### **Distinctive character of the earlier trade mark**

45. 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 I-2779, 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 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).”

46. 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.

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

48. As highlighted above, the opponent’s First Earlier Mark is composed of the words JESSICA LONDON. The word JESSICA will be recognised as a girls name, and the word LONDON, in the context of the goods, will be recognised as the location where the clothing is produced or where the company is based. Therefore, when taking the mark as a whole into account, I consider that it is inherently distinctive to a medium degree.

### **Likelihood of confusion**

49. 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.

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

- I have found the marks to be visually, aurally and conceptually similar to between a medium and high degree.
- I have found the opponent's First Earlier Mark to be inherently distinctive to 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 the parties' goods to be identical.

51. Taking all of the factors listed in paragraph 50 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 identity of the goods, 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.

52. The beginnings of marks tend to make more of an impact than the ends. Therefore, I consider that because both marks begin with the forename JESSICA and end with the word LONDON, the word JOY in the middle of the applicant's mark would be easily overlooked by the average consumer. 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 First

Earlier Mark and applicant's mark. In my view, this results in a likelihood of direct confusion.

53. It now falls to me to consider the 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.”

54. 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.

55. I note that the opponent claims that there is both a likelihood of direct and indirect confusion. I agree. Both marks share the forename JESSICA at the beginning of the marks, and end with the word LONDON. I find that the additional word in the middle of the applicant's mark, JOY, does not make a significant change to the concept of the mark. As highlighted above, I consider that as the word JOY follows from the forename JESSICA, the average consumer is likely to view the word JOY as a surname.

Therefore, I find that the addition of this word in the middle of the mark will cause average consumers to consider that the mark JESSICA JOY LONDON is either an updated version of the same mark, or a sub-brand/brand extension, by the same undertaking responsible for JESSICA LONDON. I also note that the use of sub-brands and brand extensions is common in the clothing trade. The GC stated, in *Zero Industry Sri v OHIM*, Case T-400/06, at paragraph 81:

" ... it is common in the clothing sector for the same mark to be configured in various ways according to the type of product which it designates, and second, it is also common for a single clothing manufacturer to use sub-brands (signs that derive from a principal mark and which share with it a common dominant element) in order to distinguish its various lines from one another."

56. Furthermore, clothing brand marks which are composed of forenames and surnames can be "shortened", or referred to as a whole. For example, in this instance, I consider that the average consumer would see that the applicant's mark is the full name version of the mark; JESSICA JOY LONDON, with the opponent's mark being an alternative mark whereby the name "JESSICA JOY" is shortened to just "JESSICA", to make the JESSICA LONDON mark.

57. Therefore, taking all of the above into account, I consider that the average consumer would believe that the opponent's JESSICA LONDON mark and applicant's JESSICA JOY LONDON mark are alternative marks being used by the same or economically linked undertakings, being updated versions of the same marks (re-branding), and sub-brand marks. Therefore, I consider there to be a likelihood of indirect confusion.

## **CONCLUSION**

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

Class 25      Clothing; Clothes; Tops [clothing]; Knitted clothing; Hoods [clothing];  
Leisure clothing; Infant clothing; Children's clothing; Childrens' clothing;

Sports clothing; Leather clothing; Gloves [clothing]; Waterproof clothing; Girls' clothing; Layettes [clothing]; Jackets [clothing]; Maternity clothing; Thermal clothing; Belts [clothing]; Muffs [clothing]; Capes (clothing); Slips [clothing]; Veils [clothing]; Wraps [clothing]; Athletic clothing; Triathlon clothing; Windproof clothing; Silk clothing; Work clothes; Woolen clothing; Ladies' clothing; Knitwear [clothing]; Playsuits [clothing]; Jerseys [clothing]; Weatherproof clothing; Casual clothing; Combinations [clothing]; Furs [clothing]; Shorts [clothing]; Babies' clothing; Outer clothing; Bandeaux [clothing]; Women's clothing; Bodies [clothing]; Embroidered clothing.

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

Class 25 Collars [clothing].

## **COSTS**

60. 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 **£550** as a contribution towards the costs of the proceedings.

61. The sum is calculated as follows:

Filing a Notice of opposition and considering the applicant's counterstatement	£250
Preparing and filling written submissions in lieu	£300
Official Fee	£100

**Total**

**£550**

62. I therefore order JUST ELEGANT LTD to pay JESSICA LONDON, INC the sum of £550. 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 29<sup>th</sup> day of August 2023**

**L FAYTER**

**For the Registrar**