

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NOS. 3091338, 3091342, 3091344 & 3091346 BY BOOHOO.COM UK LIMITED TO REGISTER VARIOUS TRADE MARKS IN CLASSES 14, 18, 25 & 35

AND IN THE MATTER OF CONSOLIDATED OPPOSITIONS THERETO UNDER NOS. 404348-404351 BY WE BRAND S.A.R.L

DECISION

1. This is an appeal against decision O-567-17 of 13 November 2017 whereby the Registrar's Hearing Officer, CJ Bowen, upheld in part an opposition brought by the Opponent, WE Brand S.A.R.L., restricting the registration of the Applicant, Boohoo.com UK Limited, to certain goods and services in classes 14, 18 and 35. The Hearing Officer considered that the Applicant had achieved a greater measure of success than the Opponent and awarded the former £500 costs.
2. The Applicant appeals the decision and submits that the Hearing Officer should have allowed all of the Applicant's goods and services.
3. The opposition was brought under s.5(2)(b) of the Trade Marks Act 1994 whereby the Opponent objected to the registration of the following marks:

No. 3019338 – WE ARE US & WeAreUs (a series of two);

No. 3091342 - # WE ARE US & #WeAreUs (a series of two);

No. 3091344 – WE ARE & WeAre (a series of two);

No. 3091346 - # WE ARE & #WeAre (a series of two);

based upon the prior registrations:



WE



4. The Appellant/Applicant was represented by Wilson Gunn and the Respondent/Opponent by Nucleus IP Limited.

PRELIMINARY OBSERVATIONS

5. This appeal has had a troubled history. It has been adjourned three times at the request of the parties in order to allow settlement negotiations to continue and/or because of the availability of the parties' representatives.
6. Eventually the appeal was refixed to be heard on 13 January 2020.
7. On 9 January 2020, after the deadline for skeleton arguments had passed and only following prompting, I received a message from the Appellant stating that it did not wish for there to be a hearing but for the appeal to be dealt with on the papers. The Respondent indicated that it was content for the decision of the Hearing Officer to be upheld without making further submissions.
8. Following a further prompt, I eventually received written submissions from the Appellant on 13 January 2020, after the time at which the hearing had been fixed to start.
9. Where parties are professionally represented, as they are in the present case, they are expected to comply with the deadlines for hearings and in particular the deadline for skeleton arguments set out in Tribunal Practice Note 1/2016. This is not just for the convenience of the person hearing the case. The requirement to update the tribunal as to the status of the case at least two working days in advance of the hearing means that if a case has settled or a request is made for the matter to be dealt with on paper, some of the costs of the hearing (such as those of the transcript writers) can be avoided.
10. Further, in cases which have been adjourned at the request of the parties, the parties are expected to keep the tribunal up to date as to the status of any negotiations. This is to promote the smooth running of the appeal system and to avoid inconvenience to other users. The parties in the present case have been particularly poor at volunteering updates to the tribunal as to the status of the case. In future cases where an adjournment is requested I will consider making an order that it is granted on the condition that unless the parties revert to the tribunal within

a certain period of time to notify it of settlement, request a hearing or a further adjournment, then the appeal should be treated as withdrawn.

STANDARD OF APPEAL

11. I refer to the principles set out in the decision of Daniel Alexander QC, sitting as the Appointed Person, in *TT Education Ltd v Pie Corbett Consultancy* [2017] RPC 17 at [52].

THE APPEAL

12. Perhaps reflecting the time that has passed since the original hearing and the commercial interest in the outstanding issues, the written submissions provided by the Appellant were very brief. I set out the substantive submissions in full below:

The Hearing Officer has not taken into account the visual presentation of the Opponent's trade mark. We refer to point 6 in our Reasons For Appeal.

This is a critical mistake in the overall assessment and comparison of the marks and determination as to whether confusion will occur.

The Hearing Officer has not carried out a correct and proper assessment of the visual similarities of the marks.

Visually, because of the highly distinctive presentation and layout of the Opponent's mark, there are clear differences to the Appellant's marks which will not go unnoticed by the average consumer and which will ultimately lead to the conclusion that there is no likelihood of confusion

Further and in addition to the above, the Hearing officer has failed to carry out a proper assessment of the Appellant's WE ARE marks in comparison with the Opponent's trade mark set out in the above table.

The above mistakes have a critical impact on the outcome of the dispute. The Appellant considers that the Opponent's mark in the table above, which the Hearing Officer considers to be the Opponent's strongest case, is not similar to the Appellant's marks or at least is only similar to a very low degree. Consequently, there will be no likelihood of confusion.

The Hearing Officer has made errors which have resulted in a decision which is clearly wrong.

13. In the circumstances I will also deal with the appeal succinctly. In essence, the Appellant submits that the Hearing Officer did not consider the differences between the visual presentations of the respective marks. Had he done so the Appellant submits that he would have found the marks sufficiently dissimilar to have allowed the application in full.

14. The Hearing Officer dealt with the visual aspects of the Opponent's WE IS ME mark (referred to by the Hearing Officer as the Opponent's first trade mark) in the section of the Decision entitled "Comparison of Marks" at §§9-22.
15. The Reasons for Appeal refer expressly to paragraphs 20, 21 and 22 of the Decision. These read as follows:

The comparison with the opponent's first trade mark

20. The only word the opponent's first trade mark has in common with the applicant's trade marks is, once again, the word "WE". However, the presence of two additional short words i.e. "IS" and "ME" (the latter of which is also a pronoun) in the opponent's first trade mark (although undeniably visually and aurally different to the additional words in the applicant's "WE ARE US"/"WE ARE" trade marks), creates a three word unit which is, irrespective of the presence or absence of the # symbol, in my view, visually similar to the applicant's "WE ARE US" trade marks to an above average degree and to its "WE ARE" trade marks to a medium degree.
 21. Turning to the aural comparison, I have already concluded that the applicant's trade marks will be referred to as the three or five syllable combinations "WE ARE US" or "hashtag WE ARE US" and two and four syllable combinations "WE ARE" and "hashtag WE ARE" respectively. As the opponent's first trade mark will be articulated as the three syllable combination "WE IS ME," the similar aural rhythm it creates results, in my view, in an above average degree of aural similarity to the applicant's "WE ARE US" trade marks and a medium degree of aural similarity with its "WE ARE" trade marks. In terms of the variants including a hashtag, as above, the respective degree of similarity will be slightly lower in each case.
 22. Finally, the conceptual comparison. Although the precise concepts the opponent's first trade mark and the applicant's trade marks convey is difficult to pin down, they all revolve around the juxtaposition of, inter alia, various pronouns. Considered on that basis, the opponent's first trade mark is, in my view, conceptually similar to the applicant's "WE ARE US"/"WE ARE" trade marks to a fairly high and medium degree respectively; as above, the presence of the hashtag does not alter the conceptual meanings conveyed.
16. The Reasons for Appeal allege that the Hearing Officer failed adequately to compare the respective marks because he failed to take proper account of their visual and/or conceptual differences. In particular it is said that the Opponent's WE IS ME mark is a distinctive visual/figurative logo mark and not a word mark, as the Hearing Officer treated it.

17. Paragraph 12 of the Decision dealing with the characteristics of this mark reads as follows:

12. This consists of three two letter combinations i.e. “WE”, “IS” and “ME” presented in white in a slightly stylised but unremarkable font and placed one above the other within a black square which acts as a background. Given what, in my experience, is the average consumer’s natural inclination to make sense of such combinations, the letters in the opponent’s first trade mark will be construed as words which create a unit (the meaning of which is different to the individual words of which it is composed) and in which the word “WE” does not play an independent distinctive role. It will be understood by the average consumer as the phrase “WE IS ME”. It is the unit that creates the overall impression and in which the distinctiveness lies.

18. I can see no basis for interfering with the Hearing Officer’s analysis of the Opponent’s first trade mark made in this paragraph. The Hearing Officer took into account the visual presentation of the Opponent’s mark and was entitled to analyse the mark as he did; indeed I consider he was right to do so. He treated the mark as a whole, as he was required to do by the authorities, and was entitled to conclude that overall it would be understood by the average consumer as a unit, namely the phrase “WE IS ME”. As a result I reject the criticism that he should have treated the Opponent’s mark as a distinctive visual/figurative logo mark and not a word mark.

19. The Hearing Officer later reached his conclusion on the overall question under s.5(2)(b) as follows:

Conclusion in relation to the opponent’s first trade mark

66. Earlier in this decision, I concluded that the opponent’s first trade mark was visually similar to the applicant’s “WE ARE US” trade marks (including the hashtag and conjoined variants) to an above average degree, aurally similar to at least a slightly lower than above average degree and conceptually similar to a fairly high degree. I further concluded, that in relation to the applicant’s “WE ARE” trade marks (including the hashtag and conjoined variants), the opponent’s first trade mark was visually similar to a medium degree, aurally similar to at least a slightly lower than medium degree and conceptually similar to a medium degree. I further concluded that certain goods and services in the applications were either identical or similar (to varying degrees) to goods and services in the opponent’s specifications.

67. In reaching a conclusion, I begin by reminding myself that I have concluded that the average consumer for specific services in class 35 will be a business user paying a fairly high degree of attention during the selection process (making them less prone to the effects of imperfect recollection). However, keeping the

interdependency principle firmly in mind i.e. where a greater degree of similarity in the competing trade marks can offset a lower degree of similarity in the goods and services (and vice versa), I am satisfied that a consumer paying even a fairly high degree of attention during the selection process to the identical and similar goods and services shown below is likely imperfectly to recall the opponent's first fairly highly distinctive trade mark and the applicant's "WE ARE US" trade marks (including the hashtag variants) leading to at the very least a likelihood of indirect confusion. I reach the same conclusion in relation to the applicant's "WE ARE" trade marks (including the hashtag variants);

20. On the basis of his earlier conclusion as to how the Opponent's first trade mark would be seen by the average consumer, I can see no basis for the interfering with the overall assessment of the Hearing Officer. He plainly considered both the visual and conceptual characteristics of the Opponent's first trade mark and the interdependency principle.
21. As for the visual aspects, he noted that the WE IS ME mark was visually similar to the Appellant's "WE ARE US" trade marks to an above average degree and to its "WE ARE" trade marks to a medium degree. Conceptually he held that they all revolve around the juxtaposition of various pronouns and were similar to a fairly high and medium degree respectively.
22. Based upon this, the Hearing Officer was entitled to conclude that there was a likelihood of confusion in respect of services in class 35. There is no reason to interfere with his decision.

COSTS

23. The Appellant has failed in its appeal. The Respondent is entitled to be compensated for considering the brief Reasons for Appeal. As the Respondent did not file written submissions or attend a hearing I will award it £500 for its costs of the appeal.
24. The Appellant was the beneficiary of a costs order of £500 made below.
25. Therefore overall the appeal should be dismissed with no payment of costs between the parties.

Thomas Mitcheson QC
The Appointed Person
22 January 2020