

O-1054-23

TRADE MARKS ACT 1994

IN THE MATTER OF

TRADE MARK APPLICATION NOS 3605329 & 3605293

BY MR AMRITPAL CLAIRE

TO REGISTER

**DESIGNER
MONEY**

&

Designer Money

AS TRADE MARKS IN CLASS 25

AND

OPPOSITION THERETO (UNDER NO. 425707 & 425708)

BY

MONEY INDUSTRIES LIMITED

BACKGROUND

1) On 5 March 2021, Mr Amritpal Claire ('the applicant/Mr Claire') applied to register the two trade marks shown in the cover page of this decision in respect of 'clothing' in class 25.

2) Both applications were published in the Trade Marks Journal on 7 May 2021 and notice of opposition was later filed against both applications by Money Industries Limited ('the opponent'). The opponent claims that the trade mark applications offend under section 5(2)(b) of the Trade Marks Act 1994 ('the Act')¹. The opponent relies upon two trade mark registrations and all of the goods covered by them. The marks and goods covered by those registrations are identical. As such, I only consider it necessary to base my considerations on one of those registrations as the other clearly does not offer the opponent any stronger prospect of success. The registration that I intend to base my assessment on is UKTM 3251218. Further, as that registration covers the term 'clothing', there is no need to set out any of the other goods falling within class 25 of that registration because it is 'clothing' which obviously represents the opponent's strongest prospect of success. Details of the relevant earlier mark are, as follows:

i) **UKTM No. 3251218**



Class 25: Clothing, [and other goods].

Filing date: 18 August 2017

Date of entry in the register: 24 November 2017

¹ Additional claims made under section 5(3) of the Act in each opposition were subsequently struck out for want of evidence in support of them, as per the official letter of 12 January 2023.

3) The trade mark relied upon by the opponent is an 'earlier' mark, in accordance with section 6 of the Act. As it had not been registered for five years or more at the date on which the contested application was filed, it is not subject to the proof of use conditions, as per Section 6A of the Act.

4) The applicant filed a counterstatement, denying, with explanation, that there is any similarity between the respective marks. The applicant makes no mention of the opponent's claim that the respective goods are identical. I have read all the comments made in the counterstatement and will bear them in mind. Further to receipt of the applicant's counterstatements, the two cases were consolidated.

5) The opponent is represented by Alpha & Omega. The applicant is without legal representation. Neither party filed any evidence of fact nor any submissions during the evidence rounds. As an unrepresented party, the applicant was invited to file a costs proforma, providing a breakdown of his costs, if he wished to make a request for costs. The applicant filed the necessary costs proforma on 22 February 2023. A hearing took place before me on 27 June 2023 at which the applicant represented himself². The opponent did not attend the hearing but filed written submissions in lieu³. I will not refer to all the submissions made to me but will refer to certain of them if, and when, it becomes appropriate and relevant to do so. I have, however, given due consideration to all of Mr Claire's oral submissions made to me at the hearing and to the written submissions that have been filed by both parties.

DECISION

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

"5. - (2) A trade mark shall not be registered if because –

(a)....

² Mr Claire also filed written submissions on the morning of the hearing, on 27 June 2023, which he used as a framework to guide his oral submissions at the hearing.

³ Dated 23 June 2023

(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.

5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

Case law

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

The principles

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely

upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

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

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

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

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

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

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.

Comparison of goods

9) Both of the applicant's marks are applied for in relation to 'clothing' in class 25. These goods are self-evidently identical to 'clothing' covered by the opponent's earlier mark.

Average consumer and the purchasing process

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

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

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




Comparison of marks

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

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

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

12) The marks to be compared are:

The opponent's mark	The applicant's marks
	<p data-bbox="810 416 1257 454"><u>Application no. 3605329 ('329):</u></p> <div data-bbox="954 528 1257 645" style="text-align: center;">  </div> <p data-bbox="810 781 1257 819"><u>Application no. 3605293 ('293):</u></p> <div data-bbox="911 931 1302 987" style="text-align: center;">  </div>

13) The earlier mark consists of the word 'money', presented in a hand-written type font. The overall impression of that mark is dominated by the word 'money' with the presentation playing a lesser role.

14) As regards the applicant's marks, mark '329 consists of the words 'DESIGNER MONEY' in block capitals where 'DESIGNER' is presented in the colour gold and 'MONEY' in black. The letters in the word 'MONEY' appear to be taller than those in 'DESIGNER'. The word 'MONEY' is also presented in bold but the word 'DESIGNER' is not. At the hearing, Mr Claire submitted that the word 'Designer', being the first word in both of his marks, is, therefore, memorable and emphasized. I note this contention. However, I find that it is the word 'MONEY which carries the greatest weight in the overall impression of both marks. In respect of the '329 mark, this is for two reasons. First, the word MONEY is far more distinctive than the word 'DESIGNER' in relation to clothing, owing to the fact that 'Designer' is notoriously used as a descriptive adjective in the clothing industry to refer to clothing that is expensive and fashionable and/or made by a famous/prestigious designer.

Secondly, the word MONEY appears to be larger than the word 'DESIGNER' in the '329 mark and is, therefore, more visually prominent. Turning to the '293 mark, this contains the words 'Designer Money' in plain title case letters. Again, I consider that, despite its presence at the end of the mark, it is the word 'MONEY' which carries the greatest weight in the overall impression of that mark, owing to its relatively greater degree of distinctiveness as compared to the descriptive adjective, 'Designer'.

15) Visually, the marks coincide in that they both contain the same word, 'money', albeit in different kinds of font. They differ due to the presence of the word 'Designer' which is present in both of the applicant's marks and is absent from the opponent's mark. Despite the latter differences, I find a medium degree of visual similarity overall between the opponent's mark and each of the applicant's marks.

16) Aurally, the word 'money' in the earlier mark will be pronounced as MUN-EE. The same word in the applicant's marks will also be pronounced in that way. The respective marks therefore coincide in that respect. However, the word 'Designer' will also be articulated when referring to the applicant's marks. That word consists of three syllables which are entirely absent from the earlier mark. The applicant's marks therefore consist of five syllables in total, the first three of which are entirely absent from the earlier mark but the last two of which are identical to the earlier mark. Overall, I find a medium degree of aural similarity between each of the applicant's marks and the earlier mark.

17) Conceptually, both marks consist of well-known English words with an immediately graspable meaning. The concept conveyed by the opponent's mark is simply that of money. Mr Claire submitted that his mark has no definitive meaning and is 'a brand name where you can make what you want from it'. I find that Mr Claire's marks also portray the concept of money although that concept is qualified as being 'designer' money (money that is fashionable and/or made by a famous/prestigious designer). Despite that qualification being absent from the earlier mark, I find that the conceptual similarity between the earlier mark and each of the applicant's marks is, nevertheless, high, owing to the common 'money' concept.

Distinctive character of the earlier mark

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

The opponent has filed no evidence and therefore I have only the inherent degree of distinctiveness of the mark to consider. The opponent's mark neither describes nor alludes to any characteristic of the earlier goods. I find it to have a normal degree of inherent distinctiveness.

Likelihood of confusion

19) I must now feed all of my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors: i) the interdependency principle, whereby a lesser degree of similarity between the goods may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*); ii) the principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*), and; iii) the factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*).

20) I will first consider the likelihood of direct confusion. This is when the average consumer mistakes one mark for the other because they think they are the same. The respective goods are identical. The marks are visually and aurally similar to medium degree and conceptually highly similar. The opponent's mark also has a normal degree of inherent distinctiveness. The average consumer, being a member of the general public, is likely to pay a medium degree of attention. Weighing all these factors, I find that the average consumer is unlikely to mistake either of the applicant's marks for the opponent's mark or vice versa, even allowing for imperfect recollection. There is no likelihood of direct confusion.

21) I will now consider the likelihood of indirect confusion. This is when the average consumer recognises that the marks are not the same but puts the similarities between them (and the goods) down to the respective goods coming from the same or linked undertaking(s). In this connection, I bear in mind that in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10 (*L.A. Sugar*), Mr Iain Purvis Q.C. (as he then was), sitting as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that

the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: 'The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark'.

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

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).
- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).
- (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)".

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

23) The categories listed above in *L.A. Sugar* are, of course, not an exhaustive list of all the ways in which indirect confusion can occur; they are merely examples of the way in which it tends to occur.

24) In the case before me, I consider that the average consumer is likely to believe that the respective goods come from the same or linked undertaking(s). I come to this conclusion having borne in mind, particularly, that: i) the respective goods are identical ('clothing'), ii) the most dominant element of the applicant's mark is the distinctive word 'MONEY', iii) the word 'Designer' is commonly used in the relevant industry as a descriptor, and iv) there is a high degree of conceptual similarity between the marks. I find that the average consumer is likely to believe that both of the applicant's marks are brand extensions of the earlier mark. There is, therefore, a likelihood of indirect confusion in respect of both of the applicant's marks.

25) My conclusion above is not disturbed by Mr Claire's reference to a number of trade marks being on the register containing the word 'money'. Firstly, the marks listed by Mr Claire⁴ were all filed after his mark. The relevant date for assessing the likelihood of confusion is the date on which Mr Claire filed his mark, namely 5 March 2021. Those registrations therefore tell me nothing about the distinctiveness of the word 'money' at the relevant date. Moreover, the mere presence of such marks on the register does not mean that any of those marks are actually in use in the UK and therefore tells me nothing about the average consumer's likely perception of them or their ability to differentiate between such marks.

26) Further, Mr Claire's submissions made to me about the manner in which he uses his marks and the genesis behind his marks also do not disturb my findings. I am required to assess the likelihood of confusion notionally and objectively, based upon what I consider to be the average consumer's likely perception of the marks before me when used on the identical goods at issue. Mr Claire's intentions when he created the marks and the actual way in which he, or the opponent, currently use their marks is irrelevant to that assessment.

⁴ In Mr Claire's submissions dated 27 June 2023, page 3

OUTCOME

27) The opposition under Section 5(2)(b) of the Act succeeds in full.

COSTS

28) As the opponent has been successful, it is entitled to a contribution towards its costs. As I explained to Mr Claire at the hearing, the relevant guidance that I must use when assessing the costs to be awarded to the successful party is found in Tribunal Practice Notice 2/2016. I also bear in mind that the two cases were consolidated. I award the opponent costs on the following basis:

Preparing a statement and considering the other side's statement	£300
Official fee (Form TM7) x 2	£400
Submissions in lieu of a hearing	£300
Total:	£1000

29) I order Mr Amritpal Claire to pay Money Industries Limited the sum of **£1000**. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 6th day of November 2023

Beverley Hedley
For the Registrar,
the Comptroller-General