O/1094/23

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF TRADE MARK APPLICATIONS NUMBERED 3613801 AND 3613686

BY

DANIEL QUILLAN

TO REGISTER THE FOLLOWING TRADE MARKS

AND

SoulSistar

AND OPPOSITIONS THERETO UNDER NUMBERS 425500 AND 428448

BY

TWINMAR GROUP LIMITED

Background and Pleadings

1. On 21 March 2021, Mr Daniel Quillan ("the Applicant") applied to register the trade marks as set out below:

(i) UKTM no. 3613801

("mark '801")

Registered for goods in classes 25 and 28 namely *T-shirts* and *Dolls' clothes; Dolls' clothing; Doll clothing.*[1]

(ii) UKTM no. 3613686

("mark '686")

SoulSistar

Registered for goods in class 25 namely *T-shirts*.[2]

2. Twinmar Group Limited ("the Opponent") opposed the applications[3] under section 5(2)(b) of the Trade Marks Act 1994 ("the Act") relying on the following trade marks for each of the oppositions:

(i) UKTM no. 900919191

("Mark '191")

SOLE SISTER

Filed on 24 August 1998 and registered on 5 April 2000, relying on the following goods in class 25 '*footwear, headgear, articles of clothing'.* It claims to have only used the mark for footwear.

[1] Whilst originally the applications included broader terms, on 9 December 2021 Mr Quillan filed form TM21B narrowing his specification for both trade mark applications in class 25 to T-shirts only. No amendment was sought in relation to its class 28 goods,
[2] See above.
[3] Filed on the 12 July 2021 and 23 November 2021 respectively.

(ii) UKTM no. 3320350

(“mark ‘350”)

SOLE TRADER

Filed on 25 June 2018 and registered on 7 June 2019 for services in class 35 namely ‘Retail and on-line retail services connected with the sale of clothing, footwear, headgear, bags, holdalls, valises, rucksacks, baggage, ladies and men’s handbags, bags for carrying sporting kit and sporting accessories, luggage and carrying bags, umbrellas and parasols, cosmetics, perfumery and skin creams, sunglasses, belts, shoe care products and accessories.’

(iii) UKTM no. 917962687

(“mark ‘687”)

Filed on 27 September 2018 and registered on 6 March 2019 for the following goods and services:

Class 18: Bags, holdalls, valises, rucksacks, baggage; ladies and men's handbags; bags for carrying sporting kit and sporting accessories; luggage and carrying bags; umbrellas and parasols; walking sticks; goods made of leather and imitation leather namely wallets, purses and all the aforementioned.

Class 25: Clothing, footwear, headgear.

Class 35: Retail sale both online and off-line of clothing, footwear, headgear, bags, holdalls, valises, rucksacks, baggage, ladies and men's handbags, bags for carrying sporting kit and sporting accessories, luggage and carrying bags, umbrellas and parasols, cosmetics, perfumery and skin creams, sunglasses, belts, shoe care products and accessories.

(iv) UKTM no. 2212448

("mark '448")

Filed on 26 October 1999 and registered on 10 August 2001 relying on the following goods in class 25 namely *footwear, headgear, articles of clothing*. It claims to have only used the mark for footwear.

(v) UKTM no. 2212458

("mark '458")

Filed on 26 October 1999 and registered on 27 April 2001 relying on the following goods in class 25 namely *footwear, headgear, articles of clothing*. It claims to have only used the mark for footwear.

(vi) UKTM no. 3380449 (series of two)

("mark '449")

SOLE® and SOLE®

Filed on 5 March 2019 and registered on 7 June 2019 for the following goods and services:

Class 14: Watches, clocks, articles of jewellery.

Class 18: Bags, holdalls, valises, rucksacks, baggage; ladies and men's handbags; bags for carrying sporting kit and sporting accessories; luggage and carrying bags; umbrellas and parasols; walking sticks; wallets and purses made of leather and imitation leather.

Class 25: Footwear, headgear, articles of clothing.

Class 35: Retail sale both online and off-line of clothing, footwear, headgear, bags, holdalls, valises, rucksacks, baggage, ladies and men's handbags, bags for carrying sporting kit and sporting accessories, luggage and carrying bags, umbrellas and parasols, cosmetics, perfumery and skin creams, sunglasses, belts, shoe care products and accessories, watches, clocks, articles of jewellery.

3. The Opponent contends that there is a likelihood of confusion between the respective marks including a likelihood of association as a result of the identity/similarity between the respective marks and the respective goods/services. Furthermore, the Opponent claims that it holds an enhanced degree of distinctive character in its marks by virtue of the use it has made of them. In relation to all of the earlier marks save for mark '191, it claims that it is the proprietor of a 'family of marks' containing the element SOLE such that the public would recognise this element when combined with the other visual or border elements to be associated with the Opponent to denote trade origin. It is said therefore that use by the Applicant of a similar mark including this element would lead consumers to believe that it was part of the same family.

4. Mr Quillan filed a defence and counterstatement denying each ground of opposition contending that:

"SOUL and SOLE are clearly two different words. Likewise SISTAR and SISTER. SOULSISTAR and SOLE SISTER doesn't look the same either.

The concept of SoulSistar is:

> Being in or of the starts, a heavenly realm personified by love. There is no link whatsoever to shoes. Lots of words sound like each other but people aren't confused otherwise we wouldn't be able to communicate with each other.
>
> I am absolutely 100% certain that I could take a survey (which is now possible) and no one would be confused.
>
> I have taken 3 different words namely SOUL, SISTER and STAR and brought them together and abbreviated one too."

5. The trade marks upon which the Opponent relies qualify as earlier trade marks pursuant to section 6 of the Act. Marks '448, '458 and '191 completed their registration process more than 5 years before the applications were filed, and therefore they would ordinarily be subject to the proof of use requirements under section 6A of the Act. The Opponent whilst relying on a wider specification, pleaded that it had used its marks for footwear only. However, Mr Quillan did not require the Opponent to show proof of use of its marks and therefore it may rely upon all the goods/services of its registrations without having to demonstrate the use it has made of them.

6. The Opponent is professionally represented by Mitchiners, whereas the Mr Quillan represents himself. Neither party filed evidence during the evidence rounds, however, Mr Quillan filed brief evidence after the evidence rounds concluded, to which I shall refer in greater detail below. Both parties filed submissions. Whilst I have read all the submissions filed by both parties, I do not propose to summarise them here but I have taken them into account and will refer to them where appropriate during my decision. Neither party requested to be heard on the matter but both filed submissions in lieu of a hearing. This decision is taken following a careful perusal of all the papers.

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

Evidence

8. As stated, neither party filed evidence during the evidence rounds and therefore the proceedings were originally passed for a decision from the papers on 24 January 2023. Following this date, however, Mr Quillan filed a number of additional submissions via email that included evidence of fact. Mr Quillan was advised that those submissions would be considered when the decision fell to be finally determined. The Opponent, however, requested a right of reply which resulted in both parties filing further comments and submissions. In order to draw matters to a conclusion the Registry wrote to the parties on 22 February 2023 as follows:

> "We refer to the recent correspondence and having referred the matter to a Hearing Officer the parties are reminded that in accordance with Tribunal Practice Notice 2/2010 the evidence rounds concluded on 21 December 2022 and that each party was given the opportunity to file their final submissions by 18 January 2023.
>
> Given that neither party requested a hearing, it was decided that a decision from the papers would be issued. The purpose of setting clear evidence rounds and deadlines for the filing of submissions, is so that finality is achieved and proceedings do not go on indefinitely. Admitting additional material after the evidence rounds are closed and after both parties have had the opportunity to file their final written submissions, adds significantly to the length of time it will take to conclude the proceedings and adds to the parties' costs. Therefore, it has to be shown that any additional evidence/submissions filed, after these deadlines, is material to the issues that the Hearing Officer has to determine. Furthermore, before any additional material can be admitted, permission needs to be sought first from the Registrar. Given that no permission was sought by the [Applicant], and it is unclear at this stage as to the materiality of the additional documents, they have not been admitted into the proceedings and will not be taken into account."

9. Mr Quillan was given until the 8 March 2023 to request permission for the additional material to be considered, with a full explanation as to why this material was relevant to the issues to be decided and an explanation as to why it was not filed earlier in the proceedings during the evidence rounds or as part of the final submissions.

10. Furthermore, Mr Quillan was advised that should he wish to adduce any evidence of fact, then it needed to be filed in the correct format.

11. Mr Quillan duly requested to file additional evidence; this request was subsequently granted by the Registry. The additional material, however, was not filed by way of witness statement. Following a further exchange of emails Mr Quillan filed a document titled statutory declaration but it did not comply with the requirements of the Statutory Declarations Act 1835.[4] The document was taken as his witness statement, therefore, and was finally admitted into proceedings on 5 July 2023. The Opponent was given the opportunity to file evidence in reply but chose not to do so.

12. Mr Quillan's evidence which was contained in his witness statement dated 13 June 2023 can be summarised as follows:

- The term "Soul Sister" is a phrase from the 1960's.

> Meaning:
> 1.
> INFORMAL•US
> (in African American usage, often as a form of address) a black woman.
> 2.
> a woman whose thoughts, feelings, and attitudes closely match those of another; a kindred spirit.
> People today and the average consumer are well aware of its spelling and meaning.
>
> Indeed "Soul Sister" clothing can be bought all over the internet and no one is confused as to what they are buying (EVIDENCE ATTACHED).

- In 2020 Twinmar Limited, owner and operator of Soletrader's stores went into voluntary Liquidation. This fact was not UK news or widely known to the public and therefore Sole Sister is not something that is embedded in [our] psyche.

13. Mr Quillan's statement was accompanied by a number of screenshots accessed on 6 March 2023, and included the following:

- Five screenshots of the result pages of a google search for the words "soul sister t shirts". The results reveal images of t-shirts displaying the words 'soul sister' and links to webpages of entities selling 'Soul Sister t-shirts' namely Zazzle, DJ Tees, SoulSisters Tees, Etsy and Amazon UK. The images appear to mostly show the use of the words 'Soul Sister' as slogans on t-shirts.

[4] See letter dated 30 May 2023

- A screenshot of an article dated 6 July 2020 taken from www.drapersonline.com confirming the restructure of Soletrader via voluntary liquidation.
- A Screenshot of the results of a google search engine search for 'The Twinmar Group Receivership' which confirms that Twinmar was the owner and operator of the retailer Soletrader which was placed into a creditor's voluntary liquidation resulting in the closure of eight UK stores.

Decision

Section 5(2)(b)

13. Section 5(2)(b) of the Act states 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.

14. Section 5A of the Act is as follows:

> "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."

15. 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 greater 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 to mind the earlier mark, is not sufficient;

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

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

Comparison of the goods and services

16. When conducting a goods/services comparison, all relevant factors should be considered as per the judgment of the Court of Justice of the European Union ("CJEU") in *Canon Kabushiki Kaisha v Metro Goldwyn Mayer Inc* Case C-39/97, where the court stated at paragraph 23 of its judgment 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".

17. I am also guided by the relevant factors for assessing similarity identified by Jacob J in *Treat*, [1996] R.P.C. 281 namely:

(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.

18. 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 Applicant relies on those goods as listed in paragraph where the goods designated by the trade mark application are included in a more general category designated by the earlier mark."

19. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM),* Case T-325/06, the GC provided a summary as to the meaning of "complementary" in relation to goods and services, namely:

> "...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking".

20. In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the GC held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

21. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as 'complementary' and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. chicken against transport services for chickens. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings.

22. All of the of the Opponent's specifications, save for Mark '350, overlap and include the terms clothing/articles of clothing and footwear, therefore I shall begin by dealing with the comparison of the goods/services collectively against these terms first.

23. Mr Quillan's applications include the term 't-shirts' which are encompassed in the Opponent's broader category of '*clothing/articles of clothing'* goods and as such these terms are identical in accordance to the principles in *Meric*.

24. For the avoidance of doubt given that the Opponent claims use only for footwear for those marks that were subject to proof of use, I also find that the applied for '*t-shirts'* are similar to *footwear* overlapping in trade channels. These goods are often seen and sold together in the same retail outlets, within close proximity to each other. I consider that they also overlap in purpose each intended to cover and protect parts of the body, albeit different parts of the body. The respective goods would also reach the market by the same methods and are directed at the same end user. I consider that they are similar to a medium degree.

25. In so far as the applied for *Dolls' clothes; Dolls' clothing; Doll clothing* in class 28, although these appear in a different class to the Opponent's clothing/articles of clothing in class 25 they are nevertheless similar to a low degree. The applied for doll's clothing are items of clothing designed or intended specifically for dolls whereas the Opponent's clothing is directed at humans, they do however overlap in nature, trade channels (particularly for children's clothing) and are directed at the same end user.

26. In so far as the applied for *t-shirts* as against the Opponent's *retail and on-line retail services connected with the sale of clothing* (mark '350), the retail of clothing would include the retail of t-shirts coinciding in trade channels and end user. Furthermore the retail services and the goods are complementary to each other. The applied for goods and the services are similar to between a low and medium degree.

Average consumer and the purchasing process

27. When considering the opposing trade marks, I must determine, first of all, who the average consumer is for the goods/services. I must then determine the purchasing process. The average consumer is deemed reasonably well informed and reasonably observant and circumspect. For the purposes of assessing the likelihood of confusion

the average consumer's level of attention is likely to vary according to the category of goods and services in question.[5]

28. 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."

29. Overall, I consider that the contested goods/services will be directed at members of the general public, who predominantly select the goods via visual means by inspection from rails or shelves of retail premises or their online equivalents. The services will be selected either from the signage of the premises itself or as with the goods, online. Aural considerations may also play a part, where requests/enquiries are made to sales assistants for example.[6] In so far as the parties' goods in class 25, whilst accounting for variations in price, overall, the goods are neither particularly expensive nor infrequent purchases, with considerations such as fashion trends, price, quality and suitability/fit taken into account in the selection process. For these reasons, I consider that an average degree of attention will be undertaken in the purchasing process i.e. no higher or lower than the norm for such goods. The same level of attention would apply for those goods in class 28 and the retail services in class 35.

Comparison of the trade marks

30. 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

[5] *Lloyd Schuhfabrik Meyer*, case C-342/97.
[6] *New Look Limited v OHIM,* joined cases T-117/03 to T-119/03 and T-171/03

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."

31. It would be wrong, therefore, to dissect the trade marks artificially, although it is necessary to consider 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 trade marks.

32. The respective trade marks are as follows:

The applied for marks	The Opponent's earlier marks
Mark '686 SoulSistar Mark '801  	Mark '191 SOLE SISTER Mark '350 SOLE TRADER Mark '687  Mark '448

	 Mark ‘458  Mark ‘449 (series of two) 

33. The Opponent submits:

> “Visually, the marks SOLE SISTER and SOULSISTAR are highly similar. They are largely composed of the same two words in the same word order. The first two letters of the first word appear in the same order in both marks. The first word of the earlier mark is spelt slightly differently but still includes the letter ‘L’ prominently. The differentiation is in the vowel only, so the public are likely to focus on the ‘structural’ letter ‘L’ not the vowel.
>
> Phonetically, the marks SOLE SISTER and SOULSISTAR are identical. There is no phonetic difference between the distinctive characters of the marks.

Conceptually, the marks are highly similar if not identical. The only difference is that the earlier mark can be considered a play on words of the later mark, recognisable by an English speaker. SoulSistar is a popular music allusion in the R&B music world. The Opponent created a deliberate play on words with a subtle change of SOUL to SOLE, increasing the distinctiveness with the play on words."

34. Mr Quillan submits:

"Can the Twinmar Group provide one person anywhere in the world (without impairment) who is confused by the words sole and soul? The reason why any brand becomes successful is because the "average consumer" is very astute at recognising their product.

Indeed, if anyone wanted to counterfeit a brand the last thing they would do is make it look different, spell it differently and imbue an entirely different message. It somewhat defeats the purpose does it not?

Likewise: Sister and Sistar.

I take it for granted that you would apply the same logic. Moreso, with both words together spelled differently."

My Approach

35. I shall first of all undertake the comparison as against the applied for marks and the Opponent's '191 mark, namely SOLE SISTER, as I consider that this mark appears closest in terms of similarity and therefore provides the Opponent with its best case. I shall return to consider the remainder of those marks as relied upon if it becomes necessary to do so.

Overall impression

36. The Applicant's '686 mark consists of the word SoulSistar presented in title case in an unremarkable font. Despite being presented as one word, the mark will be seen as consisting of two elements/words, the word Soul and the word Sistar, this word being seen as a misspelling of the word sister. The overall impression lies in the entirety of the word and in the two elements in combination.

37. The ‘801 mark is for the same word SoulSistar but this time it is presented in a stylised pink font enclosed with a blue outline. The word is presented on a black rectangle. Whilst the stylisation and colours contribute to the overall impression of the mark it is dominated by the word SoulSistar, in which the overall impression resides. The black rectangle will merely be seen as a background and therefore has little trade mark significance.

38. The earlier ‘191 mark consists of the two words SOLE and SISTER presented in capitals in a black unremarkable font. Despite being different in length neither word dominates the other, and I consider that the overall impression of the earlier mark resides in the combination of the two words.

The ‘686 mark and the earlier ‘191 mark

Aural comparison

39. To my mind the marks are aurally virtually identical or at least highly similar. I consider that the word SISTAR will be seen as a misspelling of the word sister but since the last syllable is spelt as -TAR as opposed to -TER it may give rise to a slight difference in pronunciation, but I consider that any difference is so slight that it is unlikely to be noticed when the marks are spoken. Although the words SOUL and SOLE may be spelt differently and have different meanings, they would nevertheless be pronounced identically given that they are homophones of each other. Overall, accounting for the potential for the last syllable to be pronounced differently, I consider that the marks are aurally highly similar.

Visual comparison

40. Firstly the fact that the contested mark is presented as one word as opposed to two words, and is in title case as opposed to capital letters is not a determinative factor to act as a point of visual difference, given that the caselaw states that a word mark can be used in any font, colour or case. The marks overlap in the letters SO-L-SIST-R presented in the same position and letter pattern. The differences arise between the spelling of the first word/element SOUL versus SOLE and the spelling of the second word/element SISTAR and SISTER. Overall weighing up the similarities as against the differences, I consider that visually the marks are highly similar.

Conceptual Comparison

41. The Applicant submits that its mark will be seen as the combination of the words soul, sister and star abbreviated into one word. I disagree. In order for conceptual message to be relevant it must be capable of immediate grasp.[7] I consider that the applied for mark with be understood by the average consumer to be the misspelling of the phrase SOUL SISTER and understood as per the dictionary definition provided by Mr Quillan in his evidence to mean "A woman whose thoughts feelings and attitudes closely match those of another a kindred spirit." I consider that the meaning attributed to the earlier mark will also be understood as a misspelling of the phrase 'soul sister' where the first word sole will be seen as a play on words (when seen in the context of the Opponent's footwear goods) to the soles of the feet. On this basis I consider that overall the respective marks are conceptually highly similar.

The '801 mark and the '191 earlier mark

42. Given that the stylisation and the colours used by the contested mark will have little impact on the aural and conceptual similarities, I consider that the same findings would apply in relation to these factors, as with the word only mark. In so far as the visual similarities, the use of colour, presentation and stylisation are points of visual difference such that the visual similarity is reduced to between a medium and high degree between the '801 and the '191 marks, especially given that notional and fair use allows the earlier mark to be used in any colour, including the same pink/blue combination as is used in the applied for mark.

Distinctive character

43. The case of *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV,* Case C-342/97 sets out the legal position to determine the distinctive character of a mark. In this case 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-

[7] Case C-361/04 P *Ruiz-Picasso and Others* v *OHIM* [2006] ECR I-00643; [2006] E.T.M.R. 29

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)."

44. Registered trade marks possess varying degrees of inherent distinctive character, some being suggestive or allusive of a characteristic of the goods and services on offer, to those with high inherent distinctive character such as invented words which have no allusive qualities. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark the greater the likelihood of confusion.

45. The Opponent did not file evidence and therefore despite pleading an enhanced degree of distinctive character I only have the inherent position to consider.

46. As stated I consider that the earlier mark relates to a play of words relating to the phrase 'soul sister' understood to mean a kindred spirit, and in the context of the earlier mark's footwear goods whilst not directly descriptive is a playful reference to the sole of the feet. I consider that the mark, overall, possesses an above average degree of inherent distinctive character.

Likelihood of confusion

47. In determining whether there is a likelihood of confusion between the marks I must consider whether there is direct or indirect confusion. Direct confusion is where one mark is mistaken for the other or imperfectly recalled, whereas indirect confusion is where the average consumer recognises that the marks are not the same but

nevertheless due to the similarities between the marks leads to the belief that the respective goods or services originate from the same or related source.

48. There are a number of factors in the global assessment to bear in mind. The first is 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 or services and vice versa. It is necessary for me to keep in mind the distinctive character of the Opponent's trade mark, the average consumer for the goods/services and the nature of the purchasing process. In doing so, I must consider 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.

49. I remind myself that earlier in my decision I made the following findings:

- The '686 mark was visually highly similar to the earlier mark whereas the '801 mark was visually similar to between a medium and high degree.
- Aurally both of the contested marks were highly similar to the earlier mark.
- All the marks were conceptually highly similar.
- Some goods were identical, whilst others were similar ranging from a low to medium degree.
- The average consumer was a member of the general public undertaking an average degree of attention in the selection process, purchasing the goods predominantly by visual means but not discounting aural considerations.
- The earlier mark was inherently distinctive to an above average degree.

The '686 mark and the earlier '191 mark

50. Given that the parties' clothing goods will be purchased by an average level of attention, I consider that the inherent distinctiveness of the earlier mark which I found to be above average, combined with the high visual, aural and conceptual similarities will lead consumers to imperfectly recall or mistake the marks one for the other. The differences arising between the spelling of SOLE versus SOUL, and SISTAR versus SISTER and the contested marks being presented as one word instead of two, are insufficient for consumers to distinguish between them especially where the respective goods are identical/similar. The average consumer has a tendency to see what it

expects to see and to hear what it expects to hear especially when confronted with a similar mark.[8] So, for those consumers who are familiar with the earlier mark they are likely to misread/mishear SoulSistar for Sole Sister because on no more than a quick scan, they would see the same overall structure of the letters/words, combined with the highly similar concepts and jump to the conclusion that they are one and the same mark. Given that consumers rarely have a chance to compare marks side by side, I am satisfied that the strong conceptual hook together with the high visual and aural similarities is sufficient for the marks to be imperfectly recalled one for the other, even for goods that are only similar to a low degree. The differences in spelling will be swallowed up by the commonality of the remaining letters leading to there being a likelihood of direct confusion.

The ’801 mark and the earlier ‘191 mark

51. I find that the same conclusion would apply as between the earlier mark and the ‘801 mark where the word SoulSistar is presented in colour on a black rectangle. Whilst these elements may reduce the degree of visual similarity between the respective marks, I do not consider they will impact significantly nor have any bearing on the aural or conceptual comparison. Normal and fair use of the earlier mark allows for it to be used in any colour combination to include being used in the same colours as the application, which would lead to an even greater likelihood of confusion. The similarity between the words themselves are likely to lead the average consumer to mistakenly recall or misremember them particularly when spoken. The stylisation and colour used in the application is insufficient for consumers to distinguish between them especially given that the overall impression of the application resides predominantly in the words rather than the stylisation/ figurative elements. I find that there would also be direct confusion.

52. Even if I am wrong and the average consumer notices the differences between the presentation, stylisation and use of colour in the contested mark I still believe that they will consider that the marks originate from the same or connected undertakings. Once the words are imperfectly recalled, the stylisation and colour combination will be regarded as a variant mark, one that is used on packaging or advertising for example

[8] *Aveda Corporation v Dabur India Limited* [2013] EWHC 589 (Ch) [48], Mr Justice Arnold

as opposed to the word only version used in text. This would lead to a likelihood of indirect confusion.

The '801 and '686 marks and the Opponent's SOLE marks (the '350, '687, '448, '458 and '449 marks)

53. Given that the Opponent has succeeded when relying upon its '191 mark, on a question of proportionality it is unnecessary to consider the assessment as against the Opponent's remaining marks, and I decline to do so. Whilst the Opponent claimed that these SOLE marks formed a 'family' of marks, in order to succeed with such a claim it was necessary for it to file evidence of the presence of these marks on the market as at the relevant date, namely 21 March 2021. It did not, however, file evidence to support such a claim. Without evidence there is no way for me to assess that the average consumer has become accustomed to the word SOLE either in its word only version or figurative form, or in combination with the word TRADER, as being representative of the Opponent. The family of marks argument therefore fails at the first hurdle. In any event I would not have been persuaded that the marks relied upon which mostly appear to be figurative variants of the same word SOLE would register sufficiently with the average consumer for them to believe they constitute a family. Furthermore, the aural identity between the words sole and soul is insufficient by itself to give rise to a likelihood of confusion given the obvious visual and conceptual differences between the respective marks. The oppositions would not have succeeded by reliance on these marks.

Conclusion

54. The opposition under section 5(2)(b) succeeds in its entirety by reliance on the '191 earlier mark. Subject to appeal the applications shall be refused registration.

Costs

55. As the Opponent has been successful it is entitled to a contribution towards its costs. Notwithstanding that the proceedings were consolidated and involved two sets of proceedings the claims under section 5(2)(b) overlapped. Whilst two sets of TM7 forms were filed by the Opponent, there was considerable overlap between them; the statement of grounds/pleadings were virtually identical in content and therefore I shall award costs collectively for the preparation of these documents. In relation to the

Opponent's submissions and particularly the submissions in lieu of hearing, the latter were very brief and merely reconfirmed the contents of the earlier submissions filed rather than introducing any fresh arguments. In so far as the additional submissions and evidence filed by the Applicant after the evidence rounds had concluded, other than a brief delay to the proceedings, this material had little impact on the decision or required any significant, if any, input from the Opponent. I note that Mr Quillan was an unrepresented party and that he did not require the Opponent to prove the use of its marks which would have increased costs. Overall, I take into account that the outcome of this decision was determined on the Opponent's best mark and that the Opponent's 'family of marks' claim and enhanced distinctive character claim did not succeed since no evidence was filed.

56. Taking these matters into account I award costs in accordance with the scale as set out by Tribunal Practice Notice 2/2016. Applying this guidance I award costs as follows:

Preparing two statement of grounds and considering the other side's statements:	£300
Preparing submissions and submissions in lieu of hearing and considering the other side's submissions/evidence:[9]	£400
Official fee (2x £100)	£200
Total	**£900**

57. I order Mr Daniel Quillan to pay Twinmar Group Ltd the sum of £900. 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.

[9] I have considered both sets of submissions together and awarded costs collectively.

Dated this 17th day of November 2023

Leisa Davies

For the Registrar