

O/1170/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003761148
BY BRIXTON STREET WEAR LIMITED
TO REGISTER

BRIXTON
STREET WEAR

EST 19XX



IN CLASS 25

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 434308 BY
BRIXTON, LLC

BACKGROUND AND PLEADINGS

1. On 2 March 2022, Brixton Street Wear Limited (“the applicant”) applied to register the trade mark shown on the cover of this decision (“the applicant’s mark”) in the UK for “clothing” in class 25. It was published for opposition purposes on 18 March 2022 and, on 17 June 2022, it was opposed by Brixton, LLC (“the opponent”). The opposition is based on sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). Under the 5(2)(b) ground, the opponent relies upon the following marks:

BRIXTON

UK registration no. 904905998¹

Filing date 16 February 2006; registration date 9 June 2010

Relying on all goods, namely:

Class 18: Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; umbrellas, parasols and walking sticks; whips, harness and saddlery; with the exception of bags.

Class 25: Apparel, footwear and headgear.

Class 28: Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees.

(“the opponent’s first mark”);

BRIXTON

International Registration designating the UK no. 959328

International registration date 4 April 2008

Date protection granted in the UK 6 May 2009

¹ The opponent’s first mark is a comparable trade mark based on the opponent’s pre-existing EUTM, being EUTM no. 4905998. On 1 January 2021, in accordance with Article 54 of the Withdrawal Agreement between the UK and the European Union, the UK IPO created comparable UK trade marks for all right holders with existing EUTMs.

Registered for the following goods:

Class 25: Clothing, namely shirts, T-shirts, tank tops, undershirts, sweaters, sweatshirts, vests, jackets, coats, ties, belts for clothing, pants, trousers, socks, neckerchiefs, scarves, rain coats, wind-resistant jackets, gloves, and mittens; and headwear, namely hats, caps and visors, beanies and head bands.

("the opponent's second mark"); and



International Registration designating the UK no. 1583703

International registration date 19 January 2021

Designation date 19 January 2021

Registered for the following goods:

Class 25: Clothing, namely, shirts, T-shirts, tank tops, sweaters, sweatshirts, vests, jackets, coats, belts for clothing, pants, trousers, shorts, sweatpants, dresses, skirts, swimwear, board shorts, socks; headwear, namely, hats, caps.

("the opponent's third mark")

2. In respect of the 5(2)(b) ground, the opponent pleads that the applicant's mark contains the word element of the opponent's marks and is, therefore, similar to the opponent's marks. Further, the opponent argues that the applicant's mark is to be registered for goods that are identical or highly similar to that of the opponent. As such, the opponent's position is that there exists a likelihood of confusion on the part of consumers.
3. Under the 5(3) ground, the opponent relies on its first and second marks only. In respect of this ground, the opponent claims that it has made extensive use of its marks and, therefore, enjoys a reputation in the goods for which they are

registered. As a result of this reputation, the opponent claims that use of the applicant's mark would give rise to an unfair advantage in favour of the applicant, would be detrimental to the opponent's reputation and could cause detriment to the distinctive character of the opponent's marks.

4. Lastly, under the 5(4)(a) ground, the opponent relies on the unregistered right 'BRIXTON', which it claims to have used throughout the UK since at least 2006 in respect of "clothing" and "headwear".
5. The opponent claims that as a result of the use of its unregistered sign, it has generated a protectable level of goodwill and, as a result, use of the applicant's similar mark would amount to misrepresentation that would lead to consumers mistakenly believing that the applicant's goods are those of the opponent. The opponent claims that, in turn, this misrepresentation would lead to damage to the opponent.
6. The applicant filed a counterstatement wherein it denied the claims against it. The applicant also sought to put the opponent to proof of use in respect of its first and second marks.
7. The opponent is represented by Kilburn & Strode LLP and the applicant is represented by Barker Brettell LLP. Both parties filed evidence with the opponent also electing to file evidence in reply. No hearing was requested and both parties elected to file written submissions in lieu. This decision is taken following a careful perusal of the papers.
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.

EVIDENCE

9. The opponent's evidence in chief came in the form of the witness statement of Mr Brian Reichel dated 19 December 2022. Mr Reichel is the SVP (presumably standing for 'senior vice president') of 'Sales & Mark' at the opponent, a position he has held since April 2019. Mr Reichel's evidence is accompanied by seven exhibits, being those labelled BR1 to BR7.

10. The applicant's evidence came in the form of the witness statement of Ms Lucy Walker dated 16 February 2023. Ms Walker is a partner at the applicant's representative firm and is, therefore, duly authorised to make a statement on the applicant's behalf. Ms Walker's statement is accompanied by 20 exhibits, being those labelled LAW1 to LAW20.

11. As above, the opponent filed evidence in reply. This came in the form of the witness statement of Ms Nora Fowler dated 17 April 2023. Ms Fowler is a trade mark attorney at the opponent's representative firm and is, therefore, duly authorised to make a statement on the opponent's behalf. Ms Fowler's statement is accompanied by three exhibit, being those labelled NXF1 to NXF3.

12. I do not propose to summarise the parties' evidence or submissions in lieu here. However, I have taken them all into consideration in reaching my decision and will refer to them below, where necessary.

PRELIMINARY ISSUE

13. In its evidence, the applicant makes reference to the fact that it has previously applied for a trade make in the UK (under no. 3522978) for the word only mark 'BRIXTON STREET WEAR'. The evidence explains that this mark was rejected on inherent grounds and I note that a copy of the Hearing report explaining the reasons has been provided in evidence.² I note that the reasons include reliance upon the absolute grounds for refusal set out in sections 3(1)(b) and (c) of the Act.

² LAW16

There is also reference to a decision of the EUIPO wherein it ruled that the marks 'ICELAND' and 'ICELAND (figurative)' were invalid as they are descriptive of a geographical name. A copy of the decision itself is provided in evidence.³ Lastly, there is evidence of a YouTube video involving a Mr Andrew Nelson regarding the registrability of 'BRIXTON'.⁴ It is alleged, by reference to a print-out from the USPTO website,⁵ that Mr Nelson is the opponent's US trade mark attorney.

14. While this evidence is noted, the fact that the applicant had a registration refused for 'BRIXTON STREET WEAR' is not relevant to my decision, neither is the refusal of 'ICELAND' in the EUIPO. The opponent's marks are validly registered and, as far as I am aware, no application has been brought to invalidate the same. As such, the 'registrability' of marks including 'BRIXTON' is not in issue. While I will expand upon the issue of the distinctiveness of the opponent's marks later in my decision, the 'registrability' of the same is not a factor in such an assessment. Lastly, in regard to the video involving Mr Nelson, I am of the view that his comments are purely speculative and he even sets out in the video that 'BRIXTON' was a client at his previous firm. Further, the video was not made for the purpose of these proceedings and simply appears to be a video made for informative purposes to an unknown audience, presumably one in the US.

DECISION

Proof of use

15. As set out above, the applicant has put the opponent to proof of use for its first two marks. However, the opponent's third mark is not subject to the proof of use provisions as it did not complete its registration process prior to the filing date of the applicant's mark.⁶ Regardless of whether there is genuine use of the first and second marks or not, the opposition based on the section 5(2)(b) ground will proceed. Taking this into account together with the similarities between the opponent's marks and the goods for which they are registered, I will proceed to

³ LAW17 and 18

⁴ LAW19

⁵ LAW20

⁶ As per section 6A of the Act.

consider the 5(2)(b) ground on the basis of the opponent's third mark only. If necessary, I will discuss this issue further in my final remarks at the conclusion of my 5(2)(b) assessment.

16. For the purpose of this section of my decision, I will refer to the opponent's third mark simply as 'the opponent's mark'.

Section 5(2)(b): legislation and case law

17. Section 5(2)(b) of the Act reads as follows:

“(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 or association with the earlier trade mark.”

18. Section 5A of the Act states as follows:

“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.”

19. The opponent's mark qualifies as an “earlier trade mark” for the purposes of this decision since it was applied for (designated for protection) at an earlier date than the applicant's mark.⁷ As I have set out above, the opponent's mark did not

⁷ See Section 6(1)(a) of the Act

complete its registration process more than five years prior to the filing date of the applicant's mark meaning that it is not subject to proof of use pursuant to section 6A of the Act. This means that the opponent can rely upon all goods for which said mark is registered.

20. 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 Office for Harmonization in the Internal Market (Trade Marks and Designs) ("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

21. The competing goods are as follows:

The opponent's goods	The applicant's goods
<u>Class 25</u> Clothing, namely, shirts, T-shirts, tank tops, sweaters, sweatshirts, vests,	<u>Class 25</u> Clothing.

jackets, coats, belts for clothing, pants, trousers, shorts, sweatpants, dresses, skirts, swimwear, board shorts, socks; headwear, namely, hats, caps.	
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22. The General Court confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, that, even if goods are not worded identically, they can still be considered identical if the goods specified in the contested trade mark application are included in a more general category covered by a term under the earlier mark (or vice versa).

23. The applicant seeks registration for “clothing” at large. While the opponent’s specification also includes “clothing”, it is limited to cover a range of specific items of clothing. Despite the limitation to various specific types of clothing, the opponent’s goods all fall within the term of the applicant’s specification. Given what I have said in the paragraph immediately preceding this one, this is sufficient for me to find that the goods at issue are identical.

The average consumer and the nature of the purchasing act

24. As the case law set out above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods. I must then decide the manner in which these goods are likely to be selected by the average consumer in the course of trade. 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. (as he then was) 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.”

25. The applicant submits that the average consumer base will consist of members of the general public at large. The opponent also submits that the goods at issue are aimed at the general public. I agree with both parties and hereby find that the average consumer for the goods at issue is, unsurprisingly, made up of members of the general public at large. The goods at issue will be available via general retailers and their online equivalents. In physical stores, the goods will be displayed on shelves and self-selected by the consumer. A similar approach will follow for online sales in that the consumer will select them having viewed images of the goods on a website. As a result, I find that the visual component will dominate the selection process of the goods at issue. Having said that, I do not discount an aural component playing a part as a result of advice from sales assistants or word of mouth recommendations.

26. The goods at issue are such that they will be selected relatively frequently. As for the cost of the goods, I am of the view that this will vary on the basis that clothing (such as socks, for example) are likely to be cheap but I appreciate that some clothing goods can be relatively expensive. In respect of the level of attention that the consumer will pay, I am of the view that, generally, the average consumer will consider factors such as materials used, fit and the current fashion trends. On this point, I note that the applicant submits that the degree of attention will be average and the opponent submits that it will be no higher than average. I am in agreement with both parties but rather than categorise it as average, I am of the view that the degree of attention paid will be medium.

Comparison of the marks

27. It is clear from *Sabel 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.

28. The Court of Justice of the European Union (“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.”

29. 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.

30. The respective trade marks are shown below:

The opponent’s mark	The applicant’s mark
	

31. I have submissions from both parties in respect of the marks comparison. I do not intend to reproduce these here but confirm that I have taken them into account in conducting my assessment.

Overall Impression

32. The applicant's mark is a figurative mark that consists of both word and device elements. The word elements are 'BRIXTON', which is positioned above 'STREET WEAR' which itself is positioned above 'EST 19XX'. All of the words are presented in a black standard typeface. 'BRIXTON' is the largest element, with 'STREET WEAR' slightly smaller and 'EST 19XX' smaller again. 'BRIXTON' is curved and the top of the lettering in 'STREET WEAR' is warped, albeit only very slightly. Underneath 'EST 19XX' is three different black and white shapes that are presented in such a way that they appear to form one circular device. On the basis that average consumers tend to focus on elements that can be read (and given the size of the device element), it is the words that will grab the consumers' attention. On the basis that 'BRIXTON' is the largest element of the mark and for reasons that I will explore further below, I am of the view that this element will play the greater role in the overall impression of the mark with 'STREET WEAR', 'EST 19XX' and the device element all playing lesser roles.

33. Turning to the opponent's mark, this is a figurative mark made up of one word element and one device element. The device element, which sits atop of the mark, is a black and white shield device. While placed prominently at the top of the mark, I am of the view that this is a fairly banal device element (especially given that the 'shield' is bare). Underneath this is the word 'BRIXTON' presented in a black, standard typeface. Given what I have already said in respect of the device together with the fact that consumers focus on elements that can be read, I find that the word 'BRIXTON' will play the greater role in the overall impression of the mark with the device playing a lesser role.

Visual Comparison

34. Visually, the marks share the word 'BRIXTON'. This is the element that plays the strongest role in both marks. The points of difference between the marks come in the different device elements in both marks and the presence of 'STREET WEAR' and 'EST 19XX' in the applicant's mark. While these differences all play lesser roles in their respective marks, they still contribute to the visual comparison. Taking

all of this into account and bearing in mind the overall impression of the respective marks, I am of the view that they are visually similar to between a medium and high degree.

Aural Comparison

35. The word 'BRIXTON' is the sole aural element of the opponent's mark. This word is made up of two syllables and will be pronounced in the ordinary way. In considering the applicant's mark, I bear in mind the comments of Mr Phillip Harris who, as the Appointed Person in the case of *Purity Hemp Company Improving Life as Nature Intended*, Case BL O/115/22, found that the descriptiveness of an element does not necessarily make it aurally invisible. I agree that this is applicable to the word 'STREET WEAR' on the basis that consumers will still seek to articulate it. However, I do not consider that this principle applies to 'EST 19XX'. I will expand upon the concept of this element below but, for now, I will say that consumers do not ordinarily seek to articulate information such as the founding year of a company responsible for a trade mark. This leaves the aural element of the applicant's mark as 'BRIXTON STREET WEAR' which consists of four syllables that will be pronounced in the ordinary way. In comparing these marks, I note that the beginning two syllables of the applicant's mark are identical to the entire aural element of the opponent's mark. While the two syllables at the end of the applicant's mark have no counterpart in the opponent's mark, I remind myself that consumers tend to focus on the beginnings of marks⁸ which, in this case, are identical. As such, I consider that these marks are aurally similar to between a medium and high degree.

Conceptual Comparison

36. I have no submissions as to what the device element in the applicant's mark is meant to represent. As such, it will simply be seen as a decorative element with no meaning. This leaves the words 'BRIXTON STREET WEAR EST 19XX' as being the only elements from which a concept can derive. I will discuss 'BRIXTON' in

⁸ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

greater detail when considering the distinctiveness of the opponent's mark below but, for now, I will say that a substantial proportion of average consumers in the UK will simply understand it as a reference to an area or borough of London. As for 'STREET WEAR', this is descriptive of a type of clothing. While the applicant's goods are not limited to 'streetwear', this is an immediately graspable concept that will be understood regardless. Lastly, as alluded to above, I am of the view that 'EST 19XX' is a reference to the founding of the company with 'EST' being commonly understood as 'established' and '19XX' being a reference to a year in the 1900s with no indication as to what exact year. While this will contribute to the concept of the mark, its impact from a trade mark perspective will be limited as, in my view, consumers are used to seeing such information contained within trade marks. Taking all of this into account, the overall concept of the applicant's mark is that it is a streetwear brand from Brixton that was established at some point in the 1900s.

37. As for the opponent's mark, I do not consider that the shield device has any concept, especially given that nothing is presented within the shield itself. As such, the opponent's mark is dominated solely by the concept of 'BRIXTON' which, as above, will be understood as an area/borough of London. While it makes no reference to a type of clothing or year of establishment, I am of the view that the shared concept of 'BRIXTON' results in a high degree of conceptual similarity between the marks, especially given that the conceptual differences are from non (or less) distinctive elements.

Distinctive character of the opponent's mark

38. 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).”

39. Registered trade marks possess varying degrees of inherent distinctive character, perhaps lower where a mark may be suggestive or allusive of a characteristic of the goods or services for which it is registered, ranging up 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 made of it. The opponent has claimed that its mark enjoys an enhanced degree of distinctive character through use and has filed evidence to that effect.

40. Before considering the position in respect of enhanced distinctiveness through use, it is necessary to consider the inherent position. I have discussed above that ‘BRIXTON’ is the strongest element of the mark with the device element playing a lesser role. A similar finding applies to the mark’s inherent distinctive character, namely that it is dominated by ‘BRIXTON’ with the shield device having very little impact. On this point, I do not consider that the device element is such that it increases the overall distinctive character of the mark beyond that which is created by the word ‘BRIXTON’. As such, I am of the view that the level of distinctive character associated with ‘BRIXTON’ equates to the level of distinctive character of the mark as a whole. In respect of the word ‘BRIXTON’, I note that I have evidence before me from the applicant in respect of the position that ‘BRIXTON’ is

non-distinctive on the basis that it is the name of an area/borough of London.⁹ On this point, I note that the opponent does not deny that 'BRIXTON' is an area of London but does not admit that it is particularly widely well known. Further, the opponent argues that:

"The evidence submitted on behalf of the applicant describes 'BRIXTON' as a vibrant area with a Caribbean cultural scene, with a particular emphasis on the food and music scene. The evidence does not suggest that Brixton is known for clothing or fashion."¹⁰

In support of the above, I note that the opponents' evidence in reply introduces evidence that seeks to demonstrate that Brixton is not known for fashion or clothing.¹¹

41. While the opponent's position in respect of the overall knowledge of Brixton (as a location) amongst the consumer base in the UK is noted, I disagree. While some consumers may not know precisely where it is, it is my view that a majority of them will be aware that Brixton is a location in London. As such, the opponent's mark will, on the goods at issue, be viewed as a reference to clothing that originates from Brixton. I consider this to be the case regardless of whether Brixton is a place well-known for fashion/clothing or not.¹² On this point, I am of the view that average consumers are well accustomed to seeing place names on various types of clothing goods, regardless of whether the locations are well-known for fashion/clothing or not. Having said all of the above, by virtue of being a registered mark, it must be assumed that the opponent's mark has at least some distinctive character.¹³ In the present case, I am of the view that the reference to an area/borough of London in respect of clothing goods is such that it gives the opponent's mark a very low degree of inherent distinctive character.

⁹ I do not consider it necessary to discuss this evidence in full but note the existence of Exhibits LAW5 to LAW12 in respect of this point.

¹⁰ See paragraph 51 of the opponent's written submissions

¹¹ See exhibits NXF1 to NXF3

¹² I appreciate that this issue may come in to play in determining section 3 grounds (as per paragraphs 31 to 36 of *Windsurfing Chiemsee v Boots Attenberger*, Case C-108/97 and C-109/97). However, I do not consider that it is necessarily relevant to the assessment I must make here.

¹³ *Formula One Licensing BV v OHIM*, Case C-196/11P,

42. I turn now to consider the position in respect of enhanced distinctiveness due to the use made of it by the opponent. In reviewing the evidence with an eye on the issue of enhanced distinctiveness, I consider it to be somewhat light. I don't say this as a criticism of the evidence but more so in relation to the onerous requirements to prove enhanced distinctiveness of trade marks in the UK. The evidence of Mr Reichel consists of a copy of a distribution agreement with a UK distributor,¹⁴ four invoices addressed to the opponent's UK distributor from 2013 with a combined value of \$102,139.09,¹⁵ screenshots of the opponent's website between 2013 and 2022,¹⁶ advertising efforts in the UK¹⁷ and details of one transaction from 2018 for a 'fiddler cap'.¹⁸ Further, the narrative evidence from Mr Reichel sets out that the opponent began selling apparel in the UK in 2007 and has been doing so ever since. More specifically, the comments of Mr Reichel set out that between 2018 and 2022, sales made in the UK directly from the opponent's website exceeded £350,000.¹⁹ Having considered the four invoices provided and the images from the opponent's website, it is clear to me that the opponent's goods cover a range of clothing goods.

43. While I note that the applicant did not address the opponent's evidence with the distinctiveness point in mind, it did mention it in respect of proof of use. The applicant's position is that the sales provided only demonstrate trivial or token use and are insufficient to show that the opponent's marks have been commercially exploited. I appreciate that the level of use before me, when compared to the size of the clothing market in the UK, is low. Having said that, I do not consider that the use before me is trivial or token.²⁰ As mentioned above, the requirements for enhanced distinctiveness are rather onerous and, on balance, the level of use before me is clearly not sufficient to cross that threshold. As such, I find that the opponent's use of its mark is not capable of proving that it has enhanced the distinctiveness of its mark. Therefore, the inherent position applies.

¹⁴ BR1

¹⁵ BR2

¹⁶ BR3

¹⁷ BR6 and BR7

¹⁸ BR4

¹⁹ See paragraph 3 of the witness statement of Mr Reichel

²⁰ On the point of the evidence, I also note that I have no reason to disbelieve that accuracy of the turnover figures provided and neither do I consider that the invoices cannot be relied upon, even taking into account that they include some redaction and cover only four invoices to one distributor.

Likelihood of confusion

44. 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. 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 and vice versa. As I mentioned above, 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.

45. In my goods comparison above, I found the parties' goods to be identical. I have found the average consumer for the goods to be members of the general public at large who will select the goods at issue via primarily visual means, although I do not discount an aural component playing a part. I have concluded that the average consumer will, generally, pay a medium degree of attention when selecting the goods at issue. In respect of the similarity of the marks at issue, I have found them to be visually and aurally similar to between a medium and high degree and conceptually similar to a high degree. Lastly, I have found that the opponent's mark is inherently distinctive to a very low degree. However, on this point, I remind myself that a weak distinctive character of an earlier mark does not preclude a likelihood of confusion.²¹

²¹ *L'Oréal SA v OHIM*, Case C-235/05 P

46. In considering all of the above and bearing in mind the principle of imperfect recollection, I am of the view that the marks at issue represent a paradigm case of those that are capable of being directly confused. I say this because I do not consider that the average consumer, when confronted with the marks at issue, would accurately remember which mark included the words 'STREET WEAR', the 'EST 19XX' element and the respective device elements, especially given that the marks will be viewed on identical goods. The element that will be recalled (and, consequently, the one that will remain in the minds of consumers) is the 'BRIXTON' element. I find that this is the case regardless of its understanding as a location in London. As such, I find that average consumers are likely to misremember or mistakenly recall one mark for the other.

47. For the avoidance of doubt, I have reached the above conclusion whilst also giving consideration to the fact that the opponent's mark only has a very low degree of distinctive character. As above, the low level of distinctive character does not mean that there cannot be confusion. In respect of this point, the case law cited above sets out that a finding that there is no likelihood of confusion on this basis would require me to conclude that the consumer would disregard the similarity of the marks in favour of a consideration based on the low distinctive character of the shared element. I appreciate that this may apply in cases where there are significant points of visual, aural or conceptual difference between marks. However, that is not the case here as the differences come in descriptive or simply device elements. As such, I do not consider that this type of comparison is something that the average consumer would undertake. Put simply, there are no additional elements that contribute to the distinctiveness of either mark to such a degree that they can be said to point away from the fact that the consumer would be directly confused by the common use of 'BRIXTON'. Consequently, regardless of the very low degree of distinctive character of the opponent's mark, I consider that there exists a likelihood of confusion between the marks at issue.

48. For the sake of completeness, I turn now to consider a likelihood of indirect confusion. In respect of such, I remind myself of the case of *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, wherein Mr Iain Purvis Q.C., 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)”.

49. In the event that the differences between the marks at issue are noticed by the average consumer, I am of the view that they fall squarely within category (b) of *L.A Sugar* (cited above). This is on the basis that the applicant's mark simply adds a number of elements to the shared 'BRIXTON' element that will, in my view, be seen as logical indicators of a brand extension, namely that the clothing brand 'BRIXTON' has expanded into selling a range of street wear. Further, the reference to the year that the streetwear brand was established will not do anything to point away from this finding. I say this on the basis that, as already mentioned above, consumers are accustomed to seeing references to when brands were established in their trade marks. As such, it does nothing to point away from there being a belief amongst consumers that the marks share the same commercial origin. Lastly, I do not consider that the device elements will impact the finding either as neither of them have any qualities that can be said to be anything other than minor decorative elements. Consequently, I consider that there is a likelihood of indirect confusion in respect of the marks. For the avoidance of doubt, following the same reasons as those discussed when considering direct confusion, I am of the view that this finding applies regardless of the very low distinctive character of the shared element.

Final Remarks under 5(2)(b)

50. As set out above, the opponent relied on three earlier marks, two of which were subject to proof of use. I explained at the outset of this decision that I would consider the third mark only as it was not subject to proof of use. In respect of that mark, the opposition has succeeded in its entirety meaning that the applicant's mark is to be refused regardless of the success of any of the remaining grounds relied upon. As such, the issue regarding the opponent's first and second marks does not further the opponent's case.

51. The above being said, I wish to briefly discuss that, had I been required to consider those marks (and genuine use of the same), the opponent's reliance upon them would have also succeeded in full. In respect of use, I appreciate that some of the evidence that I have summarised at paragraphs 42 and 43 above does not apply

on the basis that it falls prior to the relevant period.²² Further, I accept that I have found that the use before me is low, especially when considering that it has been used on a range of clothing goods. Even considering these points, use need not be quantitatively significant in order for it to be genuine and, as such, I am satisfied that the evidence filed is sufficient to demonstrate that the opponent has sought to create or preserve an outlet for the goods sold under the marks.²³ Even if said use was limited to specific types of clothing goods, this would have still garnered identity with the applicant's goods.²⁴ In light of this, I am of the view that the opponent's reliance upon its first and second marks would have followed similar outcomes in respect of the marks comparison and distinctiveness of the opponent's marks as those that I have already assessed above. Such outcomes would ultimately have led to the same final outcome, namely that there exists both a likelihood of direct and indirect confusion.

52. While the opposition succeeds in full, I will briefly go on to consider the remaining grounds.

Section 5(3)

53. Section 5(3) of the Act states:

“5(3) A trade mark which –

is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.”

²² Being the five year period before the filing date of the applicant's mark

²³ See paragraph 106, sub-paragraphs (5) and (7) of *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247

²⁴ This is on the basis that the applicant sought registration for 'clothing' at large which would, on the principle outlined in *Meric*, encompass any item of clothing that the opponent's first and second marks may have been permitted to rely on.

54. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L’Oreal v Bellure*, Case C-323/09, *Marks and Spencer v Interflora*, Case C383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows:

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Salomon*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark’s reputation and distinctiveness; *Intel*, paragraph 42

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark’s ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the

goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the holder of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74* and *the court's answer to question 1 in L'Oreal v Bellure*).

55. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that its marks and the applicant's marks are similar. Secondly, the opponent must show that its marks have achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier marks being brought to mind by the later mark. Finally, assuming the first three conditions have been met, section 5(3) requires that one

or more of the types of damage will occur. It is unnecessary for the purposes of section 5(3) that the goods be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

56. I can deal with this ground relatively swiftly. While I appreciate that the evidence of the opponent (that I have summarised at paragraphs 42 and 43 above) may be acceptable to support a finding of genuine use, it is not acceptable to support a finding of a reputation. On this point, I remind myself that the test for considering a reputation is more onerous than that for genuine use. I say this because a finding of genuine use only requires a sufficient level of use (as per the case of *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, this need not be quantitatively significant) whereas a finding of a reputation requires that the marks relied upon are known by a significant part of the relevant public in the UK or the EU.²⁵ Having considered the evidence with this point in mind, I am of the view that it falls far short of this requirement. Without a reputation, there can be no link and no subsequent damage to the opponent's marks. Consequently, the opposition based upon section 5(3) falls at the first hurdle.

Section 5(4)(a)

57. Section 5(4)(a) of the Act reads as follows:

“(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(aa)

²⁵ In the present case, the opponent's first mark is a comparable mark based on an earlier EUTM meaning that the EU forms part of the relevant territory for the assessment of a reputation. However, no evidence is before me regarding use in the EU.

(b)

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

58. Subsection (4A) of Section 5 states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

59. In considering the issue of the existence of a protectable level of goodwill, I remind myself that a small business which has more than a trivial goodwill can protect signs which are distinctive of that business under the law of passing off even though its goodwill and reputation may be small.²⁶ I have already set out throughout this decision that the opponent’s evidence is representative of a low level of use. However, bearing in mind what I have said above, I consider that the evidence is sufficient to establish a protectable goodwill (albeit a modest one) of which the sign relied upon, being ‘BRIXTON’, is distinctive of and/or associated with.

60. In considering the issue of misrepresentation, it should come as no surprise (based on everything I have said throughout this decision) that I consider that the sign relied upon, being ‘BRIXTON’ is similar to a higher degree with the applicant’s mark (be that outright high or between a medium and high degree). As for the goods at issue, I have not made a determination as to precisely what goods benefit from the opponent’s goodwill and neither do I consider it particularly necessary to do so. This is on the basis that the goods would be identical, regardless of whether I were to allow a goodwill in ‘clothing’ at large or a specific sub-set of the same. In any event, at the very least the parties clearly operate in common fields of activity (i.e. the clothing industry). As a result, I find that a consumer who is aware of the

²⁶ See *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590, for example.

opponent's 'BRIXTON' clothing goods would believe that any clothing items produced by the applicant and sold under its similar mark would originate from the same undertaking, being the opponent. Overall, I find that use of the applicant's mark for the goods applied for constitutes a misrepresentation to a substantial number of consumers.

Damage

61. Having found the existence of goodwill and misrepresentation, I consider that damage through diversion of sales is easily foreseeable. The opposition based upon section 5(4)(a) is, therefore, successful.

CONCLUSION

62. The opposition has succeeded in its entirety under sections 5(2)(b) and 5(4)(a) and the applicant's mark is, subject to any appeal, refused for all of the goods applied for.

COSTS

63. As the opponent has succeeded, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the opponent the sum of **£1,400** as a contribution towards his costs. The sum is calculated as follows:

Preparing the notice of opposition and considering the counterstatement:	£200
Filing evidence, considering the applicant's evidence and filing evidence in reply:	£700
Written submissions in lieu:	£300

Official fees: £200

Total: £1,400

64. I hereby order Brixton Street Wear Limited to pay Brixton, LLC the sum of £1,400.

The above sum should 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 12th day of December 2023

A COOPER

For the Registrar