O/1208/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3880529
IN THE NAME OF MARVIN BAILEY
TO REGISTER THE FOLLOWING TRADE MARK:

IN CLASS 25

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 600002883
BY SOCIEDAD TEXTIL LONIA, S.A.

Background and pleadings

1. On 21 February 2023, Marvin Bailey ("the Applicant") applied to register the trade mark, UK00003880529, shown on the cover page of this decision in the UK. It was accepted and published in the Trade Marks Journal on 17 March 2023 in respect of the following goods:

   Class 25: *Clothing*

2. On 10 May 2023, SOCIEDAD TEXTIL LONIA, S.A. ("the Opponent") opposed the application under Section 5(2)(b) of the Trade Marks Act 1994 ("the Act") on the basis of its earlier UK Trade Mark:

   PG

   UK Registration no. UK00003701408[1]
   Date of registration: 29 April 2022

   Relying upon the following goods:

   Class 25: *Clothing; Footwear; Headgear.*

3. By virtue of its earlier filing date of 17 December 2019, the above registration constitutes an earlier mark within the meaning of section 6 of the Act. As the earlier mark had not completed its registration process more than five years before the filing date of the application in issue, it is not subject to proof of use pursuant to section 6A of the Act. The Opponent can, therefore, rely upon all of the goods it has identified without having to demonstrate use.

4. The Opponent argues that the respective goods are identical or similar and that the marks are similar, resulting in a likelihood of confusion.

[1] On 1 January 2021, the UK left the EU after the expiry of the transition period. Under Article 59 of the Withdrawal Agreement between the UK and EU, applications for EUTMs made before the end of the transition period that had received a filing date can form the basis of a UK application with the same filing date as the corresponding EUTM, provided they were filed within 9 months of the end of the transition period. The Applicant's EUTM number 18167050 was filed at the EUIPO on 17 December 2019, whereas its UK application was re-filed on 27 September 2021. Accordingly, the UK application was given the same filing date as its EUTM.

5. The Applicant filed a counterstatement in which it accepts that the goods are identical but denies the marks are similar as the letters “PG” are presented differently. Consequently, the Applicant denies there is a likelihood of confusion.

6. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that: “(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.” The net effect of these changes is to require the parties to seek leave in order to file evidence in fast track oppositions. No leave was sought to file evidence in these proceedings.

7. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken. A hearing was neither requested nor considered necessary; however, the Applicant filed written submissions in lieu. This decision is taken following a careful consideration 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 upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to the case law of the EU courts.

Preliminary issue

9. The Applicant states that there are ongoing rectification proceedings involving an additional PG mark with a third party[2]. It claims that “the earlier registration is proof that the letters PG in a different format to that of the Opponent’s trade mark can be

[2] The Applicant’s Defence and Counterstatement, paragraph 7

distinguished from one another even if the letter elements are the same."[3] The presence of the additional PG mark referred to has no probative value as the fact that the Opponent has not sought to oppose these marks is entirely irrelevant to the present case. Furthermore, for clarity, whilst I note that the additional mark is referred to as an earlier registration, it does not pre-date the filing date of the mark relied upon by the Opponent. Therefore, I will say no more about the existence of the additional PG mark.

DECISION

Section 5(2)(b)

10. Section 5(2)(b) of the Act is as follows:

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

11. 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.

[3] Ibid

(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; Page 8 of 20

(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

12. The goods for comparison are as follows:

Opponent's goods	Applicant's goods
Class 25: Clothing; Footwear; Headgear.	Class 25: Clothing;

13. The Applicant concedes that "*The goods of the application and the Opponent's registration are identical".*[4] I agree, the term "Clothing" appears in both parties' specifications and is self-evidently identical.

Average consumer and the purchasing act

14. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then 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. 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.

[4] The Applicant's Defence and Counterstatement paragraph 10.

The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median”.

15. In respect of the goods in class 25, the average consumer is likely to be a member of the general public with the end goods self-selected from traditional high street retail outlets or their online equivalents. The goods may vary in price, but none are likely to be prohibitively expensive and all will be purchased reasonably frequently.

16. *New Look Ltd v OHIM* Cases T-117/03 to T-119/03 and T-171/03, the General Court (GC) said this about the selection of clothing:

> “50. Generally in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly, the visual aspect plays a greater role in the global assessment of the likelihood of confusion.”

17. Given the process of selection, the marks’ visual impact is likely to play the greater role, though I do not discount the opportunity for aural recommendations made by salespeople, for example. Weighing all factors, I find that the average consumer will apply a medium degree of attention to the purchase.

Distinctive character of the earlier trade mark

18. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In *Lloyd Schuhfabrik*, 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)."

19. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

20. The Opponent has not filed any evidence to support that the earlier mark's distinctive character has been enhanced through use. Consequently, I have only the inherent position to consider.

21. I have nothing from the Opponent on this point. However, the Applicant claims that the Opponent's mark has only a low level of distinctive character and that the graphical differences between the marks will have a substantial impact on how the average consumer views the marks.[5] In support,[6] the Applicant refers to O2 v CXO2[7], in which the Hearing Officer found *"I find that the marks are (at most)*

[5] The Applicant's submissions in lieu paragraph 11.
[6] The Applicant's submissions in lieu paragraph 12.
[7] BL O/658/18

averagely distinctive. This is because the combination of a letter and number, or two numbers, is relatively banal." I note that this was upheld on appeal to the Appointed Person.[8]

22. The earlier mark consists solely of the letters, "P" and "G" in a minimally stylised font. I do not find the letters to be descriptive or allusive of the goods, and it is my view that they will convey no particular meaning to the consumer. However, whilst no meaning will be attributed to the letters, I consider the short and relatively simple two letter combination "PG" to hold (at most) a medium level of distinctiveness.

Comparison of marks

23. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union 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."

24. It would be wrong, therefore, to dissect the trade marks artificially, 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.

25. The respective trade marks are shown below:

[8] BL O/393/19

Earlier trade mark	Contested trade mark
PG	

Overall impression

26. The Applicant's contested mark consists of the letters "PG" in a white stylised font on a black oval shaped background. The edges of the letters "P" and "G" are cut off at the outer edge of the background shape. The letters "PG" plays a greater role in the overall impression in equal measure, with the black oval background and the stylisation playing a lesser role.

27. The Opponent's mark consists of two letters, "P" and "G", with minimal stylisation, as such, the overall impression is derived from the letters in equal measure with neither letter having a dominant role.

Visual comparison

28. The competing marks are visually similar as they both contain the letters "PG". There is a point of difference created through the use of a black oval shaped background on the contested mark. The earlier mark is presented in a black font with minimal stylisation, while the contested mark is presented in white stylised font on a black background. Considering these factors, I find the marks to be visually similar to a high degree.

Aural comparison

29. Both marks consist of the letters "P" and "G", which would be articulated in the same way. As the letters do not form a word, consumers will pronounce the individual letters themselves. The oval shape and stylisation of the letters would not change the way either mark would be articulated. I therefore consider the marks to be aurally identical.

Conceptual comparison

30. The letters “P” and “G” in the competing marks are likely to be perceived as acronyms, with no particular meaning. The black oval background of the contested mark and the stylisation of the respective marks do not add to the conceptual impression of either mark. The conceptual position is, therefore, neutral.

Likelihood of confusion

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

32. I have found that the competing goods are identical. The average consumer will be a member of the general public who will pay a medium degree of attention during the purchasing process. The purchasing process is predominantly visual, although I do not discount an aural component. The marks are visually similar to a high degree, aurally identical and conceptually neutral. The earlier mark also has (at most) a medium level of distinctiveness.

33. In my view, the differences in the stylisation between the marks, and the black oval background in the contested mark are likely to be insufficient to distinguish between the competing marks. Therefore, it is entirely feasible that the average consumer will recall the identical letters “P” and “G”, which are the dominant elements, whilst overlooking the differences in presentation. Taking all of these factors together and bearing in mind the potential for imperfect recollection along with the interdependency principle, I find that the average consumer paying a

medium degree of attention is likely to mistake one mark for the other. There is, therefore, a likelihood of direct confusion.

34. That leaves indirect confusion to be considered. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis QC, (as he then was) sitting as the Appointed Person, explained that:

> "16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: "The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.
>
> 17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:
>
> > (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ("26 RED TESCO" would no doubt be such a case).
> >
> > (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a

sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

35. These three categories are not exhaustive; rather, they were intended to be illustrative of the general approach, as has been confirmed by the Court of Appeal. I recognise that a finding of indirect confusion should not be made merely because the competing marks share a common element. In this connection, it is not sufficient that a mark merely calls to mind another mark: this is mere association not indirect confusion.[9]

36. Furthermore, in *Liverpool Gin*,[10] Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

37. In the event that I am wrong, and the average consumer notices the differences in the stylisation, and the presence/absence of the black oval background in the contested mark, in my view, these differences are not distinctive. Therefore, given the use of the identical letters “P” and “G” which dominate the overall impressions of both marks it is my view that the differences between the marks would likely be attributed to a brand revamp rather than denoting goods from different undertakings. I consider that it is not uncommon for undertakings to undergo a

[9] *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17
[10] *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207

brand ‘re-fresh’ or ‘brand-revamp’ from time to time to accommodate changes in marketing considerations. Consequently, there is a likelihood of indirect confusion.

Conclusion

38. The opposition under section 5(2)(b) of the Act has been successful. Subject to any successful appeal against my decision, the application will be refused in respect of all goods.

COSTS

39. The Opponent has been successful and is entitled to a contribution towards its costs. I note that in the applicant’s submissions it is stated that “the Opponent did not contact the applicant prior to the filing of the opposition.” I refer to Tribunal Practice Notice (TPN 6/2008) which states that:

> “3. As from 3 December 2007, costs are not usually awarded against rights holders or applicants who do not defend an action brought without prior notice.
>
> 6. Where an opposition is defended, the provision or otherwise of prior notice will not usually affect the award of costs at the conclusion of the proceedings, which will normally be based on the published scale of costs.”

40. Therefore, considering the above and using the guidance in Tribunal Practice Notice 1/2023, I award the Opponent costs on the following basis:

Preparing a statement and considering the Counterstatement[11]	£100
Official fee (Form TM7F)	£100
Total:	**£200**

[11] I have made an appropriate reduction to reflect the scant nature of the Form TM7.

41. I therefore order Marvin Bailey to pay SOCIEDAD TEXTIL LONIA, S.A. the sum of **£200**. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 21st day of December 2023

Emma Rees

For the Registrar