

O/285/21

IN THE MATTER OF THE TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK REGISTRATION NUMBER 3,366,278 IN THE  
NAME OF BAFFOUR OWUSU AMANKWATIA

AND IN THE MATTER OF AN APPEAL FROM THE DECISION OF HEATHER  
HARRISON (O/515/20) DATED 19 OCTOBER 2020

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DECISION

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### Introduction

1. This is an appeal from the decision of Ms Heather Harrison, for the Registrar, dated 19 October 2020 (O/515/20) where she dismissed the opposition of Original BUFF SA under section 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 to Mr Baffour Owusu Amakwatia's application (No 3,366,278). Original BUFF SA now appeals in relation to section 5(2)(b) and 5(3) only.
2. Mr Amakwatia applied to register the following mark in relation to "clothes" in Class 25:



3. Original BUFF SA opposed the mark based on five earlier trade marks. The Hearing Officer took the view that the word mark BUFF (Int No 1,370,544) was the most similar, it is protected for the following goods in Class 25:

**Class 25:** Ready-made clothing for external and internal use; handkerchiefs (not included in other classes); caps; footwear (except orthopedic footwear) and headgear.

4. The Appellant submits that because of the similarity of colour the Hearing Officer should also have considered the following mark (which was EUTM 10,496,404; but

now carries the UK No 910,496,404) which is registered for the same goods in Class 25:



5. The Hearing Officer found that “clothes” covered by the application was: (i) identical to “clothing” covered by both earlier marks (Decision, [32]); (ii) similar to a high degree to “headgear” covered by both earlier marks (Decision, [36]); and (iii) similar to a fairly high degree to “footwear” covered by those marks (Decision, [37]). These findings were accepted on appeal.

#### **Standard of Appeal**

6. The standard of appeal is by way of review. Neither surprise at a Hearing Officer’s conclusion nor a belief that she has reached the wrong decision will suffice to justify interference in this sort of appeal. Before that is warranted, it is necessary for me to be satisfied that there was a distinct and material error of principle in the decision in question or that the Hearing Officer was wrong. The relevant principles were set out in *TT Education Ltd v Pie Corbett Consultancy* [2017] RPC 17 by Daniel Alexander QC and subsequently by the Supreme Court in *Actavis Group PTC EHF v ICOS Corporation* [2019] UKSC 15.
7. When considering this appeal, and applying these principles, it is important to remember the high bar set.

#### **Average consumer**

8. The Hearing Officer considered the average consumer for all the goods covered by both marks to be a member of the general public (Decision, [39]). While the Appellant accepted this finding, Ms Tolson submits that the average consumer might also be a “sports person” selecting the goods for their performance characteristics.
9. While it is possible for goods to have more than one average consumer, this would assist the Appellant only if there would be a likelihood of confusion among sportspersons which would not exist among the public more widely. However, goods which are selected for performance characteristics, rather than purely aesthetics, are likely to be much more closely examined by consumers to ensure the relevant characteristics are present. Therefore, confusion is less likely. This means that if there were an error by the Hearing Officer in not considering a sportsperson’s purchasing decisions it would not be material to the outcome of the case. I therefore reject this ground of appeal.

#### **The meaning of BUFF**

10. Ms Tolson criticised the finding of the Hearing Officer in relation to the meaning of the word BUFF. The Hearing Office held at Decision, [42] (footnotes omitted):

The word “buff” has a number of meanings, as pointed out by Mr Amankwatia. It may be a colour, mean an expert (for example, a film buff) or be a verb meaning to polish. It may also mean that a person is attractive or muscular. There is no evidence on the extent to which the latter meaning would be known to the UK consumer. Collins English Dictionary indicates that as an adjective meaning “fit” or “attractive” it is an informal word. The Oxford English Dictionary shows that it is a slang word (meaning “muscular”, “well-toned” or “attractive”) which originated in the US. It seems to me that its inclusion in two major dictionaries signals that it is in current if not frequent use and will be understood as meaning, broadly, attractive, by the average consumer. I would add that this confirms rather than contradicts my original impression, based upon my own experience as an average consumer, which I do not consider atypical. In the context of goods worn on the person, the word may, therefore, be taken to be a statement about the wearer rather than indicating trade origin, or descriptive of a characteristic of the goods (i.e. their colour, or their ability to enhance the appearance of muscles, e.g. by being close-fitting)...

11. Ms Toulson submits that BUFF in terms of attractiveness means attractive *and* muscular (or as a result of being muscular) and not mere attractiveness (thereby implying that an attractive slender person would not be called “buff”). She is essentially arguing that the Hearing Officer misquoted what the dictionaries said. The Appellant is correct that the Collins Dictionary definition relied upon by the Hearing Officer does restrict the meaning of “buff” to being attractive by reason of physique; but the Oxford Dictionary provides that “buff” can be used in relation to a person (or a person’s body) to mean “muscular, well-toned; physically attractive”. The use of the semi-colon in this second dictionary suggests that “buff” can be used in relation to an attractive slender person as well as an attractive muscular person. I do not accept, therefore, that the definitions were misquoted.
12. Ms Toulson also submits that there are other errors in the Hearing Officer’s reasoning: (i) BUFF is not commonly used to describe the colour of clothing, footwear or headgear; (ii) in relation to the goods in question the word BUFF has little relevance in terms of polishing; and (iii) being muscular is not material to neckwear and headwear.
13. The Hearing Officer considered two dictionaries and her own experience to determine what the word BUFF is likely to mean in terms of the goods in question. Her assessment was a value judgment and was made on a proper basis. In such a case, it would be entirely improper to substitute a new meaning for the word even if I had a different view from the Hearing Officer. I therefore reject this ground of appeal.

### **Distinctiveness**

14. The Hearing Officer concluded (or more precisely, she was forced to conclude) that in relation to the goods covered by the earlier mark the word BUFF had the minimum distinctiveness required to get registered: Decision, [42]. She went on to consider the Appellant’s evidence and whether it could establish that the mark BUFF had any enhanced distinctive character. She concluded that in relation to headgear and neckwear there was evidence demonstrating the mark had developed a modest degree of enhanced distinctive character, but that due to the low starting point overall the mark BUFF was distinctive only to a fairly low degree (Decision, [43 to 44]).
15. The Appellant challenges this finding and submits that in relation to headgear and neckwear the mark’s enhanced distinctiveness should have led to the mark having an

above average level of distinctiveness overall. Ms Toulson put forward three reasons why the Hearing Officer's finding was wrong.

16. First, Ms Toulson criticises the Hearing Officer for not referring to the copyright date of items as a way of indicating the date of origin. While it is true that the evidence includes two instances where copyright dates were provided (Star Wars scarf, Exhibit, HK1, p 47 and 48; Spiderman headwear, Exhibit HK4, p 101), the Hearing Officer accepted that there had been some sales of headwear and neckwear and some distinctiveness had resulted. Even if these two copyright dates had been missed by the Hearing Officer (and it is not apparent this is the case) it is not clear what difference they would have made to her conclusion on enhanced distinctiveness. This is because the date the mark was used was only relevant in relation to goods other than scarfs and headgear (see Decision, [43 and 44]).
17. Secondly, Ms Toulson argues that the Hearing Officer should have taken into account the fact that in order to get the word mark BUFF registered it had been necessary to file evidence to show that the mark had become distinctive. This argument is flawed. As the Hearing Officer acknowledged, in accordance with C-196/11P *Formula One Licensing BV v OHIM*, EU:C:2012:314, the registrar must treat all earlier trade marks as possessing sufficient distinctiveness to be registered. The mere fact that an examiner determines that a mark has acquired sufficient distinctiveness to be registered proves nothing more than *Formula One* requires; namely, that the mark is distinctive to the minimum degree required for registration.
18. Finally, Ms Toulson submitted that the Hearing Officer was wrong to conclude that the mark's modest degree of enhanced distinctiveness led to the mark having only a fairly low degree of distinctiveness overall. In principle, there is nothing wrong with this finding. A mark's distinctiveness being enhanced can turn a weak mark into a slightly less weak mark. Enhancement does not automatically confer above average distinctiveness. Accordingly, I dismiss this ground of appeal as well.

### **Similarity of the mark**

19. Ms Toulson submits that the Hearing Officer erroneously considered the mark would be pronounced "BB BUFF BODY" when, she says, in fact it would be said "BUFF BODY". The Hearing Officer dealt with this point as follows in Decision, [50]:

The device in the contested mark will not be verbalised. It is possible that the contested mark will be articulated as either "BB BUFF BODY", as "BB" or as "BUFF BODY". I regard the former as the most likely, given the prominence of the letters "BB" and the additional meaning offered by the words...
20. Accordingly, it is clear that the Hearing Officer considered how the mark would be verbalised and took account of the approach now advocated by the Appellant. The Hearing Officer was entitled to reject that approach and she did so. This ground of appeal too must fail.
21. As I have dismissed all the grounds of appeal relating to the Hearing Officer's findings on section 5(2)(b), I conclude therefore that her finding that there was no likelihood of confusion between BB BUFF BODY and BUFF must stand.

### **Figurative Mark EU404**

22. The Appellant submits that the Hearing Officer erred in substantively considering the word mark BUFF only (the IR544 mark) and not the figurative mark (the EU404 mark).
23. The Hearing Officer indicated at Decision, [29] that she would focus her assessment on IR544 because it was not stylised and so it is the closest to the Applicant's mark. She concluded (at Decision, [60]) that the other marks were visually less similar than IR544 and any increased distinctiveness would be attributable to the stylisation, which is not present in the Applicant's mark.
24. Ms Toulson submits, in essence, that the background colour of EU404 (orange) makes that mark more similar than the word mark (IR544) to the Applicant's mark. While the sharing of a colour might add to the visual similarity of a mark in one respect it is more than outweighed by the numerous visual differences between the Applicant's mark and EU404.
25. First, in respect of the word common to both marks, BUFF, a different typeface and font is used in the Applicant's mark from that used in EU404 (and it is worth noting that for word marks such as IR544 the registration covers the use of that word in any typeface, font or colour: *Dreamers Club Ltd's TM Application* [2019] RPC 16, [11 and 12]). Secondly, there is an image of a woman doing a partial handstand in the Applicant's mark and no characters appear at all in EU404. Thirdly, there is the large "BB" and the word "Body" in the Applicant's mark but only the word BUFF in EU404. Fourthly, the word BUFF is smaller than both the "BB" and the character in the Applicant's mark and it appears at the bottom of the mark, whereas it is the centre piece of EU404. Finally, the Applicant's mark has graduated orange colours from darker orange in the centre of the circle to lighter shades at the edge (there is also a corona effect at the edge which makes it look like the character is performing in front of a sunset) whereas EU404 has a single shade of orange.
26. In short, I entirely agree with the Hearing Officer's conclusion that the differences between the Applicant's mark and EU404 are such that visually it is less similar than IR544. Nevertheless, it would have been better had the Hearing Officer expressly addressed the "orange" colour issue in her reasoning as it had been raised. But her failure to do so does not undermine her overall conclusion.

### **Reputation**

27. The Appellant also challenges the Hearing Officer's finding that its mark's reputation was "modest" (Decision, [64]). Ms Toulson submits that in an earlier case *RUFF ELEGANCE* (O/642/19), [59] the same mark was found by another Hearing Officer to have a "reasonably strong reputation" (and an above average degree of enhanced distinctiveness) and so the Hearing Officer in this case must be mistaken in her less generous assessment.
28. There are numerous reasons why this submission is ill-founded. First, the evidence considered by the Hearing Officer in the *RUFF* case was more extensive (the Hearing Officer in this case limited the number of pages of evidence that could be filed, and the Appellant did not appeal that decision). Secondly, the relevant date in the *RUFF* case was 19 February 2018; in this case it was 11 January 2019. In principle, there is no reason why a reputation could not have diminished over that time. Thirdly, in terms of an appeal in this case, there is no reason why the Hearing Officer in *RUFF* should be

treated as having been right in assessing the evidence. Finally, the rule from *Hollington v Hewthorn* [1943] KB 587 that earlier judgments cannot be used as evidence to support the findings of fact made therein precludes the *RUFF* decision being evidence of reputation in this case.

29. The Appellant also argued that the Respondent made an admission that the Appellant's "goodwill is well established" in his Witness Statement. This takes the case nowhere. Goodwill is not the same as reputation and is a "well established" reputation greater or less than a "modest" reputation? Accordingly, I uphold the Hearing Officer's findings on reputation.

### **Link**

30. The Appellant's final challenge was that the Hearing Officer had erred in concluding that there would be no link in the mind of the average consumer between the two marks. Her conclusion was expressed at Decision, [71]:

Despite a lower level of similarity being required to establish a link than is the case for confusion, I find that the relevant public will not make a link between the marks. Although the goods are identical or highly similar, the suggestive nature of the earlier mark and its modest reputation are not sufficient to establish that there will be a link when considered against the differences between the marks, in particular the visual differences and the specific meaning of the phrase "BUFF BODY". The opposition under s. 5(3) is dismissed.

31. Each of the reasons Ms Toulson puts forward for why the Hearing Officer should have found a link between the Respondent's mark and the Appellant's earlier mark were considered by the Hearing Officer in this paragraph. The fact that the Appellant does not like the Hearing Officer's finding is not a reason to overturn it. Accordingly, I dismiss the appeal so far as it relates to section 5(3).

### **Conclusion**

32. I therefore uphold the Hearing Officer's decision in all material respects and dismiss the appeal in its entirety.
33. Mr Amankwatia is a litigant in person and, when asked, he indicated that he would not be seeking any costs. Accordingly, I make no order as to costs.

PHILLIP JOHNSON  
13 APRIL 2001

### **Representation:**

Appellants: Jacqueline Tolson (of IP21 Limited)

Respondent: Baffour Owusu Amankwatia (representing himself)