

O/295/21

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003444313

BY JERMAIN LAWLOR TO REGISTER THE FOLLOWING TRADE MARK:

Selfmadesavage

IN CLASS 25

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 419496 BY TSMC LTD

Background and Pleadings

1. On 14 November 2019, Jermain Lawlor ('the Applicant') filed an application to register the trade mark shown on the cover page of this Decision, number 3444313. The application was published for opposition purposes in the *Trade Marks Journal* on 6 December 2019. Registration is sought in respect of the following goods:

Class 25

Hats; hoodies; t-shirts; tracksuits; body warmers.

2. On 18 February 2020, the application was opposed by TSMC LTD ('the Opponent') based on section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opposition is directed against all of the Applicant's goods. The Opponent relies on the following earlier trade mark registration for its section 5(2)(b) ground:

UK00003403252

THE SELFMADE COMPANY

THE SELFMADE CO

(Series of two marks)

Filing date: 30 May 2019; Date registration completed: 20 September 2019.

Relying on its registered goods in **class 25**:

Clothing; footwear; headgear; hooded sweatshirts; shirts; sweatshirts; t-shirts; vests; fancy dress costumes; costumes; underwear; hats; berets; knitted headwear; sportswear; dresses; skirts; blouses; belts; waist belts; coats; jackets; knitwear; jumpers; tights; socks; loungewear; bathrobes; capes; evening wear; gowns; trousers; shorts; jeans; suits;

*neckwear; nightwear; outerclothing;
rainwear; ties; parts, accessories or
fittings for the aforesaid*

3. The Opponent claims that there is a likelihood of confusion under section 5(2)(b) and its opposition is directed against all of the goods within the Applicant's mark's specification.
4. The Applicant filed a defence and counterstatement, denying the grounds, albeit conceding that 'there is some overlap' between the respective goods.
5. Only the Applicant has filed evidence and written submissions. Neither party has filed written submissions in lieu of a hearing.
6. The Opponent is represented by Brand Protect Limited; the Applicant is represented by Eversheds Sutherland (International) LLP.

Preliminary issues

7. Section 6A of the Act provides that where the registration date of the earlier mark is more than 5 years prior to the application date of the applied-for mark, the opponent may be required to prove use of the earlier mark. In the instant case, Section 6A is not engaged because the registration date of the earlier mark, i.e. 20 September 2019, is less than 5 years prior to the application date of the applied-for mark, i.e. 14 November 2019. Consequently, the Opponent is entitled to rely upon its mark in respect of all of the goods upon which it relies.
8. The Applicant has submitted the following at paragraphs [46] and [47] of its written submissions:

The Applicant's Trade Mark has been in use in the UK since 2017 in relation to a range of clothing, headwear and accessories items.

It is therefore evident that use of the Applicant's Trade Mark pre-dates the date of filing of the Opponent's Registrations, namely, 30 May 2019.

9. How the Applicant has used, is currently using, and intends to use, its mark is irrelevant to the Tribunal's assessment of whether there is a likelihood of confusion. A defence based upon prior use is wrong in law; see Tribunal Practice Notice 4/2009. There has, to my knowledge, been no application to invalidate the earlier trade mark registration. I must only consider the 'notional' use of both parties' marks for the goods in their specifications.

10. The concept of 'notional use' was addressed in *Compass Publishing BV v Compass Logistics* [2004] R.P.C. 41 per Laddie J.:

"22. It is frequently said by trade mark lawyers that when the proprietor's mark and the defendant's sign have been used in the market-place but no confusion has been caused, then there cannot exist a likelihood of confusion under Art.9.1(b) or the equivalent provision in the Trade Marks Act 1994 ("the 1994 Act"), that is to say s.10(2). So, no confusion in the market-place means no infringement of the registered trade mark. This is, however, no more than a rule of thumb. It must be borne in mind that the provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to be a finding of infringement. Similarly, even when the proprietor of a registered mark uses it, he may well not use it throughout the whole width of the registration or he may use it on a scale which is very small compared with the sector of trade in which the mark is registered and the alleged infringer's use may be very limited also. In the former situation, the court must consider notional use extended to the full width of the classification of goods or services. In the latter it must consider notional use on a scale where direct competition between the proprietor and the alleged infringer could take place."

11. The Court of Justice of the European Union¹ ('CJEU') has stated the following²:

“Once a mark has been registered its proprietor has the right to use it as he sees fit so that, for the purposes of assessing whether the application for registration falls within the ground for refusal laid down in that provision, it is necessary to ascertain whether there is a likelihood of confusion with the opponent’s earlier mark in all the circumstances in which the mark applied for might be used if it were to be registered.

12. In my assessment, I must therefore consider all of the possible circumstances in which the mark applied for *might* be used if it were registered.

13. The Applicant has submitted the following at paragraph [27] of its written submissions:

Distinctiveness plays an important role in conceptual comparison, since conceptual similarity is more determinative where the shared element is distinctive for the relevant goods/services. The Opponent has failed to submit any evidence to establish that their registration has acquired distinctiveness through use and it has therefore failed to establish that the Opponent’s Registrations enjoy enhanced distinctiveness.

And the following at paragraph [45] of its written submissions:

Furthermore, since the Opponent has failed to substantiate acquired distinctiveness in respect of their registration, such registration should not enjoy a broader scope of protection.

The Opponent has not raised the matter of *acquired* distinctiveness in its pleadings; there is no requirement for the Opponent to provide evidence of *acquired* distinctiveness. The matter of the *inherent* distinctive character (as opposed to *enhanced* distinctive character) of the earlier mark is an issue to be

¹ Although the UK has left the EU, section 6(3)(a) of the European (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 Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision makes reference to the trade mark case-law of EU courts.

² *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06.

considered by this Tribunal.

State of the Register

14. The Applicant has submitted the following at paragraphs [43] and [44] of its written submissions:

However, based on a cursory search of the UKIPO database, it is also apparent that there are a number of trade marks all containing the words 'SELF MADE' that currently co-exist on the register in relation to goods in Class 25. Examples of some of these marks are attached at **Annex 6**. This level of coexistence not only shows that the words 'SELF MADE' are not particularly distinctive when used alone in relation to goods in Class 25, but that there is also scope for co-existence of other marks that contain the words 'SELF MADE' and that also contain additional distinctive elements or stylisation.

In view of the number of 'SELF MADE' formative trade marks existing on the UK trade mark register, it is clear that 'SELF MADE' is a commonly used term in respect of the goods on which this action is based, and it follows that no party is entitled to exclusivity in this term in relation to the goods concerned. If the Opponent believed that it was entitled to exclusive rights in the word 'SELF MADE' *per se*, then they would have applied for this mark without any additional elements.

15. The presence of other marks containing the element 'SELF MADE', in relation to class 25 goods, on the Register does not necessarily entail that 'SELF MADE' is 'not particularly distinctive when used alone in Class 25'.

16. The fact that previous marks containing the element 'SELF MADE' have been allowed on to the Register does not necessarily weaken the Opposition against the Applicant's mark.³ The presence, or otherwise, of such marks on the Register

³ In *Zero Industry Srl v OHIM*, Case T-400/06, the General Court stated that:

"73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word 'zero', it should be pointed out that the Opposition Division found, in that regard, that '... there are no indications as to how many of such trade marks are effectively used in the market'. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word 'zero' is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T-135/04

has no bearing on the instant proceedings. My assessment is concerned only with the particular marks referred to in this opposition.

Applicant's evidence

17. The Applicant's evidence comes from the Applicant, Jermaine Lawlor. Their witness statement is dated 4 December 2020. The witness statement focuses on the history of the Applicant's business and its prior use of the mark. The following items are exhibited:

Exhibit JL1 – comprises a number of screenshots from the Applicant's Instagram accounts displaying the Applicant's goods, the earliest post provided dated October 2018.

Exhibit JL2 – comprises a number of invoices, relating to the Applicant's goods, for various dates between 1 August 2017 and 27 July 2020.

Exhibit JL3 – comprises the Companies House record for the Applicant's company.

Exhibit JL4 – comprises correspondence, dated November 2019, from HMRC to the Applicant's company confirming its Company Unique Taxpayer Reference.

Exhibit JL5 – comprises a printout from the webpage '<https://who.is/whois/selfmadesavage.co.uk>' displaying information relating to registration of the domain name 'selfmadesavage.co.uk'.

Exhibit JL6 – comprises a single screenshot from the Applicant's website '<http://selfmadesavage.co.uk>' displaying a model wearing clothing bearing the Applicant's brand name.

GfK v OHIM – BUS(Online Bus) [2005] ECR II-4865, paragraph 68, and Case T-29/04 Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH) [2005] ECR II-5309, paragraph 71.”

18. The origin of the Applicant's company and whether or not it has registered a domain name for its website are irrelevant to the matter of the likelihood of confusion between the marks. Exhibits JL3 – JL4 are therefore irrelevant and the Tribunal is, therefore, unable to take them into account.

19. Exhibits JL1, JL2, JL 5 and JL6 are irrelevant for the reasons provided above under 'Preliminary issues' at paragraphs [7] – [11].

20. The following decision has been made after careful consideration of the papers before me.

Decision

Section 5(2)(b) of the Act and related case law

21. Section 5(2)(b) of the Act states:

“5(2) A trade mark shall not be registered if because –

(a) ...

(b) It is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

There exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

22. The following principles are derived from the decisions of the CJEU⁴ 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*

⁴ Although the UK has left the EU, section 6(3)(a) of the European (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 Trade Marks 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.

Klijisen 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 C120/04; Shake di L. Laudato & C. Sas v OHIM, Case C-334/05P; and Bimbo SA v OHIM, Case C-591/12P

The principles:

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

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

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

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

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

(k) if the association between the marks creates a risk that the public 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

23. I bear in mind the decision of the General Court in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut für Lernsysteme

v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

24. The goods and services to be compared are as follows:

Opponent’s mark:	Applied-for mark:
<p>Class 25 <i>Clothing; footwear; headgear; hooded sweatshirts; shirts; sweatshirts; t-shirts; vests; fancy dress costumes; costumes; underwear; hats; berets; knitted headwear; sportswear; dresses; skirts; blouses; belts; waist belts; coats; jackets; knitwear; jumpers; tights; socks; loungewear; bathrobes; capes; evening wear; gowns; trousers; shorts; jeans; suits; neckwear; nightwear; outerclothing; rainwear; ties; parts, accessories or fittings for the aforesaid</i></p>	<p>Class 25 <i>Hats; hoodies; t-shirts; tracksuits; body warmers.</i></p>

25. All of the Applicant’s goods are included within the Opponent’s broad term *clothing*. Therefore, applying the principle in *Meric*, underlined above at [23], the respective goods are identical.

Average consumer and the purchasing act

26. The average consumer is deemed to be reasonably well-informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's

level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

27. In *Hearst Holdings Inc*⁵ Birss J. described the average consumer thus:

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

28. The average consumer of the goods in question is a member of the general public. The goods will be sold from physical shops, catalogues or online. The goods will, in most cases, be self-selected: in retail premises, they will be selected from shelves or rails; online, they will be ‘added to the shopping basket’ after visual inspection of the product listing. The purchasing act will, in most cases, be primarily visual; in instances where a member of staff is consulted, there will be an aural aspect. In my view, the average consumer will consider factors including: size of the garment; colour; composition of the fabric; care instructions; comfort/how the fabric feels; durability and how the garment looks when tried on. In my view, the average consumer will display at least an average level of attention when purchasing these goods.

Comparison of the marks

THE SELFMADE COMPANY	
THE SELFMADE CO	Selfmadesavage

⁵ *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).

(Series of two marks)	
Opponent's (earlier) mark	Holder's (contested) mark

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

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

30. 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.

31. The Opponent relies on a series of two earlier marks. Both are word only marks comprising three elements, rendered in plain font of uniform size, all letters being upper case. The two marks are identical, but for the final words, ‘COMPANY’ and ‘CO’, respectively. Both marks share the first two words ‘THE SELFMADE’. For each mark, the overall impression resides in the mark in its entirety, with the ‘SELFMADE’ element having dominance over the descriptive elements ‘COMPANY’ and ‘CO’.

32. The Applicant's mark is also a word only mark in a plain font; it comprises the words 'selfmade' and 'savage' conjoined as if to form a single word 'Selfmadesavage'. Only the first letter is in upper case. The overall impression resides in the mark in its entirety; the conjoining of the three words prevents any of the three words having visual dominance over any other.

33. Visual comparison

Both the Opponent's marks and the Applicant's mark contain the element 'SELFMADE'. The respective marks differ to the extent that the word elements comprising the Applicant's mark are conjoined or 'run together' as one string, whereas the elements of the Opponent's marks are separated by spaces. In my view, the conjoined nature of the Applicant's mark is a visual difference that will be discerned by the average consumer. Other points of difference are that: the Opponent's marks each comprise three words whereas the Applicant's mark, when broken down, comprises two words; the Opponent's marks each begin with 'THE'. Consequently, I find that the level of visual similarity between the respective marks is low.

34. Aural comparison

I consider that the Opponent's marks will be articulated respectively as: 'THE-SELF-MADE-KUM-PANY' and 'THE-SELF-MADE-CO', with the emphasis on the third syllable. The Applicant's mark will be articulated as 'SELF-MADE-SAV-AGE', with the emphasis on the third syllable. The 'SELFMADE' element of the respective marks will therefore differ aurally to the extent that, in the Opponent's marks, the emphasis will be on 'MADE', whereas there will be no such emphasis on that element in the Applicant's mark. Other points of aural difference which will be discerned by the average consumer are: the presence of 'THE' at the beginning of each of the Opponent's marks, which is absent from the Applicant's mark; the presence of 'SAVAGE' in the Applicant's mark, which is absent from either of the Opponent's marks. The alliterative use of the letter 'S' in the Applicant's mark (i.e. 'Selfmadesavage') is a feature that will be noted by the average consumer when the mark is articulated. In my view, the alliteration in the

Applicant's mark allows the mark, when spoken, to flow or 'trip off the tongue' in a way that the Opponent's marks do not. Consequently, I find that the respective marks are aurally similar to a low degree.

35. Conceptual comparison

'Selfmade' is a word in the English language which is, strictly speaking, hyphenated i.e. self-made. The dictionary defines 'self-made' as an adjective meaning 'rich and successful as a result of your own work and not because of family money'.⁶ Dictionary definitions aside, I consider that some average consumers might presume that 'selfmade' means that the goods are made by the company itself, rather than the company simply putting its brand name on items manufactured by another business, for instance. The dictionary defines 'company' as 'an organization that sells goods or service in order to make money'.⁷ It is well-known that 'Co' is an abbreviation for the word 'company'.

36. In my view, 'THE SELFMADE COMPANY' and 'THE SELFMADE CO', as marks for clothing, would convey the idea of a company built up from nothing as a result of hard work, with an intimate connection to its products to the extent that it makes the clothing itself. The presence of the word 'THE' conveys the idea of authenticity and uniqueness.

37. I now turn to the Applicant's mark. 'Savage' is a word in the English language whose dictionary definition refers to a number of senses of the word⁸:

- As an adjective:
extremely violent, wild or frightening;
very serious or cruel;
very large and severe;
(of an animal) wild and fierce, or (of a remark) violently cruel.

⁶ <https://dictionary.cambridge.org/dictionary/english/self-made>, accessed 15 April 2021, at 18:56.

⁷ <https://dictionary.cambridge.org/dictionary/english/company>, accessed 15 April 2021, at 18:58.

⁸ <https://dictionary.cambridge.org/dictionary/english/savage>, accessed 15 April, at 19:27.

- As a noun:

a person whose way of life is at a very early stage of development;

someone who is thought to be in a wild state and to have no experience of a civilized society.

38. In my view, the conjoining of the word 'Selfmade' with 'savage' causes the word to be perceived, by the average consumer, differently to the way in which it is perceived as a component of the Opponent's mark. I consider that 'Selfmadesavage' as a mark for clothing would likely conjure the idea that patrons of the brand are rebellious, wild or 'edgy' individuals who tend to go against the orthodoxy where fashion is concerned. In my view, 'Selfmade', as an element of the Applicant's mark, when conjoined with 'savage', conveys a sense of uniqueness, individuality and resistance to convention. Consequently, I find that the respective marks have a low level of conceptual similarity.

Distinctive character of the earlier mark

39. *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).”

40. In my view, ‘Selfmade’ will, for some average consumers, be somewhat allusive to the goods by suggesting that the clothes are made by the Opponent itself, as opposed to being manufactured by a third party and sold under the Opponent’s brand. Consequently, I find that the earlier mark is inherently distinctive to a low degree.

41. The CJEU held in *Sabel*⁹ that:

“24. The more distinctive the earlier mark, the greater will be the likelihood of confusion.”

42. This principle was given an important qualification by Mr Iain Purvis Q.C, as the Appointed Person, in the decision of *Kurt Geiger v A-List Corporate Limited*¹⁰:

“39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be

⁹ *Sabel BV v Puma AG* (C-251/95), [1998] E. T. M. R. 1 (1997) at [24].

¹⁰ BL O-075-13.

confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything, it will reduce it.”

Likelihood of confusion

43. Confusion can be direct or indirect. Mr Ian Purvis Q. C., as the Appointed Person, explained the difference in the decision of *L.A. Sugar Limited v By Back Beat Inc*¹¹. Direct confusion occurs when one mark is mistaken for another. In *Lloyd Schuhfabrik*¹², the CJEU recognised that the average consumer rarely encounters the two marks side by side but must rely on the imperfect picture of them that he has in his mind. Direct confusion can therefore occur by imperfect recollection when the average consumer sees the later mark before him but mistakenly matches it to the imperfect image of the earlier mark in his ‘mind’s eye’. Indirect confusion occurs when the average consumer recognises that the later mark is indeed different from the earlier mark, but, concludes that the later mark is economically linked to the earlier mark by way of being a ‘sub brand’, for instance.

44. Before arriving at my decision, I must make a global assessment taking into account all of the relevant factors, including the principles a) – k) set out above at [22].

45. When considering all relevant factors ‘in the round’, I must bear in mind that a greater degree of similarity between goods *may* be offset by a lesser degree of similarity between the marks, and vice versa.

The purchasing act will, in most cases, as noted above at [28], be visual in nature; though there will in some cases be an aural aspect. In *New Look Limited v OHIM* the General Court stated that:

¹¹ Case BL O/375/10 at [16].

¹² *Lloyd Schuhfabrik Meyer and Co GmbH v Klijsen Handel BV* (C-34297) at [26].

“49. ...it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market...”

And

“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.”

46. I have determined that:

- The respective goods are identical;
- The marks are visually similar to a low degree;
- The marks are aurally similar to a low degree;
- The marks are conceptually similar to a low degree.

47. In my view, although the respective goods are identical, the visual and conceptual distinctions between the marks are sufficient to rule out any likelihood of direct confusion.

48. I also conclude that there is no likelihood of *indirect* confusion. In reaching this conclusion, I have borne in mind *Whyte and Mackay*¹³ in which it was held that where an average consumer perceives that a composite mark consists of two or

¹³ *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271.

more elements, one of which has a distinctive significance independent of the mark as a whole, confusion may occur as a result of the similarity/identity of that element to the earlier mark. In my view, the 'SELFMADE' element common to the respective marks has not retained its independent distinctive role in the Applicant's mark. As noted above, at [38], the conjoining of 'selfmade' with 'Savage' results in the Applicant's mark conveying a different concept than that conveyed by the Opponent's mark.

Final Remarks

49. The Opposition has failed. The Application may proceed to registration.

COSTS

50. I award the Applicant the sum of **£500** as contribution towards its costs, calculated as follows¹⁴. I have not awarded any sum in respect of the evidence filed due to its irrelevance, for the reasons already provided above at paragraphs [7] – [11] and [18] – [19].

Consideration of the Opposition and preparation of Defence and Counterstatement	£200	
Preparation of written submissions	£300	
Total:		£500

51. I therefore order TSMC LTD to pay to Jermain Lawlor the sum of **£500**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

¹⁴ Based upon the scale published in Tribunal Practice Notice 2/2016.

Dated this 22nd day of April 2021

Mx N. R. Morris

For the Registrar,

the Comptroller-General