

**TRADE MARKS ACT 1994**

**IN THE MATTER OF:**

**OPPOSITION No. 414528**

**IN THE NAME OF G. & G. S.R.L**

**TO TRADE MARK APPLICATION No. 3331103**

**IN THE NAME OF UKBD OUTLET LTD**

**DECISION**

1. On 12 August 2018, UKBD Outlet Ltd (“the Applicant”) applied under number 3331103 to register the following sign, graphically represented in colour, as a trade mark for use in relation to a wide range of goods in Class 25:



2. The colours red, white and blue applied to the letters “UK” echo those of the national flag of the United Kingdom and the colours green and red applied to the letters “BD” echo those of the national flag of Bangladesh.
3. On 29 November 2018, G. & G. Srl (“the Opponent”) filed a Notice and Statement of Grounds of Opposition objecting to the application for registration so far as relevant for present purposes on the basis that use of the opposed mark would conflict with the rights to which it was entitled under s. 5(2)(b) of the Trade Marks Act 1994 as proprietor of the earlier trade mark **BD BAGGIES** registered as an EU Trade Mark under number 15115926 in Class 25 for: “*clothing; outerwear; sportswear; knitwear; underwear; nightwear; beachwear; ties; hosiery; scarves; gloves; belts; pocket squares; footwear; headgear.*”
4. The question raised by the objection under s.5(2)(b) was whether there were similarities in terms of the marks in issue and the goods in issue which would combine to give rise to the existence of a likelihood of confusion if the marks were to be used concurrently

in the United Kingdom for goods of the kind for which they were respectively registered and sought to be registered as at 12 August 2018.

5. Only the Opponent filed evidence. This consisted of a Witness Statement made by Mr Ross Manaton, the attorney acting for the Opponent in the present proceedings. At Exhibit RTM1 he produced “a collection of screenshots taken from standard references on the internet, relating to the meaning of the word ‘baggies’ in the English language”. The sources for the screenshots were identified as Wikipedia, dictionary.com, Oxford Living Dictionaries and Merriam-Webster online dictionary. At Exhibit RTM2 he produced a copy of the EUIPO’s “*Common Communication on the Common Practice on the General Indications of the Nice Class Headings v1.2*” dated 28 October 2015.
6. Neither party requested a hearing. No written submissions were filed by either side in lieu of attending a hearing. The Opposition proceeded to a determination on the basis of the papers on file.
7. It was rejected in its entirety for the reasons given by Ms Teresa Perks on behalf of the Registrar of Trade Marks in a Decision issued under reference BL O/439/19 on 26 July 2019. The Applicant did not take up the opportunity it was given to establish a basis for claiming an award of costs in its favour. The Opposition was therefore dismissed with no order as to costs.
8. In paragraphs [10] to [17] of her Decision, the Hearing Officer determined that the goods of interest to the Applicant fell within the scope of the wording of the list of goods for which the earlier trade mark was registered in Class 25. She therefore concluded that the Class 25 goods in issue should be regarded as “identical” for the purposes of the Opponent’s objection to registration under s. 5(2)(b) of the Act. Her determination to that effect stands unchallenged on this Appeal.
9. The Hearing Officer summarised the evidence at Exhibit RTM1 in paragraph [24] of her decision. Her assessment with regard to the distinctive character of the Opponent’s earlier trade mark **BD BAGGIES** was as follows (with footnotes omitted):

26. Whilst I think that most UK consumers of clothing will be familiar with the expression ‘baggy clothing’, I am not sure that the same consumers will be familiar with the expression BAGGIES or that they will readily understand BAGGIES as meaning loose-fitting clothing, trousers or shorts. Dictionary.com and Merriam Webster are American based dictionary websites and although the term BAGGIES may be used in American English, there is no evidence that it was commonly used in the UK at the relevant date to denote a particular style of clothing. I should also add that, as the opponent’s evidence showed, the first and main result of a search for the term BAGGIES on English Oxford Living Dictionary returned BAGGY as the most recognised word. The same result indicated that BAGGIES has the meaning informal for ‘loose, wide-legged trousers or shorts’: however, this was the least recognised meaning and no details have been given as to the actual frequency of use of the word BAGGIES in the UK.

27. In my view, it is telling that two of the dictionary definitions exhibited by the opponent are from American-based online dictionaries. It is also telling that the only dictionary definition which could (arguably) relate to the UK, namely the one from English Oxford Living Dictionary, identified BAGGY as the most recognised word. Though the word might be used in current American English, it is not the same as the English spoken in the UK.

28. Finally, as regards the extract from Wikipedia there are two issues. Firstly, Wikipedia is not a reliable source of information as it is freely editable so it has limited probative value. Secondly, even if I were to give some weight to the evidence that 'Baggies' was a name given to a particular type of jean in the early 1980s in the United Kingdom, I am not prepared to take judicial notice of the fact that the average consumer of clothing in the UK would have been aware of this at the relevant date.

29. In conclusion, I dismiss the opponent's argument that the UK average consumer will understand the word BAGGIES in the earlier mark as descriptive for the goods.

30. Likewise, I do not accept (and the opponent made no specific submission on the point) that BAGGIES will be taken as a synonym for 'baggy clothes'. This is particularly true in relation to the earlier *Underwear; Nightwear; Beachwear; Ties; Hosiery; Scarves; Gloves; Belts; Pocket squares; Footwear; Headwear* for which the association with 'baggy clothes' would not even be made. I have also considered that the opponent's mark could be used in relation to loose-fitting articles of clothing. However, my conclusion is that, even in that context, the element BAGGIES could, at most, be said to evoke the concept of 'baggy clothes'. But this would not in any way mean that BAGGIES is a usual term for it and the word would still be a distinctive element of the mark.

31. As regards the distinctiveness of the element BD, I propose to approach the matter from the point of view of the Registry's practice in relation to abbreviations, acronyms or initials as set out in the Work Manual (version published at the time of writing). This indicates that: "Trade marks consisting of abbreviations, acronyms or initials will be accepted unless research indicates that the letters represent descriptive words used in trade to denote the goods and / or services intended for protection."

32. There is nothing to suggest that the letters BD are, or would be regarded as, descriptive or otherwise non-distinctive in relation to the registered goods in class 25. That said, the element BD is a two-letter combination and whilst I do not consider it appropriate to pitch its distinctiveness at only a very low level. I do not think that it would strike the average consumer as particularly distinctive. The mark I have to consider is, in any case, not simply BD but BD BAGGIES. I come to the view that the combination BD BAGGIES as a whole is distinctive to a medium degree.

10. On comparing and contrasting the marks in issue she found as follows:

35. The opponent's mark consists of the words BD BAGGIES, written in capital letters. The overall impression of the mark[s] lies in the combination of these two elements, with neither element dominating.

36. The applied for mark is made up of the letters UKBD written in upper case and the getup (including the colour contrast) applied to those components. The letters UK and BD are stylised differently: the detailing in the letters UK is the Union Jack, that in the letters BD is a colour pattern consisting of a green background with a red semi-circle in each letter. Due to the colour contrast, the mark breaks down fairly naturally into its component elements, i.e. UK and BD. The letters UKBD have the greatest relative weight in the overall impression because this is how the mark will be memorised and referred to. Nevertheless, since the get-up reinforces how the mark is made up and gives the mark a particular visual impact, it will still play a role.

...

38. I agree with the opponent that whilst some UK consumers may recognise that the letters BD in the applicant's mark are used to signify Bangladesh (a reference that is reinforced by the colours of the letters BD, which evoke those of the flag of Bangladesh), a substantial proportion of the general public will not. For those consumers who will perceive the element BD as a reference to Bangladesh, the overall impression of the mark will be that of a combination of four letters, UKBD, which stands for UNITED KINGDOM-BANGLADESH. For the other group of consumers, i.e. those who will not perceive the existence of a link between BD and Bangladesh, the overall impression of the mark will still be that of a combination of four letters, however, whilst consumers will still recognise UK as an abbreviation for United Kingdom, they will not attribute any meaning to the letter[s] BD beyond that of being a combination of two letters. Either way, the verbal element of the mark will be memorised as UKBD. As regards the opponent's argument that BD is the most distinctive element and UK has the least relative weight, I do not accept it. This is because (a) the letters UK blend in the mark as a whole and are not placed in a subsidiary position so the average consumers will concentrate on the combination UKBD as a whole and (b) the element BD is not visually dominant, and whatever is the significance that will be attributed to it, it does not have an autonomous function.

11. In paragraphs [39] and [40] of her Decision she decided that the marks were visually and aurally similar to a low degree. With regard to conceptual similarity, she decided in paragraph [43] that:

43. For those consumers who will understand the letters UKBD as an abbreviation for United Kingdom/Bangladesh, the marks are conceptually different. For the other group of consumers who will see BD as a random combination of two letters with no meaning, to the extent that the same combination is incorporated in both marks and might be said to convey the concept of the same two letter combination (if that can be said to be a concept), the marks are similar, at best, to a very low degree.

12. It is clear from paragraphs [9] and [44] of her Decision that the Hearing Officer directed herself correctly as to the legal principles applicable to the determination of the objection under s. 5(2)(b). She rejected the Opponent's case for the reasons summarised in paragraph [48] of her Decision (with footnote omitted):

48. In my view, the applicant's argument that, since the BD element of the earlier mark is reproduced in its entirety in the applied for mark, there is likelihood of confusion cannot be accepted. This is true in relation to those consumers who will see in the applied for mark in reference to Bangladesh, because that reference has no counterpart in the earlier mark. But, equally, even in relation to the other group of consumers who will perceive the letters BD in the earlier mark just as letters, there will be no likelihood of indirect confusion. This is because (1) the overall impression created by the marks, taking into account the dominant and the distinctive components, is different (2) the average consumer will not ascribe any specific meaning to the letters 'BD' in 'UKBD' or in 'BD BAGGIES' and even if (s)he were to be aware of the existence of the earlier 'BD BAGGIES' mark, (s)he would put the presence of the letters 'BD' in both marks down to coincidence rather than associate it with the same commercial origin. **There is no likelihood of indirect confusion.**

13. The Opponent appealed to an Appointed Person under s. 76 of the 1994 Act contending, in substance, that the Hearing Officer had erred by failing to proceed on the basis that in the marks in issue the letters **BD** perform "an independent distinctive role" in the presence of additional elements "of lesser distinctive impact than the common BD element". These contentions were developed in written and oral argument on behalf of the Opponent at the hearing before me.
14. It is axiomatic that trade marks must be considered and compared without dismemberment or excision.
15. The decision taker must make a realistic appraisal of the net effect of the similarities and differences between the marks and the goods in issue, giving the similarities and differences as much or as little significance as the relevant average consumer, who is taken to be reasonably well-informed and reasonably observant and circumspect, would have attached to them at the relevant point in time.
16. It is necessary to consider, as part of that process, how the interplay between the visual, aural and conceptual aspects of the marks in issue would affect the way in which they were liable to be perceived and remembered.

17. The Hearing Officer's assessment of the Opponent's objection to registration conformed to the approach I have summarised in paragraphs [14] to [16] above.
18. It is not apparent from the papers before me that the question whether the letters **BD** performed "an independent distinctive role" in the marks in issue was specifically raised by the Opponent as a matter for determination in the proceedings below.
19. The case law of the CJEU confirms that: "Where a common element retains an independent distinctive role in the composite sign, the overall impression produced by that sign may lead the public to believe that the goods or services at issue come, at the very least, from companies which are linked economically, in which case a likelihood of confusion must be held to be established ... However, the Court has also stated that a component of a composite sign does not retain such an independent distinctive role if, together with the other component or components of the sign, that component forms a unit having a different meaning as compared with the meaning of those components taken separately ...": Case C-20/14 BGW Beratungs-Gesellschaft Wirtschaft mbH EU:C:2015:714 at paragraphs [38], [39].
20. The Hearing Officer's conclusion, briefly stated, was that the Opponent's mark would be perceived as a designation in which **BD** qualified **BAGGIES** and **BAGGIES** qualified **BD**, whereas the Applicant's mark would be perceived unitarily as a combination of the four letters **UKBD**. Her conclusion to that effect left no room for the objection to registration under s. 5(2)(b) to succeed simply on the basis that **BD** was a common element which performed "an independent distinctive role" in the composite marks in issue. With regard to the Opponent's mark **BD BAGGIES** she considered that: "*The overall impression of the mark[s] lies in the combination of these two elements with neither element dominating.*": paragraph [35]. With regard to the Applicant's mark, she considered that: "*... the element BD is not visually dominant, and whatever is the significance that will be attributed to it, it does not have an autonomous function.*": paragraph [38].
21. In paragraphs 5 to 22 of its Statement of Grounds of Appeal, the Opponent criticises the Hearing Officer at length: for misleading herself into "*underestimating the descriptive nature of the word BAGGIES in the Opponent's mark*"; for illogically failing to find that "*the BD element is a dominant distinctive feature of the Opponent's mark*"; for illogically failing to find that "*the BD element is a dominant distinctive element of the Applicant's mark*"; for illogically ascribing "*a medium degree of attention*" to the relevant average consumer; for coming to an unsound conclusion "*that the marks are visually similar 'to a low degree'*"; for illogically concluding "*that the marks are [conceptually] similar, at best, to a very low degree*"; and for illogically concluding that "*the average consumer will not ascribe any particular meaning to the letters 'BD' ... and ... would put the presence of the letters 'BD' in in both marks down to coincidence rather than associate it with the same commercial origin*".
22. The Hearing Officer is said to have acted illogically by rejecting the Opposition despite making 'findings' to the following effect (which I quote with emphasis added in order to identify the particular words which the Opponent singled out for attention in its Statement of Grounds):

- (i) *“I have also considered that the opponent’s mark could be used in relation to loose-fitting articles of clothing. However, my conclusion is that, even in that context, **the element BAGGIES could, at most, be said to evoke the concept of ‘baggy clothes’.**”(paragraph [30]);*
  - (ii) *“**There is nothing to suggest that the letters BD are, or would be regarded as, descriptive or otherwise non-distinctive in relation to the registered goods in class 25.**” (paragraph [32]);*
  - (iii) *“Due to the colour contrast, the [Applicant’s] mark **breaks down fairly naturally into its component elements i.e. UK and BD.**” (paragraph [36]);*
  - (iv) *“For ... those who will not perceive the existence of a link between BD and Bangladesh, the overall impression of the mark will be that of a combination of four letters, however, **whilst consumers will still recognise UK as an abbreviation for United Kingdom, they will not attribute any meaning to the letter[s] BD** beyond that of being a combination of two letters.” (paragraph [38]);*
  - (v) *“ ... but the letters BD will **have no meaning** in the absence of any verbal reference in the [Applicant’s] mark to what the letters stand for.” (paragraph [41]); and*
  - (vi) *“For ... consumers who will see BD as a random combination of two letters with no meaning, to the extent that **the same combination is incorporated in both marks and might be said to convey the concept of the same two letter combination** (if that can be said to be a concept), the marks are similar, at best, to a very low degree.” (paragraph [43]).*
23. If the points raised by the Opponent’s criticisms were all to be considered afresh, the Decision below would end up being re-taken by this Tribunal under the guise of reviewing it for error. However, it is necessary in order to maintain the required distance between the role of decision taker at first instance and the role of decision taker on appeal for this Tribunal to proceed on the basis that the Decision below should stand unless the matters on which the Opponent relies are by force of what they reveal sufficient to establish that the Decision is vitiated by error.
24. I have reviewed the Decision with the Opponent’s criticisms of it firmly in mind. Having done so, I think it is readily apparent from what she said in the paragraphs I have set out in paragraphs [9] to [12] above that the Hearing Officer’s conclusions cannot be faulted for being illogical relative to any of the ‘findings’ instanced by the Opponent. More broadly, I am satisfied that the matters relied by the Opponent reveal no mistakes on her part and therefore cannot be taken, individually or together, to establish that the Decision under s. 5(2)(b) is vitiated by error. In short, it was clearly open to the Hearing Officer on the evidence and materials before her to come to the conclusions she did for the reasons she gave.
25. The Appeal is dismissed for the reasons I have given. It is dismissed with no order as to costs since I have no reason to believe that the Applicant has incurred any or any significant costs in respect of it.

Geoffrey Hobbs QC

14 September 2020

Mr Ross Manaton of Bromhead Johnson appeared on behalf of the Opponent.

No appearance on behalf of the Applicant.

The Registrar took no part in the Appeal.