

**TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK REGISTRATION NO. 3403379**



IN THE NAME OF SAVAGE101 CLOTHING

AND

AN APPLICATION FOR INVALIDATION

UNDER NO. 503012

BY KAVEH SAVAGE

Background and pleadings

1. Savage101 Clothing (“the proprietor”) owns the following trade mark registration with no. 3403379 for clothing in Class 25:



The application to register the mark was filed on 30 May 2019, and it entered in the register on 27 December 2019.

2. On 4 February 2020, Kaveh Savage (“the applicant”) applied for a declaration of invalidity against all the goods in the registration by filing a form TM26(1) based on section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The applicant relies upon the following UK trade mark:

Trade Mark No. 2244426: “SAVAGE”

Filing date: 4 September 2000

Registration date: 5 October 2001

Goods:

Class 18 Bags, wallets, purses, briefcases, articles made of leather and artificial leather, belts.

Class 25 Clothing; headgear; footwear.

3. The applicant argues that there is a likelihood of confusion, including the likelihood of association because the competing marks and goods are identical or highly similar.
4. Given its date of filing, the trade mark upon which the applicant relies qualifies as an earlier trade mark under section 6 of the Act.

5. The proprietor filed a counterstatement denying the grounds of invalidation. As these are the only submissions from the proprietor, they are reproduced below in full:

“I believe we are targeting two different audiences with our brand. We don’t have the same clientele. The clothing we both make is completely different. After looking online, I can see I am not the only person using “savage” as a trade mark, so I am unaware if I am the only company getting opposed.”

6. Even though the applicant provided a statement that it has used the mark in relation to all the goods in Classes 18 and 25, the proprietor has requested the applicant to provide proof of use of the mark only in relation to clothing, fashion hats and trainers in Class 25.
7. The proprietor is a litigant in person and the applicant is represented by Sonder IP. Only the applicant filed evidence. I will summarise the evidence to the extent I consider appropriate. No hearing was requested. Only the applicant filed written submissions in lieu. I make this decision after a careful reading of all the papers filed by the parties.

Evidence

Cancellation applicant’s evidence

8. This consists of the witness statement of Kaveh Savage, with eighteen exhibits. Mr Savage is the applicant in the current proceedings and the proprietor of the UK trade mark SAVAGE (registration no. 2244426). Mr Savage states that he has been designing, manufacturing and selling clothing and accessories under the trade mark SAVAGE since 1999.¹

¹ Para 2.

9. Mr Savage states that the business operates from a retail store located in London and also through the website *www.savagelondon.com*.

10. Mr Savage provides the following turnover figures:

2015 - £45,300

2016 - £42,665

2017 - £68,915

2018 - £94,400

2019 - £135,500

11. Mr Savage claims that goods sold under the trade mark SAVAGE in the last five years include t-shirts, jumpers, hats, bags, wallets and belts.²

12. Exhibit KS2 contains images of the SAVAGE store in London and the items on display. The sign  is displayed as the name of the store. There are images of t-shirts, bags and baseball caps with the word SAVAGE printed on it in a stylized font.

13. Exhibit KS3 contains prints of the archived versions of the website *www.savagelondon.com*. Prints from the years 2015 – 2019 are in evidence. Items on display on the website are t-shirts, sweatshirts and hoodies. Some of the items have “SAVAGE” printed on it in a stylised font. The following details are provided on the home page of the website:

“More choice than any other t-shirt site and our prices are still the same as the beginning of the millennium.”

14. Exhibits KS4 – KS8 contains over 50 selected invoices dated between the years 2016 – 2019. The invoices were issued by Savage London to recipients based

in the UK and some of the EU countries. Either the sign  or

² Para 6.

 SAVAGE LONDON™ appears on all the invoices. Invoices show the sale of t-shirts, babywear, sweatshirts and hoodies.

15. Images of a product tag and a carrier bag are provided as Exhibit KS9 and KS10, respectively. The mark displayed on both images is 

16. A copy of the business card is provided as Exhibit KS11. The sign displayed is



17. Exhibit KS12 contains an image of a card wallet. The sign displayed is



. Mr Savage claims that the card wallets were given to the customers free of charge with every purchase.

18. Exhibit KS13 shows what appears to me as google customer reviews for “Savage London – T-shirts and Hoodies for Men, Women and Children. T-shirt printing in London”. Although there are indications that the reviews were posted for example, “a month ago” or “6 months ago”, the reviews do not state the date of posting.

19. The evidence includes pages from the applicant’s Facebook, Instagram and Twitter accounts as Exhibits KS14 – KS16. The Facebook page was created on 20 July 2009. There are 1,276 likes for the Facebook page. Some of the posts date to 2018. The Instagram account has 175 followers. The posts date between 2013 – 2018. The Twitter account created in 2009 has 888 followers. The tweets filed in evidence appear to have been made in 2018 and 2019. The user name appearing on all the social media profiles is Savage London, and

the profile photo is . The pages filed in evidence have several images of t-shirts, bags and baseball caps.

20. Several images of hoodies, t-shirts, bags and baseball caps bearing the mark SAVAGE are produced as Exhibit KS17. The images are undated, and the source of the images is not clear.

21. Images from various magazines are in evidence as Exhibit KS18: ES magazine (dated 1 December 2000), Bliss (undated) and More! (dated 28 July -10 August 1999). I note that this Exhibit pre-dates the relevant five-year period during which the applicant is required to demonstrate genuine use.

Proof of Use

Applicable law

22. As the applicant's mark had completed its registration process more than 5 years before the date of application for invalidation and the date of application of the contested registration, it is subject to proof of use pursuant to section 47(2A) of the Act. The proprietor has requested that the applicant provide proof of use of its mark.

23. The relevant statutory provisions under section 47 are as follows:

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless—

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if—

(a) the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with their consent in relation to the goods or services for which it is registered—

(i) within the period of 5 years ending with the date of application for the declaration, and

(ii) within the period of 5 years ending with the date of filing of the application for registration of the later trade mark [...] or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) For these purposes—

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(2D) [...]

(2DA) [...]

(2E) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

24. Section 100 of the Act is also relevant, which reads:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

25. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

- (1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].
- (2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].
- (3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul*

at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

- (4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].
- (5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial raison d'être of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].
- (6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the

proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no de minimis rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

26. In *Awareness Limited v Plymouth City Council*,⁷ Mr Daniel Alexander Q.C. as the Appointed Person stated that:

“22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor

is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

Relevant period

27. Pursuant to section 47(2B) of the Act, the relevant periods for assessing whether there had been genuine use of the earlier mark are the 5-year period ending with the date of application for invalidation, i.e. 3 February 2015 to 4 February 2020 and the 5-year period ending with the date of application for registration of the contested mark, i.e. 29 May 2014 - 30 May 2019.

Form of the Mark

28. In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the Court of Justice of European Union (CJEU) found that:

“32. [...] as is apparent from paragraphs 27 to 30 of the judgment in *Nestle*, the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

And

35. [...], a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term ‘genuine use’ [...].

29. In *Nirvana Trade Mark*, BL O/262/06, Mr Richard Arnold Q.C. (as he then was), sitting as the Appointed Person, summarised the test under section 46(2) of the Act which deals with comparable issues of non-use as follows:

“33. ...The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter’s distinctive character. As can be seen from the discussion above, this second question breaks down in the sub questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all.”

30. Although this case was decided before the judgment of the CJEU in *Colloseum*, it remains sound law so far as the question is whether the use of a mark in a different form constitutes genuine use of the mark as registered. The later judgment of the CJEU must also be taken into account where the mark is used as registered, but as part of a composite mark.

31. The registered form of the mark is “SAVAGE”, however, on most of the evidence, the mark appears as SAVAGE LONDON or  SAVAGE LONDON³. The average consumer is likely to see London as merely an indication of geographic origin and the device  as a separative figurative element. Accordingly, notwithstanding the presence of the additional elements, the average consumer is likely to perceive SAVAGE as indicative of the origin of the products. As the use in conjunction with another sign falls within the ambit of genuine use,³ the applicant can rely on the use of the mark as demonstrated. The evidence also



shows the use of the sign ; I again consider is an acceptable variant of the applicant’s word mark “SAVAGE”. In my view, the stylization of the word “SAVAGE”, notably the elongation of the tail to the letter “g” is a modification

³ See *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12.

that does not result in an alteration of the distinctive character of the mark in the form in which it is registered.

Assessment of the evidence of use

32. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.⁴
33. The earlier mark is registered in the UK in relation to clothing, headgear and footwear in Class 25 and it has been put to the proof of genuine use only in relation to clothing, fashion hats and trainers. Therefore, the evidence of the use of the mark on products such as bags⁵, and any use demonstrated elsewhere in the EU are irrelevant to the issues under consideration. It is worth mentioning that the expectation from the proprietor is to request proof of use in respect of terms within the specification. The applicant is not constrained to show use for trainers or fashion hats if the evidence of other items of clothing or headgear is sufficient to sustain the broad terms “clothing and headgear”.
34. The applicant’s invoices were addressed to end consumers based in several locations across the UK. All the invoices bear the mark SAVAGE. The invoices identify items of clothing sold under the mark SAVAGE. Some models of the clothing are themselves identified as “SAVAGE”.
35. The sales are spread over five years from 2015-2019 with sales recorded at regular intervals every year. The evidence shows annual turnover for goods under the mark as ranging from over 42,000 to over 135,000 pounds. I recognise that some of that turnover will be attributable to goods that are not relevant – such as bags. However, the evidence indicates that the business has a particular focus on t-shirts. I therefore accept that it is likely that those figures are attributable substantially to such clothing goods. While I do not

⁴ *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

⁵ Bags are registered in Class 18.

consider those figures to be especially considerable – particularly in the context of the clothing market – I note that there is no *de minimis* rule as such. I also note that the volume of sales made during the relevant periods shows a consistent increase. The evidence also indicates that the use was directed, geographically, at the whole of the UK. Considering the evidence as a whole, I am satisfied that the use of the applicant’s earlier mark is sufficient to create and maintain a market for clothing goods in the UK over the relevant five-year periods. Although some images of baseball caps bearing the mark “SAVAGE” are filed in evidence, the applicant has not provided evidence of sales of those products. Therefore, I am unable to conclude that the applicant has shown genuine use of the mark in relation to caps or the broader category of headgear. Likewise, there is no evidence of use in respect of footwear of any sort.

Fair Specification

36. The next step is to decide whether the extent of use entitles the applicant to rely upon the term “clothing” for which he has claimed use.

37. In *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchin L.J. (with whom Underhill L.J. agreed) set out the correct approach for devising a fair specification where the mark has not been used for all the goods/services for which it is registered. He said:

“63. The task of the court is to arrive, in the end, at a fair specification and this in turn involves ascertaining how the average consumer would describe the goods or services in relation to which the mark has been used, and considering the purpose and intended use of those goods or services. This I understand to be the approach adopted by this court in the earlier cases of *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2002] EWCA Civ 1828, [2003] RPC 32; and in *West v Fuller Smith & Turner plc* [2003] EWCA Civ 48, [2003] FSR 44. To my mind a very helpful exposition was provided by Jacob J (as he then was) in *ANIMAL Trade Mark* [2003] EWHC 1589 (Ch); [2004] FSR 19. He said at paragraph [20]:

“... I do not think there is anything technical about this: the consumer is not expected to think in a pernicky way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. ... Thus the "fair description" is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods ("the penumbra"). A lot depends on the nature of the goods – are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made”.

64. Importantly, Jacob J there explained and I would respectfully agree that the court must form a value judgment as to the appropriate specification having regard to the use which has been made. But I would add that, in doing so, regard must also be had to the guidance given by the General Court in the later cases to which I have referred. Accordingly I believe the approach to be adopted is, in essence, a relatively simple one. The court must identify the goods or services in relation to which the mark has been used in the relevant period and consider how the average consumer would fairly describe them. In carrying out that exercise the court must have regard to the categories of goods or services for which the mark is registered and the extent to which those categories are described in general terms. If those categories are described in terms which are sufficiently broad so as to allow the identification within them of various sub-categories which are capable of being viewed independently then proof of use in relation to only one or more of those sub-categories will not constitute use of the mark in relation to all the other sub-categories.

65. It follows that protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider belong to the same group or category as those for which the mark has been used and which are not in substance different from them. But conversely, if the average consumer would consider that the goods or services for which the mark has been used form a series of coherent categories or sub-categories then the registration must be limited accordingly. In my judgment it also follows that a proprietor cannot derive any real assistance from the, at times, broad terminology of the Nice Classification or from the fact that he may have secured a registration for a wide range of goods or services which are described in general terms. To the contrary, the purpose of the provision is to ensure that protection is only afforded to marks which have actually been used or, put another way, that marks are actually used for the goods or services for which they are registered”.

38. I also bear in mind the law summed up by Mr Geoffrey Hobbs Q.C. as Appointed Person in *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

39. I bear in mind that the term clothing is a broad term that is discernible into sub-categories, for example, dresses, sleepwear, t-shirts, jackets or sportswear. The items that are identifiable from the evidence as having been shown as sold are t-shirts, babywear, sweatshirts and hoodies. I am not convinced that the use of the mark as demonstrated is sufficient to justify use in relation to a wider

range of clothing items or on babywear. In my view the average consumer would describe the category of goods upon which the use has been shown as “t-shirts, sweatshirts and hoodies” in Class 25. I, therefore, consider the fair description of the applicant’s goods under the earlier mark to be:

Class 25: t-shirts, sweatshirts and hoodies

Section 5(2)(b)

40. 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”.

Case law

41. The following principles are gleaned from the judgments 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 C3/03, *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.

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 the 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 greater 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 to mind the earlier mark, 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

The average consumer and the nature of the purchasing act

42. 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 determine the manner in which these goods are likely to be selected by the average consumer.

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

44. The goods at issue in these proceedings are articles of clothing. The average consumer for such goods is a member of the general public.

45. In *New Look Ltd v Office for the Harmonization in the Internal Market (Trade Marks and Designs)* Joined cases T-117/03 to T-119/03 and T-171/03, the General Court (“GC”) commented upon the manner in which articles of clothing are selected. It stated:

“50. The applicant has not mentioned any particular conditions under which the goods are marketed. 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. The average consumer of clothing is likely to purchase such goods fairly frequently. The goods are most likely to be the subject of self-selection from retail outlets, websites or catalogues. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount an aural element to the purchase, particularly when advice is sought from a sales representative or a purchase is made further to a word-of-mouth recommendation. When making a purchase, factors such as size, material, colour, cost (which will vary according to the item) may be considered. These factors suggest that the average consumer will pay a medium level of attention when making their selection.

Comparison of goods

47. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM) case T-133/05, the General Court (“GC”) stated:

“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 the trade mark application (Case T-388/00 *Institut für*

Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

48. The competing goods are as follows:

Cancellation Applicant’s goods	Proprietor’s goods
<u>Class 25</u> T-shirts, sweatshirts and hoodies	<u>Class 25</u> Clothing

49. The proprietor submits:

“I believe we are targeting two different audiences with our brand. We don’t have the same clientele. The clothing we both make is completely different.”⁶

The range of customers the parties target is irrelevant to the decision I have to make. Concerning the proprietor’s argument that the parties are engaged in producing different types of clothing are also irrelevant. This is because I must consider the notional and fair use of the proprietor’s mark in all the circumstances in which it may be used in relation to the term “clothing” for which it is registered, which includes use of the mark in relation to t-shirts, sweatshirts and hoodies. Given that the term clothing is broad enough to include t-shirts, sweatshirts and hoodies covered by the applicant’s registration, the competing goods are identical based on the *Meric* principle.

⁶ See the proprietor’s counterstatement.

Distinctiveness of the earlier mark

50. The distinctive character of the earlier marks must be considered. The more distinctive they are, either inherently or through use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

51. Invented words usually have the highest degree of distinctive character, while words which are allusive of the goods have the lowest. Distinctiveness can also be enhanced through the use of the marks.

52. The word “SAVAGE” is neither allusive nor suggestive of the goods at issue. I find that the mark is distinctive to a medium degree. Although the evidence filed

by the applicant demonstrates the use of the mark in relation to t-shirts, sweatshirts and hoodies, the applicant has not claimed enhanced distinctiveness of its mark. Given the size of the UK market for clothing, the use on the scale shown by the applicant is insufficient to establish any enhancement to the distinctiveness of the mark in relation to the goods for which genuine use was demonstrated.

Comparison of marks

53. It is clear from *Sabel BV v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the 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 in 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.”

54. It would be wrong, therefore, artificially to 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.

55. The trade marks to be compared are as follows:

Proprietor's trade mark	Applicant's trade mark
	<p data-bbox="1062 309 1193 338">SAVAGE</p>

56. The proprietor's mark is comprised of the word "SAVAGE" presented in a stylised font. The device presented under the crossbar and in between the downward strokes of letter A appears in more than one way, for example, "101", "707", or "ZoZ". It appears to me that the proprietor intended it to be presented as the numeral 101, which I think will accord with how a potentially significant portion of the average consumers is likely to recognise the device element.⁷ The device is presented in a much smaller font than that of the word. Although the stylization will not be ignored, the overall impression of the mark is dominated by the word SAVAGE. The numeral, given its much smaller size and the manner of presentation, plays only a weaker role in the overall impression of the mark.

57. The applicant's mark is comprised of the word "SAVAGE". The overall impression and the distinctiveness of the mark lie in this word.

58. Concerning the visual comparison, the applicant submits:

"The marks are visually similar to a very high degree. The mark of the proprietor consists of the word SAVAGE in a large stylized font, placed above the numerals 101 in a small font. The dominant visual element of the proprietor's mark is the term SAVAGE and consequently the mark of the Applicant is contained within the mark of the proprietor in its entirety."⁸

⁷ In the application to register the trade mark, the device is described as numeral 101. See Certificate of Filing dated 30 May 2019.

⁸ See Cancellation Applicant's written submissions dated 10 September 2020, para 8.

59. Visually, both marks coincide in the word “SAVAGE” which is the only element in the applicant’s word mark, and which is the dominant element in the proprietor’s mark, albeit presented in a stylised font. The proprietor’s mark contains the device element which does not have a counterpart in the applicant’s mark. Overall, I find that the marks are visually similar to a high degree.

60. The proprietor’s mark is likely to be pronounced in more than one way. Some average consumers are likely to pronounce all the elements that constitute the mark. In those circumstances, the proprietor’s mark will be pronounced as “savage one-oh-one”. The marks, therefore, will coincide in the pronunciation of the word “SAVAGE”. The aural difference between the marks is then introduced by the numeral 101 in the proprietor’s mark which does not have a counterpart in the applicant’s mark. Weighing up those factors, I find that the marks are aurally similar to a medium degree. There may also be a group of consumers who, due to the presentation of the numeral in a much smaller font, is likely pronounce only the word "SAVAGE" in the proprietor’s mark. In those circumstances, given that "SAVAGE" is the only element in the applicant's mark, I find that the competing marks are aurally identical.

61. As regards the conceptual comparison, the applicant submits:

“The marks are conceptually similar to a high degree. The term ‘Savage’ is defined as a noun being ‘a brutal or vicious person’ or as an adjective meaning fierce, violent and uncontrolled. As this term constitutes the entirety of the mark relied upon by the Applicant and the dominant element of the mark of the proprietor there is clear conceptual similarity. The addition of the numerals 101 does not serve to alter the concept of the mark of the proprietor.”⁹

⁹ See Cancellation Applicant’s written submissions dated 10 September 2020, para 11.

62. I find that the average consumer will understand the word “savage” in line with the definitions submitted by the applicant.¹⁰ The proprietor’s mark contains the word savage and the numeral 101. Although I am mindful that certain numbers such as 8, 10 or 12 could refer to the size of particular items, it does not appear to me, nor there is any evidence before me that number 101 or conjunction of the word savage with the number 101 has any meaning that may create conceptual imagery in the mind of the average consumer. In my view, the only concept the average consumer is likely to perceive from the proprietor’s mark is that from the word “SAVAGE” and whatever meaning is attributable to it is likely to be the same in both the marks. Considering these factors, I find that the marks are conceptually identical. If I am wrong, and a degree of conceptual difference arises from the presence of the numbers in the contested mark, I would anyway consider the marks to be conceptually highly similar based on their shared identical concept from the word element.

Likelihood of confusion

63. The proprietor submits:

“I am not the only person using “savage” as a trade mark, so I am unaware if I am the only company getting opposed.”¹¹

The proprietor has provided no evidence of third-party use of the mark “SAVAGE” on the UK market. In the absence of evidence, I am unable to assess how the existence of other identical or similar marks might affect the matter of likelihood of confusion between the competing trade marks. Whether the applicant has taken action against any trade mark owners for the use of the mark “SAVAGE” is of no relevance to the matter I must decide.

64. In determining whether there is a likelihood of confusion, I need to bear in mind several factors. The first is the interdependency principle, i.e. a lesser degree of similarity between the respective goods may be offset by a greater degree of

¹⁰ According to *Collins English Dictionary*, the word “SAVAGE” in the applicant’s mark means wild or untamed - <https://www.collinsdictionary.com/dictionary/english/savage> accessed 29 October 2020.

¹¹ See the counterstatement.

similarity between the trade marks (Canon at [17]). It is also necessary for me to bear in mind the distinctive character of the applicant's trade marks, as the more distinctive those trade marks are, the greater the likelihood of confusion (Sabel at [24]). I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks, relying instead upon the imperfect picture of them he has retained in his mind (Lloyd Schuhfabrik at [26]).

65. Confusion can be direct (which occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods/services down to the responsible undertaking being the same or related).

66. The difference between direct and indirect confusion was explained in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, by Iain Purvis Q.C., sitting as the Appointed Person, where he 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”.

67. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, James Mellor Q.C., sitting as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls another mark to mind. This is mere association not indirect confusion.

68. I have found the respective marks to be visually similar to a high degree and aurally identical or similar to a medium degree depending on how the mark is articulated and conceptually identical or similar to a high degree. The goods will be selected primarily by visual means, with a medium degree of attention by the general public. The goods are identical. I also concluded that the shared component "SAVAGE", which is the only element in the earlier mark, is distinctive to a medium degree.

69. I bear in mind that the distinctiveness of the common element is key¹². I also remind myself that it is still a whole mark comparison that must be made. With those conclusions in mind, I find that the similarity between the marks and the identity between the goods is enough to cause direct confusion. Given the small size of the device element in the proprietor's mark, the average consumer is likely to overlook the differences and mistake one mark for the other, particularly when the effects of imperfect recollection are borne in mind. I also find that where the average consumer recalls the device element, he/she is likely to think that the marks are variant marks used by the same undertaking or economically linked undertakings to provide identical goods. The confusion is still likely even where the marks are aurally similar only to a medium degree. The similarity between the marks and the identity between the goods will counteract any visual, aural and conceptual differences. There is a likelihood of both direct and indirect confusion.

Conclusion

¹² Kurt Geiger v A-List Corporate Limited, BL O/075/13

70. The application for invalidation has succeeded and the contested mark is hereby declared invalid in respect of all the goods for which it was registered. Under section 47(6) of the Act, the registration is deemed never to have been made.

Costs

71. The applicant has been successful and is entitled to an award of costs. Awards of costs are governed by Tribunal Practice Notice (“TPN”) 2/2016. I award costs to the applicant on the following basis:

Official fee:	£200
Preparing statements and considering the proprietor’s statement:	£200
Preparing and filing evidence:	£500
Preparing written submissions:	£300
Total:	£1,200

72. I order Savage101 Clothing to pay Kaveh Savage the sum of £1,200. This sum is to be paid within two months 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.

Dated this 5th day of November 2020

**Karol Thomas
For the Registrar
The Comptroller-General**