BLO/887/22

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION UK3225990 IN THE NAME OF AYA DESIGN GROUP LIMITED FOR THE TRADE MARK Les Boys IN CLASSES 3, 9, 18, & 35

AND THE APPLICATION FOR DECLARATION OF INVALIDITY THERETO UNDER NUMBER 503016 BY CHANEL LIMITED

DECISION

INTRODUCTION - THE DECISION UNDER APPEAL

1. This is an appeal from a decision of the Registrar's hearing officer, Mr Denzil Johnson dated 21st May 2021, whereby he upheld the application for a declaration of invalidity by Chanel ("the Applicant") in respect of the trade mark "Les Boys" ("the Trade Mark") owned by AYA Design Group Limited ("the Appellant"). The Trade Mark was filed on the 20 April 2017 (registered on 25 August 2017) for various fashion-and cosmetics and related articles and services namely the following:

> Class 3: Perfumery, essential oils, non-medicated cosmetics; nonmedicated soaps.
>
> Class 9: Glasses, sunglasses, spectacles; parts, fittings and accessories for all of the aforesaid goods.
>
> Class 18: Leather and imitations of leather; luggage and carrying bags; handbags; rucksacks; briefcases; purses; wallets; vanity cases; parts, fittings and accessories for all of the aforesaid goods.
>
> Class 35: Retail services related to clothing, footwear, clothing and footwear accessories, eyewear, perfume and cosmetics; online retail store services related to clothing, footwear, clothing and footwear accessories, eyewear, perfume and cosmetics.

2. On 5 February 2020, the Applicant, initiated invalidation proceedings against the Trade Mark, under section 47(2) of the Trade Marks Act 1994 ("the Act"). The sole ground was section 5(2)(b) of the Act and was directed against a sub-set of the goods and services for which the Trade Mark is registered namely:

> Class 3: Perfumery, essential oils, non-medicated cosmetics; non-medicated soaps.
>
> Class 35: Retail services related to perfume and cosmetics; online retail store services related to perfume and cosmetics.

3. The objection to registration was based on the Applicant's earlier UK registered trade mark No. 3137592 for the word "BOY" filed on 24 November 2015 and which completed its registration process on 26 February 2016. The goods relied on are those in Class 3: Preparations for application to or care of the skin, scalp, hair or nails; soaps; perfumes; essential oils; make-up; deodorants; cosmetics; non-medicated toilet preparations.

The decision

4. Given the similarity, and in some cases identity, of the respective goods and services, the key issue for the hearing officer was whether the marks Les Boys and BOY were sufficiently similar to cause confusion. He held that there was insufficient likelihood of direct confusion but that there was a likelihood of indirect confusion. He upheld the objection to continued registration on that basis.

5. The hearing officer set out the established principles of law in a way which is not criticised on this appeal and which it is unnecessary to repeat. Key to his decision were his conclusions as to how the respective marks were likely to be perceived by the average consumer. Since those formed the primary focus of criticisms on this appeal it is convenient to set out how the hearing officer reached his conclusions.

Average consumer

6. As to the average consumer, he said:

> "33. I agree that the average consumer is a member of the general public and that the goods are everyday consumables. I also agree with the respective

submissions as to the level of attention the average consumer will exhibit. Although I find that the level of attention paid by the average consumer will generally be moderate, I accept, following the Proprietor's submission, that a proportion of the relevant public may take a higher than average level of care and attention at the point of selection, due to the nature of the goods at issue, or where consumers are particular as to allergies, skin sensitivities, or other preferences.

34. I consider that the goods are most likely to be obtained by self-selection from the shelves of a retail outlet, from a website equivalent or perhaps from a specialist undertaking. Consequently, visual considerations are likely to dominate the selection process. However, I do not discount that there may be an aural component to the purchase of the goods, given that orders may be placed over the telephone; and purchases may be made on word-of-mouth recommendations or on the advice of sales assistants or representatives.

35. The services at issue are offered in shops on the high street (or online equivalents). The purchase is predominantly visual, with the consumer selecting the retail service following visual inspection of the shop front or website, though I do not discount an aural component. The average consumer will wish to ensure, for example, that the desired product range is offered for sale, or that individual items are in stock. Overall, consumers will pay an average degree of attention when selecting an appropriate retail channel."

7. In my view, this is a realistic approach to the characterisation of the average consumer for the goods and services in question. It is important to one of the arguments on appeal that the average consumer was likely to be a member of the general public. Such an individual cannot be assumed to have detailed knowledge of specialist slang or sub-culture language, which may be common or standard usage in some quarters but may not necessarily form part of common linguistic currency among the range of consumers.

Comparison of marks

8. As to the comparison of the marks, the hearing officer said:

> "43.There seems to me to be no doubt that the Proprietor's mark is formed of two words, Les and Boys; and that its overall impression is that it is a term –

representing either "the boys" or a genus of boys (I will form a conclusion as to the likely perceived meaning later in this decision). However, I consider, irrespective of how the first word of the mark is perceived, "Boys" is marginally more dominant than "Les"; because it is the noun or object of the term, whereas "Les" (depending on how it is defined/perceived) merely introduces the noun/object (if it is perceived as the French definite article); or is an adjective describing the noun (if it is taken as the abbreviation for lesbian). I must make clear, however, that the average consumer will not spend time considering whether a word or words in the mark is an adjective, object or a noun, but will simply look at the mark as a whole and attach more significance to the word "Boys"; given that it is an ordinary dictionary word, with recognisable meaning. Furthermore, it is an English word (taking the argument of the Proprietor), within the construct of a composite whole consisting of French and English words."

9. Again, this seems to be a realistic approach to how the average consumer, with the characteristics identified above, would approach the question of similarities and differences between the marks.

Similarity

10. The hearing officer went on to consider and evaluate the degree of similarity, visual, aural and conceptual as follows. His headline conclusions and the reasons for them were these:

Visual similarity - moderate

"44. The visual point of similarity between the marks is the presence in both marks of "Boy". The "Les" element and the "s" after "Boy" are the points of visual difference, at the beginning and ending of the Proprietor's mark respectively, with no counterparts in the earlier mark. Consequently, there is a moderate degree of visual similarity between the marks."

Aural similarity - moderate

"45. From an aural perspective the Applicant's mark comprises of one word "BOY"; whereas the Proprietor's mark consists of two verbal elements, "Les" and

"Boys". The "Les" element (present at the beginning of the contested mark with no counterpart in the earlier mark), may be pronounced as either "LAY" or "LEZ". The pluralisation of the second element, "Boys", will not create a significant difference in pronunciation with the earlier mark. As a result, I find that there is also a moderate degree of aural similarity between the marks."

Conceptual similarity – high

Having analysed at some length the evidence relating to the meaning(s) of "Les Boys" to which I return below, the hearing officer concluded at para. [38] (on page 26, there being a difficulty with the paragraph numbering) that

"…the relevant public will most likely perceive the "Les Boys" mark as something to do with boys, whether or not they are familiar with the Proprietor's suggested meaning. Therefore, for all of the above reasons, I find that the marks are conceptually similar to a high degree."

Distinctive character - low

11. As to distinctiveness, the hearing officer said:

"42.The Applicant asserts that its mark "enjoys an above average level of inherent distinctiveness in respect of "perfumes; essential oils; make-up; cosmetics" which are not products that are marketed to boys or children generally. With regard to the remaining goods covered by the Applicant's Mark, we submit that the Applicant's Mark enjoys an average level of distinctiveness. In this respect, we note that skincare preparations, soaps etc. are marketed to babies or children and not specifically to children based on gender. Accordingly, the Applicant's Mark is unusual and fanciful in respect of these goods.

43.The Proprietor on the other hand, contends that "the word 'Boy' is descriptive of the Relevant Goods in the sense that the average consumer will perceive it to be a reference to the public, for which the corresponding goods are meant or intended" and as a consequence, the earlier mark "enjoys only a very low level of distinctiveness".

44.I agree with the Proprietor's line of reasoning. I consider that the Applicant's mark comprises a common, recognisable dictionary word and that it does possess

some allusive quality. I find that the mark's level of inherent distinctive character is low."

12. There is no criticism of this evaluation and I agree with it.

Direct/indirect confusion

13. The hearing officer set out the principles applicable to evaluating the risk of direct and indirect confusion and then came to his reasoning which also bears setting out in full.

> "50. From a global perspective, I consider that there is a strong coincidence between the marks with a decisive impact. The word/s Boy/s will convey a conceptual message with significant overlap, which is qualified, but not critically altered, by the presence of "Les" at the beginning of the Proprietor's mark. I find that, notwithstanding the presence of the word "Les" in the later mark, the word "Boy/s" is likely to fix itself in the average consumer's mind and act as an important hook in prompting their recall of the competing trade marks. An appreciable proportion of the relevant public will perceive the later mark as constituting the plural form of the earlier mark, "BOY". However, I consider that the "Les" element in the Proprietor's mark will be sufficient to enable the average consumer to differentiate between the marks; they will not be misremembered or mistakenly recalled as each other. I am satisfied that the average consumer will not simply mistake one mark for another. Therefore, I do not find that there is a likelihood of direct confusion.
>
> 51. Although I consider that the average consumer will notice that there is a difference between the marks and is unlikely to directly confuse one for another, confusion works both ways; and I must also consider the possibility of indirect confusion. In my view, the similarities pointed out above (particularly the high degree of conceptual similarity), are likely to lead the relevant public to perceive the Proprietor's mark as a sub-brand or extension of the earlier mark; or that the competing goods and services, that are identical or similar to an average degree, come from the same undertaking or economically linked undertakings; despite the possible higher level of attention some of the relevant public may exhibit for those goods and services. Accordingly, there is a likelihood of indirect confusion."

14. Accordingly, he upheld the objection to registration.

THE APPEAL

15. Before addressing the substance of the appeal, it is necessary to bear the standard of appellate review in mind. Arnold LJ said in a judgment concerning an allegation of indirect confusion, *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207 (05 August 2021, "*Sazerac"*) at [27], which was published after the hearing officer's decision in the present case

> "27. Since the judge's conclusion that there was a likelihood of indirect confusion was a multi-factorial evaluation this Court can only intervene if he erred in law or in principle" (citing *Actavis Group PTC EHF v ICOS Corp* [2019] UKSC 15, [2019] Bus LR 1318 at [78]-[81])

16. A similar approach applies to appeals to the Appointed Person.

17. The Appellant submitted that the decision in this case was wrong and that appellate caution required in cases of this kind should not be taken so far that it became a barrier to being able to deal properly with them. I agree with that submission as far as it goes: there are situations in which it is sufficiently clear that a decision is wrong for this tribunal to interfere. However, the law is equally clear that it does not suffice that the decision by the hearing officer may not have been one this tribunal would have made if deciding the case de novo.

Grounds of Appeal

18. Although formulated in various different ways and refined orally, the Appellant advanced three main arguments against the hearing officer's conclusions.

(i) How the average consumer would understand the Trade Mark

19. First, the Appellant argued that the hearing officer failed to take account (or sufficient account) of its evidence concerning the way in which the "Les Boys" would be understood by the average consumer. This, it was argued, was fundamental because it

affected the way in which that mark would be viewed and the degree of similarity. This argument split into two strands of which one was an argument that the hearing officer should have had greater regard to the specific evidence of Ms Rees MBE on this issue and the other was that, even in the absence of that evidence, the definition in the Urban Dictionary should have been taken to be the understanding that an average consumer would have of the Trade Mark as a whole.

20. As to the evidence strand, the Appellant drew particular attention to paragraphs 9 and 13 of the statement of Ms Rees which related to the way in which the term "Les Boys" would be understood. Ms Rees is the main shareholder in the Appellant. She has long experience in the fashion industry, having been at the forefront of developing "on-trend fashion" which keeps up with developments in society generally and, in particular, the treatment of gender and sexuality. The Appellant submitted that she was particularly well qualified to provide evidence as to the understanding of the mark she had selected.

21. The relevant paragraphs in her evidence made the following points. First that, given the nature of the mark and its mixture of French and English and the nature of the brand, the Urban Dictionary was the "perfect source" as to how the term "Les Boys" should be interpreted. Ms Rees says that she was aware of these meanings before she adopted the brand and refers to the fact that the Urban Dictionary had been relied on by various tribunals considering trade marks in the past. Mr Rees also gives evidence about how she came up with the brand, watching her young adolescent children growing up in a world where gender was no longer defined as rigidly as it has been and where she wanted a brand which blurred the boundaries between genders, avoiding forced conformity to a gender norm. She says that she did not want to talk about men and women as it sounded too old fashioned and out-dated and that the "Les Boys" was not intended to be read as "the boys". She exhibited an entry in the Urban Dictionary in support of her views which is reproduced below:

Urban Dictionary: lesboy

A lesbian-identified male(a homosexual woman who was born with a male body and is not seeking gender reassignment surgery. Instead of female hormones and corrective surgery to help make the outside match her inside, she simply lives with the package she came wrapped in as a lesbian to the best her body will allow). Typically a male who often seems gay/girly, but is highly attracted to lesbians and bisexual females with no attraction to other men.

If he doesn't like guys why does he seem so gay?
He's a lesboy. Only likes girls, but preferably bis and lesbians.

A polite, yet condescending, phrase from the 1980's to describe homosexual males, especially those of the more flamboyant or effeminate side, and those that took care of closeted businessmen.

Referenced in the Dire Straits song "Les Boys" from the "Making Movies" record

Person 1: I've seen her dating with someone from class X, she must be lesbian
Person 2: Actually, that she is actually a he, He's a Lesboy.

by Syn276 December 05, 2017

A group of young, boastful and often times borderline arrogant young men with a penchant for an activity played on ice that's sometimes considered a brawl to begin with but a game in the end, or possibly the other way around, and is known to the general public as "ice hockey." These young men have a taste for grit and a love for finesse and use such obscure terminology such as "Dangling and tricks with skates and sticks," or "Atta boy lad! Keep wheelin!" These young men have indomidable spirits and are known to make poor boyfriends from the months October through May.

Jesus Christ, Kev is such a lesboy.

Why is your brother's girlfriend making out with the girl next to her?

'Cause Karl's a lesboy.

22. The Appellant submitted that her evidence should have been taken account of by the hearing officer and was not, alternatively that, in so far as it was taken into account, insufficient weight was given to it. In order to evaluate that argument it is necessary to consider what reference the hearing officer made to this material, which he did as follows.

> "32. On the question as to whether the Proprietor's mark would be perceived as "the boys" or gender-fluid boys, the Applicant contends that the Proprietor's reliance upon the Urban Dictionary and the Dire Straits song "Les Boys" to argue for the latter concept is untenable. The Applicant provides "internet print outs relating to [the] Urban Dictionary, from which it can be seen that it is a crowdsourced online dictionary for slang words and phrases. Anyone may contribute a "definition" to the dictionary…. While the site provides basic content guidelines, the primary quality control is a group of "volunteer editors" (comprising other users of Urban Dictionary) who can choose to include or reject a definition, but cannot actually edit the definitions that are submitted".
>
> 33. Evidence adduced by the Applicant shows that the Dire Straits song "Les Boys" was "released only as an album track". On this point the Applicant argues that "the lyrics to the song do not define or demonstrate any specific meaning of "Les Boys"; [and] the song was released only as an album track over 40 years ago. It hardly

proves that the term "Les Boys" is known and understood by UK consumers in the specific way suggested by the Proprietor. Thus the Proprietor's submissions and evidence regarding the concept of the Proprietor's Mark are not persuasive".

34. In its submissions in lieu of hearing, the Proprietor maintains "that [the] Urban Dictionary has been cited in a number of cases before the English High Court and the United Kingdom and European Intellectual Property Offices". In support of its reliance on the Dire Straits song, the Proprietor also suggests that the Applicant ignores the fact that the Dire Straits album at issue was "certified platinum in the United States and double-platinum in the United Kingdom".

35. Even if I accept the Urban Dictionary entries for "Les Boys", it does not overcome the argument (in the absence of evidence in support) that "the mere existence of a word or phrase in [the] Urban Dictionary does not in any way prove that the particular word or phrase is in fact known to the public or understood as denoting the "definition" given on the website, and far less that it is known and understood by the UK public".

36. I therefore consider that the Urban Dictionary entries, the provenance of which is not known, bear very little, if any, weight, without further evidence to show that the concept is known in the UK or that the average consumer of the goods and services would be aware of it. Furthermore, I consider that the word "Les" will be recognised by a significant proportion of the general UK public as the French plural definite article for "the"; given the linguistic/cultural influences of France in the UK. This is reinforced by its use with an ordinary dictionary word, in the plural form, "Boys". In the alternative, I consider that the average consumer will attach meaning to the word "boys", whether or not it is taken to mean a gender-expansive boy, the underlying concept relates to "a male of any age" whether or not they identify as the gender to which they were assigned at birth. In other words, a boy who identifies as lesbian could not be classed as "Les Boy", unless he was in fact a biological boy. Therefore, even if the mark is perceived to convey the meaning of a lesbian-identified male, it retains a conceptual connection to boy, given the antecedent to which it (Les Boys) refers."

23. The key points from these passages are, first, that the hearing officer did consider the definition(s) in the Urban Dictionary with some care. Second, he did not refer specifically to the evidence of Ms Rees separately but said that he was not persuaded that the Urban Dictionary, without further evidence to show that the concept was known to the average consumer, was sufficient.

24. In my view the Appellant was a long way from showing that the hearing officer failed to have adequate regard to the totality of the evidence before him or that, as regards the second strand of this argument, the Urban Dictionary should have been regarded as authoritative of the understanding of the average consumer in this case.

25. First, the hearing officer was entitled to consider that the fact that a term appeared in the Urban Dictionary was not sufficient to show that it would be understood in that sense by the general public in the UK or the average consumer. It is well-known and the evidence is to the effect that the Urban Dictionary is (in part) a dictionary of slang. It includes terminology which is likely to be known and understood only by certain sections of the community. In some cases, the terms included appear there because of their comparative obscurity to the general public and it affords a guide for those less familiar with certain aspects of the language. To that extent, in some respects, but not all, it can be regarded as a dictionary of parts of a language that may well be "foreign" to the general public or the average consumer. Although not strictly relevant, and caution must be taken with regarding any given individual as representative of the average consumer, this tribunal was not familiar with the term "Les Boys" as defined in the Urban Dictionary or with the specific Dire Straits song or lyrics referring to it to which Ms Rees referred.

26. The Appellant also relied on three cases in particular in which reference has been made to the Urban Dictionary for the meaning of terms.

27. *Confetti Records v. Warner Music* [2003] EWCH 1274 (Ch) concerned copyright infringement in a track of garage music where one, relatively minor, question was whether there was derogatory treatment of the work for which the meaning of certain terms was relevant. The court referred to two slang phrases "mish mish man" and

"shizzle my nizzle" and reference was made to the Urban Dictionary for definitions. Lewison J, as he then was, said:

> "154. Mr Pascal did not himself claim to know what street meanings were to be attributed to the disputed phrases, but said that he had been told what they were by an unnamed informant conversant with the use of drugs. Mr Howe submitted, correctly in my opinion, that the meaning of words in a foreign language could only be explained by experts. He also submitted again correctly in my opinion, that the words of the rap, although in a form of English, were for practical purposes a foreign language. Thus he submitted that Mr Pascal's evidence, not being the evidence of an expert, was inadmissible. I think that he is right, although the occasions on which an expert drug dealer might be called to give evidence in the Chancery Division are likely to be rare."

28. It was in that rather unusual context that there was reference to the inclusion of what were regarded as effectively foreign language phrases or "street meanings" in the Urban Dictionary. To my mind that case, if anything, confirms the fact that the Urban Dictionary is not to be regarded as a reliable record of aspects of language all of which are likely to be well-known and understood by the average consumer, although undoubtedly it includes terms whose meaning would be known and understood to many.

29. In *Frank Industries Pty Ltd v. Nike Retail BV* [2018] EWHC 1893 (Ch); [2019] E.T.M.R. 4 Mr Justice Arnold, as he then was, sitting in IPEC referred to the Urban Dictionary (among other references) for how the abbreviation LDN would be understood. However, the court in that case did not rely only on the Urban Dictionary for the conclusion that LDN was a well understood abbreviation for London. It was common ground between the parties that it was and this was also supported by entries in Wikipedia and a volume of other material. It is for question whether the court would have accepted an abbreviation as being commonly understood if it had *only* appeared in the Urban Dictionary.

30. In a decision of the General Court in 2020 in Case T-503/19, *Global Brand Holdings, LLC* in relation to the application to register the mark XOXO, the examiner's objection

was based on 7(1)(b) of the EU Trade Mark Regulation (2017/1001). As in *Frank*, there was a considerable amount of evidence on file showing how the sign XOXO would be understood. The General Court said:

> "42. It must be stated that it is clear from the evidence in the file relating to the proceedings before EUIPO that the sign XOXO will be understood by the relevant public as meaning 'hugs and kisses'. That is, in particular, shown by the online dictionaries Urban dictionary and Internetslang which the examiner mentioned in her decision, a decision to which the Board of Appeal expressly referred in paragraph 26 of the contested decision."

31. While it is true that this passage of the judgment referred to the Urban Dictionary, there was other evidence supporting the public understanding. Moreover, the context in which reliance was placed on the Urban Dictionary was different from that here. The argument based on Article 7(1)(b) referred to the fact that it was sufficient that a ground of refusal existed in relation to a non-negligible part of the target public and it was unnecessary in that regard to examine whether other consumers belonging to the relevant public were also aware of that sign. Accordingly, as was submitted in argument in that case, even if the sign XOXO had been understood as meaning 'hugs and kisses' by only teenagers and very young women, that was a sufficiently non-negligible part of the relevant public for the prohibition on registration to arise.

32. The Appellant submitted on the basis of these authorities that the hearing officer ought to have taken the meaning given in the Urban Dictionary of "les boys" as that of the average consumer. Attractively as those submissions were developed, I am not able to accept them.

33. First, it seems to me that the extent to which any entry in the Urban Dictionary is regarded as decisive, or even relevant, as to its meaning depends on the purpose for which it is deployed. If the Urban Dictionary is used to show that a given term could mean a particular thing to some members of the public in the UK or even that it does mean that to most members of the public in a particular group, it can be very useful. That point is highlighted by the XOXO case. However, it is not a dictionary designed

to show what its entries mean to most members of the public in the UK. Indeed, as is well known, it contains a large number of entries which have a primary meaning to the general public in the UK which is well removed from the "street meaning" attributed to it in the Urban Dictionary.

34. Against that background, the hearing officer was justified in not giving weight to the fact that the witness exhibiting that material was herself familiar with the usage. It is clear that Ms Rees is in the forefront of fashion design and contemporary culture. However, trade mark law takes as its touchstone of understanding that of the average consumer for the goods and services for which the mark is or is proposed to be registered. In this case, these goods and services are described in general terms and are of interest to the general public. The hearing officer was entitled to find that the knowledge on the part of the proprietor and the Urban Dictionary would not be the same as that of the average consumer. More specifically, the hearing officer was correct in thinking that the average consumer would be more likely to treat the term "Les" as a French definite plural article. Although a detailed knowledge of French vocabulary may equally not be widespread in the UK, the word "Les" (as in for example "Les Miserables") is sufficiently well known for the hearing officer to have reasonably taken that to be the meaning the average consumer would attribute to it. Even if some of the UK public would most naturally think of "Les" as an abbreviation of or allusive to "lesbian", I do not think the hearing officer could be faulted for considering that this would not be a majority.

35. There is a further factor in play here. The goods in question are or are closely related to perfumery and cosmetics Although the connection is increasingly historical, perfumes are commonly and many (including some of the most famous) are known or thought to be French in origin or associated with French fashion houses. The average consumer could reasonably think that "Les Boys" was a French sounding (perhaps "Franglais") way of referring to Boys. I do not give that point a great deal of weight but it provides some support to the argument that, in the particular context in which the Trade Mark would be likely to be used, there is no reason to think that for the average consumer "Les" would create a lesbian rather than a French connection.

36. Accordingly, I do not think the hearing officer fell into error in his evaluation of how the average consumer would be likely to perceive the Trade Mark.

(ii) Comparison of mark and sign

37. The second ground of appeal again splits into a number of strands of which it is convenient to take some together. The Appellant's broad point was that the hearing officer had wrongly compared the respective marks and had done so in six different ways, as follows.

(1) The finding that 'Boys' was the dominant part of the Mark

38. At paragraph 43 of the Decision [p21] the hearing officer said:

> ""Boys" is marginally more dominant than "Les"; because it is the noun or object of the term, whereas "Les" (depending on how it is defined/perceived) merely introduces the noun/object (if it is perceived as the French definite article); or is an adjective describing the noun (if it is taken as the abbreviation for lesbian). I must make clear, however that the average consumer will not spend time considering whether a word or words in the mark is an adjective, object or a noun, but will simply look at the mark as a whole and attach more significance to the word "Boys"; given that it is an ordinary dictionary word, with recognisable meaning…"

39. The Appellant criticises this on the basis that the reasoning is contradictory because the hearing officer had stated (correctly) that the average consumer will not consider whether a word is an adjective or a noun etc but will look at the mark as a whole, but then reasons that 'Boys' has dominance because it is a noun or object. It is also said that the hearing officer asserted that more significance will be attached to the word "Boys" given that it is an ordinary dictionary word, with recognisable meaning but that this renders it less likely to have any dominance in accordance with the approach in T-117/02: *Chufafit* [2004] E.C.R. II-2073 at [51] along with the fact that it forms the second part of the mark.

40. I do not find these arguments persuasive and think they involve an over-analysis of what the hearing officer was saying and of the Trade Mark. In my view, the hearing officer was entitled to reach the view that for, whatever reason, which might include the fact that the "Boys" was a noun or object, it would be treated as the dominant feature of the Trade Mark. This conclusion would be reinforced by the fact that the hearing officer was right to hold that "Les" would be more likely to be perceived as a definite article.

(2) Did 'Les' merely introduce 'Boys' and would a significant proportion of the relevant UK public recognise 'Les' as meaning the plural definite article for 'the'

41. The hearing officer said paragraph 36 [p24]:

> "I consider that the word "Les" will be recognised by a significant proportion of the general UK public as the French plural definite article for "the"; given the linguistic/cultural influences of France in the UK. This is reinforced by its use with an ordinary dictionary word, in the plural form, "Boys"."

42. The Appellant criticises this conclusion on the basis that he had no evidence as to whether any of the general public, let alone a significant proportion of it, would recognise "Les" as meaning the French plural definite article for "the" (as opposed to merely recognising it as a French word). In particular the Appellant drew attention to the fact that, whilst there was some evidence before him of the use of 'franglais', the Trade Mark was not itself a form of franglais, this being commonly understood as the use of an English word as part of a French saying/sentence where there is no equivalent in French but that the Trade Mark was two separate words in different languages to which ordinary rules of grammar would not apply. The Appellant also says that whilst there was some evidence of other brands mixing two languages or using 'le', 'la', 'les' or 'l' there was no evidence showing the dates, locations, or amounts of use of such marks. Nor was there any evidence of whether the relevant public would not just recognise these words but would understand them to mean "the". It is said that even if "Les" is understood as French for "the", it would be given greater dominance by the very fact of its "Frenchness".

43. Again, I do not find these points persuasive and think that they overcomplicate what is ultimately a fairly simple assessment. The hearing officer did not have to find that all members of the UK public understood "Les" in the Trade Mark as French for "The".

44. The concept of the average consumer involves considering a range of people with different perceptions and, in trade mark law, is broad enough to encompass both (for example) "baby-boomers" whose perception of "Les" may be viewed more through the lens of years of compulsory school French and members of "Generation Z" who may be much more sensitive to gender fluidity and its associated terminology. That generation and those who supply products for it may be more accustomed to thinking that "Les Boys" might describe an individual who identifies, whether sexually or otherwise, as a gender different to that of the body which they are born with and/or who is sexually/gender intertwined or sexually/gender free, i.e. neither male nor female which is how the Appellant submits the conceptual meaning of the term would be understood. However, it was not wrong for the hearing officer to think that a significant proportion of the general public would not be so used to that way of thinking that they would attribute the meaning which the Appellant ascribes to it, even though it might be quite natural for the Appellant, Ms Rees and the particular demographic to which the Appellant's products sold under the brand may be directed to do so.

45. The hearing officer held that "Les" would be understood by a significant proportion of the general public as French for "The" and, in my view, he was entitled to do so. First "Les" is, in fact, French for "The". To hold that a significant proportion of the general public would understand it in that way is prima facie rational. Second, that being so, it seems to me rather that the burden would lie on the Appellant to show that a very significant proportion of the general public did not understand it in that way. While there are some areas (perhaps highly specialist) where only a tiny minority of the general public could be expected to be aware of the linguistic usage, this is not one of them. Third, there was specific evidence of some other brands mixing French or other non-English definite articles which suggests that it would be assumed that such would be understood. In all, I think the hearing officer had sufficient material to reach the conclusion he did on this.

(3) Capitalisation of the letter 'B' in 'Les Boys'

46. The next issue related to the capitalisation of the letter B in Boys. At paragraph 39 at p20) of the Decision, the hearing officer said that the word trade mark registration protects the word itself, irrespective of the font capitalisation or otherwise. The Appellant does not take issue with this but contends that the hearing officer should have taken account of the difference in capitalisation of "Les Boys" in the Trade Mark and refers to R 3290/2014-4: *Daima* §36 and R 720/2004-2: *PacDrive / P DRIVE* at §27. I am not convinced that these cases make that point or that it is a good one. Rather they are about the fact that, in some contexts, capitalisation of a letter in the middle of a word or phrase can reinforce the division of a mark into parts. However, here there is no dispute that the Trade Mark would be viewed as a two word mark. So I do not think this point takes the appeal further.

(4) Comparison as a composite whole and weight given to the presence in both marks of the word 'Boy'

47. It is convenient to treat these grounds together. The Appellant contends that the hearing officer erred by dissecting the Trade Mark into each of its components rather than considering it as a composite whole and, to the extent that he did so, did not give enough weight to the French element "Les" (on the assumption that it was so understood) and too much to the presence of the word "Boys".

48. Again, I do not think the hearing officer fell into error in this respect. He considered, with some care, the relative dominance and distinctiveness of the two elements "Les" and "Boys" and concluded, for reasons that are sound, that the "Boys" element was the dominant element. Given his findings that "Les" was likely to be perceived as a definite article (albeit in French) that conclusion is hard to disagree with. In those circumstances, it was right to give greater weight to the "Boys" element in reaching his conclusions about similarity.

(5) Conceptual similarity

49. Finally under this section, the Appellant criticises the hearing officer for taking insufficient account of the evidence of Ms Rees as to her understanding of the meaning of "Les Boys". I have addressed that point above and, as explained, do not think he fell

into error. The hearing officer was entitled to find that to a significant proportion of the public the mark "Les Boys" would denote a "Frenchified" plural of "BOY" and was therefore conceptually similar to the extent that he held.

50. In all, I do not think that the hearing officer performed the assessment of similarity incorrectly and I would reject this ground of appeal.

(iii) The finding of indirect confusion

51. The third ground of appeal raises the question of whether the hearing officer was right to make a finding of a likelihood of indirect confusion, having found that there was no likelihood of direct confusion.

52. The law relating to indirect confusion was originally developed in the *LA Sugar* case and has been re-stated and to some extent reformulated by the Court of Appeal in *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207 (05 August 2021, "*Sazerac"*). In *Sazerac,* the Court of Appeal summarised the principles as follows:

> "9. … As Kitchin LJ (with whom Sir John Thomas PQBD and Black LJ agreed) put it in *Specsavers International Healthcare Ltd v Asda Stores Ltd* [2012] EWCA Civ 24, [2012] FSR 19 at [87]:
>
> > "In my judgment the general position is now clear. In assessing the likelihood of confusion arising from the use of a sign the court must consider the matter from the perspective of the average consumer of the goods or services in question and must take into account all the circumstances of that use that are likely to operate in that average consumer's mind in considering the sign and the impression it is likely to make on him. The sign is not to be considered stripped of its context."
>
> 10. It is well established that there are two main kinds of confusion which trade mark law aims to protect a trade mark proprietor against (see in particular Case C-251/95 *Sabel BV v Puma AG* [1997] ECR I-6191 at [16]). The first, often

described as "direct confusion", is where consumers mistake the sign complained of for the trade mark. The second, often described as "indirect confusion", is where the consumers do not mistake the sign for the trade mark, but believe that goods or services denoted by the sign come from the same undertaking as goods or services denoted by the trade mark or from an undertaking which is economically linked to the undertaking responsible for goods or services denoted by the trade mark.

11. In *LA Sugar Ltd v Back Beat Inc* (O/375/10) Iain Purvis KC sitting as the Appointed Person said:

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

apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).

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

12. This is a helpful explanation of the concept of indirect confusion, which has frequently been cited subsequently, but as Mr Purvis made clear it was not intended to be an exhaustive definition. For example, one category of indirect confusion which is not mentioned is where the sign complained of incorporates the trade mark (or a similar sign) in such a way as to lead consumers to believe that the goods or services have been co-branded and thus that there is an economic link between the proprietor of the sign and the proprietor of the trade mark (such as through merger, acquisition or licensing).

13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/219/16) at [16] "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Mr Mellor went on to say that, if there is no likelihood of direct confusion, "one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion". I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion.

14. "Likelihood of confusion" usually refers to the situations described in paragraph 10 above. As this Court held in *Comic Enterprises*, however, it also

embraces situations where consumers believe that goods or services denoted by the trade mark come from the same undertaking as goods or services denoted by the sign or an economically-linked undertaking (sometimes referred to as "wrong way round confusion")."

53. The key question is therefore whether the hearing officer had a proper basis for concluding that there was a likelihood of indirect confusion in this case.

54. As noted above, the hearing officer's key point was that he thought the similarities between the marks were likely to lead the relevant public to perceive the Trade Mark as a sub-brand or extension of the earlier mark or that they came from a connected enterprise. However, this finding cannot be taken in isolation. It was made against the background of findings in the previous paragraph of a "strong coincidence between the marks with a decisive impact" and that the word/s Boy/s will convey a conceptual message with significant overlap, which was qualified, but not critically altered, by the presence of "Les" at the beginning of the Trade Mark and would be likely to "fix itself in the average consumer's mind and act as an important hook in prompting their recall of the competing trade marks".

55. The case law sets a high hurdle for an appellant to overcome in overturning a determination by a hearing officer of this kind. In my view, this is a case in which, although somewhat marginal, the hearing officer did have a proper basis for a finding of a likelihood of indirect confusion, even though he had found that the average consumer would be able to distinguish the marks and that direct confusion may therefore not arise.

56. First, the kinds of situation in which an average consumer would be likely to appreciate that the marks were different but that the goods so marked came from the same or a related trade source are not closed. The present situation does not fall squarely into one of the situations mentioned in *L.A. Sugar* but it is not far removed from them in that it involves a common linguistic and conceptual element albeit with an added modifier. On the assumption that the average consumer would see the element "Les" as a French definite article, the Trade Mark has added a non-distinctive element to the earlier mark.

57. Second, the hearing officer was, in my view, entitled to reach the conclusion implicit in his decision that the respective marks would be remembered as either singular or plural “BOY” marks. The elements are also sufficiently distinct in the Trade Mark that the ”Boys” element can legitimately be regarded as performing a separate (and sufficiently independent) specific distinctive role from that of the ”Les” element.

58. Third, it is also a matter of general knowledge that the field of commerce in which the respective marks are registered, broadly speaking, cosmetics and related products and services, is one in which brand extensions are not uncommon and may therefore be expected by an average consumer. The Appellant gave examples at the hearing of situations in which a brand extension argument might have been more plausible, including, "mini boy", "giant boy" or "premier boy”, contrasting these with “Les”. Although those examples may present stronger cases, I do not think they undermine the case based on “Les” as a qualifier.

59. Fourth, the Appellant also criticises the hearing officer for not giving greater weight to the fact that the mark “BOY” was itself not very distinctive and would, in consequence, be less likely to generate confusion if found in a different mark. It is true that “BOY” is not particularly distinctive as such for the goods for which it is registered but I do not think that this is so to such an extent that it significantly undermines the hearing officer’s conclusion that the Decision went wrong on this account. The term “BOY” could be seen as describing the kinds of persons (namely boys) to whom the goods or services for which the marks are registered are particularly directed as, for example, “homme” is commonly used for male-directed versions or brand extensions of products whose primary market may be female. However, the Appellant did not contend, rightly in my view, that the term “BOY” was wholly non-distinctive. Questions of degrees of distinctiveness of this kind are for the hearing officer to evaluate in making a multifactorial assessment and I do not think he fell into error in the evaluation he made.

60. For the above reasons, the hearing officer had a sufficient basis for finding that the respective marks were sufficiently similar in relevant respects for there to be the requisite likelihood of confusion. Accordingly, I do not find this ground of appeal is made out.

CONCLUSION

61. Since the case does not overcome the hurdle required for overturning a decision of the hearing officer in an evaluation of this kind, this appeal must be dismissed.

COSTS

62. The Applicant/Respondent filed short written submissions on this appeal. The hearing officer had previously ordered the Appellant to pay the Applicant £1600 as a contribution to its costs, of which £400 was for written submissions below. I consider that a similar sum is appropriate for such submissions on this appeal including considering the submissions of the Appellant.

63. Accordingly, I order that Aya Design Group Limited to pay Chanel Limited the total sum of **£2000** as a contribution towards its costs too be paid within 21 days.

DANIEL ALEXANDER KC

APPOINTED PERSON

12 October 2022

Representation

Ms Victoria Jones (instructed by Briffa Solicitors) for the Appellant

Withers and Rogers (written submissions only) for the Respondent