O/0203/24

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3742807
IN THE NAME OF GAL LONDON LTD FOR

GAL London
Gal London

(A SERIES OF TWO MARKS)

IN CLASS 25

AND

THE OPPOSITION THERETO
UNDER NO 433200 BY
GAP (ITM) INC.

Background and pleadings

1. On 13 January 2022, GAL London LTD ("the applicant") applied for GAL London and Gal London, as a series of two marks (application 3742807), for *Clothing; Clothes; Girls' clothing; Ladies' clothing; Women's clothing* in class 25. Following publication, the application was opposed by Gap (ITM) Inc. ("the opponent").

2. The grounds of opposition are that the application offends sections 3(1)(b) and (c), 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act"). Under sections 5(2)(b) and 5(3) of the Act, the opponent relies upon the following two earlier marks:

(i) 900027292[1]

GAP

Relying on *clothing* in Class 25.

Filing date: 1 April 1996; registration date: 27 May 2002.

(ii) 1265985

GAP

Relying on *underpants, trousers, skirts; vests; jackets; jumpers, dresses, jumpsuits, sweaters, shirts, hats, shorts; jeans, belts, halter tops, socks, scarves; shoes; all included in Class 25*.

Filing date: 29 April 1986; registration date: 30 September 1988.

[1] The mark is a UK registration derived from a European Trade Mark ("EUTM") as provided for in the Trade Marks (Amendment etc.) (EU Exit) Regulations 2019 (see Tribunal Practice Notice 2/2020). The EUTM, and therefore this UK 'comparable' mark, benefit from seniority dates derived from earlier UK applications stretching back many years. One of those applications is mark (ii) relied upon in these proceedings. Nothing turns upon the seniority dates.

3. The pleadings are, in summary:

- section 3(1)(b) and/or Section 3(1)(c): GAL will be understood by the average consumer of the applicant's goods as slang for, or a diminutive version of, the word 'girl'. 'London' acts as a geographical indicator and is therefore a non-distinctive element. The mark offends section 3(1)(c) because it is descriptive of the kind, quality, intended purpose, geographical origin or other characteristics of the applied for goods or, in the alternative, in relation to the goods as they relate to or may be worn by women. The 3(1)(b) objection is predicated on the same basis;

- section 5(2)(b): GAL is the dominant element of the contested mark, the first two letters of the parties' marks are the same, leading to high visual and aural similarity for identical goods. London is a geographical identifier and plays no, or a secondary, role in the comparison of the parties' marks. On this basis, there is a likelihood of confusion;

- section 5(3): the opponent has a significant reputation in the UK for its GAP mark for clothing. The relevant public will be confused into believing that the applicant's business is endorsed by or commercially connected to the opponent's GAP brand. There will also be unfair advantage because the applicant's mark will benefit from the opponent's significant financial investment in promoting its GAP mark. The opponent will have no control over the use of the application, leading to detriment to the repute of the earlier mark and the use of the application will dilute the distinctive character of the earlier mark, reducing its power of attraction;

- section 5(4)(a): relying on the use of the sign GAP in the UK from 1987 in relation to clothing. The opponent claims significant goodwill in the business of which GAP is distinctive. Misrepresentation and damage will occur through use of the applicant's mark because consumers will think that the applicant's mark is connected to or endorsed by the opponent.

4. The applicant filed a defence and counterstatement, denying the grounds and stating that the marks are very different (it also states that its mark is derived from its company name which is very different to the opponent's company name, which it gives as "GAP GROUP Ltd").

5. The opponent's registrations are both potentially subject to the proof of use requirements in section 6A of the Act because they had been registered for five years or more at the date on which the contested application was filed. However, that requirement only becomes necessary if the applicant requests the opponent to prove that it has made genuine use of its earlier registrations in the five years prior to its own application being filed. In the form TM8, defence and counterstatement, the applicant ticked 'no' to the question as to whether it requests the opponent to provide proof of use. The consequence of this choice is that the opponent may rely on the goods identified in its pleadings, without having to show that it has used the mark in relation to those goods.

6. Both parties filed evidence. Neither party asked to be heard and only the opponent filed written submissions in lieu of a hearing. The opponent is represented by Stephenson Harwood LLP and the applicant represents itself. I will refer to the parties' evidence and to the submissions where relevant to the issues I have to decide.

Evidence

7. The opponent's evidence-in-chief comes from Patricia McMahon, the opponent's Director of Global Brand Protection. The purpose of her evidence is to show the opponent's use of the mark, and the sign relied upon for the passing off ground, to establish reputation and goodwill.[2]

8. The applicant's evidence comes from Shan He, the applicant's director. It is a very brief witness statement dated 2 April 2023, giving some details about the choice of the mark.

[2] Witness statement dated 13 September 2022 and exhibits.

9. The opponent's evidence-in-reply comes from Robert Jacob, an attorney at the opponent's firm of representatives. He provides some online references regarding 'gal'. This is, presumably, in response to the applicant's statement about its choice of GAL, although it would have been preferable for the opponent to have provided this material in its evidence-in-chief because it goes to the pleadings made under section 3(1)(b) and (c).

Sections 3(1)(b) and (c) of the Act

10. Sections 3(1)(b) and (c) state:

> "**3.**— (1) The following shall not be registered –
>
> (a) […]
>
> (b) trade marks which are devoid of any distinctive character,
>
> (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,
>
> […]:
>
> Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it."

11. The relevant date for determining the above grounds of opposition is the date on which the application for the contested mark was filed: 13 January 2022.

12. The opponent's pleadings under section 3(1)(b) are the same as for its ground under section 3(1)(c). At paragraph 55 of *Koninklijke KPN Nederland NV v Benelux-*

Merkenbureau (POSTKANTOOR) [2004] E.T.M.R. 57, Case C-363/99, the Court of Justice of the European Union ("CJEU") described section 3(1)(c) as requiring "that all signs or indications which may serve to designate characteristics of the goods or services in respect of which registration is sought remain freely available to all undertakings in order that they may use them when describing the same characteristics of their own goods."[3] The public interest underlying section 3(1)(b) of the Act is described in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* (Case C-265/09 P): the mark "must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings".

13. The case law under section 3(1)(c) (corresponding to article 7(1)(c) of the EUTM Regulation, formerly article 7(1)(c) of the CTM Regulation) was set out by Arnold J. (as he then was) in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch) as follows:

> "91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:
>
> > "33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40 , p. 1), see, by analogy, [2004] ECR I-1699 , paragraph 19; as regards Article 7 of Regulation No 40/94

[3] The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

, see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C-191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18 , paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461 , paragraph 24).

36. … due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94 . Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, inter alia , *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44 , paragraph 45, and *Lego Juris v OHIM* (C-48/09 P) , paragraph 43).

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley* , paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94, it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie* , paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest,

or who might have an interest, in using the sign in question (*Joined Cases C-108/97 and C-109/97 Windsurfing Chiemsee [1999] ECR I-2779*, paragraph 35, and *Case C-363/99 Koninklijke KPN Nederland [2004] ECR I-1619*, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (Koninklijke *KPN Nederland*, paragraph 57).

And

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland* , paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a ‘characteristic’ of the goods

or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94 , the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56)."

92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97]."

14. The applicant states in its evidence:

"We used 'GAL' to represent the word 'girl' which is pronounced in a particular British accent."

15. In his evidence, Mr Jacob states that he understands the applicant's statement to mean that the applicant accepts that 'gal' is descriptive of 'girl'. He provides the results of online searches made for 'gal' on 5 July and 6 July 2023. Exhibit RMJ1 comprises the following references:

- Collins Dictionary: "Gal is used in written English to represent the word 'girl' as it is pronounced in a similar accent. *… a Southern gal who wants to make it in the movies.* Synonyms: girl, woman, lady, dame [*old-fashioned, or derogatory, slang, mainly US, Canadian*]."
    - " gal in British English … *informal* a girl.";

- Cambridge Dictionary: "informal or humorous…a woman or girl. *You're just an old-fashioned gal, aren't you, honey!*"; and

- Oxford Dictionary: "informal, mainly North American, a girl or young woman. ORIGIN late 18th century: representing a pronunciation [4]

16. Exhibit RMJ2 comprises examples of articles from online UK magazines:

(a) an article dated 4 July 2023 in Cosmopolitan regarding a fashion swap event at Selfridges: "…get your gals together and join in the fun of Thursday Lates where you can take part in the Swap Shop…";

(b) an article dated 20 June 2023 in Cosmopolitan: "Dua Lipa has been one busy gal!";

[4] I have not included the reference from Merriam-Webster because it is a US dictionary.

(c) an article dated 13 June 2023 in Cosmopolitan about Billie Eilish: “Ever the modest gal, Billie simply commented “🙈”.”;

(d) an article dated 9 December 2022 in Cosmopolitan: “We love halternecks, pleated skirts and corsets as much as the next gal.”;

(e) an article dated 17 February 2011 from redonline.co.uk about knitwear trends in New York: “Michael Kors, the king of up-town-gal luxe …”;

(f) an article dated 29 May 2019 from redonline.co.uk: “If you’re more of a jeans and nice top kinda gal, why not try the ‘Austin’ blouse?”;

(g) an article dated 26 July 2019 from redonline.co.uk: “…so there’s literally a perfect fit for every kinda gal”;

(h) an article dated 7 March 2019 from redonline.co.uk about tweets regarding Top Shop jeans, one tweeter saying “I speak for tall, regular and petite gals…”;

(j) an article dated 27 April 2015 from redonline.co.uk: “All this ‘not washing your jeans’ thing really only applies to purist guys and gals.”;

(k) an article dated 28 April 2023 in Elle: “… and if you’re moving your runs outdoors when you’re usually a treadmill kinda gal…”;

(l) an article dated 11 July 2022 in Elle about the Kardashian sisters: “It seems likes the gals are there for a birthday trip…”;

(m) an article dated 14 February 2018 in Elle: “…feel free to purchase these tights and wear them to every single public outing with your gal pals.” I note that although the website address for this article is elle.com/uk/life-and-culture/articles, there is a reference to tights in John Lewis at $7.50, which is clearly not UK currency; and

(n) an article dated 1 September 2017 from Elle: "Loved by both 'What a Girl wants' and 'Dirrty' Christina Aguilera-type gals…".

17. The first of the Collins dictionary entries refers to gal being mainly US or Canadian and that it is old-fashioned. That accords with my own experience: a term used in old Hollywood movies. The Oxford dictionary reference also says it is mainly North American and that it represents a certain pronunciation, from the 18th century. The Cambridge dictionary example of use fits in with the old-fashioned use of the term, and the example itself looks American. I acknowledge the second Collins entry says that gal in British English is an informal term for a girl. What all these references have in common is that gal is informal.

18. I do not consider that the magazine articles improve the opponent's claim. They come from three UK fashion magazines and are, as would be expected, written by journalists. They are all written in a similar style. I note that the first Cosmopolitan article (a) was written by the same journalist as article (c), and article (f) in redonline was written by the same journalist as article (g). Article (g) has a note at the bottom of the article crediting it as coming from Cosmopolitan. The same formulation is used in articles (f) and (g) (by the same journalist) and (k): "kinda gal", which again sounds like something from an old Hollywood movie. All these usages are in the contexts of sentences. I doubt that without such context, as in the contested mark which is simply Gal London (and not even London Gal), the meaning of a slang or informal reference to 'girl' would be perceived by the average UK consumer for the goods.

19. I bear in mind that the applicant has said that it chose GAL to "represent the word 'girl' which is pronounced in a particular British accent." The applicant does not state that GAL describes the goods, nor that GAL is the same as GIRL. The applicant appears to consider that a certain British pronunciation of girl sounds like 'gal'. I am unaware of what accent or dialect the applicant has in mind, but the key issue is the average consumer's perception on encountering GAL London in relation to clothing. Without added context (such as the sentences in the magazines), I do not think that the average consumer will see GAL London as meaning clothing for girls (or females)

in or from London. It is too elliptical for such a descriptive meaning to be immediate, without further thought, even if 'gal' is known in the UK as an informal term for 'girl', which I also doubt. The evidence for that is not compelling. *Technopol* states that a sign can be refused registration "only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of [the characteristics in section 3(1)(c)]". It would take some stretch of the imagination to arrive at the meaning contended for by the opponent without further explanation, such as the context in the magazine articles. The section 3(1)(c) ground of opposition fails.

20. The section 3(1)(b) ground of opposition is predicated on the same basis as that for section 3(1)(c). As that has failed, the section 3(1)(b) ground also fails, for the same reasons.

Section 5(2)(b) of the Act

21. Section 5(2)(b) states:

> "5. (2) A trade mark shall not be registered if because –
>
> (a) …
>
> (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,
>
> there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

22. Section 5A states:

> "Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the

trade mark is applied for, the application is to be refused in relation to those goods and services only."[5]

23. The following principles for determining whether there is a likelihood of confusion under section 5(2)(b) of the Act are taken from the decisions of the CJEU 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 C-3/03, *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 a mark as a whole and does not proceed to analyse its various details;

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

[5] This section also applies to the ground raised under section 5(3) of the Act.

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

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

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

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

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

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

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

24. The applicant is silent in its notice of defence and counterstatement about the opponent's claim that the parties' goods are identical. In any event, the goods are identical either because the parties' terms are identical or because earlier mark (i) covers all of the applicant's goods, and the applicant's goods cover all of the goods registered under earlier mark (ii): see *Gérard Meric v OHIM*, Case T-33/05, General Court of the European Union ("GC").

Average consumer and the purchasing process

25. As the case law cited above indicates, it is necessary to decide who the average consumer is for the parties' goods and how they purchase them. "Average consumer" in the context of trade mark law means the "typical consumer."[6] The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*.

26. The average consumer for the parties' goods is the general public. By and large, consumers pay a medium degree of attention to quality, material, fit, suitability and aesthetics. The goods will be selected mainly from displays in shops, or from catalogues and websites. This means that the selection process is predominantly visual, which accords with case law. For example, in *Quelle AG v OHIM*, the GC stated that:[7]

> "68..... If the goods covered by the marks in question are usually sold in self-service stores where consumers choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any phonetic similarity between the signs (*NLSPORT, NLJEANS, NLACTIVE and NLCollection*, paragraph 53 supra, paragraph 49).
>
> 69. Likewise, the degree of phonetic similarity between two marks is of less importance in the case of goods which are marketed in such a way that, when making a purchase, the relevant public usually perceives visually the mark designating those goods (*BASS*, paragraph 56 supra, paragraph 55, and Case T-301/03 *Canali Ireland* v *OHIM – Canal Jean (CANAL JEAN CO. NEW YORK)*

[6] *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).
[7] Case T-88/05.

[2005] ECR II-2479, paragraph 55). That is the case with respect to the goods at issue here. Although the applicant states that it is a mail order company, it does not submit that its goods are sold outside normal distribution channels for clothing and shoes (shops) or without a visual assessment of them by the relevant consumer. Moreover, while oral communication in respect of the product and the trade mark is not excluded, the choice of an item of clothing or a pair of shoes 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 (*NLSPORT, NLJEANS, NLACTIVE and NLCollection*, paragraph 53 supra, paragraph 50). The same is true of catalogue selling, which involves as much as does shop selling a visual assessment of the item purchased by the consumer, whether clothing or shoes, and does not generally allow him to obtain the help of a sales assistant. Where a sales discussion by telephone is possible, it takes place usually only after the consumer has consulted the catalogue and seen the goods. The fact that those products may, in some circumstances, be the subject of discussion between consumers is therefore irrelevant, since, at the time of purchase, the goods in question and, therefore, the marks which are affixed to them are visually perceived by consumers."

27. Therefore, whilst I do not discount an aural dimension to the selection process, it is the visual selection which is the most important consideration.

Comparison of marks

28. Both of the earlier marks are GAP, so I will refer to the earlier marks in the singular from this point in the decision. There is also no material difference in the comparison to be made in respect of the applicant's series because registration in block capitals covers use in upper and lower case. I will make the comparison on the basis of the first mark in the series, GAL London. For ease of reference, the comparison is:

Opponent's mark	**Applicant's mark**

GAP	GAL London

29. *Sabel BV v. Puma AG* explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

30. It is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

31. The earlier mark consists of a single element in which the overall impression of the mark resides. The applicant's mark comprises two elements. London is the second and less distinctive of the elements. It is GAL which is the dominant and distinctive element of the applicant's mark.

32. The earlier mark consists of three letters and the applicant's mark of nine letters. The point of visual similarity between the marks lies in the first two letters which are the same, GA. All the other letters in the applicant's mark are not present in the earlier mark and P and L do not look similar. There is a low degree of visual similarity between the marks.

33. The earlier mark contains one syllable and the later mark three syllables. GAP is a common word which will be given its normal pronunciation. The first and second

letters of the marks will sound the same: a hard G and a short A. That is where the phonetic similarity between the marks ends. P and L sound nothing alike, and the two-syllable word London is absent from the earlier mark, as are all the letters in London.

34. Conceptually, the earlier mark is the well-known word gap meaning a space. London has its obvious geographical meaning which is absent from the earlier mark. GAL will be seen as an invented word. However, if I am wrong about the section 3(1)(b) and (c) outcomes and it would be seen as meaning 'girl', the meanings of the marks are entirely different which means that they are conceptually dissimilar. If GAL is seen as an invented word, the marks have no conceptual similarity.

Distinctiveness of the earlier mark

35. The assessment as to whether there is a likelihood of confusion includes considering whether the distinctive character of the earlier mark has been enhanced (i.e. more distinctiveness has been acquired) through the use made of it. If a mark has an inherently high, or an enhanced, level of distinctiveness, the likelihood of confusion is increased. The earlier mark does not describe or allude to the goods or their characteristics. As a common dictionary word, it has an average degree of inherent distinctiveness.

36. I turn to the opponent's evidence of use of its mark to decide whether the inherent distinctiveness of the earlier mark has been enhanced by the use made of it in the UK. Distinctive character is a measure of how strongly the earlier mark identifies the goods or services for which it is registered, determined, according to *Lloyd Schuhfabrik Meyer & Co.*, partly by assessing the proportion of the relevant public which, because of the mark, identify the goods or services as originating from a particular undertaking. At paragraph 23, of its judgment, the CJEU stated:

> "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).

37. Some of the opponent's evidence is quite old, such as details of awards in 2001 and 2006, and a good deal of it relates to countries outside of the EU and the UK. I have extracted the following relevant data from the evidence:

Date	**No. of GAP stores in the UK**	**Sales made in UK stores**	**Online sales made via GAP UK website**	**UK advertising expenditure**
2021		€93,771,000	$58,399,000	£787,000
2020	78	€99,497,00	$65,507,000	£762,000
2019	95	€266,204,000	$55,776,000	£933,000
2018	104	€113,318,000		£913,000
2017	108	€145,140,000		£1,051,000
2016	115	€158,344,000		£954,000
2015	124	€160,439,000		£1,093,000
2014	138			£1,504,000
2013	143			

38. Advertising prior to the relevant date took place in print, television and online. Examples are shown in Exhibit PM32; for example, in Cosmopolitan, Elle (UK), GQ, Vanity Fair (UK) and Vogue (UK).

39. Despite a decline in sales and the other figures, in the years closest to the relevant date, the opponent's GAP sales figures in the UK were substantial and it advertised its mark in major UK fashion magazines, sometimes modelled by celebrities. I find

that, at the relevant date, the average inherent degree of distinctiveness of GAP had been enhanced to a high level in the UK for clothing.

Likelihood of confusion

40. Deciding whether there is a likelihood of confusion is not scientific; it is a matter of considering all the factors, weighing them and looking at their combined effect, in accordance with the authorities set out earlier in this decision. One of those principles states that a lesser degree of similarity between goods and services may be offset by a greater degree of similarity between the trade marks, and vice versa. The parties' goods are identical, which is a factor in the opponent's favour. However, the opposition fails under section 5(2)(b). This is because, despite the goods being identical and the earlier mark being highly distinctive, the balance of the other factors in the global assessment which I have considered throughout this part of the decision means that there is no likelihood of confusion. There are two types of confusion, direct and indirect.[8] Neither will occur.

41. Direct confusion occurs where marks are mistaken for one another, flowing from the principle that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them which has been retained in the mind. I bear in mind that the dominant and distinctive part of the contested mark differs only from the earlier mark in the third (and final) letter. This could be a factor in imperfect recollection because the beginnings of marks are generally important in recollection, *El Corte Inglés, SA v OHIM*.[9] Nevertheless, it is a rule of thumb and each case must be considered on its own facts. It also does not trump the requirement, set out in the authorities cited earlier in this decision, that it is the marks as wholes which must be assessed in deciding whether there is a likelihood of confusion. The visual differences between the parties' marks are important because the consumer will see the marks during purchase, paying the normal degree of attention, even if there is also an aural element to selection.

[8] *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, paragraph 10.
[9] Cases T-183/02 and T-184/02, General Court.

However, despite the letters GA forming the beginning of both marks, there are two reasons why I consider imperfect recollection will not occur.

42. The first of these is that differences between short marks or short elements in marks (i.e. between GAP and GAL) can have proportionately more impact on the average consumer's visual perception of the marks/elements and contribute to reducing the likelihood of confusion.[10] The second reason is that GAP has a well-known meaning which GAL does not share. In *The Picasso Estate v OHIM*, the CJEU found that:[11]

> "20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law."

43. Even if I am wrong about my conclusions under section 3(1)(b) and (c), *Picasso* still applies because it would mean that the GAP and GAL components each have their own meanings which are very different. Either way, GAP and GAL are conceptually different or conceptually neutral and this is enough, with the other differences between the marks in what is primarily a visual purchase, to avoid them being directly confused, even taking into account the enhanced distinctive character of the earlier mark and that the goods are identical.[12] GAP is a word the meaning of which is clear and specific, which will be grasped immediately by the average consumer for the goods. The degree of conceptual strength is a factor and I consider that the conceptual difference is strong enough to counteract the visual and aural similarities between the marks, which are at a low/very low level.[13] Putting all the

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[10] See, for example, the Appointed Persons' decisions *Formula One Licensing BV v Bux & Co Ltd*, case BL O/013/21, and *Yell limited v Yelp! Inc*, case BL O/021/13 which concerned the marks YELL and YELP. The last letters in that case were the same as in the present case: P and L.
[11] Case C-361/04 P.
[12] It is sufficient that only one of the common elements has a clear and specific meaning; see *JT International S.A. v Argon Consulting & Management Limited*, case BL O/049/17, Mr Iain Purvis QC, sitting as the Appointed Person.
[13] *Diramode S.A. v Richard Turnham and Linda Ann Turnham*, case BL O/566/19, Mr Geoffrey Hobbs QC, sitting as the Appointed Person.

factors together, I conclude that the average consumer will not make the sort of mistake which results in direct confusion.

44. Indirect confusion occurs when the consumer recognises that the marks are different, but puts the similarities between them down to the undertakings being the same or economically linked.[14] Indirect confusion is not a consolation prize for an opponent which has not succeeded in a finding of direct confusion.[15] I acknowledge that the common element does not have to be identical for there to be indirect confusion, if the common element is imperfectly recalled.[16] However, the differences between the marks which are the reason why there is no likelihood of direct confusion are also the reason why there is no indirect confusion.[17] There is no reason for anyone to conclude that GAL London/Gal London is a sub-brand or offshoot of GAP.

45. The section 5(2)(b) ground of opposition fails.

Section 5(3) of the Act

46. Section 5(3) states:

> "(3) A trade mark which-
>
> is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark".

[14] See *Back Beat Inc v L.A. Sugar (UK) Limited*, BL O/375/10, Mr Iain Purvis QC, sitting as the Appointed Person.
[15] See the comments of Mr James Mellor QC, sitting as the Appointed Person in *Cheeky Italian Limited v Ashish Sutaria*, BL O/219/16
[16] *Aveda Corporation v Dabur India Limited* [2013] EWHC 589 (Ch) and *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271.
[17] *Supra* at 15.

(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected."

47. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors,* Case 252/07, *Intel,* Case C-408/01, *Adidas-Salomon,* Case C-487/07, *L'Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C-383/12 P, *Environmental Manufacturing LLP v OHIM.* The law appears to be as follows.

(a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; G*eneral Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel*, paragraph 42.

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68*;* whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

(f) the more immediately and strongly the earlier mark is brought to mind by the later mark, the greater the likelihood that use of the latter will take unfair advantage of, or will be detrimental to, the distinctive character or the repute of the earlier mark; *L'Oreal v Bellure NV*, paragraph 44.

(g) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel,* paragraphs 76 and 77 and *Environmental Manufacturing*, paragraph 34.

(h) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel*, paragraph 74.

(i) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV,* paragraph 40. The stronger the reputation of the earlier mark, the easier it will be to prove that detriment has been caused to it; *L'Oreal v Bellure NV*, paragraph 44.

(j) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is

clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure).*

48. For a successful claim under section 5(3), cumulative conditions must be satisfied by the opponent: similarity between the marks; a qualifying reputation in the earlier mark; a link between the marks (the earlier mark will be brought to mind on seeing the later mark); and one (or more) of the claimed types of damage. It is not necessary that the goods be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the relevant public will make a link between the marks.

49. The first condition of some similarity between the marks is satisfied, as found earlier in this decision.

50. The next condition is reputation. Reliance upon this ground requires evidence of a reputation amongst a significant part of the relevant public, as stated in *General Motors*. Given the size of the figures which I set out earlier in this decision in relation to enhanced distinctive character, it is undoubtedly the case that, at the relevant date, the earlier mark had a sufficient reputation in clothing for this ground of opposition. I have not referred to the EU evidence upon which the opponent may rely up to 31 December 2020 because the UK figures are substantial enough by themselves; furthermore, it is the UK relevant public's knowledge of the earlier mark which is key to the question of whether a link between the marks will be made.[18]

51. I find that a link will not be made between the marks by the UK relevant public because the marks are simply not similar enough, for the reasons given earlier, even bearing in mind the enhanced distinctive character and substantial reputation of the earlier mark for identical goods. I find the marks are not similar enough even though the similarity for a link to be found can be less than that for a likelihood of confusion.[19]

[18] In passing, in 2020, there were 137 company-owned GAP stores in Europe. In the same year, the opponent's EU sales stood at US$319 million. The Opponent may rely upon mark (i) prior to 31 December 2020 because it is a comparable mark; see Tribunal Practice Notice 2/2020.
[19] *Intra-Presse SAS v OHIM,* Joined cases C-581/13P & C-582/13 P.

As the conditions for section 5(3) are cumulative, without a link there can be no damage.

52. The section 5(3) ground of opposition fails.

Section 5(4)(a) of the Act

53. Section 5(4)(a) states:

> "(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-
>
> > (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,
> >
> > (aa) […]
> >
> > (b) […]
>
> A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an "earlier right" in relation to the trade mark."

54. Subsection (4A) of Section 5 states:

> "(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application."

55. The three elements which the applicant must show are well known. In *Discount Outlet v Feel Good UK* [2017] EWHC 1400 (IPEC), Her Honour Judge Melissa Clarke, sitting as a Deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

> "55. The elements necessary to reach a finding of passing off are the 'classical trinity' of that tort as described by Lord Oliver in the Jif Lemon case (Reckitt & Colman Product v Borden [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.
>
> 56 In relation to deception, the court must assess whether *"a substantial number"* of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21)."

56. The concept of goodwill was explained in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 at 223:

> "What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start."

57. As there is no evidence that the contested mark has been used, the *prima facie* relevant date is the date of the application for the contested mark: 13 January 2022.[20] The opponent must show that it had sufficient goodwill at this date to bring the claim. I find that it has shown substantial evidence of goodwill in relation to clothing.

58. However, for the same reasons as there would be no likelihood of confusion, a substantial number of the opponent's customers would not be deceived.[21] Although the average consumer test is not strictly the same as the 'substantial number' test, in the light of the *Court of Appeal's judgment in Comic Enterprises Ltd v Twentieth*

[20] The applicant states that it has not yet begun trading because of the present dispute.
[21] Neutrogena Corporation and Another v Golden Limited and Another,1996] RPC 473.

Century Fox Film Corporation [2016] EWCA Civ 41, it seems doubtful whether the difference between the legal tests will (all other factors being equal) produce different outcomes. This is because they are both normative tests intended to exclude the particularly careless or careful, rather than quantitative assessments. All other factors are equal. In relation to the sign GAP, I remain of the view that the opponent's customers (or potential customers) will not engage in an analysis which brings them to a conclusion that the contested mark signifies the opponent's goods, or that of a business connected with the opponent.

59. The section 5(4)(a) grounds fails.

Overall outcome

60. The opposition fails. The application may proceed to registration.

Costs

61. The applicant has been successful and is entitled to a contribution towards its costs. As the applicant is unrepresented, in its letter to the applicant of 18 July 2023, the Tribunal said:

> "If you intend to make a request for an award of costs you must complete and return the attached pro-forma and send a copy to the other party. Please send these by e-mail to tribunalhearings@ipo.gov.uk.
>
> If there is to be a "decision from the papers" this should be provided **on or before 15 August 2023.** If a hearing is taking place you will be advised of the deadline to do so when the Hearing is appointed.
>
> If the proforma is not completed and returned, costs, other than official fees arising from the action (excluding extensions of time), may not be awarded. You must include a breakdown of the actual costs, including accurate estimates of the number of hours spent on each of the activities listed and any travel costs. Please note that The Litigants in Person (Costs and Expenses) Act 1975 (as

amended) sets the minimum level of compensation for litigants in person in Court proceedings at £19.00 an hour."

62. No cost pro forma has been received to date. Since the applicant did not file a cost pro forma by the deadline given in the Tribunal's letter of 18 July 2023 and as the applicant has not incurred any official fees in defending its application, I make no order as to costs.

Dated this 8th day of March 2024

Judi Pike
For the Registrar,
the Comptroller-General