

O/0302/24

TRADE MARKS ACT 1994

**IN THE MATTER OF
TRADE MARK APPLICATION NO. 3629901
IN THE NAME OF REFORM CLOTHING LIMITED
TO REGISTER AS A TRADE MARK**

WEAR THE FUTURE

IN CLASSES 25 AND 35

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 427065
BY C&A AG**

BACKGROUND AND PLEADINGS

1. On 21 April 2021, Reform Clothing Limited (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the United Kingdom. The application was accepted and published for opposition purposes on 25 June 2021, in respect of the following goods and services:

Class 25: *Clothing, footwear, headgear.*

Class 35: *Retail services connected with the sale of clothing, footwear, headgear.*

2. The application is opposed by C&A AG (“the opponent”). The opposition was filed on 23 September 2021 and is based upon Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against all of the goods and services in the application. The opponent relies upon the following marks:

WEAR THE CHANGE

UK trade mark registration number 917127631

Filing date: 18 August 2017

Registration date: 01 December 2017

Registered in Classes 25 and 35

Relying on all goods and services, namely:

Class 25: *Clothing, footwear, headgear.*

Class 35: *The bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof), enabling consumers to conveniently view and purchase those goods, namely, clothes, Shoes, headpieces; The bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof), enabling customers to conveniently view and purchase those goods via websites, namely clothing, footwear and headgear; Business management; Business administration; Office functions; Presentation of goods on communications media, for commercial purposes; Writing and publication of publicity texts; Services*

and activities relating to promotion; Advertising; Marketing services; Business information; Consumers (Commercial information and advice for -) [consumer advice shop]; Data search in computer files for others; Sales promotion for others; Updating of advertising material.

(The '631 mark); and

WEAR THE CHANGE

International Registration No.: WO1400980

International Registration date: 2 February 2018

Priority claimed from CH709134, with a priority date of 18 August 2017

UK Date of Designation: 2 February 2018

Date protection conferred in the UK: 23 August 2018

Protected for goods and services in classes 25 and 35

Relying on all goods and services, namely:

Class 25: *Clothing, footwear, headgear.*

Class 35: *Advertising; marketing; business information; commercial information and advice for consumers (consumer advice shop); data search in computer files for others; sales promotion for others; updating of advertising material; the bringing together, for the benefit of others, of a variety of goods (excluding transport thereof) enabling consumers to view and purchase those goods conveniently, namely, clothing, footwear, headgear; the bringing together, for the benefit of others, of a variety of goods (excluding transport thereof) enabling consumers to view and purchase those goods conveniently, via websites, namely, clothing, footwear, headgear; commercial business management; commercial administration; office functions; presentation of goods on communication media for commercial purposes; writing and publication of advertising texts; promotional services and activities.*

(The '980 mark).

3. Each of the two trade marks upon which the opponent relies qualifies as an earlier trade mark as defined in Section 6(1) of the Act. As neither mark had completed its

registration procedure or been protected more than five years before the application date for the contested mark, they are not subject to the use provisions contained in section 6A of the Act.

4. The applicant filed a counterstatement to the opponent's notice of opposition, denying that the applied-for mark is similar to the opponent's earlier marks and denying that the goods for which registration is sought are identical and/or similar to the goods covered by the earlier rights of the opponent. The applicant denies that there exists a likelihood of confusion and requests that the opposition is rejected in its entirety and that an award of costs is made in its favour.

5. The opponent filed written submissions during the evidence rounds; the applicant filed written submissions in lieu of a hearing. The written submissions will be referred to as and where appropriate during this decision. Neither party elected to file evidence and neither party requested a hearing, therefore this decision is taken following careful consideration of the papers.

6. In these proceedings, the opponent is represented by Bird & Bird LLP and the applicant is represented by FRKelly.

DECISION

7. 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.

Section 5(2)(b)

8. Section 5(2)(b) is relied on and reads as follows:

“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”.

9. 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.”

10. I am guided by the following principles which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (“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:

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely

upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

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

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

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

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

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

11. The goods and services to be compared are:

Opponent's goods and services
<p>The '631 mark</p> <p><u>Class 25</u> <i>Clothing, footwear, headgear.</i></p> <p><u>Class 35</u> <i>The bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof), enabling consumers to conveniently view and purchase those goods, namely, clothes, Shoes, headpieces; The bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof), enabling customers to conveniently view and purchase those goods via websites, namely clothing, footwear and headgear; Business management; Business administration; Office functions; Presentation of goods on communications media, for commercial purposes; Writing and publication of publicity texts; Services and activities relating to promotion; Advertising; Marketing services; Business information; Consumers (Commercial information and advice for -) [consumer advice shop]; Data search in computer files for others; Sales promotion for others; Updating of advertising material.</i></p> <p>The '980 mark</p> <p><u>Class 25</u> <i>Clothing, footwear, headgear.</i></p> <p><u>Class 35</u> <i>Advertising; marketing; business information; commercial information and advice for consumers (consumer advice shop); data search in computer files for others; sales promotion for others; updating of advertising material; the bringing together, for the benefit</i></p>

of others, of a variety of goods (excluding transport thereof) enabling consumers to view and purchase those goods conveniently, namely, clothing, footwear, headgear; the bringing together, for the benefit of others, of a variety of goods (excluding transport thereof) enabling consumers to view and purchase those goods conveniently, via websites, namely, clothing, footwear, headgear; commercial business management; commercial administration; office functions; presentation of goods on communication media for commercial purposes; writing and publication of advertising texts; promotional services and activities.

Applicant's goods and services

Class 25

Clothing, footwear, headgear.

Class 35

Retail services connected with the sale of clothing, footwear, headgear.

The contested goods in Class 25

Clothing, footwear, headgear.

12. The applicant's *Clothing, footwear, headgear*" are self-evidently identical to the opponent's "*Clothing, footwear, headgear*", as covered under both of the earlier marks relied upon.

The contested services in Class 35

Retail services connected with the sale of clothing, footwear, headgear.

13. While the wording is different, the applicant's "*Retail services connected with the sale of clothing, footwear, headgear*" are self-evidently identical to the opponent's "*The bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof), enabling consumers to conveniently view and purchase those goods, namely, clothes, Shoes, headpieces*" (the '631 mark), and "*the bringing together, for the benefit of others, of a variety of goods (excluding transport thereof)*

enabling consumers to view and purchase those goods conveniently, namely, clothing, footwear, headgear” (the ‘980 mark).

The average consumer and the nature of the purchasing act

14. The average consumer is a legal construct, deemed to be reasonably well informed and reasonably circumspect: see *Hearst Holdings Inc & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), paragraph 60. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97, at [26].

15. The applicant has submitted that the goods at issue include alcoholic drinks and that the average consumer will be adults who will pay an average degree of attention to the purchasing act.¹ As the goods at hand are clearly not alcoholic drinks, I will make no further reference to the applicant’s submissions in regard to the average consumer.

16. The opponent submits that the goods and services at issue, being clothing, footwear and headgear and the retail of those goods, are directed towards the general public at large who will have an average degree of attention when viewing the marks, given they frequently purchase the goods and engage in the services in everyday life.²

17. I agree with the opponent’s submissions that the general public will most likely be the average consumer of the goods and services. During the selection of the goods, considerations such as quality, material and the fit of the goods will all play a part, as well as the “look” of the goods, the cost, and the suitability according to the occasion for which they are being purchased. The goods may be purchased from physical stores, by predominantly visual means, although I do not discount aural considerations, and from catalogues and via the internet, where they will be viewed

¹ Point 10 of the applicant’s written submissions in lieu, dated 20 September 2023.

² Point 14 of the opponent’s written submissions dated 5 June 2023.

and self-selected by the consumer. In *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03, the General Court (“GC”) stated that:

“50..... Generally in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly the visual aspect plays a greater role in the global assessment of the likelihood of confusion.”

18. In my view, the level of attention during the selection of the goods will vary, from medium for everyday wear, to slightly higher for luxury and special occasion items of clothing, footwear and headgear.

19. When using the retail services at issue, the average consumer will make their choice based on the range of goods available and the prices charged, the customer services offered, in addition to, for example in the case of physical stores, the location of the retailer. The visual element will be important as the mark will be displayed on signage and advertising, as well as on the web pages of online retailers. However, I do not discount the aural element, as word-of-mouth recommendations may play a part in the choice of retailer. Overall, it is my view that the average consumer will be pay a medium degree of attention when choosing the retail services at issue.

Comparison of marks

20. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo SA v OHIM* Case C-591/12P, 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.”³

21. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

22. The opponent’s earlier marks are each registered/protected for the identical mark “**WEAR THE CHANGE**”. Given that I have found identity between the applicant’s goods and services and those covered by each of the earlier marks, from here on in, I will refer to “the opponent’s mark” in the singular. However my subsequent findings will be the same for both the earlier marks.

23. The competing marks each consist of three words, presented in a standard typeface in capital letters, with no other elements to contribute to the overall impression: “**WEAR THE CHANGE**” v “**WEAR THE FUTURE**”. The words within each mark form a slogan, with no individual word dominating. The overall impression of each mark therefore rests in the combination of words.

24. Visually, the competing marks both comprise three words, which share the same first two words, **WEAR THE**, presented in the same order. In the opponent’s mark, the six letter word **CHANGE** follows, while the applicant’s mark is completed by the six letter word **FUTURE**. Considering the marks as a whole, I find there to be a medium degree of visual similarity between them.

25. Aurally, the common elements of the competing marks are the first two words, with the opponent’s mark pronounced in its entirety as three words of three syllables,

³ Paragraph 34

WHERE-THUH-CHAINDGE, while the contested mark will be voiced as three words of four syllables, WHERE-THUH-FEW-CHUH. Overall, I consider the marks to be aurally similar to a medium degree.

26. With regard to conceptual comparison, in *Luciano Sandrone v European Union Intellectual Property Office (EUIPO)*, Case T-268/18, the GC held:

“... In that regard, it must be borne in mind that the purpose of the conceptual comparison is to compare the ‘concepts’ that the signs at issue convey. The term ‘concept’ means, according to the definition given, for example, by the Larousse dictionary, a ‘general and abstract idea used to denote a specific or abstract thought which enables a person to associate with that thought the various perceptions which that person has of it and to organise knowledge about it.’”⁴

27. The applicant submits that apart from the fact that the respective marks allude to wearing something, the ends of the marks result in totally different impressions.⁵

28. The opponent submits that the word “FUTURE” is often linked to progress and evolution, giving it a strong conceptual association with the word “CHANGE”. As a result, it submits that the marks are conceptually very similar, if not identical. It further submits that the overlapping “WEAR THE” element at the forefront of each mark provides a strong conceptual meaning such that changing the proceeding word is not sufficient to eliminate the concept the words create in the minds of the consumer.⁶

29. While both marks relate to clothing, footwear and headgear, and the retail thereof, with the goods obviously being worn by the consumer, I agree with the opponent that there is an overlap in the conceptual message sent by the competing marks as a whole. Although I disagree that the message is identical, both marks implore the consumer to buy goods which are different to the norm (WEAR THE CHANGE) or to the here and now (WEAR THE FUTURE). In both cases, the consumer is invited to

⁴ Paragraph 8.

⁵ See point 9 of the applicant’s written submissions in lieu.

⁶ See points 17 and 18 of the opponent’s written submissions.

be part of something that is not commonplace at the present time through the clothes that they choose to wear. As such, I consider each of the marks as a whole to be conceptually similar to a high degree.

Distinctive character of the earlier mark

30. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. The factors I must take into account in assessing the level of distinctive character were set out by the CJEU in *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97:

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

31. Registered trade marks possess varying degrees of inherent distinctive character, being lower where they are allusive or suggestive of a characteristic of the goods and services, ranging up to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it. The opponent has not claimed that its mark has enhanced distinctiveness and no evidence of use has been filed. Therefore, I only have the inherent characteristics of the mark to consider.

32. The earlier mark comprises what I consider to be a promotional slogan, “WEAR THE CHANGE”. Earlier in this decision, I considered that the concept of the mark

related to the consumer being invited/implored to be part of something that is different to the norm. While the words “WEAR THE” allude to the fact the goods and services at issue relate to clothing, footwear and headgear, which, by their very nature, will be worn by the consumer, the mark as a whole is not directly descriptive of such goods or the retail services for those goods. The concept of change is somewhat vague, and the mark does not express how the change or difference actually manifests itself. Looking at the mark as a whole, I consider it to be inherently distinctive for the goods and services to no more than a medium degree.

Likelihood of confusion

33. There is no simple formula for determining whether there is a likelihood of confusion. It is clear that I must make a global assessment of the competing factors (*Sabel* at [22]), keeping in mind the interdependency between them i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa (*Canon* at [17]). I must consider the various factors from the perspective of the average consumer, bearing in mind 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 he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

34. There are two types of possible confusion: direct, where the average consumer mistakes one mark for the other, or indirect, where the average consumer recognises that the marks are different, but assumes that the goods and/or services are the responsibility of the same or connected undertakings. The distinction between these was explained by Mr Iain Purvis Q.C. (as he then was), sitting as the Appointed Person, in *L.A. Sugar Limited v Back Beat Inc*, Case BL-O/375/10. He 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).”

35. The above are examples only which are intended to be illustrative of the general approach. These examples are not exhaustive but provide helpful focus.

36. Earlier in this decision, I found the contested goods and services to be identical to the opponent’s goods and services. I considered that, whilst not ignoring aural considerations, the goods and services would be selected by predominantly visual means. I found that the degree of attention of the general public when selecting the goods would vary between medium for everyday wear, to slightly higher for luxury or special occasion wear, while the degree of attention when choosing the retail services would be medium.

37. I considered the competing trade marks to be visually and aurally similar to a medium degree, and to be conceptually similar to a high degree. I found the earlier mark to be inherently distinctive to no more than a medium degree.

38. While allowing that the average consumer is unlikely to see the marks side-by-side and will therefore be reliant on the imperfect picture of them they have kept in their mind, I consider it unlikely that they would mistake one mark for the other. In my view, the average consumer will notice and recall the differences between the marks. I find this even though the respective goods and services are held to be identical, which offsets a lesser degree of similarity between the marks. Consequently, I do not consider there to be a likelihood of direct confusion.

39. I now turn to consider whether there might be a likelihood of indirect confusion.

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

41. In *Liverpool Gin Distillery Ltd and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207, Lord Justice Arnold referred to the comments of James Mellor QC (as he then was) sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said (at [16]) that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Lord Justice Arnold added that there must be "a proper basis" for concluding that there is a likelihood of indirect confusion when there is no likelihood of direct confusion.

42. I bear in mind the various factors in my decision and the principle of interdependency between them. I acknowledge the common elements within the competing marks and the degree of conceptual similarity between the marks as a whole, as well as the identical goods and services. Taking into account the previously

outlined guidance of Mr Iain Purvis Q.C. (as he then was), in *L.A. Sugar*, as per paragraph 17(c) of that decision, I consider it reasonable that a significant proportion of the average consumer would perceive a different ending to the common elements “WEAR THE...” as logical and consistent with a brand extension or a sub-brand of the owner of the earlier mark, or that they would assume that there is an economic connection between the undertakings. Consequently, I consider there to be a likelihood of indirect confusion between the marks in relation to all of the applied-for goods and services.

43. The opposition under section 5(2)(b) of the Act succeeds in its entirety.

CONCLUSION

44. The opponent has been successful. Subject to any successful appeal, the application by Reform Clothing Limited is refused registration.

COSTS

45. The opponent has been successful, and is therefore entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice (“TPN”) 2/2016. Applying the guidance in that TPN, I award the opponent the sum of £600, which is calculated as follows:

Official fee:	£100
Preparing the notice of opposition and considering the counterstatement:	£200
Filing written submissions:	£300
Total:	£600

46. I therefore order Reform Clothing Limited to pay C&A AG the sum of £600. The above sum should be paid within twenty-one days of the expiry of the appeal period

or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 4th day of April 2024

**Suzanne Hitchings
For the Registrar,
the Comptroller-General**