O/0397/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3931754

IN THE NAME OF FRED GEORGE PEARSON
TO REGISTER THE FOLLOWING TRADE MARK:

CAPRE

IN CLASS 25

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 444924
BY

CULTURE KINGS USA, INC

Background and pleadings

1. Fred George Pearson ("the applicant") applied to register the trade mark CAPRE in the UK on 10 July 2023, application no. UK00003931754. It was accepted and published in the Trade Marks Journal on 6 October 2023 in respect of the following goods:

> Class 25 - Clothing; Clothes; Shorts [clothing]; Denims [clothing]; Embroidered clothing; Casual clothing; Clothing for leisure wear; Leisure clothing; Tops [clothing]; Men's clothing; Jackets [clothing]; Parts of clothing, footwear and headgear.

2. On 28 December 2023 Culture Kings USA, Inc ("the opponent") filed an opposition opposing the application in full under section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opponent relies on the following International Registration ("IR"):

International Registration number: WO000001575858A

Whilst registered for goods and services in classes 9, 25 and 35, for the purposes of this opposition it relies upon the following only:

> Class 25 - Knitwear (clothing); pants (clothing); polo shirts; printed t-shirts: shirts; short-sleeve shirts: t-shirts; tee-shirts; skirts; dresses; suits; neckties; socks; mittens; bandanas (neckerchiefs); shawls: scarfs; swimming suits; outer clothinq; baseball caps; beach caps; caps being headwear; flat caps; berets; shorts; jumpers (pullovers); jumpers (sweaters); polo neck jumpers: sports jumpers; singlets; sports singlets; headbands (clothing); jackets (clothing); apparel (clothing, footwear, headgear), excluding innerwear; clothing and

clothing accessories (in this class), excluding innerwear; clothing, excluding innerwear; shoes, excluding slippers; footwear, excluding slippers.

3. The opponent's mark was registered on 03 December 2020 and, with effect from the same date, the opponent designated the UK as a territory in which it seeks to protect its mark under the terms of the Protocol of the Madrid Agreement. Protection was granted on 10 September 2021. The opponent's mark is derived from an earlier trade mark registered by the opponent in Australia. As such, the opponent's mark benefits from an earlier priority date of 10 November 2020, being the filing date of the opponent's Australian mark.

4. Under section 5(2)(b) of the Act, the opponent claims that there is a likelihood of confusion on the basis that the marks are similar, and the goods are either identical or highly similar leading to a likelihood of confusion, including a likelihood of association, and that the contested mark should be refused registration.

5. The applicant filed a counterstatement submitting that the two marks do not look or sound the same, and that the brands aren't phonetically similar when spoken. The applicant argues that there will not be any confusion to the public between the two brands and that the public will not consider that there is a connection between them. Within his counterstatement, the applicant submitted as follows:

> "1. There is no way there could be any confusion between the two brands. The opponents trademark is 2 letters different which means their name doesn't look or sound the same.
>
> 2. There won't be any confusion for the public because the brand names look different when on clothes. The public wouldn't think there is any connection between the two brands.
>
> 3. The opponents brand name isn't phonetically similar when spoken/heard. There is a big difference between the way they are both said.
>
> 4. The fact that I'm already using the Capre trade mark I feel I have prior rights.

5. I have no obligation for the opponent to start retailing their products in the UK because there could be no way of confusion between the two brands”

6. In accordance with section 6 of the Act, the IR relied upon by the opponent is considered an earlier mark. The IR had not been registered for five years as at the date of application for the contested mark and so, in accordance with section 6A of the Act, it is not subject to proof of use; the opponent may rely upon all the goods of its registration.

Representation

7. The opponent is represented by Ashfords LLP and the applicant is self-represented. Neither party filed evidence or submissions beyond those filed in their respective pleadings. No hearing was requested and therefore this decision is taken following a careful consideration of the papers.

Relevance of EU LAW

8. 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.

Decision

Section 5(2)(b)

9. Section 5(2)(b) of the Act is as follows:

“5(2) A trade mark shall not be registered if because-

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

10. Section 5A of the Act states as follows:

> "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."

Relevant law

11. The following principles are gleaned from the decisions of the Court of Justice of the European Union ("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 C120/04, *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;

(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

12. The competing goods are shown in the table below:

The IR	**The contested mark**
Class 25 - Clothing; Clothes; Shorts [clothing]; Denims [clothing]; Embroidered clothing; Casual clothing;	Class 25 - Knitwear (clothing); pants (clothing); polo shirts; printed t-shirts: shirts; short-sleeve shirts: t-shirts; tee-

Clothing for leisure wear; Leisure clothing; Tops [clothing]; Men's clothing; Jackets [clothing]; Parts of clothing, footwear and headgear.	shirts; skirts; dresses; suits; neckties; socks; mittens; bandanas (neckerchiefs); shawls: scarfs; swimming suits; outer clothinq; baseball caps; beach caps; caps being headwear; flat caps; berets; shorts; jumpers (pullovers); jumpers (sweaters); polo neck jumpers: sports jumpers; singlets; sports singlets; headbands (clothing); jackets (clothing); apparel (clothing, footwear, headgear), excluding innerwear; clothing and clothing accessories (in this class), excluding innerwear; clothing, excluding innerwear; shoes, excluding slippers; footwear, excluding slippers.

13. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account, as per *Canon*, where the CJEU stated at paragraph 23 of its judgement:

> "In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary."

14. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

15. In *Gérard Meric v Office for Harmonisation in the Internal Market,* Case T- 133/05, the General Court ("GC") stated that:

> "29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut fur Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark."

16. I bear in mind that it is permissible to group goods together for the purposes of the assessment[1].

[1] *Separode Trade Mark* O/399/10

Class 25

Knitwear (clothing); pants (clothing); polo shirts; printed t-shirts: shirts; short-sleeve shirts: t-shirts; tee-shirts; skirts; dresses; suits; neckties; socks; mittens; bandanas (neckerchiefs); shawls: scarfs; swimming suits; outer clothinq; baseball caps; beach caps; caps being headwear; flat caps; berets; shorts; jumpers (pullovers); jumpers (sweaters); polo neck jumpers: sports jumpers; singlets; sports singlets; headbands (clothing); jackets (clothing); apparel (clothing, footwear, headgear), excluding innerwear; clothing and clothing accessories (in this class), excluding innerwear; clothing, excluding innerwear; shoes, excluding slippers;

17. All the aforementioned goods in the applicant's specification are items of clothing which are self-evidently identical or fall within the broader categories of 'clothing' in the opponent's specification in Class 25. The goods are, therefore, identical on the principle outlined in *Meric*.

Footwear, excluding slippers; shoes, excluding slippers;

18. These goods are worn as footwear and in broader terms may be encompassed within the opponent's category of 'parts of clothing, footwear and headgear' if a broader interpretation is taken of the opponent's term i.e. footwear at large. If this is the case, they will be identical either self-evidently or according to *Meric*. If I am wrong about that, and a narrower interpretation is taken, namely the opponent's specification only covers 'parts of footwear' then I consider that the nature of these items will likely be the same or similar to the opponent's footwear, and for the same purpose. These items will likely be sold through the same trade channels to the same users as the opponent's goods and vice versa. I do not find complementarity. I therefore consider the goods to be similar to a medium degree.

The average consumer and the purchasing process

19. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The*

Partnership (Trading) Limited, U Wear Limited, J Fox Limited, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

> "60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The word "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

20. The average consumer for the goods is likely to be a member of the general public. The goods are unlikely to be particularly expensive purchases. They are not likely to be purchased every day, although will be purchased reasonably frequently. Factors such as materials, aesthetics and comfort are likely to be taken into consideration. The goods are likely to be purchased by self-selection from the shelves of a retail outlet, or online equivalent. Consequently, visual considerations will dominate the selection process. However, I do not discount an aural component to the purchase given that advice may be sought from retail assistants and word-of-mouth recommendations may play a part. Consequently, I consider that the average consumer will pay an average degree of attention during the purchasing process.

Comparison of marks

21. 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 Court of Justice of the European Union 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."

22. It would be wrong, therefore, to dissect the trade marks artificially, 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.

23. The respective trade marks are shown below:

Earlier trade mark	Contested trade mark
	CAPRE

24. The opponent submits as follows

"c. self-evidently, the opponent's trade mark and the applicant's mark are visually similar with only 1 letter difference in the middle of both words (the letter P (which is visually similar to the letter R) rather than the letter R);

d. The opponent's trade mark and the applicant's mark are phonetically similar when spoken/heard, both being comprised of two syllables (CA-REE / CAP-RE);

e. As per the case of *Aveda Corporation v Debur India Ltd* [2013] EWHC 589 (Ch) where Arnold J (as he then was) held: "*The human eye has a well-known tendency to see what it expects to see and the human ear to hear what it expects to hear*". In this case, it is quite likely that average consumers would misread, misspeak or mishear 'CAPRE' as 'CARRÉ'"

25. The applicant has not made specific submissions regarding the comparison of the marks, save to say that the marks look different when on clothes and aren't phonetically similar when spoken or heard.

Overall impression

26. I note that the IR is a figurative mark, the word 'CARRÉ', which is written in a stylised white font, set against a black square background. The word 'CARRÉ' is framed by a white rectangle which is set inside the black square. The black square and white rectangle contribute to the overall impression but to a lesser degree and will be seen as a background and frame upon which the word is presented, with the word itself being the main focus of the mark.

27. The contested mark is a word only mark consisting of 'CAPRE'. There are no additional elements to the contested mark and therefore the overall impression lies in the word itself.

Visual comparison

28. The competing marks include words each made up of five letters, four of which are the same and appear in the same order. The only difference in the words is that the third letter in the IR is an 'R', whereas the third letter in the contested mark is a 'P'. I note that there is also an accent above the letter 'É' in the IR which is not present in the contested mark. I agree with the opponent's submission that the letters 'P' and 'R' are visually similar. It is necessary to consider that the contested mark is a word only mark and is, therefore, capable of being presented in any typeface. A word trade mark protects the notional use of the word itself, irrespective of font, capitalisation or otherwise.

29. In the IR, the black square and white rectangle act as a background to the word and only serves to accentuate the word itself and so greater emphasis will be placed on the word rather than the figurative elements. I consider that the accent above the letter 'É' in the IR may be overlooked. Given the visual similarity between the letters 'P' and 'R', and that four out of five letters in the marks are the same, I consider that the respective marks are visually similar to a medium degree.

Aural Impression

30. Neither mark is an English dictionary word and therefore, to the average consumer, it is not clear how either will be pronounced.

31. No articulation will be given to the figurative element of the IR and therefore it will be referred to by reference to the word only. I note that both marks have two syllables. The IR will likely be pronounced as KA-REE or KA-REY, whereas the contested mark is likely to be pronounced as KAP-REE or KAP-REY. The point of aural overlap lies at the beginning and end of the word. This is the same in both marks[2]. The difference in pronunciation arises from the letter 'P' as opposed to the letter 'R' in the middle of the words. Overall, I find a medium degree of aural similarity between the marks.

Conceptual comparison

32. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer, as highlighted in numerous judgments of the GC and the CJEU[3]. I note that the opponent has submitted that "the marks/signs would have no obvious conceptual meaning for the average consumer of the goods in issue, which means a conceptual comparison is not possible and the marks/signs are conceptually neutral". The applicant has not made any specific submissions in respect of a conceptual comparison.

33. I believe that the applicant's mark, 'CAPRE', will be considered to be a meaningless term by the average consumer. The opponent has submitted that the marks have no obvious conceptual meaning for the average consumer, however, it is my own understanding that the word CARRÉ is the French word for square. Whilst a hearing officer is entitled to rely upon his or her own general knowledge[4], I do not consider that the meaning of the word would be sufficiently well known to a substantial proportion of average consumers, and therefore the word will either appear to be a

[2] *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, the General Court noted that the beginnings of word tend to have more visual and aural impact than the ends.
[3] *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R 29
[4] *esure Insurance Ltd v Direct Line Insurance Plc,* [2008] EWCA Civ 842

made-up word, or the average consumer will recognise the word as being French, or from an unidentified foreign language but not know its meaning.

34. Whilst I accept that there may be some consumers who may have some knowledge of the French language and therefore may understand the meaning of the word, given that the average consumers for the goods in issue are members of the UK general public, I do not consider that their knowledge will extend far enough for them to readily identify the meaning of 'CARRÉ'. In my view, a significant proportion of average consumers is far more likely to view the mark as being from either the French language / an unidentified foreign language but not know its meaning, or to be a meaningless word. The opponent's mark will therefore not have a meaning that is immediately graspable, and the marks will be conceptually neutral.

Distinctive character of the earlier trade mark

35. In *Lloyd Schuhfabrik Meyer & Co. GmbH* v *Klijsen Handel BV,* Case C-342/97 the CJEU stated that:

> "22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *WindsurfingChiemsee* v *Huber and Attenberger* [1999] ECR I-0000, paragraph 49).
>
> 23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of

commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)."

36. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The opponent has made submissions regarding the distinctiveness of their mark, submitting as follows:

> "The opponent's trade mark has at least an average / normal degree of distinctive character in connection with the goods in question as CARRÉ does not have any meaning in relation to the Class 25 goods in issue and/or their characteristics. The opponent reserves the right to file evidence of enhanced distinctive character acquired through use".

As no evidence has been filed in support of this, I only have the inherent position to consider.

37. The IR consists of the word CARRÉ, which is written in a stylised white font, set against a black square background. The word 'CARRÉ' is framed by a white rectangle which is set inside the black square. The mark is dominated by the word, with the black box serving to frame and accentuate the word so that the eye is naturally drawn to it. Whilst the stylisation does contribute to the overall impression, it is to a lesser degree as the black box and the rectangle are merely seen as backgrounds upon which the word is placed, contributing to the distinctiveness of the mark but to a lesser degree compared to the word itself. I have found that given that the average consumers for the goods in issue are members of the UK general public[5], the average consumer will be unaware of the meaning of the word 'CARRÉ'. Furthermore, the mark is not descriptive of the goods for which it is registered, nor does it allude to any quality of those goods. I consider the IR overall to have a medium level of inherent distinctiveness.

[5] In *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04, in the context of the assessment of distinctiveness for the purposes of registration, the CJEU held that the distinctive character of a trade mark must be assessed from the perspective of the relevant public in the territory in which registration is sought.

Conclusions on Likelihood of Confusion

38. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related.

39. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle, 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 vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact 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 that he has retained in his mind.

40. I have found as follows:

- Depending on how the opponent's specification is interpreted, the goods at issue are either self-evidently identical or on the principles in *Meric* or a medium degree of similarity.

- I have identified that the average consumer will be members of the general public. They will select the goods primarily by visual means, although I do not discount an aural component;

- I have concluded that an average degree of attention will be paid;

- The contested mark is visually similar to the IR to a medium degree;

- The contested mark is aurally similar to the IR to a medium degree;

- I have found the contested mark and the IR to be conceptually neutral;

- I have found the IR overall to be inherently distinctive to a medium degree;

41. Upon considering the above factors, and bearing in mind the principle of imperfect recollection, I consider the present case represents an example of direct confusion. I consider that the consumer upon seeing the contested mark 'CAPRE' is unlikely to recall the exact spelling of the IR 'CARRÉ', and whilst the IR has a figurative element, I consider that its impact is to a lesser degree as it only serves to accentuate the word itself, with the black box and white rectangle merely forming a background upon which the word is placed. Given the overall similarity between the words both visually and aurally, and the fact that the goods are either identical or similar to a medium degree, I consider that the consumer will overlook the difference created by the third letter of the mark, due to its position in the middle of the mark and the visual similarity of the letters meaning that any differences would be overlooked. I also consider that the accent above the 'E' will also be overlooked and that this will lead to the differences in the words being misremembered. This is particularly so because consumers rarely have the opportunity to compare marks side by side.

42. In case I am wrong about my finding of direct confusion, I will move on to consider whether there is indirect confusion. In *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

> "16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: 'The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark'.

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)."

43. These three categories are not exhaustive; rather, they were intended to be illustrative of the general approach, as has been confirmed by the Court of Appeal[6]. I recognise that a finding of indirect confusion should not be made merely because the competing marks share a common element. In this connection, it is not sufficient that a mark merely calls to mind another mark; this is mere association not indirect confusion[7]. The Court of Appeal has also emphasised that, where there is no direct confusion, there must be a "proper basis" for finding indirect confusion[8].

44. I consider that the consumer upon seeing the contested mark 'CAPRE' is unlikely to recall the exact spelling of the IR 'CARRÉ', and as I have stated, given the similarities between the letters 'P' and 'R', the differences in the words themselves are likely to be overlooked. However, if the average consumer notices the stylisation of the IR, it will take them through the mental process outlined in *L.A Sugar*. I have found the black square and white outline in the IR to act as a background which serves to frame the word itself. In this instance I consider that the average consumer is likely to

[6] *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207
[7] *Duebros Limited v Heirler Cenovis GmbH,* BL O/547/17
[8] *Liverpool Gin Distillery*

find the figurative elements of the IR and the contested mark to be different versions of the same mark, i.e. one used on packaging or advertising for example, as opposed to the word only version (as in the contested mark when the words are misremembered) might be seen as one used in text or in publications both belonging to the same owner. Therefore, I find that if I am wrong about there being direct confusion, there is a likelihood of indirect confusion.

Conclusion

45. The opposition succeeds in full and, subject to any successful appeal, the applicant's mark is refused.

Costs

46. The opponent has been successful and is entitled to a contribution towards its costs in line with TPN 1/2023. In the circumstances I award the opponent the sum of £350 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Filing a notice of opposition and considering the Applicant's counterstatement:	£250.00
Official fee:	£100.00
Total:	£350.00

47. I therefore order Fred George Pearson to pay Culture Kings USA, Inc the sum of £350.00. 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 30th day of April 2025

L Bailey

For the Registrar