O/421/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003924126
BY HENRY HOGAN LTD
TO REGISTER:

henry hogan

IN CLASS 25

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. OP000443495 BY
TOD'S S.P.A

Background and pleadings

1. On 19 June 2023, Henry Hogan Ltd ("the applicant") applied to register in the UK the trade mark shown on the cover page of this decision ("the applicants mark"). The application was accepted and published for opposition purposes on 7 July 2023 and registration is sought for the following goods:

   Class 25: Clothing; Knitwear [clothing]; Jackets [clothing]; Ready-to-wear clothing; Woolen clothing; Garments for protecting clothing; Linen clothing; Headbands for clothing; Clothes; Gloves as clothing; Gloves [clothing]; Jerseys [clothing]; Shorts [clothing]; Denims [clothing]; Cashmere clothing; Knitted clothing; Hoods [clothing]; Windproof clothing; Belts for clothing; Belts [clothing]; Casual clothing; Rainproof clothing; Waterproof clothing; Jackets being sports clothing; Stuff jackets [clothing]; Clothing for leisure wear; Ready-made clothing; Bottoms [clothing]; Woven clothing; Clothing for sports; Sports clothing; Leisure clothing; Athletic clothing; Beach clothing; Men's clothing.

2. On 9 October 2023, TOD's S.p.A ("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 upon the following mark:

   HOGAN

   UK registration no.UK00003659901
   Filing date 24 June 2021; registration date 7 January 2022
   The colour silver is claimed as a feature of the mark
   Relying on some goods, being:

   Class 25: Leather coats; leather jackets; leather trousers; leather skirts; leather tops; leather raincoats; leather long coats; leather overcoats; leather belts; leather braces for clothing; belts; suits; padded jackets; jackets; stuff jackets; jumpers; trousers; jeans; skirts; dresses; coats; overcoats; cloaks; raincoats; parkas; pullovers; shirts; T-shirts; blouses; sweaters; underwear; baby-dolls being

nightwear; bathrobes; bathing costumes; negligée; swim suits; dressing gowns; nightgowns; one-piece dresses; two-piece dresses; evening dresses; shawls; scarves; ties; neckties; gentlemen's suits; dress shirts; aloha shirts; sweatshirts; undershirts; polo shirts; body suits; blazers; shorts; sport shirts; shoes; athletic shoes; slippers; overshoes; low heel shoes; leather shoes; rubber shoes; galoshes; wooden clog; angler shoes; basketball shoes; dress shoes; heels; hiking shoes; rugby shoes; boxing shoes; baseball shoes; lacquered shoes; beach shoes; inner soles; soles for footwear; footwear upper; heelpieces for shoes and boots; non-slipping pieces for shoes and boots; tips for footwear; rain shoes; track-racing shoes; work shoes; straw shoes; gymnastic shoes; boots; ski boots; half boots; arctic boots; football boots; lace boots; field hockey shoes; handball shoes; esparto shoes or sandals; sandals; bath sandals; gloves; winter gloves; leather gloves; mittens; hats and caps; visor (headgear); leather hats and caps.

3. The opponent's mark is based on an identical earlier EUTM that was pending registration as at the date that the UK left the European Union. The opponent applied for the same mark in the UK within nine months of IP Completion Day (being 31 December 2020) and in accordance with Article 59 of the Withdrawal Agreement between the UK and the European Union, it is deemed to have the same filing date as the opponent's identical EUTM, being 5 August 2020. This is, therefore, the relevant date for the purpose of these proceedings.

4. By virtue of relying on section 5(2)(b) of the Act, the opponent's case is that the marks at issue are similar and that the goods of the parties are either identical or similar, resulting in a likelihood of confusion.

5. The applicant filed a counterstatement denying all claims made against it by the opponent.

6. The opponent is represented by Boult Wade Tennant LLP. The applicant is not represented. Only the opponent filed evidence. No hearing was requested and both parties filed written submissions in lieu of the same. This decision is taken following a careful perusal of the papers.

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.

EVIDENCE

8. The opponent's evidence came in the form of the witness statement of Daniela Paull dated 11 April 2024. Daniela Paull is a Chartered Trade Mark Attorney and Senior Associate at the opponent's representative. Their statement is accompanied by two exhibits, being DP1 and DP2. Whilst the purpose of the evidence is not expressly set out, the witness statement says that the searches that have been carried out in the exhibits have been carried out to illustrate that the only trade mark registrations on the UK register containing HOGAN in class 25 are those of the opponent and Perry Ellis International Holdings Limited, two parties that operate in different fields and their respective HOGAN marks have co-existed on the UK register since the 1990's. The witness statement also says that there is one withdrawn application for HOGAN ROX (UK00003625422) which was withdrawn following an opposition by the opponent.

9. The opponent's evidence is noted, however, evidence regarding a previous applicant having withdrawn their application following opposition from the opponent, has no bearing on the present decision. In addition, the fact that the 26 registered trade marks that include the word "hogan" are only owned by two companies (one of which being the opponent) also has no bearing on the assessment I must make in this decision. For the avoidance of doubt, the decision I must make here is multifactorial and is to be based on the principles and case law that I will set out where relevant below.

10. I do not intend to summarise the opponent's evidence any further here (or the parties' submissions for that matter). However, I confirm that I have taken all filed documents into account and will summarise them to the extent deemed necessary below.

DECISION

Section 5(2)(b): legislation and case law

11. Section 5(2)(b) of the Act 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".

12. 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."

13. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

> "(6)(1) In this Act an "earlier trade mark" means –
>
> (a) a registered trade mark or international trade mark (UK) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.

14. The opponent's mark qualifies as an earlier trade mark under the above provisions. As the opponent's mark had not completed its registration process more than five years before the filing date of the applicant's mark, it is not subject to proof of use pursuant to section 6A of the Act. Consequently, the opponent may rely on the goods highlighted in its notice of opposition.

15. 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 Office for Harmonization 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 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

16. The parties goods are as follows:

The opponent's goods	The applicant's goods
Class 25: Leather coats; leather jackets; leather trousers; leather skirts; leather tops; leather raincoats; leather long coats; leather overcoats; leather belts; leather braces for clothing; belts; suits; padded jackets; jackets; stuff jackets; jumpers; trousers; jeans; skirts; dresses; coats; overcoats; cloaks; raincoats; parkas; pullovers; shirts; T-shirts; blouses; sweaters; underwear; baby-dolls being nightwear; bathrobes; bathing costumes; negligée; swim suits; dressing gowns; nightgowns; one-piece dresses; two-piece dresses; evening dresses; shawls; scarves; ties; neckties; gentlemen's suits; dress shirts; aloha shirts; sweatshirts; undershirts; polo shirts; body suits; blazers; shorts; sport shirts; shoes; athletic shoes; slippers; overshoes; low heel shoes; leather shoes; rubber shoes; galoshes; wooden clog; angler shoes; basketball shoes; dress shoes; heels; hiking shoes; rugby shoes; boxing shoes; baseball shoes; lacquered	Class 25: Clothing; Knitwear [clothing]; Jackets [clothing]; Ready-to-wear clothing; Woolen clothing; Garments for protecting clothing; Linen clothing; Headbands for clothing; Clothes; Gloves as clothing; Gloves [clothing]; Jerseys [clothing]; Shorts [clothing]; Denims [clothing]; Cashmere clothing; Knitted clothing; Hoods [clothing]; Windproof clothing; Belts for clothing; Belts [clothing]; Casual clothing; Rainproof clothing; Waterproof clothing; Jackets being sports clothing; Stuff jackets [clothing]; Clothing for leisure wear; Ready-made clothing; Bottoms [clothing]; Woven clothing; Clothing for sports; Sports clothing; Leisure clothing; Athletic clothing; Beach clothing; Men's clothing.

shoes; beach shoes; inner soles; soles for footwear; footwear upper; heelpieces for shoes and boots; non-slipping pieces for shoes and boots; tips for footwear; rain shoes; track-racing shoes; work shoes; straw shoes; gymnastic shoes; boots; ski boots; half boots; arctic boots; football boots; lace boots; field hockey shoes; handball shoes; esparto shoes or sandals; sandals; bath sandals; gloves; winter gloves; leather gloves; mittens; hats and caps; visor (headgear); leather hats and caps.	

17. 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."

18. 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.

19. 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."

20. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), paragraph 12, Floyd J (as he then was) gave the following guidance on construing the words used in specifications:

> "[…] Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless, the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam,

or because the ordinary and natural description of jam was not ‘a dessert sauce’. Each involved a straining of the relevant language, which is incorrect. Where words of phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

21. I bear in mind that it is permissible to group goods together for the purposes of assessment: *Separode Trade Mark*.[1]

22. The opponent’s position is that the goods for which protection is sought in class 25 by the applicant are either identical or highly similar to those for which protection has been granted under the opponent’s mark.

23. As stated at paragraph 5 above, the applicant filed a counterstatement denying all claims made against it by the opponent in their statement of grounds. The applicant stated that their products, primarily plain and basic t-shirts with no visible logos, differ significantly from those that may resemble the opponent’s offerings and this design choice distinguishes the applicant products in the market. The applicant additionally states that the goods offered under the applicant’s mark are not like those offered under the opponent’s mark. In addition, I note that the applicant’s written submissions set out that its brand is positioned within a different market segment than the opponent’s brand. While the opponent targets the luxury fashion market, the applicant is focused on producing basic, logo-free t-shirts that cater to a distinct demographic. The applicant states that the products and the markets are not interchangeable, and there is no overlap in the consumer base.

24. While noted, the above has no bearing on the assessment I am required to make. When considering the likelihood of confusion under Section 5(2)(b) the assessment must be based, in fact, on the concept of 'notional and fair use’ which involves carrying out the comparison of the goods based on the specifications before me, not the goods effectively provided by the parties.[2]

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[1] BL O-399-10 (AP)
[2] *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06 at [66] and *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 at [22]

25. I do not intend to summarise the remaining comments of the parties in full here. However, I confirm that I have taken all filed documents into account and will summarise them to the extent deemed necessary below.

26. The opponent's goods cover a wide range of clothing such as *leather jackets, coats, shirts, trousers, shorts and aloha shirts*. All of these are types of clothing which fall within the applicant's terms of "clothing", "clothes", "ready to wear clothing", "ready-made clothing", "men's clothing" and "linen clothing". As a result, I find these goods to be identical under the principle outlined in *Meric*.

27. I note the opponent has goods such as *jumpers, pullovers and sweaters*. These are all types of clothing that can be knitted, woven or made of cashmere. As such, they all fall within the applicant's terms of "knitwear [clothing]", "woolen clothing", "cashmere clothing", "knitted clothing" and "woven clothing". As such, I find that these goods are identical under the principle outlined in *Meric*. The above goods of the opponent can also cover jerseys, meaning that they also fall within the applicant's term of "jerseys [clothing]", rendering them identical under the principle outlined in *Meric* also.

28. The opponent's goods include *T-shirts, shorts and sport shirts*. All of these are types of clothing that can reasonably be said to be used for sports, leisure, worn on the beach and/or casually. As such, they all fall within the applicant's terms of "clothing for sports", "sports clothing", "leisure clothing", "athletic clothing", "beach clothing", "clothing for leisure wear" and "casual clothing". As a result, I find that these goods are identical under the principle outlined in *Meric*.

29. The applicant's goods specification includes "belts for clothing", "belts [clothing]", "gloves as clothing", "gloves [clothing]", "shorts [clothing]", "bottoms [clothing]" and "stuff jackets [clothing]". While the opponent's specification includes terms that are expressed slightly differently such as *belts, gloves, shorts, trousers* and *stuff jackets* they are still the same goods just described slightly differently. Therefore, these goods are self evidently identical.

30. The opponent's goods include *jackets*. Jackets are commonly windproof, rainproof and waterproof. Jackets can be used for sports or other activities. As such, they

fall within the applicant's goods of "windproof clothing", "rainproof clothing", "waterproof clothing", "jackets being sports clothing" and "jackets [clothing]". As a result, I find that these goods are identical under the principle outlined in *Meric*.

31. The opponent's goods include *jeans*. These are clothes made of denim so are, therefore, identical under the principle outlined in *Meric* to the applicant's term "denims [clothing]". Additionally, many of the opponent's goods such as *jackets, shorts* and *dresses* could be made from denim so the same finding could be said to apply to those goods also.

32. I do not have any submissions for what "garments for protecting clothing" include but I presume it would include garments that go over existing pieces of clothing to protect them, such as aprons or overalls. Given this, I find that "garments for protecting clothing" to be similar to the opponent's goods of *overcoats, coats* and *galoshes*. Their purpose is the same being to protect the users clothing from damage and the trade channels and user will be the same. Given this, I find these goods to be similar to a medium degree.

33. The applicant's specification includes the term "hoods [clothing]". I consider this term to be similar to the opponent's specification of *coats, raincoats* and *parkas*. Their purpose is the same being to protect the user from the elements, i.e. rain, hail etc. While the majority of consumers will not buy a hood separately to an item of clothing some consumers might as they prefer a unique piece of clothing and will stitch the hood onto the garment themselves. The trade channels and user will be the same. Taking all of this into account, I find the goods to be similar to a medium degree.

34. Finally, the applicant's specification includes the term "headbands for clothing". I have no submissions as to the meaning of headbands for clothing and presume this means headbands for the user to wear on their head. If this is correct, the closest comparable term in the opponent's specification is *visor (headgear)*. I find the user and trade channels would be the same. The "headbands for clothing" could be worn to absorb sweat or to keep the user warm, whereas the *visor (headgear)* is worn to keep the sun from the users eyes. That being said, there is a shared purpose to some degree in that a garment is being worn on the head

which has decorative qualities for style purposes. Overall, I find the goods to be similar to a medium degree.

The average consumer and the nature of the purchasing act

35. The case law, as set out earlier, requires that I determine who the average consumer is for the respective parties' goods. I must then decide the manner in which these goods are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

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

36. The goods at issue are ordinary consumer goods that will be selected by the general public at large. They will likely be available from a retail outlet and their online or catalogue equivalents (where available). In physical stores, the goods will be displayed on shelves or racks where they will be self-selected by the consumer. When the selection takes place online or via a catalogue, the goods will be selected after viewing an image of them on a webpage or in a catalogue. This means that the mark will be seen and so the visual element of the mark will be the most significant.[3] Clearly, the visual component will dominate the selection process, though I do not discount the aural component entirely as suggestions may come from word-of-mouth recommendations or advice from sales assistants. In respect of the level of attention paid, I am of the view that when selecting the goods, the consumer is likely to consider factors such as the suitability of the goods, materials used, cut, quality, aesthetic appearance and durability. The cost of purchase is

[3] *New Look Limited v OHIM*, Joined cases T-117/03 to T-119/03 and T-171/03, paragraph 50

likely to vary and the goods will be purchased on a reasonably frequent basis as the need for them arises. Generally speaking, the average consumer will pay a medium degree of attention when selecting the goods.

Comparison of marks

37. 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.

38. 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."

39. 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.

40. The respective trade marks are shown below:

The opponent's mark	The applicant's mark
HOGAN	henry hogan

41. In its notice of opposition and statement of grounds, the opponent argues that the marks are visually and aurally highly similar due to the element ‘hogan’ being in both marks. The opponent states that the common element of ‘hogan’ also creates conceptual similarity.

42. In its counterstatement, the applicant submits that its mark is distinct. It states that its mark establishes a unique brand identity, significantly different from the opponent’s mark. The applicant states that the inclusion of “henry” changes the commercial impression and clearly distinguishes their brand in consumer perception. The visual and phonetic characteristics of the applicant’s mark are distinct from the opponent’s mark and these differences significantly reduce the likelihood of confusion or mistaken identity between the brands. Additionally, the applicant states that their logo design is starkly different from the opponent’s logo reducing any potential for consumer confusion and emphasizing the applicant’s brands uniqueness. In making this point, the applicant has not referred to any separate logo design and, on this point, I note that the applicant’s mark is not a ‘logo’ per se but simply a word only mark. While this is capable of being used in any standard typeface (more on this below), its use does not extend to that in a ‘logo form’.

43. As stated at paragraph 6 above, I have submissions from both the opponent and the applicant as to the similarity of the marks at issue. While I do not intend to reproduce those submissions here, I confirm that I have taken them into account in making the following comparison.

Overall impression

44. The applicant’s mark is a word only mark consisting of ‘henry hogan’ in a black lowercase font. I consider that these two words, together, will be recognised as a full name, being a forename and surname. As such, each word will inform the other so the overall impression of the mark lies across both words equally. There are no other elements that contribute to the overall impression of the mark which lies equally across the mark.

45. As for the opponent's mark, this is a figurative mark which consists of the word 'HOGAN' in upper case in a silver standard font. I appreciate that silver is claimed as a feature of the mark so the mark cannot be presented in a different colour, however, this will have a negligible impact on the mark as a whole. Located above the letter 'G' is a figurative element consisting of a wing outlined in silver with two curved silver lines each side of the wing following the curvature of the top of the letter 'G'. 'HOGAN' is presented in a fairly standard typeface that will have very little impact on the overall impression of the mark. I remind myself that consumers tend to be drawn to parts of the mark that can be read. Given this, I find that it is 'HOGAN' that will dominate the overall impression of the mark and the figurative element will play a secondary role due to its size and position within the mark.

Visual comparison

46. At the outset of the comparison, I consider it necessary to set out that the applicant's mark, being 'henry hogan' is a word only mark in black and white. As such, it is capable of being presented in the exact same typeface and colour as that used in the opponent's mark on the basis that the opponent's typeface is a standard one. Whilst it is not legitimate to perform a comparison between a word mark and the figurative presentation of a word by considering specific ways in which the word might be presented, the point I make here is that the word mark is not limited to any particular typeface or colour and therefore the typeface and colour in which the opponent's figurative mark is presented does not provide a point of distinction in itself.[4] Visually, the opponent's mark and the applicant's mark overlap through the use of the word 'hogan'. The points of visual difference are the wing device above the letter 'G' of the opponent's mark as well as the word 'henry' that sits at the beginning of the applicant's mark. Regardless of the various roles these elements play in their respective marks, they all contribute as points of visual difference between them. Overall, bearing in mind the overall impressions of the marks and the shared use of 'hogan' but also reminding myself that consumers

[4] See *HERNO S.p.A. v Miss Sparrow Ltd*, BL O/954/22, paragraphs 23 and 34.

tend to focus on beginnings of marks,[5] I find that the marks are visually similar to a medium degree.

Aural comparison

47. The opponent's mark will be pronounced 'HOE-GUN'. As for the applicant's mark, this will be pronounced 'HEN-REE HOE-GUN'. The applicant's mark has two additional syllables, which sit at its beginning which, as above, is where consumers tend to focus. Overall, owing to the identical use of 'HOGAN', I find that the marks are aurally similar to a medium degree.

Conceptual comparison

48. Conceptually, the opponent submits that insofar as consumers perceive the word 'Hogan' contained in both marks as a surname, they are conceptually highly similar and the common element 'Hogan' creates conceptual similarity. The opponent further submits that for those consumers that do not recognise 'Hogan' as a surname, the marks are conceptually neutral. The applicant submits that the conceptual differences between the marks are significant.

49. In comparing the marks, I refer to the case of *Luciano Sandrone v EUIPO* T-268/18 wherein the GC stated that:

> "85. […] a first name or a surname which does not convey a 'general and abstract idea' and which is devoid of semantic content, is lacking any 'concept', so that a conceptual comparison between two signs consisting solely of such first names or surnames is not possible.
>
> 86. Conversely, a conceptual comparison remains possible where the first name or surname in question has become the symbol of a concept, due, for example, to the celebrity of the person carrying that first name or surname, or where that first name or that surname has a clear and immediately recognisable

[5] *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

semantic content.

87. The Court has thus previously held that the relevant public would perceive marks containing surnames or first names of persons as having no specific conceptual meaning, unless the first name or surname is particularly well known as the name of a famous person (see, to that effect, judgments of 18 May 2011, *IIC v OHIM— McKenzie (McKENZIE*), T502/07, not published, EU: T:2011:223, paragraph 40; of 8 May 2014, *Pedro Group v OHIM— Cortefiel (PEDRO)*, T38/13, not published, EU:T:2014:241, paragraphs 71 to 73; and of 11 July 2018, *ANTONIO RUBINI*, T707/16, not published, EU:T:2018:424, paragraph 65)."

50. In addition to the above, I note that the GC has also found that names will not be conceptually similar unless they are recognised as being linked with the same family.[6]

51. In comparing the marks, I accept they both consist of the word 'hogan'. 'Hogan' is a surname and while this will be understood it does not have any known concept outside of that. Further, it will not be immediately understood as a reference to a specific celebrity. As such, it is not capable of being compared. The conceptual position is therefore neutral.

52. However, if I am wrong in reaching a conclusion of conceptual neutrality, the shared use of the surname 'hogan' is not particularly remarkable as it is simply a surname that, while not being overly common, will be well known, so the shared use between the marks would not be surprising to the consumer. Given the shared use of the word 'hogan' will not be surprising, the difference in concept created by 'henry' is such that it renders the marks conceptually similar to a low degree.

[6] *Lidl Stiftung v OHIM*, Case T-715/13

Distinctive character of the opponent's mark

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

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

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

54. 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 or services, 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 that has been made of it. In the present case, it is noted that the opponent has pleaded that its mark enjoys a high level of distinctiveness and that the evidence filed backs this up. It is not clear to me whether the reference to the evidence is meant to be viewed in support of an argument that the mark enjoys an enhanced degree of

distinctiveness. Even if that was the case, enhanced distinctiveness arises as a result of the use made of a mark. In respect of this point, the opponent does not rely on any actual use (such as turnover, for example) but simply claims that only it and one other party owned marks for the word 'HOGAN' in the UK. Firstly, I have set out above that this is of no assistance here. However even if it were, it would not assist the present assessment. As a result, I only have the inherent position to consider.

55. The case law in relation to the distinctiveness of personal names was set out by the CJEU in *Nichols plc v Registrar of Trade Marks*.[7] The CJEU's judgment makes it clear that personal names are not devoid of distinctiveness per se and that it is not appropriate to apply stricter criteria to the assessment of the distinctiveness of personal names than to other types of marks.

56. As previously outlined, the opponent's mark is a figurative one that consists of the word 'HOGAN' and a wing device that sits above the letter 'G'. While the wing device element will not be overlooked, it does not contribute to any material degree to the distinctiveness of the mark beyond that which is created by the word 'HOGAN'. As such, I find that the distinctiveness of the mark lies in the word 'HOGAN' which is a well-known surname in the UK. I appreciate that this neither describes nor alludes to the goods upon which the opponent relies. However, in *Harman International Industries, Inc v OHIM*, Case C-51/09P, the CJEU found that:

> "Although it is possible that, in a part of the European Union, surnames have, as a general rule, a more distinctive character than forenames, it is appropriate, however, to take account of factors specific to the case and, in particular, the fact that the surname concerned is unusual or, on the contrary, very common, which is likely to have an effect on that distinctive character. That is true of the surname 'Becker' which the Board of Appeal noted is common."

57. In *El Corte Inglés, SA v OHIM*, Case T-39/10, the GC found that:

[7] Case C-404/02

"54. As the applicant asserted in its pleadings, according to the case-law, the Italian consumer will generally attribute greater distinctiveness to the surname than to the forename in the marks at issue (Case T-185/03 *Fusco v OHIM – Fusco International (ENZO FUSCO)* [2005] ECR II 715, paragraph 54). The General Court applied a similar conclusion concerning Spanish consumers, having established that the first name that appeared in the mark in question was relatively common and, therefore, not very distinctive (Case T-40/03 *Murúa Entrena v OHIM – Bodegas Murúa (Julián Murúa Entrena)* [2005] ECR II-2831, paragraphs 66 to 68).

55. Nevertheless, it is also clear from the case-law that that rule, drawn from experience, cannot be applied automatically without taking account of the specific features of each case (judgment of 12 July 2006 in Case T 97/05 *Rossi v OHIM – Marcorossi (MARCOROSSI),* not published in the ECR, paragraph 45). In that regard, the Court of Justice has held that account had to be taken, in particular, of the fact that the surname concerned was unusual or, on the contrary, very common, which is likely to have an effect on its distinctive character. Account also had to be taken of whether the person who requests that his first name and surname, taken together, be registered as a trade mark is well known (Case C 51/09 P *Becker v Harman International Industries* [2010] ECR I 5805, paragraphs 36 and 37). Likewise, according to the case-law cited in the previous paragraph, the distinctive character of the first name is a fact that should play a role in the implementation of that rule based on experience."

58. Taking all of the above into account and bearing in mind that 'HOGAN' will be readily identified as a surname to UK consumers, I am of the view that it enjoys a medium degree of distinctiveness. On this point, I appreciate that the mark neither describes nor alludes to the goods upon which the opponent relies. However, the use of a popular surname as a reference to the person offering of the goods at issue is unlikely to be remarkable to consumers in the UK.

Likelihood of confusion

59. 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 and services down to the responsible undertakings being the same or related. 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 services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's 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 they have retained in their mind.

60. Whilst conducting a global assessment of the likelihood of confusion I must be aware of the fact that not all aspects of the respective marks will necessarily have the same impact. For example, the importance of the respective visual, aural and conceptual aspects will be dependent on factors such as the way the goods at issue are marketed, and in which type of store/platform they are made available.

61. Throughout the course of this decision, I have found that the respective goods range from being identical to similar to a medium degree. The average consumers are members of the general public at large who will select the goods via primarily visual means (though I do not discount an aural component) after having paid a medium level of attention during the purchasing process. I have found the marks to be similar to a medium degree from a visual and aural perspective. The position is neutral from a conceptual perspective though I have made a finding of conceptual similarity to a low degree in the event that some concept is attributed to the surname 'Hogan'. I have found the opponent's mark to possess a medium degree of inherent distinctive character.

62. In considering the issue of confusion, I am of the view that it is necessary to first consider the *Medion* principle, the correct approach to which was set out by Arnold J (as he then was) in the case of *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch). In that case, the judge said:

> "18. The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.
>
> 19. The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks – visually, aurally and conceptually – as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.
>
> 20. The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).
>
> 21. The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive

role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors."

63. In its submissions, the applicant submits that the applicant's mark should be evaluated as a whole. I agree with this approach as 'Hogan' is a well known surname in the UK and 'Henry' is a common forename in the UK. Therefore, both names will be used together to refer to an individual not just with the name 'Henry' or just with the name 'Hogan', but with the name 'Henry Hogan'. Standing back and looking at the mark like this, as most average consumers would, I find that 'henry hogan' would be seen as one, not two signs and will, therefore, form a unit. On this point, I refer to paragraph 20 of *Whyte and Mackay* (cited above) which sets out that the *Medion* principle does not apply when a mark will be viewed as a unit. Consequently, I find that the *Medion* principle is not applicable here.

64. Even though I have discounted the relevance of the *Medion* principle, this does not mean that there cannot be confusion and I will, therefore, proceed to consider the issue in the ordinary way.

65. Taking all of the above into account and even bearing in mind the principle of imperfect recollection, I do not consider that consumers would inaccurately recall or misremember the marks for one another. In short, I do not consider that the presence of the word 'Hogan' in the marks is sufficient to create a necessary degree of similarity between the marks, especially as a finding of direct confusion on this basis would be as a result of the consumer overlooking the prefix, being 'Henry', which I do not consider would occur, especially given consumers pay more attention to the words at the beginning of marks. On this point, I appreciate that common elements that sit at the end of marks may be sufficient to create a likelihood of confusion.[8] However, I do not consider that this is applicable here. In my view, the shared use of 'Hogan' is not sufficient to result in consumers overlooking the word 'henry' in the applicant's mark. It is my view that when looking to recall the marks, the consumer will pin their recollection of the applicant's mark

[8] *Bristol Global Co Ltd v EUIPO*, T-194/14

on the mark as a whole, being 'henry hogan'. Consequently, I find that there is no likelihood of direct confusion, even when the marks are considered on identical goods.

66. That leaves indirect confusion to be considered. In respect of such, I remind myself of the case of *L.A. Sugar Limited v By Back Beat Inc,* Case BL O/375/10, wherein 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)".

67. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person *in Cheeky Italian Ltd v Sutaria*,[9] 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". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

68. It is not sufficient that a mark merely calls to mind another mark: *Duebros Limited v Heirler Cenovis GmbH*.[10] This is mere association not indirect confusion.

69. The types of examples of indirect confusion as set out in *L.A. Sugar* (cited above) are not exhaustive. However, they are the most usual circumstances where indirect confusion may arise. In my judgment, none of them apply here. The word 'HOGAN' is a well-known surname and it is, plainly, not so distinctive that consumers would assume that no-one else but the brand owner would be using it in a trade mark. In respect of whether the applicant's mark includes the addition of a non-distinctive element, I am of the view that it does not. The word 'henry' is equally dominant in the applicant's mark and, therefore, cannot be considered a logical addition that indicates a sub-brand. This is especially the case given that 'henry' does not indicate a certain type of goods for which the sub-brand or brand extension could be said to relate. Moving on, I do not consider that the marks fall within category (c) of *L.A. Sugar* on the basis that they do not consider a change of one element in the way described by the examples given (i.e. BRAT FACE and FAT FACE). Lastly, it seems improbable that the applicant's mark would be taken as signifying a collaboration between the opponent and another party. I say this because, as I understand it, collaborations would rarely be referred to in a way that would take the names of two brands and combine them to create a separate unitary meaning.

[9] BL O/219/16
[10] BL O/547/17

For example, in the present case, the addition of ‘henry’ to ‘HOGAN’ would be seen as a reference to an individual person so would, in my view be illogical. In such circumstances, I consider it reasonable to suggest that any collaboration would not reference a full name but would, instead, be referred to as ‘henry & HOGAN’ or ‘henry x HOGAN’, for example. Lastly, even if it were the case that the consumer was to call to mind the opponent’s mark upon seeing the ‘henry hogan’ mark, I have set out above that this would be mere association and not indirect confusion.

70. Taking all of the above into account, I find that there exists no likelihood of indirect confusion, even when the consumers are confronted by the marks on identical goods.

CONCLUSION

71. The opposition fails in its entirety. Therefore, the applicant’s mark may, subject to any successful appeal of my decision, proceed to registration in respect of all of the goods for which protection was sought.

COSTS

72. As the opposition has been unsuccessful, it would ordinarily be the applicant that would be entitled to an award of costs. However, as it has not instructed professional representatives, it was invited by the Tribunal to indicate whether it intended to make a request for an award of costs, including accurate estimates of the numbers of hours spent on a range of activities and any travel costs relating to defending the proceedings. It was made clear by way of the Tribunal’s correspondence dated 29 July 2024 that, if the pro-forma was not completed by 26 August 2024, costs, other than official fees arising from the action (excluding extensions of time), may not be awarded. The applicant did not return a completed pro-forma to the Tribunal and as it did not incur any official fees in these proceedings, I hereby make no order as to costs.

Dated this 14th day of May 2025

N Barratt

For the Registrar