O/0655/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003985080

IN THE NAME OF MAGNERS GB LIMITED

TO REGISTER THE FOLLOWING TRADE MARK:

DARE TO BE RARE

IN CLASSES 3, 6, 9, 11, 14, 16, 18, 19, 20, 21, 24, 25, 26, 28, 32, 33, 35, 36, 38, 39, 40, 41, 42 AND 43

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. OP000446631

BY RAJESH TALWAR

Background and pleadings

1. On 28 November 2023, Magners GB Limited ("***the Applicant***") applied to register the trade mark shown on the cover page of this decision in the UK. The application was accepted and published in the Trade Marks Journal on 26 January 2024 in respect of goods and services in classes 3, 6, 9, 11, 14, 16, 18, 19, 20, 21, 24, 25, 26, 28, 32, 33, 35, 36, 38, 39, 40, 41, 42 and 43.

2. On 26 March 2024, Rajesh Talwar ("***the Opponent***") opposed the application under Section 5(2)(b) of the Trade Marks Act 1994 ("***the Act***"). The opposition is directed against some of the goods and services in the application, as set out in the Annex A to this decision. The Opponent relies upon the following two marks ("***the Earlier Marks***"):

   1) "***the '776 Mark***"

   Mark: **RARE**

   UK Registration number: UK00002493776
   Filing date: 26 July 2008
   Date of registration: 25 August 2013
   Goods and services relied upon:
   Class 25: Clothing.
   Class 35: The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase clothing from a retail outlet and by means of the Internet.

   2) "***the '985 Mark***"

   Mark: **RARE LONDON**

   UK Registration number: UK00002588985
   Filing date: 25 July 2011
   Date of registration: 25 August 2013
   Goods and services relied upon:
   Class 25: Clothing.

Class 35: Retail services connected with the sale of clothing.

3. By virtue of their respective earlier filing dates, the Opponent's above registrations constitute earlier marks within the meaning of section 6 of the Act. As the Earlier Marks completed their registration procedure more than five years before the filing date of the Contested Mark, they are, in principle, subject to the use provisions set out in section 6A of the Act. The Opponent has stated that it has used the marks for all the goods and services relied on.

4. In its statement of grounds, the Opponent submits that as the marks share use of the distinctive word 'RARE', this increases their visual, phonetic and conceptual similarity and that the goods and services are either identical or similar. The Opponent, thus, contends that the similarity of the trade marks and the identity or similarity of the goods and services is likely to give rise to likelihood of confusion including, in particular, a likelihood of association between the competing marks as the consumers would perceive the Contested Mark as a brand extension of, or slogan relating to, the brand 'RARE' or 'RARE LONDON'. For these reasons, the Opponent requests the application to be refused and an award of costs made in its favour.

5. On 20 May 2024 the Applicant filed a counterstatement within which it denied the claims made by the Opponent and it requested the Opponent to file proof of use for both earlier registrations relied upon.

6. The Applicant is represented by HGF Limited; the Opponent is represented by Wilson Gunn.

Relevance of EU law

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 and submissions

8. During the evidence rounds, only the Opponent filed evidence. This was in the form of a witness statement from Rajesh Talwar. Mr Talwar has been Director, person with significant control and CEO of GLOBAL FASHION BRANDS LIMITED (i.e., the Opponent) since the company's incorporation in 2018. Therefore, Mr Talwar is duly authorised to provide evidence on behalf of the Opponent. Mr Talwar's witness statement is signed and dated 22 July 2024, and it is accompanied by Exhibit RT1 – RT8.

9. Neither party requested a hearing, however both parties filed submissions in lieu.

10. I will not summarise the evidence and submissions here, but I will refer to them as and where appropriate during this decision. This decision is taken following a careful perusal of the papers.

Preliminary matters

11. I note that the Applicant, in its submissions in lieu, requested that the terms "*clothing for children; clothing for babies; bibs for babies*" are removed from class 25 and the same words deleted from the class 35 services.[1] I appreciate that at any time the Applicant is entitled to request a restriction of the applied-for specification. To do so, however, the Applicant is required to file a Form TM21B and clearly set out, for each class it intends to restrict, the proposed amendments. As such, in the absence of an approved Form TM21B, I will carry out my assessment of the respective goods and services on the basis of the Applicant's current specification.

Approach

12. The Opponent relies on two earlier marks for the opposition at hand as set out above in this decision. As both marks are equally subject to proof of genuine use and have essentially identical specifications, I find that the '776 Mark represents the Opponent's strongest case. This is because the '985 Mark contains the additional verbal element 'LONDON' which introduces an obvious further point of visual, aural and conceptual difference between this earlier mark and the Contested Mark. For the purposes of this opposition, if the Opponent cannot

[1] Applicant's submissions in lieu dated 20 November 2024, pages 14 and 15.

succeed on the basis of its earlier '776 Mark, it is clearly in no better position based upon the other earlier mark (i.e., the '985 Mark). I proceed accordingly.

Decision

Section 5(2)(b)

13. The opposition is based upon Section 5(2)(b) of the Act, which 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."

14. Section 5A reads:

> "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."

Case law

15. The leading authorities which guide me are from the Court of Justice of the European Union (CJEU): *Sabel BV v Puma AG,* Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and Bimbo SA v OHIM, Case C-591/12P.

The principles

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

(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; Page 8 of 20

(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 and services

16. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the CJEU in *Canon,* Case C-39/97, the court stated at paragraph 23 that:

> "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.

17. Guidance on this issue has come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

    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.

18. In *Gérard Meric v OHIM,* Case T-133/05, the General Court ("GC") stated that:

> "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 für 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".

19. In *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, Lord Kitchin set out the proper approach to considering terms in specifications:

> "365. […] The correct approach, as a matter of principle, in considering a specification of services which is defined by terms which are not clear or precise, is to confine the terms used to the substance or core of their possible meanings: see, for example, *Reed Executive plc v Reed Business Information Ltd* [2004] EWCA Civ 159; [2004] RPC 40, at para 43. So too, if a specification of goods is defined by terms which are ambiguous, then it should be confined to those goods which are clearly covered. These principles are consistent with first, the requirement that the specifications of goods and services must be clear and precise so that others know what they can and cannot do; and secondly, general fairness because any ambiguity is the responsibility of the owner of the mark. If despite this, the words used are still unclear so that they cannot be interpreted, then it is permissible to disregard them. But, in my opinion, that will rarely be the case."

20. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

> "[…] 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 or 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. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

> "In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase."

22. For the purposes of considering the issue of similarity of the goods and services, it is permissible to consider groups of terms collectively where appropriate: *Separode Trade Mark*, BL O-399-10.

23. Annex B to this decision shows a table detailing the goods and services for comparison. Having carefully considered the respective specifications, I find that some of the terms are identical. I have provided below an example of such identical terms.

Class 25

24. The Earlier Mark features the term "*clothing*" in class 25. The Applicant's specification in class 25 includes various terms that can be generally defined as 'clothing' (e.g., "*shirts*"; "*dresses*"; "*sweatshirts*"; "*trousers*"; "*outerwear*"). Therefore, I find that at least some of the Applicant's terms in class 25 fall within

the Opponent's wider category "*clothing*" and are identical in line with the principle outlined in *Meric*.

Class 35

25. The Opponent's specification features the term "*The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase clothing from a retail outlet and by means of the Internet*". The Applicant's specification in class 35 contains the term "*retail services, electronic shopping retail services, retail services provided by mail order, all connected with the sale of clothing […]*". Both terms consist of clothing retail services and are self-evidently identical.

26. In light of these findings, and for reasons which will later become apparent, I will first assess the likelihood of confusion with regard to these terms, having proceeded as if genuine use of the Opponent's goods and/or services had been proven.

Average consumer and the purchasing act

27. It is necessary for me to determine who the average consumer is for the goods and services in question; I must then determine the manner in which the goods and services are likely to be selected by the average consumer in the course of trade.

28. The average consumer of the category of goods and services concerned is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods and services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97.* 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:

> "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."

29. The Opponent submitted that:

> "*The opposed goods and services all relate to clothing, footwear, headgear, bags, umbrellas and similar goods (in both physical and digitals forms). The physical goods will be sold in traditional retail outlets, through catalogues and on the Internet. The digital goods may be sold online, but they may also be offered in conjunction with the physical goods through a traditional retail outlet by means of a code or token provided with, e.g. an item of clothing. The average consumer of such goods and services is a member of the general public who is likely to select the goods primarily by visual inspection but may also seek advice from sales staff and therefore rely on oral communication.*
>
> *The degree of attention paid by consumers of the opposed goods is likely to be no greater than average. It should be borne in mind that, in the era of "fast fashion", clothing and similar goods are increasingly viewed as semi-disposable items, with many articles of clothing costing the same as or less than the cost of a takeaway meal. In such circumstances, consumers may pay a lower than average degree of attention in the course of the purchasing decision*".[2]

30. The Applicant submitted that:

> *"[…] the average consumer for the relevant goods applied for is the general public, who is likely to purchase the goods through retail stores, whether bricks and mortar or online. It is submitted that the general public will pay no less than medium attention when purchasing the relevant goods and associated retail services*".[3]

31. I have considered the parties' submissions above and I agree that the average consumer for the goods in class 9 (e.g., software for digital clothing and accessories), class 18 (e.g., umbrellas, bags, wallets, purses, baggage tags,

[2] Opponent's submissions in lieu dated 20 November 2024, [16] and [17].
[3] Applicant's submissions in lieu dated 20 November 2024, [37].

clothing for animals), and class 25 (clothing) will be a member of the general public. I also find that the cost of purchase for these goods is likely to vary but not to be excessively high, and the goods will be purchased relatively frequently. Even where the goods are of low cost and purchased relatively frequently, a number of factors will still be considered by the average consumer during the purchasing process. When purchasing the goods, consideration will be made of the price, quality, suitability and for some of the goods, the latest trends. Generally speaking, the average consumer will pay a medium degree of attention during the purchasing process for the goods at issue.

32. The Applicant, in its submissions in lieu, also stated that "*for wholesale services, it is submitted that the average consumer would be a business user – who would pay a higher than average degree of attention when selecting the services*".

33. I agree with the Applicant that part of the relevant public for the services in class 35 (retail of clothing) could be businesses and they would pay a higher-than-medium level of attention. However, I also find that another part of the relevant public for these services is likely to be the general public. The services will range in price but, overall, they are likely to be fairly inexpensive. The goods purchased under the services are of the kind that consumers would purchase fairly regularly (i.e. clothing), consequently the services will be utilised fairly regularly. I find that the selection process is likely to be more casual than careful. However, when selecting the services, the general public will still consider factors such as the range of goods on offer, as well as the quality and speed of the service. Overall, the general public will demonstrate a medium degree of attention during the purchasing process. Following from the above, I will assess the likelihood of confusion from the perspective of the general public since they are the group who will pay the lower degree of attention.[4]

34. I consider the purchasing process of the goods and services to be mainly visual with the goods and services likely being purchased following an inspection of shopfronts, obtained by self-selection from the shelves in retail outlets, selected from online catalogues (i.e., pictures of items on websites, especially for digital clothing/accessories in class 9); however, I do not discount aural considerations

[4] Case T-356/14, [25] – [26].

will play their part, particularly when advice is sought from sales representatives or for word of mouth recommendations.

Comparison of the marks

35. It is clear from *Sabel BV v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components.

36. 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".

37. 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 trade marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the trade marks.

38. The respective trade marks to be compared are as follows:

Earlier trade mark (**"*the '776 Mark*"**)	**Contested trade mark**

RARE	**DARE TO BE RARE**

Overall impression

39. The Earlier Mark consists of the word "RARE" in standard font. The mark's overall impression lies in the single word that forms the mark.

40. The Contested Mark is comprised of the word combination "DARE TO BE RARE" in plain font. The Opponent submitted that "*the identical word RARE forms the dominant component of the Subject Mark*".[5] The Applicant denied that 'RARE' is the dominant part of the Contested Mark.[6] I agree with the Applicant. The words in "DARE TO BE RARE" are arranged in a syntactically correct structure and convey a clear message (i.e., an inspirational slogan). Therefore, the words forming the Contested Mark create a unitary meaning and the overall impression of the mark resides in the whole word combination of which it is composed.

Visual similarity

41. The Earlier Mark is the single four-letter word 'RARE' all capitalised and represented in standard typeface. The Contested Mark comprises the four-word phrase 'DARE TO BE RARE', counting a total of twelve letters, in ordinary typeface and represented all in upper case.

42. The Opponent, in its statement of grounds, submitted that "*there is visual similarity owing to the presence of this* ['RARE'] *identical word in each mark*". The Opponent also directed me to the decision *Bristol Global CO Ltd v EUIPO* (T-194/14) where the General Court held that *"[…] an at least partial identity between two marks may be an indication of their visual similarity*".

[5] Opponent's statement of grounds dated 26 March 2024, [3].
[6] Applicant's counterstatement dated 20 May 2024, [6].

43. The Applicant contended that "*the Opponent's mark is the word RARE. Recognising that this word is included in the Applicant's mark, the Applicant recognises that there is scope for a finding of some similarity between the marks. However, it is the Applicant's position that overall, the mark DARE TO BE RARE is materially different from RARE* solus*. The words DARE TO BE appear at the front/beginning of the mark, creating further distance between the two marks. It is submitted that the numerous differences between the marks outweigh any similarities. It is submitted that the marks are not visually similar or at most, visually similar to a low degree*".[7] The Applicant also directed[8] me to a prior decision from the Tribunal (BL O/028/22) submitting that when comparing 'SWIPE' and 'ANY SWIPE CAN CHANGE YOUR LIFE' the Hearing Office found a low level of visual similarity. To this regard, firstly, whilst the content of this decision is noted, it is well established that I am not bound by previous decisions of this Tribunal, the EUIPO or other National Offices. Secondly, I note that the Applicant referred me to paragraph 100 of the decision which considers the visual similarity of 'SWIPE' with the earlier marks 'ANY SWIPE CAN CHANGE YOUR LIFE' and 'SWIPE SESSIONS'. These marks do not have a syntactical structure similar to the Contested Mark and place the only identical word at the beginning. Therefore, I do not find that the section of this decision highlighted by the Applicant would support me in assessing the degree of visual similarity of the marks at hand. Nonetheless, I find paragraph 97 of decision O/028/22 to be of some relevance for the instant case as it compares the single word 'SWIPE' and the slogan 'LOVE AT FIRST SWIPE'. The Hearing Officer found that (original emphasis):

> "*[…] since the average consumer normally perceives a mark as a whole, and does not proceed to analyse its various details, the presence of an additional three words, totalling an additional eleven letters at the beginning of the mark, has a significant visual impact and I consider the marks to be* ***visually similar to a low degree***".

44. Turning to the case at hand, the shared word 'RARE' is placed at the end of the Contested Mark and the mark's initial part 'DARE TO BE –' creates a "*further*

[7] Ibid [32].
[8] Applicant's submissions in lieu dated 20 November 2024, [35].

distance between the two marks" as correctly submitted by the Applicant. In this respect, it is recalled that words are normally read from left to right[9] and that the initial part of a mark normally has a greater impact, both visually and aurally, than the following or final parts.[10] The Contested Mark is longer than the single word 'DARE' adding three words (for a total of eight letters), it forms a meaningful phrase and places the word 'RARE' at the end of it. Having considered the parties' arguments and keeping in mind the marks' overall impressions, I find the respective marks have a low degree of visual similarity.

Aural similarity

45. The Earlier Mark is comprised of the one-syllable word 'RARE'. The Contested Mark comprises the longer four-syllable phrase 'DARE TO BE RARE'.

46. The Opponent argued that "*the word RARE (together with the infinitive "to be") makes up the object of the sentence and as such, and being also the final word in the sentence, it plays a dominant role within it […]*".[11] The Applicant contended that "*the Applicant's mark is likely to be pronounced in four syllables, being dair-to-bee-rair. The Opponent's sign is likely to be pronounced in one syllable as rair. It is submitted that the marks are not aurally similar to any degree but at most, are aurally similar to a low degree*".[12]

47. The respective marks overlap in the word 'RARE', placed at the end of the Contested Mark. The Contested Mark features English dictionary words that are structured in accordance with the English grammar rules to convey a specific meaning. All words in both the Earlier Mark and Contested Mark are English dictionary words and the relevant consumer will voice them accordingly (including an identical enunciation of 'RARE' in both marks). In light of the above considerations, I find, overall, the respective marks to be aurally similar to a low degree.

Conceptual similarity

[9] *New Look Ltd v European Union Intellectual Property Office*, Joined Cases T-117/03 to T-119/03 and T-171/03, [28].
[10] *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, [81].
[11] Opponent's submissions in lieu dated 20 November 2024, [29].
[12] Applicant's submissions in lieu dated 20 November 2024, [33].

48. The Opponent did not make direct submissions concerning the meaning of 'RARE'. However, the Opponent submitted that "*the word 'RARE' has at least a medium degree of distinctiveness for the goods and services in question. None of the items are goods/services in relation to which the adjective 'rare' can readily be applied. It would not make any sense to refer to goods or services such as clothing or retail of clothing as being 'rare' (which is a word suited to, for example, gemstones, antiques etc and not ordinary consumer goods)*". [13] Thus, it appears that the Opponent intends (and refers to) the word 'RARE' as having its ordinary dictionary meaning of something uncommon and valuable.

49. The Applicant submitted that "*'RARE' is likely to be interpretated by consumers as meaning that the goods or services offered under the mark are uncommon or scarce. Meanwhile […] the Applicant's DARE TO BE RARE mark is likely to be interpreted as encouraging consumers to be brave enough to be uncommon or different. It is submitted that the marks are not conceptually similar to any material degree*".[14]

50. Considering both parties' submissions I find that they agree on the dictionary meaning of the word 'RARE' as meaning something (or someone) that is 'not ordinary' or 'uncommon'.

51. Therefore, I find that whilst the marks convey different meanings, they both refer to the concept of something (or someone) uncommon. Thus, I find the marks share no more than a low level of conceptual similarity between them owing to the common evocation relating to 'rare'.

Distinctive character of the earlier trade mark

52. 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

[13] Opponent's submissions in lieu dated 20 November 2024, [27].
[14] Applicant's submissions in lieu dated 20 November 2024, [34].

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)."

53. Registered trade marks possess varying degrees of inherent distinctive character. These range from the very low, such as those which are suggestive or allusive of the services, to those with high inherent distinctive character, such as invented words.

54. I will deal first with the inherent distinctiveness of the Earlier Mark, which comprises the single word 'RARE' in plain, all-capitalised text. As already reported at paragraph 48 above, the Opponent submitted that the Earlier Mark possesses at least a medium degree of inherent distinctiveness. The Applicant contended that "*the distinctive and dominant elements of the marks at issue are different, despite sharing the common element RARE. The common element is not "so strikingly distinctive" that the average consumer would be confused*".[15] I find that the Earlier Mark is an English dictionary word that does not convey an immediately clear message to the minds of the consumers. I appreciate that 'RARE' could be seen as alluding to the fact that the goods and/or services are uncommon and, for this reason, of some value (or even desirable to the eyes of the consumers). However, the relevant consumers would require some additional mental steps to understand

[15] Applicant's submissions in lieu dated 20 November 2024, [40].

such meaning and, for this reason, the Earlier Mark cannot be said to plainly convey a positive (or promotional) message, and it can be said to be quite allusive. Overall, I agree with the Opponent that the Earlier Mark is inherently distinctive to a medium degree.

55. Turning to the question of whether the inherent distinctiveness of the Earlier Mark has been enhanced through use, the Opponent submitted, in the witness statement from Rajesh Talwar, that Mr Talwar's company is a producer, wholesaler and retailer of clothing incorporated in 2018 and the company (with Mr Talwar's consent) has been using the mark 'RARE' since its incorporation in 2018. Mr Talwar clarified that his company markets a wide range of clothing that are distributed either to third-party retailers or directly to consumers via the company's website. Mr Talwar also provided a few examples of the mark being placed on the clothes' labels and tags as well as on the outside of the garments and submitted one picture of a label, containing the Earlier Mark, posted on the Opponent's Instagram account. Mr Talwar also provided me with the company's sales figures for the years between 2018 and 2023. These average to around £ 1 million for wholesale and almost £47 thousand for direct consumer retail. Mr Talwar did not specify the market share his company occupies, however, considering that the clothing industry in the UK is likely to be worth millions (or even billions) of pounds, I find these numbers, although relevant, not to be particularly impressive given the nature and presumable size of this market in the UK. The evidence also contains examples of the mark being used on third-party online platforms (i.e., ASOS) to market the Opponent's goods. Copies of invoices were provided showing the Opponent supplied ASOS with its goods for retail on ASOS' platform. Whilst I acknowledge the Opponent's evidence, I do not believe that the evidence provided sufficiently shows that the Earlier Mark has been used to an extent to justify a finding of enhanced distinctiveness acquired through use.

Likelihood of confusion

56. There is no simple formula for determining whether there is a likelihood of confusion. The factors considered above have a degree of interdependency (*Canon* at [17]). I must make a global assessment of the competing factors (*Sabel* at [22]), considering the various factors from the perspective of the average

consumer and deciding whether the average consumer is likely to be confused. In making my assessment, I must keep 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]).

57. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. The concept of indirect confusion was explained by Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10 as follows:

> "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).”

58. I have already elected to proceed by considering the likelihood of confusion where the marks are used in relation to identical goods and services. The consumer is likely to pay a medium level of attention in their selection of the goods at issue. Part of the relevant public for the services at issue could be businesses that would pay a higher-than-medium level of attention, but another part of the relevant public will be members of the general public who will demonstrate a medium degree of attention. I will assess the likelihood of confusion from the perspective of the general public since they are the group who will pay the lower degree of attention. The distinctiveness of the Earlier Mark is medium. The visual, aural and conceptual similarity is low. The purchasing process of the contested goods and services is considered to be mainly visual but the potential for aural use also bears some relevance.

59. I acknowledge that both marks share the word ‘RARE’, however, the Contested Mark features three additional words (absent from the Earlier Mark) and the relevant consumers, when coming into contact with the Contested Mark, will view the use of the word ‘RARE’ as ordinary dictionary use of the word as part of a longer phrase (‘DARE TO BE RARE’). That is, they will understand the mark as an alliterating inspirational message from the Applicant encouraging the consumers to find the courage to be uncommon. Thus, the combination of ‘DARE TO BE –‘ and ‘RARE’ takes on a different meaning (a more promotional/inspirational one). Such meaning, to the eyes of the consumers, will make a different impression than the word ‘RARE’ alone. Therefore, it is my view that, despite the similarity between the marks created by the commonality of the word ‘RARE’, the relevant consumers will perceive the presence of ‘RARE’ in the Contested Mark in its normal dictionary sense as part of a longer (and meaningful) phrase and it is highly unlikely that the competing marks will be mistaken or misremembered for one another. Rather, the

aforementioned differences will be sufficient to enable consumers to differentiate between them. Therefore, in my judgement, taking all the above factors into account, the difference between the competing trade marks are likely to enable consumers, paying a medium level of attention, to avoid mistaking the marks for one another, even when factoring in the principles of imperfect recollection and interdependency. As a result, I find that there is no likelihood of direct confusion.

60. I turn to consider the likelihood of indirect confusion. The three categories identified in *L.A. Sugar* are not exhaustive; rather, they were intended to be illustrative of the general approach, as has been confirmed by the Court of Appeal.[16] 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.[17] The Court of Appeal has also emphasised that, where there is no direct confusion, there must be a "proper basis" for finding indirect confusion.[18]

61. The Opponent argued that (original emphasis) "*DARE TO BE RARE could be very easily misconstrued to be the title of a new collection or "edit" of the Opponent's goods. Further or alternatively, DARE TO BE RARE, by exhorting or encouraging the reader to "be* ***rare****" naturally sounds like a promotional slogan advertising the Opponent's fashion goods bearing the trade mark RARE (hinting that consumers can express their identity through wearing the Opponent's clothing, and that in doing so they are being daring).*"[19]

62. The Applicant contended that "*a) the distinctive and dominant elements of the marks at issue are different, despite sharing the common element RARE. The common element is not* "so strikingly distinctive" *that the average consumer would be confused. b) The DARE TO BE elements in the Applicant's mark perform an important and independent role in the mark applied for. It is not a case where the Application* "adds a non-distinctive element" *to the earlier mark which could permit confusion by the relevant consumer. c) There are a number of material differences*

[16] *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207.
[17] *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17.
[18] *Liverpool Gin Distillery*.
[19] Opponent's submissions in lieu dated 20 November 2024, [32].

between the two marks – it is not the case that the Applicant's mark could realistically be seen as a "brand extension"."[20]

63. I agree with the Applicant. 'RARE' is a dictionary word that, although it carries a medium level of inherent distinctiveness in relation to the relevant goods and services, is still a fairly common English term likely to be used for marketing purposes. In this case, I believe that 'RARE' does not exhibit such a high degree of distinctiveness that relevant consumers, when encountering the Contested Mark, would perceive it as a slogan (i.e., an inspirational message) uniquely associated with the Opponent or, even less likely, as a sub-brand (e.g., the title of a new collection). This is enough to rule out any likelihood that consumers would perceive the word 'RARE' in 'DARE TO BE RARE' as indicating an economic connection between the Applicant and the Opponent and so there is no likelihood of indirect confusion in this case.

64. Having reached that conclusion in respect of identical goods and/or services (on the assumption that genuine use of the Opponent's goods and/or services had been proven), the Opponent would be in an inferior position were I to assess the likelihood of confusion based on similar goods and/or services. Therefore, it follows that there is no likelihood of confusion (both direct and indirect) for the remaining goods and services at hand.

65. For completeness, I reiterate that the opponent's '985 Mark contains the additional verbal element 'LONDON' which introduces an obvious further point of visual, aural and conceptual difference by comparison with the Contested Mark. The Opponent not having succeeded on the basis of the '776 Mark, there is no likelihood of confusion (both direct and indirect) in respect of the '985 Mark.

Conclusion

66. The opposition fails under section 5(2)(b) of the Act.

67. The Applicant has been successful. Subject to any successful appeal, the Application by Magners GB Limited may proceed to registration.

Costs

[20] Applicant's submissions in lieu dated 20 November 2024, [40].

68. The Applicant is entitled to an award of costs. The relevant scale is contained in Tribunal Practice Notice ("TPN") 1/2023. Bearing that scale in mind, I award costs to the applicant as follows:

Considering the notice of opposition and preparing the counterstatement	£250
Submissions in lieu of a hearing	£350
Total:	**£600**

69. I order Rajesh Talwar to pay Magners GB Limited the sum of **£600**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 17th day of July 2025

Andrea Rossi
For the Registrar

Annex A

Applied for goods and services being opposed

Class 9: downloadable software, namely virtual goods in the nature of digital clothing, digital sports clothing, digital clothing badges, digital bags, digital umbrellas; downloadable software, namely virtual goods, namely, digital clothing, digital sports clothing, digital clothing badges, digital bags, digital umbrellas.

Class 18: Umbrellas and parasols; bags and holdalls; tote bags; souvenir bags; luggage; handbags; rucksacks; carrying bags; toiletry bags; wallets; purses; card cases; document cases; baggage tags; sporrans; clothing for animals; leads for animals; collars for animals; bags for carrying animals; walking sticks; boot bags; parts and fittings for all the aforesaid goods.

Class 25: footwear and headgear; shoes; sandals; slippers; trainers; boots; football boots; rugby boots.

Class 35: online retail services relating to virtual goods, namely digital clothing, digital sports clothing, digital clothing badges, digital bags, digital umbrellas; wholesale services, retail services, electronic shopping retail services, retail services provided by mail order, all connected with the sale of headgear, footwear, sports footwear, slippers, caps, purses, bags, tote bags, handbags, luggage, suitcases, rucksacks, sporrans wallets, umbrellas, card cases, baggage tags, walking sticks, parasols, clothing for animals, leads for animals, collars for animals.

Annex B

Table of competing goods and services for these proceedings

Opponent's goods and services	Applicant's goods and services
"The '776 Mark"	Class 9: Downloadable software, namely virtual goods in the nature of digital clothing, digital sports clothing, digital clothing badges, digital bags, digital umbrellas; downloadable software, namely virtual goods, namely, digital clothing, digital sports clothing, digital clothing badges, digital bags, digital umbrellas. Class 18: Umbrellas and parasols; bags and holdalls; tote bags; souvenir bags; luggage; handbags; rucksacks; carrying bags; toiletry bags; wallets; purses; card cases; document cases; baggage tags; sporrans; clothing for animals; leads for animals; collars for animals; bags for carrying animals; walking sticks; boot bags; parts and fittings for all the aforesaid goods. Class 25: Clothing, footwear and headgear; T shirts; polo shirts; football shirts; rugby shirts; shirts; dresses; sweatshirts; hoodies; jumpers; trousers; shorts; jackets; replica kit; replica shirts; replica
Class 25: Clothing. Class 35: The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase clothing from a retail outlet and by means of the Internet.	

	shorts; replica socks; sports clothing; waterproof clothing; outerwear; kilts; trews; earasaids; caps; hats; bandanas; gloves; scarves; socks; belts; ties; bow ties; braces; wristbands; shoes; sandals; slippers; trainers; boots; football boots; rugby boots; underwear; nightwear; dressing gowns; kimonos; swimwear; beachwear; clothing for children; clothing for babies; bibs for babies; fancy dress costumes; aprons. Class 35: Online retail services relating to virtual goods, namely, digital clothing, digital sports clothing, digital clothing badges, digital bags, digital umbrellas; wholesale services, retail services, electronic shopping retail services, retail services provided by mail order, all connected with the sale of clothing, headgear, footwear, kilts, sports clothing, sports footwear, clothing for children, clothing for babies, bibs for babies, waterproof clothing, t shirts, hoodies, beanies, earasaids, trews, socks, underwear, scarves, slippers, belts, gloves, caps, aprons, fancy dress costumes, dressing gowns, sportswear, swimwear, sleepwear, wallets, purses, bags, tote bags, handbags, luggage, suitcases, rucksacks, umbrellas, card cases, baggage tags, sporrans, walking sticks,

	parasols, clothing for animals, leads for animals, collars for animals.