

O/0725/24

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO. 3562154
IN THE NAME OF BEREAL WEAR LIMITED
FOR THE FOLLOWING TRADE MARK:

BeReal[®]

IN CLASS 25

AND

AN APPLICATION FOR A DECLARATION OF INVALIDITY
UNDER NO. 506416
BY BEREAL

BACKGROUND AND PLEADINGS

1. BEREAL WEAR LIMITED (“the proprietor”) is the proprietor of the trade mark on the cover page of this decision. The proprietor’s mark was filed on 30 November 2020 and entered into the register on 18 June 2021. It stands registered for the following goods:

Class 25: *Clothing for cyclists; clothing for gymnastics; clothing for leisure wear; clothing for men, women and children; clothing for sports; clothing.*

2. On 14 August 2023, BeReal (“the cancellation applicant”) applied to have the contested mark declared invalid under section 47 of the Trade Marks Act 1994. The invalidity is based on section 5(2)(b) and is directed at the proprietor’s mark in its entirety.

3. The cancellation applicant relies on the following mark:

BE THE REAL

UK Trade Mark no. 3490021

Filing date 14 May 2020; date of entry in the register 14 August 2020

Relying on the following goods:

Class 25: *Clothing.*

4. The cancellation applicant claims that there is a likelihood of confusion because the marks are either identical or similar to its own mark and the respective services are identical or similar. The proprietor filed a defence and counterstatement denying the claims made.

5. Only the proprietor filed evidence in the form of the witness statement of Batool Zaidi dated 2 February 2024, which is accompanied by 4 exhibits. I do not intend to summarise the evidence at this stage. However, I confirm that I have taken all of the

filed documents into account and will summarise them to the extent that I deem necessary below.

6. A hearing took place before me on 30 May 2024, via video conference. The cancellation applicant was represented by Craig Beaumont of Barker Brettell and the proprietor represented itself, with Ms Zaidi appearing on behalf of BeReal Wear Limited.

7. The provisions of the act relied upon in these proceedings are assimilated law as they are derived from an 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.

PRELIMINARY ISSUE

Issue and discussion

8. Ms Zaidi submitted that she wants the current case before me to be struck out because there was an abuse of process made on behalf of the cancellation applicant which relates to the matrix of proceedings between the parties. The matrix of proceedings involves the following:

- the proprietor's opposition (number 434629) against the cancellation applicant's international registration for the mark BeReal in class 25 was provisionally successful, depending on the outcome of this invalidation action (506416) against the earlier mark;
- the first invalidation action (506174) was filed late in the opposition proceedings. A case management conference on 7 June 2023 regarding the cancellation applicant's request for an extension of time to file evidence in the section 5(1), and 5(2)(a) and 5(2)(b) opposition. This request was refused for

insufficient reasons and the cancellation applicant's request to suspend the opposition proceedings pending the outcome of this first invalidation action was also refused because it had been made so late in the day;

- the proprietor filed a cancellation application against the BE THE REAL mark on 6 November 2023 on the basis of section 3(6) of the Act because it claimed that the assignment had been made in bad faith. That cancellation application was struck out by the Registrar because the claim did not and could not relate to whether BE THE REAL had been invalidly registered. The proprietor appealed to the Appointed Person and the decision to strike out the application was upheld by Mr Geoffrey Hobbs KC, sitting as the Appointed Person, in decision BL O/0376/24, dated 23 April 2024.
- the proprietor filed a cancellation application against the BE THE REAL mark on 6 November 2023 on the basis of section 3(6) of the Act because it claimed that the assignment had been made in bad faith. That cancellation application was struck out by the Registrar because the claim did not and could not relate to whether BE THE REAL had been invalidly registered. The proprietor appealed to the Appointed Person and the decision to strike out the application was upheld by Mr Geoffrey Hobbs KC, sitting as the Appointed Person, in decision BL O/0376/24, dated 23 April 2024.

9. Ms Zaidi's reasoning for the current case being struck out was on the basis that the cancellation applicant was using the trade mark system for purposes other than those for which it is intended. In particular, the proprietor submitted that the cancellation applicant initiated these proceedings *"assuming that it would put pressure on us and with an intention to delay the decision, cause reputational and financial loss"* and thwart the registered proprietor's success by acquiring the 'BE THE REAL' mark in these proceedings. Further, Ms Zaidi submitted that given that the cancellation applicant's mark is registered in the United Kingdom only, under the ownership of a French company, this indicates that there is no genuine interest of the cancellation applicant to use its mark. Ms Zaidi also submitted that the filing of this cancellation action by the cancellation applicant was merely a *"strategy to delay proceedings and complicate things for us because the first cancellation application failed"*. In response,

the cancellation applicant denies these assertions and submits that the proceedings before me should focus solely on this cancellation and not the other proceedings that have already taken place.

9. From what I can see from the decision of Mr Geoffrey Hobbs KC¹ in BL O/0376/24 and the opposition referenced by Ms Zaidi at the hearing² (specifically referenced the discussion in the costs decision),³ Ms Zaidi made similar submissions before the other Hearing Officer and Mr Hobbs in relation to the invalidation against the cancellation applicant's mark and the opposition against the registered proprietors mark on the basis of the acquisition and reliance upon 'BE THE REAL' as an earlier mark.

Case law and principles

10. In relation to abuse of process and the resultant effect of a successful finding of abuse of process, the Trade Marks Manual reads as follows:

"4.19 Summary judgment and striking out

Although there is no mention in the rules of 'summary judgment' it is considered, in appropriate circumstances, to be within the Tribunal's inherent jurisdiction - both on application by one of the parties and of its own volition.

The CPR gives the general basis for striking out at part 3.4 and summary judgment at part 24.2. Rule 3.4 makes provision for the court to strike out a statement of case or part of a statement of case if it appears that it discloses no reasonable grounds for bringing or defending a claim.

A party may seek summary judgment on a case, i.e. have the entire case thrown out, because the other party is estopped from its action or, because its action is an abuse of process. In cases of estoppel and abuse of process it is for one

¹ BL O/0376/24

² BL O/1156/23, 5 December 2023

³ BL O/0503/24

party to raise the issue, the hearing officer will not raise the matter of his/her own motion.

In other cases it may be appropriate when scrutinising the statement and counterstatement for the Tribunal to consider striking out a ground of objection or a ground of defence. A ground of objection may be struck out as it has no chance of success e.g. relying on a trade mark that has a later date of filing for an action under section 5(2) of the Act.” (original emphasis)

11. Part 3.4(2)(b) of The Civil Procedure Rules gives a basis for striking out a statement of case or part of the statement of case for a number of reasons. It reads as follows:

“(2) The court may strike out a statement of case if it appears to the court –

- (a) that the statement of case discloses no reasonable grounds for bringing or defending the claim;
- (b) that the statement of case is an abuse of the court’s process or is otherwise likely to obstruct the just disposal of the proceedings; or
- (c) that there has been a failure to comply with a rule, practice direction or court order.”

12. The considerations that are to be made in relation to striking out as a result of abuse of process and multiple proceedings are outlined in *Walbrook Trustees (Jersey) Ltd & Others v William Simon Fattal & Others* [2009] EWCA Civ 297, which reads as follows:

3. Where a person brings successive actions in respect of the same subject matter, the court may strike out the later proceedings as an abuse of process if he seeks to raise in the later proceedings claims which he should have made in earlier proceedings. The House of Lords have recently considered this long-standing principle. It generally requires unjust harassment of the defendant. In

essence, the court must make a "broad merits-based judgment" as to whether there is an abuse of process. It is not enough to show that the claim could have been brought in the earlier proceedings.

4. This principle was described and explained in the speech of Lord Bingham, with whom three other members of the House agreed, in *Johnson v Gore Wood & Co* [2002] 2 AC 1, 31 in the following passage:

"But *Henderson v Henderson* abuse of process, as now understood, although separate and distinct from cause of action estoppel and issue estoppel, has much in common with them. The underlying public interest is the same: that there should be finality in litigation and that a party should not be twice vexed in the same matter. This public interest is reinforced by the current emphasis on efficiency and economy in the conduct of litigation, in the interests of the parties and the public as a whole. The bringing of a claim or the raising of a defence in later proceedings may, without more, amount to abuse if the court is satisfied (the onus being on the party alleging abuse) that the claim or defence should have been raised in the earlier proceedings if it was to be raised at all. I would not accept that it is necessary, before abuse may be found, to identify any additional element such as a collateral attack on a previous decision or some dishonesty, but where those elements are present the later proceedings will be much more obviously abusive, and there will rarely be a finding of abuse unless the later proceeding involves what the court regards as unjust harassment of a party. It is, however, wrong to hold that because a matter could have been raised in earlier proceedings it should have been, so as to render the raising of it in later proceedings necessarily abusive. That is to adopt too dogmatic an approach to what should in my opinion be a broad, merits-based judgment which takes account of the public and private interests involved and also takes account of all the facts of the case, focusing attention on the crucial question whether, in all the circumstances, a party is misusing or abusing the process of the court by seeking to raise before it the issue which could have been raised before. As one cannot comprehensively

list all possible forms of abuse, so one cannot formulate any hard and fast rule to determine whether, on given facts, abuse is to be found or not. Thus while I would accept that lack of funds would not ordinarily excuse a failure to raise in earlier proceedings an issue which could and should have been raised then, I would not regard it as necessarily irrelevant, particularly if it appears that the lack of funds has been caused by the party against whom it is sought to claim. While the result may often be the same, it is in my view preferable to ask whether in all the circumstances a party's conduct is an abuse than to ask whether the conduct is an abuse and then, if it is, to ask whether the abuse is excused or justified by special circumstances. Properly applied, and whatever the legitimacy of its descent, the rule has in my view a valuable part to play in protecting the interests of justice."

Decision

13. I note that Mr Hobbs said this in his decision BL O/0376/24 :

"... I do not doubt that the Registrar has an inherent power to strike out Registry proceedings, in whole or in part, on the basis that they involve or amount to an improper and abusive assertion of the rights conferred by registration of a trade mark. Any application for an order to that effect would clearly need to have been made by BRW [the proprietor] in answer to Invalidation Application No. 506416.

The caselaw relating to the operation of Civil Procedure Rule 3.4(2)(b) (which enables a Statement of Case in court proceedings to be struck out on the basis that it is an abuse of the Court's process, or is otherwise likely to obstruct the just disposal of the proceedings) shows that there is little scope for a **well-founded** claim to be struck out on that ground.

The same can be said of the caselaw relating to Article 3(2) of the Enforcement Directive (Directive 2004/48/EC) which specifies that measures, procedures and remedies for the enforcement of intellectual property rights, which of course includes registered trade mark rights, shall be applied in such a manner as to

avoid the creation of barriers to legitimate trade and to provide for safeguards against their abuse. And likewise in relation to claims for liability for malicious prosecution and abusive use of process, as discussed at length in chapter 15 of the current (24th) edition of Clerk & Lindsell on Torts.

On the limited information presently available to me, the claim for invalidity made by BRS [the applicant] against BRW's trade mark Registration No. 3562154 appears to be no less lawful and legitimate for BRS to pursue after 28th July 2023 than it would have been for Joseph Andrews to pursue if he had wished to do so prior to that date. However, that is as far as I am prepared to go in relation to the arguments addressed to me on that subject in the context of the present appeal. And I must emphasise that nothing I have said in this decision is to be taken as determinative, one way or the other, of any application which BRW might hereafter decide to make to the Registrar, for Invalidity Application No. 506416 to be struck out."

14. The proprietor is asking me to strike out the proceedings on the basis of the way that the cancellation applicant has conducted itself throughout all the proceedings between the parties. It would not be right for me to take into account in these particular invalidation proceedings what else has gone on in the other proceedings, to which Mr Hobbs and the other Hearing Officer referred. However, even if I did not think it was right for me to take into account the other proceedings, I am not of the view that the evidence before suggests that there is a well founded claim to strike out the proceedings on the basis of abuse of process.

15. Abuse of process is an improper use of the judicial process and can take place following frivolous or vexatious legal claims, by putting the other party to expense, harassment or commercial prejudice by starting or continuing vexatious or malicious claims, and/or use of a court's procedures for a purpose or in a way significantly different from their primary purpose, which is to resolve disputes finally and completely. I consider that the proprietor's submissions in relation to abuse of process amount to a submission of vexatious litigation and multiple proceedings before the tribunal by the cancellation applicant.

16. Applying the limited information provided to me in the form of evidence, the proceedings raised by the cancellation applicant do not appear to me to be unlawful or illegitimate. The action raised by the cancellation applicant cannot be said to have little or no basis in law because a trade mark proprietor can legitimately raise a cancellation action against another proprietor. Therefore, I do not consider there to be an abuse of process by using the process of the court for a purpose or in a way which is significantly different from the ordinary and proper use of the court process – the action of the cancellation applicant cannot be deemed to be vexatious based on the evidence before me.

17. In relation to multiple claims and proceedings, I note that multiple proceedings are to be avoided and that the tribunal maintains an inherent power to prevent abuses of process. This would include preventing repeat claims, re-litigation of disputes, raising new issues that should have been dealt with in previous litigations and a deliberation continuing of proceedings to avoid justice rather than achieve it. Given that this proceeding has not covered the same subject matters, this is not a matter that has already been decided by a Court/Tribunal and this is not raising an issue in fresh litigation that should have been raised in previous proceedings between the same parties, none of the situations in which it would be appropriate to exercise that power apply here. I note that the burden is on the accused to show, on the balance of probabilities, that they are entitled to a strike out of proceedings on the grounds of abuse of process. From the evidence, I note that the registered proprietor filed the following:

- a) A snapshot of an item of clothing bearing the mark 'BeReal'.
- b) An excerpt from the TM26(I) in relation to cancellation 506174 – these are proceedings that have already been addressed and the resultant appeal was heard by the Appointed Person. The registered proprietor challenges the finding that goodwill was made out and the delay in raising the action. This matter has already been addressed and reviewed in the associated procedural hearing and appeal – I do not intend to reassess this issue here.
- c) The full opposition case of 434629 has been provided.

- d) The case of *Fashion TV Board Holdings CV vs CBM Creative Brands Marken GmbH*.⁴

18. Taking into account the evidence before me, I do not consider that the proprietor has met the burden that on the balance of probabilities that they are entitled to strike out the proceeding on the basis of an abuse of process. On the contrary, the combination of the evidence has failed to provide a well-founded claim that abuse of process is taking place. Subsequently, I dismiss the claim that an abuse of process has taken place and will continue to address the 5(2)(b) ground raised for this invalidation action.

DECISION

19. Section 5(2)(b) of the Act has application in invalidation proceedings because of the provisions of section 47 of the Act, which states as follows:

“47. (1) [...]

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) [...]

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2ZA) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 5(6).

⁴ Case R 2445/2017-G

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met. [...]

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c)

(2G) An application for a declaration of invalidity on the basis of an earlier trade mark must be refused if it would have been refused, for any of the reasons set out in subsection (2H), had the application for the declaration been made on the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application.

(2H) The reasons referred to in subsection (2G) are-

(a) [...]

(b) that the application for a declaration of invalidity is based on section 5(2) and the earlier trade mark had not yet become sufficiently distinctive to support a finding of likelihood of confusion within the meaning of section 5(2);

(c) [...]

(3) [...]

(4) [...]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed.”

20. Section 5 of the Act reads as follows:

(2) A trade mark shall not be registered if because—

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or

(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.

21. Given its filing date, the cancellation applicant’s mark qualifies as an earlier trade mark pursuant to section 6 of the Trade Marks Act. The cancellation applicant’s mark did not complete its registration process more than five years before the filing date of the applicant’s mark. The condition of use, therefore, does not apply to the registration. Consequently, the opponent can rely on all the goods in its registration.

22. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v 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 impression created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

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

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

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

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

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

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

COMPARISON OF THE MARKS

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

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

25. The respective marks are shown below:

The proprietor's mark	The cancellation applicant's mark
BeReal [®]	BE THE REAL

26. The cancellation applicant's mark consists of the word-only mark 'BE THE REAL' which appears in upper case. There are no other elements that contribute to the overall impression of the mark which lies in the phrase as a whole. The proprietor's mark consists of the word-only mark 'BeReal', of which the 'B' and 'R' are capitalised. To the right of the words is a registered trade mark symbol. I consider that the words 'Be' and 'Real' are readily identified from the mark by the average consumer. The word 'BeReal' plays a greater role in the overall impression of the mark. This is because the average consumer will overlook the registered trade mark sign and view it as merely an indication that the mark is registered.

27. Visually, the marks coincide in the words 'Be' and 'Real'. The word 'The' present in the cancellation applicant's mark has no counterpart in the proprietor's mark and there is no equivalent in the proprietor's mark to the registered trade mark symbol. The capitalisation in the mark does not make a material difference. Taking the above into account, I consider that the marks are visually similar to a medium to high degree.

28. Aurally, I consider that the words 'Be' and 'Real' in the proprietor's mark will be given their ordinary pronunciation. I do not consider that the registered trade mark symbol in the proprietor's mark will be pronounced. In relation to the cancellation applicant's mark, I consider that the words will be given their ordinary dictionary

pronunciation. The marks will overlap on 'Be' and 'Real', which is present in both marks. Therefore, I consider the marks to be aurally similar to a high degree.

29. Conceptually, the cancellation applicant submitted that the average consumer would understand 'BeReal' as having one of the following meanings: i) being yourself and coming across as honest, genuine, and authentic, ii) being honest with yourself and acting according to your own personal values, iii) or showing yourself to the world as you are and not how the others want you to be. I consider that the cancellation applicant's submissions on the meaning, whilst elaborated differently in all three scenarios, follow the same theme of an individual being true to yourself and being honest, genuine and authentic. I note that the parties agree insofar as the proprietor also submits that conceptually its mark means authenticity. I am of the view that the average consumer will perceive the mark as having the meaning of being true to yourself and honest, genuine and authentic.

I note that in relation to its own mark, the cancellation applicant submits that the consumer would understand "Be the Real" to have the same conceptual meaning. It was submitted that this is on the basis that both marks start and end with the identical words "BE" and "REAL". Further, the cancellation applicant submitted that the word "THE" is non-distinctive and makes no (or very limited) contribution to the overall impression produced by its mark. I note that the competing marks share the same common components of 'BE' and 'REAL', which will be given their ordinary dictionary meanings – however, taken as a whole I consider that the average consumer will view the mark 'BE THE REAL' as conceptually incomplete; when the average consumer looks at the mark "BE THE REAL" they will be left wondering what the mark is attempting to 'Be the real' version of. Despite this, the marks share some similarity in so far as they will both be viewed as sharing the concept of being real/authentic. Therefore, I consider that the marks will be conceptually similar to a low to medium degree.

COMPARISON OF THE GOODS

30. The goods to be compared are listed below:

The proprietor's goods	The cancellation applicant's goods
Class 25: <i>Clothing for cyclists; clothing for gymnastics; clothing for leisure wear; clothing for men, women and children; clothing for sports; clothing.</i>	Class 25: <i>Clothing</i>

31. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union (“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.”

32. 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.

33. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05, the General Court (GC) stated:

“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 the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

34. *Clothing* appears in both parties’ specifications and, therefore, is self-evidently identical.

Clothing for cyclists; clothing for gymnastics; clothing for leisure wear; clothing for men, women and children; clothing for sports.

35. The above goods in the proprietors’ specification are encompassed by “*clothing*” in the cancellation applicant’s specification. Therefore, I consider that the goods are identical on the principle outlined in *Meric*.

THE AVERAGE CONSUMER AND THE PURCHASING PROCESS

36. As the law above indicates, it is necessary for me to determine who the average customer is for the parties’ goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J (as he then was) 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.”

37. The average consumer for the goods at issue is the general public at large. The goods are most likely to be sold through a range of clothing retailers and their online or catalogue equivalents. In physical retail premises, the goods at issue will be displayed on shelves or racks, where they will be viewed and self-selected by the customer. A similar process will apply to websites and catalogues, where the consumer will select the goods having viewed an image displayed 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: see *New Look Limited v OHIM*, Joined cases T-117/03 to T-119/03 and T-171/03, paragraph 50. Visual considerations, therefore, dominate the selection process, although I do not discount an aural component playing a part. The price and frequency of the purchase of the goods at issue may vary. 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 selecting the goods at issue the average consumer may consider current fashion trends, price, quality and suitability. With this in mind, I consider that the average consumer will pay a medium degree of attention during the purchasing process.

DISTINCTIVE CHARACTER OF THE CANCELLATION APPLICANT’S MARK

38. 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 C108/97 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).”

39. Registered trade marks possess varying degrees of inherent distinctive character through use, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with a high inherent distinctive character, such as invented words which have no allusive qualities.

40. The cancellation applicant has not shown use of its mark and thus cannot benefit from any enhanced distinctiveness. In this respect, I have only the inherent distinctiveness of the cancellation applicant’s mark to consider. The cancellation applicant’s mark consists of the phrase ‘BE THE REAL’ which are recognised English words, and conveys the meaning described earlier in this decision. I note that the mark does not describe or allude to the goods relied upon in this cancellation. The mark as a whole is not invented. On balance, the incomplete phrase formed by the combination of these words adds to the distinctiveness of the mark. Consequently, I find that the cancellation applicant’s mark enjoys a medium to high degree of inherent distinctive character.

LIKELIHOOD OF CONFUSION

41. 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 or vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be mindful to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

42. I have found the marks to be visually similar to a medium to high degree, aurally similar to a high degree and conceptually similar to a low to medium degree. I have identified the average consumer as the general public who will purchase/select the goods by visual means (although I do not discount an aural component). I have concluded that a medium degree of attention will be paid during the purchasing process. I have found the cancellation applicant's mark to be inherently distinctive to a medium to high degree. I have found the goods to be identical.

43. Taking all the above and the principle of imperfect recollection into account, I am of the view that the average consumer is likely to misremember or mistakenly recall the marks for one another. This is particularly the case given that both marks share the words 'BE' and 'REAL'. Furthermore, given that the average consumer rarely has the opportunity to compare marks side-by-side and will instead encounter them in different settings at different times, to my mind, the medium to high degree of visually similarity and high degree of aural similarity will lead the average consumer to mistake one mark for the other, especially as the purchasing process is predominantly visual. Therefore, the visual similarity will play a more important role in the similarity of the marks. I also note that the marks are conceptually similar to a low to medium degree. Further, I do not consider that the presence of 'THE' between 'BE' and 'REAL' in the cancellation applicant's mark is sufficient to avoid the marks being misremembered or mistakenly recalled, as I consider that it will be overlooked by the average consumer. When confronted with both marks on identical goods, that the 'THE' element and registered trade mark symbol, as points of difference will not be recalled/remembered

by the average consumer. Consequently, bearing in mind that the average consumer rarely has the chance to make direct comparisons between trade marks and, instead must rely on the imperfect picture of them retained in his/her mind. Consequently, I consider that there is a likelihood of direct confusion between the marks.

Costs

44. The opponent has been successful as it is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Note 2/2016. In the circumstances, I award the opponent the sum of £1800 as a contribution towards its costs. The sum is calculated as follows:

Preparing a statement and considering the other parties' statement	£300
Preparing for and attending the hearing	£800
Considering and commenting on the other side's evidence	£500
Official fee	£200
Total	£1800

45. I, therefore, order BeReal Wear Limited to pay BeReal the sum of £1800. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 2nd day of August 2024

A Klass

For the Registrar,

the Comptroller - General