**O/0726/25**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF**
**APPLICATION NO. 3947072**
**BY SHENZHEN KAIBOJINGCHAO ENTERPRISE MANAGEMENT CONSULTING CO., LTD.**
**TO REGISTER:**

CuteJazz

**AS A TRADE MARK**
**IN CLASS 25**

**AND**

**IN THE MATTER OF OPPOSITION THERETO**
**UNDER NO. 444531**
**BY SAUCONY, INC.**

## BACKGROUND AND PLEADINGS

1. Shenzhen KaiboJingchao Enterprise Management Consulting Co., ("the applicant") applied to register the trade mark shown on the cover page of this decision in the UK on 18 August 2023. The application was accepted and published in the Trade Marks Journal on 15 September 2023 in respect of the following goods:

> Class 25: Jerseys [clothing]; waterproof clothing; trousers; clothing; shirts; sweaters; skirts; sports jerseys; dresses; overcoats; tee-shirts; clothing incorporating LEDs; underwear; dressing gowns; tights; corselets; corsets [underclothing]; waistcoats; pyjamas; underpants; adhesive bras; babies' pants [underwear]; layettes [clothing]; bathing caps; bathing trunks; bathing suits; clothing for gymnastics; masquerade costumes; football shoes; gymnastic shoes; footwear; boots; shoes; sports shoes; berets; hats; hosiery; footmuffs, not electrically heated; sweat-absorbent socks; gloves [clothing]; cycling gloves; shawls; neckties; scarves; girdles; shower caps; sleep masks; wedding dresses.

2. On 7 December 2023, Saucony, Inc. ("the opponent") filed a notice of opposition on the basis of Section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opposition is directed at some of the goods in the application, namely:

> Class 25: Football shoes; gymnastic shoes; footwear; boots; shoes; sport shoes; footmuffs, not electrically heated.

3. The opponent relies on the following trade mark:

JAZZ

Comparable UK trade mark (EU) registration no. UK900421685[1]

[1]Following the end of the transition period of the UK's withdrawal from the EU, all EU trade marks ("EUTM") registered before 1 January 2021 were recorded as comparable trade marks in the UK trade mark register (and as a consequence, have the same legal status as if they had been applied for and registered under UK law). A 'comparable trade mark (EU)' retains the same filing date, priority date (if applicable) and registration date of the EUTM from which it derives.

Filing date 8 November 1996; date of entry in register 27 January 1999.

Relying on some of the goods, namely:

Class 25: Footwear

4. The opponent submits that there is a likelihood of confusion because the applicant's mark is similar to its own mark and the respective goods are identical. The applicant filed a defence and counterstatement denying the claims made.

5. The opponent initially requested a hearing, and notice was given to both parties that a hearing was to be held on 8 February 2025. However, on 24 January 2025, the opponent wrote to the registry requesting that the hearing be vacated and a decision be made based on the papers. The applicant is represented by KBJC LLC; the opponent is represented by Pinsent Masons LLP. Only the opponent filed evidence in chief. The opponent also filed submissions after the evidence rounds.[2] This decision is taken following careful consideration of all the papers.

6. 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**

7. As set out above, only the opponent filed evidence in these proceedings. The opponent's evidence in chief came in the form of the witness statement of Mr Florian Peter Traub dated 7 May 2024 and accompanied by 4 exhibits (FPT1-FPT4). Mr Traub is a Partner at Pinsent Masons, a position he has held since April 2018.

[2] As a hearing was scheduled when the opponent filed its submissions, it was not deemed to be submissions in lieu at the time. However, as they were filed at the end of the evidence rounds, and given the circumstances outlined above, if a costs order is made in favour of the opponent, the submissions will be treated as submissions in lieu of a hearing.

8. While I do not intend to summarise the evidence and submissions at this stage, I have considered them in detail and will, where necessary, refer to them below.

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

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

> "(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 or association with the earlier trade mark."

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

> "Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only."

11. Given its filing date, the opponent's mark qualifies as an earlier mark under section 6 of the Act. The opponent's mark completed its registration more than five years before the application date of the applicant's mark and would have been subject to proof of use provisions. However, in its Form TM8, the applicant did not request that the opponent demonstrate proof of use of its mark for the goods that it wanted to rely upon in the opposition. Therefore, the opponent can rely upon the goods listed above in paragraph 3.

12. 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 GOODS**

13. The applicant's goods to be compared can be found in paragraph 2, and the opponent's goods to be compared can be found in paragraph 3.

14. The General Court ("GC") confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, that, even if goods (although it equally applies to services) are not worded identically, they can still be considered identical if one term falls within the scope of another or (vice versa):

> "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".

15. I note that the opponent submits that the goods are identical. I agree with the opponent's submission and consider that the applicant's goods, being *"football shoes", "gymnastic shoes", "footwear", "boots", "shoes", "sport shoes"* and *"footmuffs, not electrically heated"* are either self-evidently identical or encompassed by the opponent's *"footwear"* and are, therefore, identical on the principle outlined in *Meric.*

**THE AVERAGE CONSUMER AND THE PURCHASING PROCESS**

16. As the law above indicates, it is necessary for me to determine who the average consumer 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 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."

17. In my view, the average consumer of the goods at issue will be members of the general public. The goods at issue will be available via various retailers. Regardless of the retailer, the goods at issue will be displayed on shelves or racks and self-selected by the consumer. In addition, the goods at issue will also be available via the retailers' online equivalents, where they will be displayed on webpages and will be selected by the consumer after having viewed an image of the products. In my view, the visual aspect will dominate the selection process; however, I do not discount the aural component playing a role by way of word-of-mouth recommendations or after discussions with sales people. It is my understanding that the goods at issue will range both in price and in the frequency of the purchase, with, for example, more high-end footwear being purchased less frequently and having a higher cost.

18. Turning to the level of attention paid, the goods will attract a range of factors such as the aesthetic, the materials used and the reputation of the brand. While the goods at issue are goods that can vary in price and in some cases be rather expensive, but it is not likely to be at the very highest end of the scale, the factors considered are not particularly complex, and I am of the view that, regardless of the price, the consumer will pay a medium degree of attention.

**COMPARISON OF THE MARKS**

19. The respective trade marks are shown below:

| CuteJazz | Jazz |
|---|---|
| **The applicant's mark** | **The opponent's mark** |

20. 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 trade marks must be assessed by reference to all the overall impressions created by the trade 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."

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

22. The applicant's mark consists of the word 'CuteJazz' which appears in a standard font. Despite being presented as a conjoined word, I agree with the opponent that it will be perceived as two recognisable dictionary words. This is based on the capitalisation of the letters 'C' and 'J' which, are the initial letters in each word. In addition, this is also because even though consumers normally perceive marks as a whole, they nevertheless will break down elements if they suggest a meaning or resemble words known to them.[3] I note that the opponent submits that 'cute' is a word that is used to describe the clothing which appears in the applicant's specification,

[3] *Usinor SA v OHIM,* Case T-189/05,

and, therefore, the greater impression of the applicant's mark should lie in the word 'Jazz'. Whilst this is noted, I am aware that clothing is not a good at issue in these proceedings. Further, contrary to the opponent's submissions, I do not consider that it is descriptive of the goods at issue.[4] Descriptive in this instance would mean to indicate what the goods are or what the goods are like, for example, if the mark was 'Jazz Footwear' and it was being used on footwear, then this is descriptive of the goods. That is not the case here. Therefore, I disagree with the opponent that the greater impression lies in the 'Jazz' element of the applicant's mark. Rather, taking all the above into account, I believe that the two words will be perceived to hang together as a combination. Taking all this into account, I consider that the overall impression of the mark lies in the words as a whole.

23. The opponent's mark consists of the word 'Jazz' which appears in standard font. As plain word marks, they are protected in whatever colour or standard font they are used in.[5] There are no other elements that contribute to the overall impression of the mark.

24. Visually, the marks share the word 'Jazz'. The opponent's 'Jazz' mark is wholly contained at the end of the applicant's mark. The other element in the applicant's mark, being 'Cute', is not present in the opponent's mark. Taking all of this into account, I am of the view that the marks are visually similar to a medium degree.

25. Aurally, the marks will coincide in the ordinary dictionary pronunciation of the word 'Jazz' but differ in the ordinary dictionary pronunciation of 'Cute' in the applicant's mark. Taking the above into account, I consider the marks to be aurally similar to a medium degree.

26. The marks are conceptually similar inasmuch as they share the word and subsequent concept evoked from the word 'Jazz', being a type of music that was invented by African American musicians in the early part of the twentieth century. I consider that the word 'Jazz' as an aspect of the applicant's marks and the totality of the opponent's mark, whilst not descriptive of the goods at issue, may be suggestive/allusive in relation to footwear, as there is a type of shoes called 'jazz

[4] Opponent's submissions, paragraph 22.
[5] *La Superquimica v EUIPO*, Case T-24/17, paragraph 39.

shoes' specifically used for jazz dance. The presence of the ordinary dictionary word 'cute' in the application is a point of conceptual difference. As submitted by the opponent in exhibit FPT03, cute is defined as *"something or someone that is cute is very pretty or attractive, or it is intended to appear pretty or attractive".* The word 'cute' qualifies the word 'Jazz', creating the concept of pretty or attractive jazz shoes. I consider that this results in a medium to high degree of conceptual similarity between the competing trade marks.

**THE DISTINCTIVE CHARACTER OF THE OPPONENT'S MARK**

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

> "22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* v *Huber and Attenberger* [1999] ECR I-0000, paragraph 49).
>
> 23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)."

28. 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.

29. The opponent has not pleaded enhanced distinctive character through use and has not filed evidence to support such a claim, therefore, I have only the inherent position to consider.

30. The earlier mark consists of the word 'JAZZ'. 'JAZZ' is an ordinary dictionary word. In my view, the mark, whilst not descriptive of the goods at issue, may be suggestive/allusive in relation to footwear, because, as mentioned above, there is a type of shoes called 'jazz shoes' specifically used for jazz dance. Taking this into account, I consider that the earlier mark possesses a low to medium degree of inherent distinctive character.

**LIKELIHOOD OF CONFUSION**

31. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade mark, the average consumer of the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

32. I have found the marks to be visually and aurally similar to a medium degree. I have found the marks to be conceptually similar to a medium to high degree. I have found the inherent distinctive character in the opponent's mark to be low to medium. For the goods, I have found them to be identical. I have found that the average

consumer will pay a medium degree of attention during the purchasing process. They will select the goods on a primarily visual basis, although I do not discount aural considerations.

33. Taking all the above into account and even bearing in mind the principle of imperfect recollection, I am of the view that the differences between the parties' marks are sufficient to overcome a likelihood of direct confusion. The medium degree of aural and visual similarity between the marks will, in my view, enable the average consumer to recall and/or remember the differences between the marks. While the 'JAZZ' element appears in both parties' marks, the additional element of 'Cute' in the applicant's mark will not be overlooked or forgotten. Especially given that point of difference appears at the beginning of the application and consumers are believed to place more emphasis on seeing and reading the initial elements of a mark.[6] Even when the average consumer encounters the marks aurally, the aural differences between the marks are fairly significant and I see no reason why the consumer would misremember or inaccurately recall the marks aurally to the extent that they will be mistaken for each another. Consequently, I find that there is no likelihood of direct confusion, even in circumstances where the marks at issue are displayed in relation to identical goods.

34. Indirect confusion involves the recognition by the average consumer of the differences between the marks. Mr Purvis QC (as he was then) in the *L.A Sugar Limited* case sets out that there are three main categories of indirect confusion and that indirect confusion 'tends' to fall into one of them.[7] Indirect confusion was described in the following terms by Iain Purvis Q.C.,(as he was then) sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

> "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

[6] *El Corte Ingles v OHMI (MUNICOR)* (n114),[83]
[7] Paragraphs 16 & 17 of *L.A Sugar Limited v By Black Beat Inc*, Case BL-O/375/10

some kind on the part of the consumer when or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: "The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ("26 RED TESCO" would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as "LITE", "EXPRESS", "WORLDWIDE", "MINI" etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ("FAT FACE" to "BRAT FACE" for example)."

35. Whilst I note that the examples set out by Mr Purvis are not exhaustive, I note the case of *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors,*[8] wherein Arnold LJ referred to the comments of James Mellor QC (as he was then) sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he stated that a finding of a likelihood of indirect confusion is not a consolidation prize and that there needs to be a reasonably special set of circumstances in order to get indirect confusion where there is no likelihood of direct confusion. Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

[8] [2021] EWCA Civ 1207

36. As referenced in the case law above, indirect confusion exists where the differences between the marks are noticed, and those differences point to the existence of an economic relationship between the marks at issue (be that being owned by the same undertaking or an economically connected one). While this may be the case, it is still possible for indirect confusion to exist where some differences are overlooked but some are not.

37. I consider that the average consumer, when confronted with the applicant's and the opponent's marks, will notice the differences between the marks. I am of the view that when the average consumer sees the identical 'JAZZ' element and the addition of the allusive word 'CUTE' in the applicant's mark, this will lead the average consumer to think that the marks came from the same or related undertakings. The differences between the marks will then, consequently, be put down to a form of rebranding and sub-branding. I consider that the word 'Jazz' will be viewed as a house brand and 'CuteJazz' will be seen as a sub-brand, potentially specialising in more aesthetically pleasing or decorative shoes and not merely practical shoes. In addition, I note that the goods operate in the same broad industry, being the footwear sector, and it is not unheard of for an undertaking to look to expand within the same sector. Consequently, I consider that there is a likelihood of indirect confusion between the marks for all of the goods that I have found to be identical.

**CONCLUSION**

38. The opponent's 5(2)(b) ground has succeeded in relation to the goods opposed. I am mindful that not all of the goods were opposed in these opposition proceedings. The opposition has succeeded for the following goods which will be refused:

> Class 25: Football shoes; gymnastic shoes; footwear; boots; shoes; sport shoes; footmuffs, not electrically heated.

39. The application will proceed to registration for the following goods, which were not subject to opposition:

> Class 25: Class 25: Jerseys [clothing]; waterproof clothing; trousers; clothing; shirts; sweaters; skirts; sports jerseys; dresses; overcoats; tee-shirts; clothing incorporating LEDs; underwear; dressing gowns; tights; corselets; corsets

[underclothing]; waistcoats; pyjamas; underpants; adhesive bras; babies' pants [underwear]; layettes [clothing]; bathing caps; bathing trunks; bathing suits; clothing for gymnastics; masquerade costumes; berets; hats; hosiery; sweat-absorbent socks; gloves [clothing]; cycling gloves; shawls; neckties; scarves; girdles; shower caps; sleep masks; wedding dresses.

## COSTS

40. The opponent has been fully successful in its partial opposition. Therefore, the opponent is entitled to an award of costs. The proceedings started after February 2023, and so the costs award will be based on the scale outlined in Tribunal Practice Notice (TPN) 1/2023. The sum to be awarded to the opponent will be as follows:[9]

| | |
|---|---|
| Filing a statement and considering the other side's statement | £250 |
| Filing evidence | £600 |
| Filing of submissions in lieu | £350 |
| **Total** | **£1200** |

41. I, therefore, order Shenzhen Kaibojingchao Enterprise Management Consulting to pay Saucony, Inc. the sum of £1200. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

**Dated this 4th day of August 2025**

**A Klass**
**For the Registrar**

[9] Initially, in an email to the Registry on 3 April 2024, the opponent requested security of costs against the applicant. The opponent subsequently emailed the tribunal on 28 January 2025 and withdrew the request for security of costs. Accordingly, this matter has not been discussed in the costs award.