

**BL O/0816/25**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF  
TRADE MARK APPLICATION NUMBER 3903681  
BY JEROME DELGARDO WILLIAMS  
TO REGISTER THE FOLLOWING TRADE MARK:**

**OOA**

**IN CLASS 25**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NUMBER 442396  
BY RISE UP FASHION GMBH**

## Background and pleadings

1. On 21 April 2023, Jerome Delgado Williams (“the applicant”) applied to register in the UK the trade mark shown on the cover page of this decision, under number 3903681 (“the applicant’s mark”). The applicant’s mark was published in the Trade Marks Journal for opposition purposes on 5 May 2023 in respect of the following goods:

**Class 25:** Hoodies, Tshirts, Joggers, Sweaters, Jumpers, Shirts, Hats, Caps, Leggings, Dresses, Shorts, Jackets, Clothing, aprons [clothing], ascots, pants for babies, bandanas, bath robes, bathing trunks, drawers as clothing, bathing suits, swimsuits, beach coverups, belts for clothing, bib overalls, boas, bodices, brassieres, breeches, camisoles, chasubles, clothing, clothing belts made from imitation leather, coats, collar protector pads, collars, shoulder wraps, combinations being one-piece undergarments, corsets, cuffs, cyclists' jerseys, detachable collars, dress shields, dresses, dressing gowns, ear muffs, fishing vests, footmuffs, fur stoles, furs muffs, gabardines, garters, shapewear, gloves, heelpieces for stockings, hoods, hosiery, sports jackets, rain jackets, jerseys, jumper dresses, knitwear, clothing layettes, leggings, leg warmers, liveries, maniples, masquerade costumes, mittens, money belts, neckties, overalls, smocks, overcoats, topcoats, pants, drawers, parkas, pelerines, pelisses, petticoats, pocket squares, pockets for clothing, ponchos, pullovers, pajamas, ready-made linings, saris, sarongs, sashes, scarves, shawls, shirt yokes, shirt fronts, short-sleeved shirts, singlets, sports jerseys, ski gloves, skirts, sleep masks, slippers, sock suspenders, socks, spats, stocking suspenders, stockings, sweat-absorbent stockings, stuff jackets, suits, suspenders, sweat-absorbent underclothing, anti-sweat underclothing, anti-sweat underwear, sweaters, teddies being underclothing, tee-shirts, tights, togas, trouser straps, trousers, underpants, underwear, uniforms, veils, vests, waistcoats, waterproof jackets, and wet suits, fleece shorts, crew neck, pullover windbreaker, windbreaker, sweatshirt, track jacket, track pants, tracksuit, jerseys, basketball jerseys, sock, shoes, trainers.

2. On 7 August 2023, Rise Up Fashion GmbH, (“the opponent”) filed a notice of opposition, opposing the application in full under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”).

The opponent relies upon the following trade mark:

## **OA**

UK registration number 918106282

Filing date: 9 August 2019

Registration date: 15 January 2020

3. For the purpose of these proceedings the opponent relies upon some of the goods in Classes 18, 25 and 26, for which the mark is registered, namely:

**Class 18:** Luggage and carrying bags; Bags for sports clothing; Sports packs; Sports and athletic bags.

**Class 25:** Clothing; Tops [clothing]; Sportswear; Articles of sport clothing; athletic pants; Sports shoes; Athletic shirts; Caps for sports; Socks for sports; Sportsjackets; Sports jerseys; Sports singlets; Moisture-absorbing sports shirts; Moisture-absorbing sports trousers; Athletic tights; Sports brassieres; Clothing for athletic use,; Maillots [hosiery]; Sports caps and hats; yoga pants (trousers); Footwear for yoga; Yoga T-shirts; Bonnetterie; Footwear; Athletics shoes; Inner socks for footwear; Athletics shoes.

**Class 26:** ribbons (elastic —); elastic tape; Accessories for clothing, sewing materials and decorative textile articles; Charms [not jewellery or for keys, rings or chains].

4. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing registered EUTM or International Registration designating the EU. As a result, the opponent's mark was converted into a comparable UK trade mark. Comparable UK marks are now recorded in the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and the original filing dates remain the same.<sup>1</sup>

5. Given the filing date, the opponent's mark is an earlier mark, in accordance with section 6 of the Act. However, as it had not been registered for five years or more at the filing date of the application, it is not subject to the proof of use requirements specified within section 6A of the Act. As a consequence, the opponent may rely upon all of the goods for which the earlier mark is registered without having to establish genuine use.

6. In its notice of opposition, the opponent states that the application should not be registered because the opposed mark is similar to the earlier mark and covers goods that are identical or similar to goods covered by the earlier mark, such that there exists a likelihood of confusion on the part of the public, including a likelihood of association.

7. The applicant filed a defence and counterstatement denying the grounds for opposition.

8. The applicant represents themselves and the opponent is represented by Wilson Gunn. A hearing was not requested and no evidence or submissions in lieu of a hearing were filed. This decision is taken following a careful consideration of the papers.

## **RELEVANCE OF EU LAW**

9. 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

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<sup>1</sup> See also Tribunal Practice Notice ("TPN") 2/2020 End of Transition Period – impact on tribunal proceedings.

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**

### Comments on s5(4)(a)

10. I note the various statements that have been made by the applicant in its counterstatement in relation to passing off<sup>2</sup>. The proceedings before me are in relation to an opposition based on s5(2)(b) only and not s5(4)(a). Therefore, these comments are not relevant and will not be considered in my assessment.

## **DECISION**

### **Section 5(2)(b)**

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

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<sup>2</sup> TM8, pages 6 & 7, paragraphs 3 & 4

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. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant, but someone who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them they have kept in their 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 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 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**

13. Section 60A of the Act provides:

“(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the “Nice Classification” means the system of classification under the Nice Agreement Concerning the International

Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975.”

14. The competing goods and services are as follows:

Opponent's goods	Applicant's goods
<p><b>Class 18:</b> Luggage and carrying bags; Bags for sports clothing; Sports packs; Sports and athletic bags.</p>	
<p><b>Class 25:</b> Clothing; Tops [clothing]; Sportswear; Articles of sport clothing; athletic pants; Sports shoes; Athletic shirts; Caps for sports; Socks for sports; Sportsjackets; Sports jerseys; Sports singlets; Moisture-absorbing sports shirts; Moisture-absorbing sports trousers; Athletic tights; Sports brassieres; Clothing for athletic use,; Maillots [hosiery]; Sports caps and hats; yoga pants (trousers); Footwear for yoga; Yoga T-shirts; Bonnetterie; Footwear; Athletics shoes; Inner socks for footwear; Athletics shoes.</p>	<p><b>Class 25:</b> Hoodies, Tshirts, Joggers, Sweaters, Jumpers, Shirts, Hats, Caps, Leggings, Dresses, Shorts, Jackets, Clothing, aprons [clothing], ascots, pants for babies, bandanas, bath robes, bathing trunks, drawers as clothing, bathing suits, swimsuits, beach coverups, belts for clothing, bib overalls, boas, bodices, brassieres, breeches, camisoles, chasubles, clothing, clothing belts made from imitation leather, coats, collar protector pads, collars, shoulder wraps, combinations being one-piece undergarments, corsets, cuffs, cyclists' jerseys, detachable collars, dress shields, dresses, dressing gowns, ear muffs, fishing vests, footmuffs, fur stoles, furs muffs, gabardines, garters, shapewear, gloves, heelpieces for stockings, hoods, hosiery, sports jackets, rain</p>

	<p>jackets, jerseys, jumper dresses, knitwear, clothing layettes, leggings, leg warmers, liveries, maniples, masquerade costumes, mittens, money belts, neckties, overalls, smocks, overcoats, topcoats, pants, drawers, parkas, pelerines, pelisses, petticoats, pocket squares, pockets for clothing, ponchos, pullovers, pajamas, ready-made linings, saris, sarongs, sashes, scarves, shawls, shirt yokes, shirt fronts, short-sleeved shirts, singlets, sports jerseys, ski gloves, skirts, sleep masks, slippers, sock suspenders, socks, spats, stocking suspenders, stockings, sweat-absorbent stockings, stuff jackets, suits, suspenders, sweat-absorbent underclothing, anti-sweat underclothing, anti-sweat underwear, sweaters, teddies being underclothing, tee-shirts, tights, togas, trouser straps, trousers, underpants, underwear, uniforms, veils, vests, waistcoats, waterproof jackets, and wet suits, fleece shorts, crew neck, pullover windbreaker, windbreaker, sweatshirt, track jacket, track pants, tracksuit, jerseys, basketball jerseys, sock, shoes, trainers.</p>
<p><b>Class 26:</b> ribbons (elastic —); elastic tape; Accessories for clothing, sewing</p>	

materials and decorative textile articles; Charms [not jewellery or for keys, rings or chains].	
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15. 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.”

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

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This

inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

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

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or 10 where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

18. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM), Case T-325/06, the GC stated that “complementary” means: “...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking.”

19. 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."

20. 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 Page 9 of 22 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."

21. For the purposes of considering the issue of similarity, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons.<sup>3</sup>

22. It is noted that there are duplicate terms that appear in the applicant's specification. Whilst performing my comparison, I will refer to these terms only once.

## **Class 25**

*Clothing; clothing, sports jerseys; sports jackets.*

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<sup>3</sup> See *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38.

23. The above goods for which the applicant seeks registration are present in the specification of the earlier mark relied upon by the opponent and are, therefore, self-evidently identical.

*Anti-sweat underclothing, anti-sweat underwear, bath robes, bathing trunks, bathing suits, beach coverups, bodices, brassieres, camisoles, clothing layettes, coats, combinations being one-piece undergarments, corsets, crew neck, drawers, drawers as clothing, dresses, dressing gowns, fleece shorts, furs muffs, fur stoles, gabardines, hoodies, hosiery, jackets, joggers, jumper dresses, jumpers, knitwear, leggings, overcoats, pants, pants for babies, pajamas, parkas, pelerines, pelisses, petticoats, ponchos, pullovers, pullover windbreaker, rain jackets, saris, sarongs, shapewear, shawls, shirts, shorts, short-sleeved shirts, shoulder wraps, skirts, slips, smocks, stockings, stuff jackets, suits, sweat-absorbent stockings, sweat-absorbent underclothing, sweaters, sweatshirt, swimsuits, teddies being underclothing, tee-shirts, tshirts, tights, togas, topcoats, tracksuit, track pants, track jacket, trousers, underpants, underwear, vests, waistcoats, waterproof jackets, windbreaker.*

24. The opponent's earlier mark is registered for "*clothing*", which as a broad term encompasses the above goods. Therefore, these goods are identical in line with the principle set out in *Meric*.

*Hats, Caps.*

25. The opponent's earlier mark is registered for "*Sports Caps and Hats*", which are encompassed in the above goods. Therefore, these goods are identical in line with the principle set out in *Meric*.

*Ski gloves*

26. The opponent's earlier mark is registered for "*Sportswear*", which as a broad term encompasses the above goods. Therefore, these goods are identical in line with the principle set out in *Meric*.

## *Jerseys*

27. The opponent's earlier mark is registered for "*Sports jerseys*", which is encompassed in the above broader term. Therefore, these goods are identical in line with the principle set out in *Meric*.

*Cyclists' jerseys, basketball jerseys.*

28. The above goods are encompassed within the opponent's "*Sports jerseys*", and are therefore identical in line with the principle set out in *Meric*.

*Singlets.*

29. The opponent's earlier mark is registered for "*Sports singlets*", which is encompassed in the above goods. Therefore, these goods are identical in line with the principle set out in *Meric*.

*Socks, sock.*

30. The opponent's earlier mark is registered for "*Socks for Sports*", which is encompassed in the above goods. Therefore, these goods are identical in line with the principle set out in *Meric*.

*Shoes, trainers.*

31. The opponent's earlier mark is registered for "*Footwear*", which as a broad term encompasses the above goods. Therefore, these goods are identical in line with the principle set out in *Meric*.

32. That concludes my summary of the goods which I have identified as either strictly identical or identical under the principle of *Meric*.

*Ascots, bandanas, belts for clothing, boas, clothing belts made from imitation leather, detachable collars, ear muffs, footmuffs, garters, gloves, leg warmers, mittens, money*

*belts, neckties, pocket squares, sashes, scarves, sleep masks, sock suspenders, stocking suspenders, suspenders, trouser straps, veils.*

33. I consider that the above contested goods in the applicant's specification are not, in my view, items of clothing, despite two of them being identified as such (belts for clothing; clothing belts made from imitation leather). Rather, I consider that these items are wearable accessories, which refer to goods that can be added to something else to make it more useful, attractive or versatile. They can complete an outfit and complement the wearer's look. As such, I will compare the applicant's class 25 goods to the opponent's class 26 goods 'Accessories for clothing'. As wearable accessories, I find the respective goods may share the same trade channels and be sold in the same outlets. There may be an overlap in nature as the applicant's goods are wearable accessories that can be added to clothing for a specific purpose. There may also be an overlap in users who are looking to enhance or compliment clothing, thereby creating a shared purpose. Taking all these factors into account, I find a medium degree of similarity between the respective goods.

*Ready-made linings, dress shields, collar protection pads.*

34. I consider that the best comparison lies in the opponent's "*clothing*", to the extent that the above goods could be described as parts or elements of clothing articles. The applicant's "*Ready-made linings*" are pre-fabricated materials that are used to line the inside of garments for a number of purposes, such as, reducing the wearing strain on clothes, thereby extending the life of the garment. The applicant's "*dress shields*" and "*collar protection pads*" are liners to clothing that protect a garment against perspiration to prevent stains and to keep the garments clean and fresh. As such, the applicant's goods provide an element of protection to the finished article of '*clothing*'. As set out in *Les Editions Albert Rene v OHIM*,<sup>4</sup> it is clear that just because a particular good is used as a part, element or component of another, it should not result in a finding of identity/similarity between those goods. However, it does not mean that there can never be similarity between such goods where there is overlap in the factors identified in *Treat*. Taking the *Treat* factors into account, I consider that the above

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<sup>4</sup> Case T-336/03

goods would differ in nature, as the applicant's goods are not intrinsically parts of clothing. They would differ in purpose, as they may be 'added' to clothing, to protect and extend the life of a garment, whilst the overall primary purpose for 'clothing' is to protect the human body. Although they may be available to the general public, they will be predominantly selected by professionals responsible for the manufacture of clothing, so there will be a limited overlap in users. The goods will not be in competition with each other or be complementary, as one is not indispensable or important for the use of the other and as such, consumers are unlikely to assume the respective goods are from the same undertaking. On balance, I find that these goods are similar to a very low degree.

*Heelpieces for stockings, pockets for clothing, shirt yokes, shirt fronts, collars, cuffs, hoods.*

35. I consider that the applicant's goods and the opponent's "clothing" are comparable on the basis that the former, are components of clothing. Bearing in mind *Les Editions Albert Rene v OHIM* as mentioned above and considering the factors identified in *Treat*, I find there would be a limited overlap in nature based on the materials used, even where "clothing" is the finished article and the applicant's goods are "components" of clothing, as there will be some compatibility between the components and the finished article. The goods will differ in purpose as the applicant's goods are component parts of clothing that are used to create the finished article and the opponents 'clothing', is the finished article. I am of the view that the average consumer for clothing at large is the general public, while the average consumer for components of clothing, whether they intend to make clothes for personal or professional use, is likely to represent a smaller demographic of the general public. As the goods are unlikely to be found in the same retail outlets or online stores, they unlikely to overlap in trade channels. As the goods will satisfy different roles, they are unlikely to be in competition with each other; however, the respective goods may be complimentary, as a 'shirt front' for example, will be necessary for the creation of the finished article and it would not be unusual for consumers to believe that they are produced by the same manufacture and therefore assume that the responsibility for those goods lies with the same undertaking. Considering all of these factors, I find a medium degree of similarity in the respective goods.

*Aprons [clothing], bib overalls, overalls, uniforms.*

36. The contested goods are all purpose-specific goods. For example, the purpose of an apron or overalls may be to offer protection, and a uniform may identify membership to a particular organisation or profession. Therefore, there is a difference in the purpose to that of the earlier term “*clothing*”. This would also create a level of distinction in their respective uses and users. However, there is an overlap in nature, as the goods are wearable and some limited overlap in trade channels, as these goods, for example ‘*uniforms*’, may be found by the general public in the clothing section of retail outlets and supermarkets. However, the goods are not complementary or in competition with each other. Accordingly, I find the goods to be similar to between a low to medium degree.

*Breeches, chasubles, maniples, fishing vests, liveries, masquerade costumes, wet suits.*

37. The contested goods are all purpose-specific goods. For example, chasubles and maniples are religious attire and a wet suit or fishing vest will be relevant to certain activities or hobbies. This creates a difference in the primary purpose of the earlier term “*clothing*”, which is to protect the human body. Furthermore, this would create a distinct difference in their respective uses and users. However, due to the goods being wearable, there will be an overlap in nature but there will be no overlap in trade channels as these goods will only be available in specialist stores. Accordingly, I find the goods to be similar to a low degree.

*Spats.*

38. The opponent’s best comparison lies in the broader term “*clothing*”. I have no submissions or evidence to help me with the contested goods. To my knowledge, the above goods are wearable goods and are predominantly selected for their specific purpose or protective qualities. “Spats” are shoe coverings,<sup>5</sup> that were traditionally

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<sup>5</sup> See Oxford English Dictionary, <https://doi.org/10.1093/OED/9306862990>.

designed to protect shoes and ankles from mud and water while walking. Although the primary purpose for “*clothing*” overall is to protect the body, the applicant’s goods are generally selected for a specific purpose, which creates a difference in the goods’ main use. There may be an overlap in users, and there is likely to be an element of similarity in the physical nature of the goods. However, trade channels are likely to differ, and they are more likely to be sold by a specialist supplier in stores or online equivalents. The respective goods are not competitive and not complementary, although they would be used in conjunction with one another. Accordingly, I find a low degree of similarity in these goods.

### **The average consumer and the nature of the purchasing act**

39. The average consumer 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 or services in question (see *Lloyd Schuhfabrik Meyer*, Case C-342/97).

40. 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.”

41. As the goods at issue are items of clothing, the average consumer of the goods will be members of the general public, with the goods self-selected from high street outlets or specialist stores, or their online equivalents. However, for those goods that fall within the remit of components of clothing, these are likely to be purchased

predominantly by clothing manufacturers and business users or, to a lesser degree, by those members of the general public who have an interest in producing ready-made clothing. Therefore, the purchasing process will be a primarily visual process, although I do not discount a verbal element due to aural recommendations through peers or sales assistants. The goods may vary in price and are likely to be purchased frequently. Various factors will be taken into consideration during the purchasing process such as suitability of the goods for the consumer's needs, materials used, aesthetic appearance and durability. Consequently, taking all these factors into account, I find that where the average consumer is the general public, they will pay a medium degree of attention during the purchasing process, which may be slightly higher than medium when purchased by a professional/business user, such as a manufacturer.

### **Comparison of marks**

42. It is clear from *Sabel BV v. Puma AG* 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 them, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo SA v OHIM*, that:

“34. [...] 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.”

43. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account their distinctive and dominant components 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.

44. The trade marks to be compared are as follows:

<b>Opponent's mark</b>	<b>Applicant's mark</b>
OA	OOA

45. The opponent in its statement of grounds claims that:

*“The Opposed Mark differs from the Earlier Mark only by a single letter, being an additional ‘O’ at the start of the mark. Both marks share the identical two-letter combination ‘OA’. Since the only difference between the marks is an additional letter ‘O’ at the start of the Opposed Mark, the respective marks are visually and phonetically similar. Overall, the Opposed Mark is similar to the Earlier Mark to a high degree.”<sup>6</sup>*

46. The applicant in its counterstatement contends that:

*“Likelihood of Confusion: While we understand your concern regarding the similarity between our “OOA Mark” and your client’s “OA Mark,” we contend that there are significant distinctions that should be taken into account. Our mark, “OOA,” is prominently associated with our brand name, “Ohms Owl Apparel,” and our targeted audience, namely the urban music and art subcultures. This specific focus results in a distinct overall presentation, message, and consumer perception.”<sup>7</sup>*

## **Overall Impression**

47. The earlier mark comprises of the letters “OA”. Therefore, the overall impression of the earlier mark lies in those two letters. Similarly, the overall impression of the applicant’s mark lies in the letters “OOA”.

## **Visual Comparison**

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<sup>6</sup> Form TM7, page 7, paragraph 6

<sup>7</sup> Form TM8, page 6, paragraph 2

48. The marks share the letters 'O' and 'A', positioned next to each other in both marks. A point of difference is the additional letter 'O' in the applicant's mark. The position of the additional letter 'O' may be noticed at the beginning of the mark, a position that generally has more impact<sup>8</sup>. Both marks also end with the same letter 'A'. I also bear in mind that there is no special test which applies to the comparison of short marks, the visual similarities must be assessed in the normal way.<sup>9</sup> However, the change of one letter to a mark which is only three letters long is more significant than a change of one letter to a longer mark.<sup>10</sup> On balance, I find that there is a medium degree of similarity between the marks.

### **Aural Comparison**

49. Neither mark is capable of being pronounced as a word so consumers will instead sound out the letters. As the respective marks contain the identical letters 'O' and 'A', with the additional letter 'O' at the beginning of the applicant's mark being a point of difference, I find that there is a medium degree of similarity between the marks.

### **Conceptual Comparison**

50. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R 29. The assessment must, therefore, be made from the point of view of the average consumer.

51. In its counterstatement, the applicant has indicated that the letters OOA is prominently associated with their brand name, "Ohms Owl Apparel". However, in the absence of evidence, this is not a conceptual factor that I can consider as this information is not known to consumers at large. Conceptually, in my view, the letters in both marks will have no particular meaning to the average consumer. The letters

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<sup>8</sup> *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

<sup>9</sup> *Bosco Brands UK Limited v Robert Bosch GmbH*, Case BL- O/301/20, paragraph 44.

<sup>10</sup> I refer to the finding of Mr Iain Purvis Q.C. (as he then was), acting as the Appointed Person in BL O/277/12, who stated: "In considering visual similarity, it was clearly right to take into account the shortness of the marks, since a change of one letter in a mark which is only 4 letters long is clearly more significant than such a change in a longer mark."

are likely to be viewed as an abbreviation or acronym, neither of which would be commonly known to the general public at large. Alternatively, the average consumers will view the terms as invented. Therefore, it is my view that neither mark will create a particular concept in the mind of the consumer. I therefore find the marks to be conceptually neutral.

### **Distinctive character of the earlier mark**

52. In *Lloyd Schuhfabrik Meyer*, 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 Alternberger* [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, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words

which have no allusive qualities. The distinctive character of a mark can be enhanced by virtue of the use that has been made of it.

54. Although the distinctiveness of a mark can be enhanced by virtue of the use that has been made of it, the opponent has not filed any evidence of use in relation to its mark. Consequently, I have only the inherent position to consider.

55. The earlier mark is comprised of two letters 'OA'. 'OA' is an invented term or combination of letters, with no particular meaning. There does not appear to be a clear relationship with the goods relied upon. Accordingly, I find the earlier mark to be inherently distinctive to a high degree.

### **Likelihood of confusion**

56. In determining whether there is likelihood of confusion, I must take all the above factors into account and consider if there is a likelihood of confusion for the average consumer.

57. 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 goods and services may be offset by a greater degree of similarity between the marks and vice versa. I must bear in mind the distinctive character of the earlier marks, the average consumer for the goods and services and the nature of the purchasing act. To do so, I must recognise 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.

58. I have found that the average consumer will predominantly be a member of the general public. However, for those goods that fall within the remit of components of clothing, these are likely to be purchased predominantly by clothing manufacturers and business users or, to a lesser degree, by those members of the general public who have an interest in producing ready-made clothing. The goods at issue will be purchased via primarily visual means, although I don't discount an aural component. I have concluded that the general public will pay a medium level of attention or if a professional/business user, a slightly higher than medium level of attention. I have found the marks to be visually and aurally similar to a medium degree and conceptually neutral. I have found the opponent's mark to be inherently highly distinctive. I have found the goods at issue to be identical, either strictly or *Meric* or similar to various degrees, including a low to medium and low degree.

59. I note that the marks are short marks, differing in the presence of the additional letter 'O' at the beginning of the applicant's mark. Even if the diverging letter is considered to be in a more impactful position, this does not preclude a finding of a likelihood of confusion as such. In *Bristol Global Co Ltd v EUIPO*, T-194/14, the General Court held that despite the fact that the beginnings of the marks were different, the common element was sufficient to create the necessary degree of similarity between the marks as wholes for the opposition to succeed. The opponent's mark is highly distinctive and neither mark has a concept to assist the average consumer in differentiating between them. Considering the principles of imperfect recollection and interdependency along with the above factors, I find that the difference created by the additional letter 'O', may not be sufficient to allow the average consumer to recall the respective marks with sufficient accuracy (even when paying slightly higher than a medium degree of attention) or differentiate between them. Due to the structure of the marks and their letter sequence, part of which is replicated in one another, they may misremember one for the other, assuming they are one and the same. Therefore, I consider there to be a likelihood of direct confusion.

60. For completeness, I find that there is a likelihood of direct confusion, even on those goods that are similar to a very low degree.

## **Conclusion**

61. The opposition based on s5(2)(b) of the Act has succeeded. Subject to any successful appeal, the application will be refused.

## **COSTS**

62. The opponent has been successful and it is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023<sup>11</sup>. I award the opponent the sum of £350 as a contribution towards its costs. The sum is calculated as follows:

Preparing a statement and considering the other side's statement:	£250
Official fee:	£100
<b>Total:</b>	<b>£350</b>

63. I therefore order Jerome Delgado Williams to pay Rise Up Fashion GmbH the sum of £350. This 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 4<sup>th</sup> day of September 2025**

**Mrs Joanne Roberts  
For the Registrar**

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<sup>11</sup> As the proceedings were commenced after 01 February 2023