

O/0821/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3999185
IN THE NAME OF JON CAWDRON
TO REGISTER THE FOLLOWING TRADE MARK:

Roots Darling

IN CLASSES 3 AND 25

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 446628
BY ROOTS CORPORATION

Background and pleadings

1. Jon Cawdron (“the applicant”) applied to register the trade mark **Roots Darling** (“the applicant’s mark”) in the UK on 8 January 2024, under number 3999185. It was accepted and published in the Trade Marks Journal on 26 January 2024 in respect of the goods in classes 3 and 25 listed in Annex A of this decision.

2. Roots Corporation (“the opponent”) opposes the trade mark on the basis of section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed at class 25 only. This is on the basis of its UK trade mark number 2231599, **ROOTS**. The opponent’s mark was filed on 04 May 2000 and became registered on 06 July 2001. It stands registered for goods in classes 14 and 25. For the purposes of the opposition, the opponent only relies on the class 25 goods, which are as follows:

Class 25: Clothing, footwear and headgear.

3. The opponent’s mark qualifies as an ‘earlier mark’ in accordance with section 6 of the Act. It had been registered for more than five years at the filing date of the applicant’s mark and is, therefore, subject to the use requirements in section 6A of the Act.

4. In its statement of grounds, the opponent contends that the competing marks are similar and that the parties’ goods are identical. On this basis, the opponent submits that there is a likelihood of confusion.

5. The applicant filed a counterstatement, denying the ground of opposition. It also indicated that it would require the opponent to provide proof of use of its mark.

6. The opponent is professionally represented by Barker Brettell LLP, whereas the applicant is not represented. Only the opponent filed evidence in these proceedings. No hearing was requested. Only the opponent filed written submissions in lieu. This decision is taken following careful consideration of all the papers before me.

Relevance of EU law

7. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained

EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

Evidence

8. The opponent's evidence consists of the witness statement of Andre Goddard, dated 29 October 2024, and five exhibits (MR01-MR05). Mr Goddard is the Senior Director of Finance for the opponent and has been employed by the opponent since May 2017. He provides evidence of use of the opponent's mark. Whilst the witness statement refers to six exhibits (MR01-MR06), the last exhibit (MR06) is not included within the body of evidence.

9. I have taken all the evidence into account in reaching my decision and will refer to it below where necessary.

Proof of use

10. Section 6A of the Act reads as follows:

“(1) This section applies where –

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes –

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

11. Pursuant to the above provisions, the relevant period for assessing whether there has been genuine use of the opponent’s mark is the five-year period ending with the filing date of the applicant’s mark, i.e. 9 January 2019 to 8 January 2024.

12. In *easyGroup Ltd v Nuclei Ltd & Ors*¹, Arnold LJ summarised the law relating to genuine use as follows:

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax*

¹ [2023] EWCA Civ 1247

Brandbeveiliging BV [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C-720/18 and C-721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37]. (2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37];

Verein at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23]. (5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

13. Moreover, section 100 of the Act states that:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

14. In the witness statement, Mr Goddard says that the opponent has used the mark in the UK in relation to all the class 25 goods in the five years preceding the relevant date.

15. Exhibit MR01 shows spreadsheets summarising sales figures for the goods marketed with the opponent’s mark in 2022 and 2023 in the UK. The spreadsheet shows that all have the country code ‘GB’. Pages 15, 16, and 25 show a range of locations across the UK in addition to the GB country code, such as London, Fife, Herefordshire, Wales, Surrey, and West Yorkshire. The descriptions of the goods in Exhibit MR01 show that the majority are types of clothing, headgear or footwear. These include fleece tops and bottoms, sweaters, hats, socks, t-shirts, dresses/skirts, “outerwear”, “sleepwear”, knit tanks, knitted tops and bottoms, shorts, gloves, scarves, boots, sandals and casual shoes. The clothing covers men, women, children, and babies/toddlers, as well as unisex clothing. I note that a small minority of the goods on pages 12, 13, 14, 15, 16, and 24 of the spreadsheets are accessories such as bags, wallets, and home goods. However, these goods do not form a significant portion of the listings submitted.

16. In his witness statement, Mr Goddard provides the following approximate sales figures:

Year	Sales figures (USD)
2019	95,000
2020	240,000
2021	195,000
2022	76,000
2023	73,000

17. Exhibit MR02 shows a range of sample invoices dated between 23 March 2019 and 05 January 2024 on pages 1 to 23. The invoices show the use of the composite

mark written as “Roots” in a basic typeface along with a figurative device, as shown below:



18. The invoices were issued to UK-based customers, with a range of different locations shown across the UK such as London, Cardiff, Cambridge, and Scunthorpe. At pages 24 to 34, Mr Goddard has provided images from the internet of the goods which feature in the invoices. These illustrate that the invoices related to jackets, t-shirts, hoodies and sweatshirts, jackets, sweatpants, shirts, shoes, and hats. Some of the goods sold specify “Roots” within the description name (such as on page 13), although this is not the case for all of the goods (such as the clothing on page 32). However, I acknowledge that they appear under the Roots composite mark in the actual invoice (on page 22).

19. Exhibit MR03 shows images of what Mr Goddard describes as the “Roots holiday collection for Autumn Winter 2019, 2021, 2022, and 2023”. Mr Goddard states that these images were used on the opponent’s website which is accessible globally, and the goods shown were available to customers in the UK. Exhibit MR03 has 35 pages, and the images show a variety of clothing goods with the word “Roots” written on them. The goods are consistent with the goods shown in the spreadsheets and invoices. The mark appears in basic typefaces on the goods, and also in the composite form shown at paragraph 17 above (for example page 2). The mark is less discernible on some of the images (for example on page 29) but appears to be present in at least one item of clothing on each page within Exhibit MR03. Furthermore, the witness states that all of these goods formed part of the ‘Roots’ collections, which has not been disputed by the applicant.

20. Exhibit MR04 contains screenshots of the Roots website (www.roots.com), obtained via the Wayback Machine. They are dated between 24 June 2019 and 8 December 2023. Mr Goddard states that these screenshots demonstrate that the

opponent offered goods for sale in GBP and shipped to the UK within the relevant period. Some of the screenshots show clothing bearing the word 'ROOTS' (such as on page 3). Even where others do not (such as on page 1), the goods are marketed on the website under the Roots brand. I note that pound sterling is listed as a purchasing currency in the screenshots from 2019 to 2022, whilst the UK is an available shipping country in those from 2023. The word 'Roots' appears in a basic typeface throughout. The composite mark shown at paragraph 17 featured on the website in 2023.

21. Page 1 of Exhibit MR05 shows an internet search performed on Google using "Roots clothing" as the search term. The top search result is "Roots Canada", which appears to be the website for the Canadian branch of the opponent's business. Although Mr Goddard highlights that the search was performed on google.co.uk, I can see that the search was set to "any country". Whilst Mr Goddard feels this shows use of the mark and highlights that the opponent's brand is the first result, internet searches use algorithms which become tailored to a user based upon their search history. Search results also vary over time and are dependent upon who is doing the search. As such, I place no real weight on the Google search results in Exhibit MR05. The data shown on page 2 of this exhibit gives the number of users with a cookie placed with a UK-based IP address. This shows that over 87,000 internet users with UK IP addresses visited roots.com in 2023.

22. The evidence is not without its limitations. For example, there are no details as to the spend on marketing activities to promote the mark in the UK. There are also no details in relation to the size of the relevant market or the share of that market held by goods bearing the opponent's mark.

23. However, an assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole.² The evidence establishes that goods bearing the opponent's mark (along with the mark itself) were displayed on the opponent's website and that around 87,000 users from the UK visited the website in 2023. This demonstrates that various items of clothing were offered for sale to UK-based consumers during the relevant period. In addition to this, whilst there is no

² *New Yorker SHK Jeans GmbH & Co. KG v OHIM*, Case T-415/09

indication of market share, Mr Goddard says that around £679,000 was generated through the sale of goods bearing the opponent's mark in the UK. These sales figures are supported by the invoices, which show sales during the relevant period to a number of different customers across the UK, as well as the spreadsheets showing sales in 2022/2023. These documents show that the sales were geographically widespread in this territory. A potential issue with the sales figures is that they have not been broken down by how much of it relates to clothing, how much of it relates to headgear, and how much of it relates to footwear. However, in this case, the list of goods relied upon are not lengthy or particularly varied and the evidence is focussed. Moreover, on the face of it, the figures provided seem modest in the context of the UK market for clothing, headgear, and footwear, which I understand to be very large. However, as the authorities cited above show, use does not need to be quantitatively significant for it to be considered genuine. Taking the evidential picture as a whole, i.e. the turnover figures, evidence of sales and the evidence of the website, I am satisfied that the opponent has demonstrated genuine use of its mark. Although the evidence mostly shows use of the opponent's mark in conjunction with a figurative device, use of a mark encompasses both its independent use and its use as part of another mark or in conjunction with that other mark.³ As such, the composite mark shown in evidence is acceptable variant use of the registered mark.

24. In determining a fair specification for the opponent's mark, I remind myself that fair protection is not to be achieved by identifying and defining particular examples of goods for which there has been genuine use but, rather, the particular categories of goods they should realistically be taken to exemplify.⁴ I must consider how the average consumer would fairly describe the goods shown in evidence.⁵ The majority of the evidence in exhibits MR01, MR02, and MR03 relates to a variety of different clothing goods for men, women, and children, as well as unisex clothing. There are also examples of both footwear and headgear within the evidence too. Whilst this is more limited than for clothing, there are multiple types of headwear listed on the invoices within exhibit MR01 (such as ladies' hats, men's hats, and general hats). Exhibits MR02 and MR03 also show several different styles of headgear sold under the

³ *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, paragraphs 32-35

⁴ *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10

⁵ *7 Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch)

ROOTS mark. I am also able to identify different types of footwear such as shoes, boots, and a variety of different styles of sock within exhibit MR01. Exhibits MR02 and MR03 also shows multiple types of footwear sold under the ROOTS mark, including different types of shoes/boots, and socks. I acknowledge that the goods relied upon by the opponent are broad categories which are capable of being broken down into various subcategories. However, it is my view that the range of different types of goods shown in evidence is sufficient for the purposes of demonstrating use for the broad categories. It is also considered that the average consumer would describe the goods shown in evidence as clothing, headgear and footwear. I therefore find that the opponent may rely upon all of their class 25 goods for the purposes of the opposition.

Section 5(2)(b)

25. Section 5(2)(b) of the Act is as follows:

“5(2) A trade mark shall not be registered if because-

(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”.

26. Section 5A states: [...] “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.”

27. I am guided by the following principles which 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.

The principles

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

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

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

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

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

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

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

(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

28. In *Canon*⁶, the Court of Justice of the European Union (“CJEU”) stated, at paragraph 23 of its judgment, that when considering whether goods are similar, all the relevant factors relating to the goods should be taken into account. The CJEU stated that those factors include their nature, intended purpose, method of use and whether they are in competition with each other or are complementary.

29. The relevant factors identified by Jacob J. (as he then was) in *Treat*⁷ 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.

⁶ Case C-39/97

⁷ [1996] R.P.C. 281

30. In *Kurt Hesse v OHIM*⁸, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*⁹, the General Court (“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.”

31. In *Gérard Meric v OHIM*¹⁰, the GC confirmed that even if goods 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 trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

32. The goods to be compared are *clothing, headgear, and footwear* for the opponent, and the goods set out in Annex A for the applicant.

33. In its statement of grounds, the opponent submits that the applicant’s goods are “clearly identical” to its goods. In addition to this, in its written submissions, it argues that the applicant has admitted that they are not designing a clothing brand and that they are using their mark on clothes to merchandise. On this basis, the opponent further submits that the goods are identical. In their counterstatement, the applicant submits that their goods and design look nothing like the opponent’s clothing.

34. In their counterstatement, the applicant has referred to merchandising clothes, and appears to accept that they are identical to the opponent’s *clothing*. However, the

⁸ Case C-50/15 P

⁹ Case T-325/06

¹⁰ Case T- 133/05

applicant has not commented on any other goods which do not fall under *clothing*. As such, I will proceed to conduct a comparison for the goods in the ordinary way.

35. Before doing so, however, I note the applicant's comment in their counterstatement that the "good (sic) and design look nothing like [the opponent's] clothing". I must clarify that these matters will have no material bearing on the comparison which follows, nor can they in law. This is because, when assessing the likelihood of confusion, it is necessary to consider all the circumstances in which a mark might be used.¹¹ Furthermore, since the way in which goods are marketed may vary over time and depend upon the parties' wishes (or those of any potential successors in title), it is not appropriate to take into account the way in which the word mark currently appears or how the goods are marketed.¹² As a result, even though the proprietor has suggested the ways in which its mark may be used, the following comparison must take into account only goods for which the proprietor's mark is registered, as they appear in the register, and the applicant's goods framed by the fair specification. Any differences between the actual goods provided by the parties, their target markets, or how they reach those markets, are not relevant unless those differences are apparent from the competing specifications.

36. For the purposes of comparing goods, 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.¹³ I have therefore assessed the applicant's goods by dividing the terms into groups as per below:

Clothing; Knitwear [clothing]; Jackets [clothing]; Ready-to-wear clothing; Woolen clothing; Furs [clothing]; Clothing layettes; Layettes [clothing]; Garments for protecting clothing; Linen clothing; Clothes; Gloves as clothing; Gloves [clothing]; Aprons [clothing]; Maternity clothing; Kerchiefs [clothing]; Jerseys [clothing]; Shorts [clothing]; Denims [clothing]; Cashmere clothing; Capes (clothing); Oilskins [clothing]; Gabardines [clothing]; Silk clothing; Clothing of leather; Leather clothing; Leather (Clothing of -); Veils [clothing];

¹¹ O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited, Case C-533/06

¹² Devinlec Développement Innovation Leclerc SA v OHIM, Case C-171/06P

¹³ *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38

Knitted clothing; Corsets [clothing, foundation garments]; Embroidered clothing; Hoods [clothing]; Windproof clothing; Wristbands [clothing]; Belts for clothing; Belts [clothing]; Casual clothing; Rainproof clothing; Bandeaux [clothing]; Waterproof clothing; Jackets being sports clothing; Jackets (Stuff -) [clothing]; Stuff jackets [clothing]; Clothing for leisure wear; Ready-made clothing; Bottoms [clothing]; Latex clothing; Trunks being clothing; Playsuits [clothing]; Woven clothing; Infant clothing; Drawers [clothing]; Drawers as clothing; Clothing for sports; Sports clothing; Leisure clothing; Athletic clothing; Ties [clothing]; Clothing for children; Muffs [clothing]; Bodies [clothing]; Clothing for infants; Clothing for babies; Tops [clothing]; Weatherproof clothing; Clothing for cycling; Water-resistant clothing; Fabric belts [clothing]; Handwarmers [clothing]; Clothing for skiing; Beach clothing; Triathlon clothing; Chaps (clothing); Thermal clothing; Cowls [clothing]; Fishing clothing; Men's clothing; Dance clothing; Mitts [clothing]; Braces for clothing; Plush clothing; Baby clothes; Baby layettes for clothing; Baby doll pyjamas; Baby bodysuits; Baby pants; Swaddling clothes; One-piece clothing for infants and toddlers; Plastic baby bibs; Nappy pants [clothing]; Baby bottoms; Babies' clothing; Babies' pants [clothing]; Infant wear; Baby tops; Underpants for babies; Girls' clothing; Baby bibs [not of paper]; Maternity underwear; Clothing made of fur; Clothing for gymnastics; Party hats [clothing]; Lingerie; Maternity lingerie; Bodices [lingerie]; Underwear; Undergarments; Jockstraps [underwear]; Teddies [undergarments]; Maillots [hosiery]; Underwear for women; Nightwear; Hosiery; Negligees; Swimwear; Panties; Corsets [underclothing]; Shapewear; Sweat-absorbent underclothing [underwear]; Strapless bras; Bras; Bra straps [parts of clothing]; Briefs [underwear]; Strapless brassieres; Pantyhose; Teddies [underclothing]; Men's underwear; Sleepwear; Underclothes; Bridal garters; Knitted underwear; Underwear (Anti-sweat -); Anti-sweat underwear; Maternity sleepwear; Bikinis; Stockings; Slips [undergarments]; G-strings; Gussets for stockings [parts of clothing]; Sweat-absorbent underwear; Body stockings; Underclothing; Disposable underwear; Camisoles; Corsets being foundation clothing; Corsets [foundation clothing]; Nightgowns; Bralettes; Brassieres; Underclothing for women; Bustiers; Nipple pasties being underclothing; Trunks [underwear]; Women's underwear; Bra straps; Beachwear; Straps for bras; Peignoirs; Swimsuits; Nighties; Babies' pants [underwear]; Functional

underwear; Fitted swimming costumes with bra cups; Loungewear; Ladies' underwear; Maternity dresses; Nursing bras; Sweat-absorbent stockings; Stockings (Sweat-absorbent -); Stockings [sweat-absorbent]; Boas [clothing]; Thermal underwear; Babies' undergarments; Leather dresses; Slips [underclothing]; Girdles [corsets]; Chemises; Knickers; Anti-sweat underclothing; Underclothing (Anti-sweat -); Bridal gowns; Dresses; Corsets; Boy shorts [underwear]; Bathing costumes for women; Sports bras; Sportswear; Casualwear; Sports garments; Menswear; Leisurewear; Outerwear; Sports clothing [other than golf gloves]; Gymwear; Moisture-wicking sports shirts; Gloves for apparel; Clothes for sports; Surfwear; Sports shirts; Clothes for sport; Sport shirts; Sportswear incorporating digital sensors; Knitwear; Moisture-wicking sports pants; Sports jackets; Golf clothing, other than gloves; Sports shoes; Quilted jackets [clothing]; Articles of sports clothing; Jogging bottoms [clothing]; Tennis pullovers; Jogging sets [clothing]; Clothing for cyclists; Rainwear; Sports pants; Foulards [clothing articles]; Tennis shirts; Moisture-wicking sports bras; Soccer shirts; Clothing for wear in judo practices; Sports jerseys and breeches for sports.

37. The items listed above are all types of clothing. I have included *hoods* amongst these goods as a finished item of clothing rather than as a constituent part of a piece of clothing, as in my experience, it is possible to buy hoods akin to a balaclava to be worn on the head (other than the type of hood attached to a jacket). In its submissions, the opponent contends that the applicant has essentially admitted in the counterstatement that their goods can be described as *clothing*. Even if the applicant had not stated this, it is my view that the goods are identical regardless of the applicant's comments. This is because *clothing* is identical on a literal basis, and the remaining goods all fall within the opponent's wider term *clothing* and are therefore identical under the principle outlined in *Meric*. However, if I am wrong in my assessment that *braces for clothing* and *belts for clothing* fall within *clothing*, then it is my view that they would be highly similar on the basis that they are clothing accessories. These goods would have the same users. Their nature and purpose overlap, as clothing is a physical item worn to cover the body whereas belts and braces are physical items which would be worn on the body in order to support the wearer's clothing. They would be sold through the same trade channels, and appear within the

same areas or nearby within those channels. There is an element of complementarity between the goods in that they could be deemed as being essential to one another, as wearing *clothing* is the basis for needing either *braces for clothing* or *belts for clothing*, and in some cases, wearing *braces for clothing* or *belts for clothing* is needed in order to wear *clothing* (such as to keep a garment on properly). Furthermore, given that *braces for clothing* and *belts for clothing* are commonly made from the same or similar materials to *clothing* in order for them to be used together, consumers are likely to think that they are made by the same or linked undertakings. However, I do not find that they would typically be in competition with one another given the slight difference in their purpose. Taking all of these factors into account, I find in the alternative that *braces for clothing* and *belts for clothing* are highly similar to *clothing*.

Baby shoes; Sport shoes; Climbing footwear; Fishing footwear; Footwear [excluding orthopedic footwear]; Thong sandals; Footwear for sports; Sports footwear; Shoes for leisurewear; Footwear for sport; Footwear for use in sport; Athletic footwear; Athletics footwear; Footwear; Leisure footwear; Sneakers [footwear]; Footwear for snowboarding; Casual footwear; Golf footwear; Footwear for women; Footwear for men; Beach footwear; Trainers [footwear]; Footwear not for sports; Footwear [excluding orthopedic footwear]; Knitted baby shoes; Bootees (woollen baby shoes); Baby sandals; Baby boots.

38. The goods listed above are all types of footwear, and therefore fall within the opponent's wider term *footwear*. On this basis, I find that the goods are identical under the principle outlined in *Meric*.

Headbands [clothing]; Visors [clothing].

39. The goods listed above are all types of items to wear on the head, so it is my view that these goods fall within the opponent's wider term *headgear*. On this basis, I find that the goods are identical under the principle outlined in *Meric*

Parts of clothing, footwear and headgear; Collars [clothing]; Pockets for clothing; Headbands for clothing; Gussets for underwear [parts of clothing]; Gussets for tights [parts of clothing].

40. These goods form constituent parts of the finished products. I have included *headbands for clothing* amongst this category as it is my view that it differs from *headbands [clothing]* in that it appears to be a constituent part of clothing, as opposed to a piece of clothing per se. In *Les Éditions Albert René v OHIM*¹⁴, the GC found that:

“61... The mere fact that a particular good is used as a part, element or component of another does not suffice in itself to show that the finished goods containing those components are similar since, in particular, their nature, intended purpose and the customers for those goods may be completely different.”

41. *Parts of clothing, footwear and headgear, collars [clothing], pockets for clothing, gussets for underwear [parts of clothing], and gussets for tights [parts of clothing]* are used to manufacture finished items clothing, footwear and headgear. As such, they have a different purpose to the opponent's *clothing, footwear and headgear*, which are worn to cover the body. Users of the goods overlap in that they may be purchased by both tradespeople who manufacture clothing as well as the public at large, such as people who make their own clothing or customise their clothes. The physical nature of the respective goods overlaps since they may be made from the same materials. They could be sold directly to trade, or to the public such as within haberdashery shops. They may be manufactured by the same undertakings. Parts of clothing in particular are of importance to finished articles of *clothing, footwear and headgear*, and consumers may think that responsibility for them lies with the same undertakings, resulting in a degree of complementarity. It is therefore considered that the goods have a low to medium level of similarity with the opponent's goods.

Average consumer and the purchasing act

42. 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 in question: *Lloyd Schuhfabrik Meyer*¹⁵.

¹⁴ Case T-336/03

¹⁵ Case C-342/97

43. 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*¹⁶, 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.”

44. The average consumer for the goods will be members of the general public as well as trade customers. The cost of purchase is likely to vary, and the goods will be purchased on a reasonably frequent basis. Several factors may influence the average consumer when purchasing the goods, such as, inter alia, the type of material, the quality, and the aesthetic appearance. I therefore consider that that the average consumer will pay a medium level of attention when selecting the goods, although this may be slightly higher for trade customers. The goods are likely to be self-selected from shelves within retail outlets, via online retailers, or in catalogues. In *New Look Limited v OHIM*¹⁷, the GC stated that:

“50. [...] Generally in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly the visual aspect plays a greater role in the global assessment of the likelihood of confusion.”

45. Visual considerations are therefore likely to be the primary factor when purchasing the goods. However, I do not discount the role that aural selection may play when

¹⁶ [2014] EWHC 439 (Ch)

¹⁷ Joined cases T-117/03 to T-119/03 and T-171/03

purchasing, such as through word-of-mouth recommendations or when placing telephone orders.

Comparison of marks

46. 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 *Bimbo SA v OHIM*¹⁸, 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.”

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

48. The respective trade marks are shown below:

The opponent's mark	The applicant's mark
ROOTS	Roots Darling

49. In its submissions, the opponent submits that “ROOTS” is the dominant element within both of the competing marks.

50. The opponent's mark is a plain word mark written in uppercase. As a word-only mark with no other elements, the overall impression lies in the word “ROOTS”. The

¹⁸ Case C-591/12P

applicant's mark is a plain word mark written in title case, with no other elements within the mark. As neither word within "Roots Darling" is descriptive or allusive in relation to the goods, I disagree with the opponent that the term "Roots" is more dominant within the applicant's mark. Instead, I find that overall impression lies equally in the two words "Roots Darling".

Visual comparison

51. In its submissions, the opponent argues that the competing marks are similar to a high degree, especially as the "identical word is the leading element of the contested mark". It also argues that the identical term "ROOTS" has independence within the contested mark.

52. The competing marks are similar because they both have the identical word "ROOTS". The applicant's mark is written in title case, whilst the opponent's mark is written in upper case. However, in *LA Superquimica v European Union Intellectual Property Office (EUIPO)*¹⁹, the GC held at [39] that word-only marks protect the word or words contained in the mark in whatever case, colour or typeface. The difference in capitalisation between "ROOTS" and "Roots" is therefore not significant. The marks differ as the applicant's mark contains the second word "Darling", which is not present in the opponent's mark. The beginnings of words tend to have more visual and aural impact than the ends²⁰, which, in my view, results in the visual difference created by the additional word 'Darling' being slightly less significant. Bearing in mind my analysis of the marks' overall impressions, I am of the view that the marks are visually similar to a medium degree.

Aural comparison

53. In its submissions, the opponent submits that the marks are aurally similar to a high degree. It argues this on the basis that the placement of "Roots" at the beginning of the applicant's mark increases the attention paid to it by the average consumer. It also submits that the additional verbal element "Darling" is a "laudatory term of low

¹⁹ Case T-24/17

²⁰ See paragraph 81 of *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

distinctive value which would not detract from the high aural similarity between the marks”.

54. The competing marks are aurally similar as they both contain the word “ROOTS”. The competing marks differ as the applicant’s mark contains the second word “Darling”, which is not present in the opponent’s mark. The beginnings of words tend to have more visual and aural impact than the ends as per *El Corte Ingles*, which, in my view, results in the visual difference created by the additional word ‘Darling’ being slightly less significant. Bearing in mind my analysis of the marks’ overall impressions, I am of the view that the marks are aurally similar to a medium degree.

Conceptual comparison

55. In its submissions, the opponent argues that the competing marks are similar to a medium to high degree. Furthermore, it also argues that the identical term “ROOTS” has independence in the contested mark. In their counterstatement, the applicant states that “Roots Darling” is their “catchphrase” for which they are known. They state that they have used on their TikTok channel for “years” and have gained “over 1 million followers on social media using this name”.

56. The word “ROOTS” in the opponent’s mark is defined in the Oxford English Dictionary as a noun with several meanings, including “the underground part of a plant” and “the embedded or basal portion of the tongue, a hair, tooth, finger, nail, or other member or structure of the body”. The applicant’s mark contains the words “Roots Darling”. Whilst I note the applicant’s comments regarding their use of these words as a catchphrase, there is no evidence to substantiate the level of notoriety that they have gained by using it or that their purported one million followers who may be familiar with it exist in the UK. Whilst there may be some consumers of the class 25 goods who are familiar with “Roots Darling” as the applicant’s catchphrase, it is likely that they will be in a small minority of consumers in the context of the entire category of relevant consumers (who are the general public at large). It is my view that the average consumer in the UK would not recognise “Roots Darling” either as a catchphrase used by the applicant, or as any other phrase formed by combining the two words to convey a unitary meaning. The first word “Roots” will be understood in the same manner as the opponent’s mark. The Oxford English Dictionary defines “Darling” as “a person

who is very dear to another; the object of a person's love; one dearly loved". As the words "Roots" and Darling" are both recognisable dictionary-defined words, I am of the view that, when encountering the words "Roots Darling", the average consumer will extrapolate the two words' individual meanings and understand them as being independent of each other. It is considered that the average consumer would not understand the words as a complete unit with its own meaning; there is no obvious conceptual meaning to the combination of the two words. As both marks share the identical dictionary-defined word 'Roots', but differ due to the inclusion of the additional word "Darling" in the applicant's mark, it is my view that the marks are similar to a medium degree.

Distinctive character of the earlier trade mark

57. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*²¹, 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

²¹ Case C-342/97

commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

58. Registered trade marks possess various 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.

59. Although the opponent has filed evidence of use, I do not consider this evidence to be sufficient for the purposes of demonstrating that the opponent’s mark had an enhanced degree of distinctive character at the relevant date of 8 January 2024. Whilst I acknowledge that the evidence demonstrates genuine use of the opponent’s mark, and sales of ROOTS-branded goods into the UK, it is considered that the evidence does not show what share of the relevant market was held by goods sold under the opponent’s mark. Whilst the evidence contains sales figures for 2019 to 2024, I am unable to ascertain how significant those sales were. On the face of it, the sales figures are likely to only represent a very small proportion of the relevant UK markets. Furthermore, although the evidence contains information to show the number of users with a cookie placed with a UK-based IP address, it is my view that this is not sufficient to demonstrate the extent to which the average consumer of the goods within the UK has been exposed to the opponent’s mark. In addition to this, the evidence contains no figures in relation to advertising spend in the UK, and there is no evidence of any advertising activities having been conducted. Taking all of these factors into account, it is my view that the evidence submitted does not support the establishment of enhanced distinctiveness. I therefore only have the inherent position to consider.

60. In its submissions, the opponent argues that its mark “inherently possesses an above-average to high degree of distinctiveness” on the basis that would be perceived as “out of the ordinary and uncommon by the average consumer” in relation to the goods. The opponent’s mark is the word “ROOTS” which does not appear to be descriptive or allusive of the goods. However, whilst I acknowledge that in *Janus International Group LLC v Grosvenor Technology Limited*²², Phillip Johnson sitting as the Appointed Person highlighted at paragraph 34 that there is no specific reason why

²² BL 0/558/25

arbitrary marks (i.e. existing words used as trade marks) cannot be inherently distinctive to a high degree, I do not consider this to be the case for the opponent's mark. This is because, in my view, 'ROOTS' is not an obscure or unusual word but, rather, an ordinary word with which the average consumer would be highly familiar. Whilst I agree that the word is arbitrary in relation to the goods, I do not consider it to be so strikingly distinctive or "out of the ordinary" in relation to the goods to be deemed as having a high level of distinctiveness. I therefore disagree with the opponent, and instead find that the opponent's mark has a medium level of inherent distinctiveness.

Global assessment – conclusions on likelihood of confusion

61. 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 set formula for establishing a likelihood of confusion between marks; it is a global assessment where a number of factors need to be borne in mind.

62. One such factor is the interdependency principle, i.e. a lesser degree of similarity between the competing marks may be offset by a greater degree of similarity between the respective goods, and vice versa. As mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be mindful that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

63. In its statement of grounds, the opponent argues that there is a likelihood of confusion between the competing marks due to the inherent distinctiveness of the opponent's mark, the principle of imperfect recollection, and the high degree of similarity between the marks. In their counterstatement, the applicant contends that "[i]f the Roots trademark (sic) meant that nobody else could ever use the word roots, why is they so many doing it?". The applicant proceeds to mention a number of other purported registered marks containing the words ROOTS.

64. I do not consider the applicant's comments regarding other 'ROOTS' marks to be relevant for the purpose of assessing whether there is a likelihood of confusion. In *Zero Industry Srl v OHIM*²³, the GC stated that:

"73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word 'zero', it should be pointed out that the Opposition Division found, in that regard, that '... there are no indications as to how many of such trade marks are effectively used in the market'. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word 'zero' is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T-135/04 *GfK v OHIM – BUS(Online Bus)* [2005] ECR II-4865, paragraph 68, and Case T-29/04 *Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH)* [2005] ECR II-5309, paragraph 71). "

65. As there is no evidence that the registered marks are in use or that consumers have become accustomed to differentiating between them, they cannot have any bearing on whether there exists a likelihood of confusion between the opponent's mark and the applicant's mark. Moreover, the mere fact that the other marks are on the register cannot be taken as evidence per se that they are peacefully coexisting.

66. Earlier in this decision I found that the applicant's goods range from being similar to a low to medium degree to being identical to the opponent's goods. The average consumer of the class 25 goods will be the general public as well as trade customers. The average consumer is likely to pay a medium amount of attention when purchasing the goods, although this may be slightly higher for trade customers. I have found the marks to be visually similar to a medium degree, aurally similar to a medium degree, and conceptually similar to a medium degree. The earlier mark has a medium level of inherent distinctive character.

²³ Case T-400/06

67. The overall impression lies solely in the word “ROOTS” in the opponent’s mark, whereas the latter word “Darling” contributes equally within the applicant’s mark’s overall impression. The addition of the word “Darling” constitutes a significant difference between the marks, and it is unlikely that the average consumer would overlook this additional word. It is my view that this difference is likely to be sufficient to prevent the average consumer from mistaking one mark for the other. I therefore find that there is no likelihood of direct confusion, even in respect of identical goods.

68. This leaves indirect confusion to be considered. In *L.A. Sugar Limited v By Back Beat Inc*²⁴, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: ‘The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark’.

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

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

²⁴ BL O/375/10

(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)."

69. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors*²⁵, Arnold LJ approved Mr Purvis's formulation but added:

"13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/219/16) at [16] 'a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion'. Mr Mellor went on to say that, if there is no likelihood of direct confusion, 'one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion'. I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion."

70. It is not sufficient that a mark merely calls to mind another mark (as per *Duebros Limited v Heirler Cenovis GmbH*²⁶). This is mere association not indirect confusion. A finding of indirect confusion should not be made merely due to a shared element within marks.

71. I do not consider the immediate case to fit neatly into one of the categories set out in *L.A. Sugar* above. However, I remind myself that these are not exhaustive. I also consider the relevance of *Medion v Thomson*²⁷ and the subsequent case law. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another*²⁸, Arnold J. (as he then was)

²⁵ [2021] EWCA Civ 1207

²⁶ BL O/547/17

²⁷ Case C-120/04

²⁸ [2015] EWHC 1271 (Ch)

considered the impact of the CJEU's judgment in *Bimbo*²⁹, on the court's earlier judgment in *Medion*. The judge said:

“18. The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19. The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20. The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21. The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It

²⁹ Case C-591/12P

remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

72. I have previously found that in the applicant’s mark, the word “Roots” (which is identical to the opponent’s mark “ROOTS”) has its own conceptual independence from the second word “Darling”, as it is my view that the average consumer of the goods would not interpret the two words “Roots” and “Darling” as being a complete unit which has its own meaning separate from the meaning of the two constituent parts. The distinctive significance of “Roots” is therefore independent from the distinctive significance of the whole mark “Roots Darling”. On this basis, the marks may be confused as a result of the moderately distinctive shared element (which has an independent distinctive significance within the applicant’s mark) being identical to the opponent’s mark “ROOTS”. I am of the view that the average consumer, even when paying a slightly higher than medium level of attention, may believe the mark “Roots Darling” to indicate a commercial connection between the respective undertakings. On this basis, I find that there is a likelihood of indirect confusion, notwithstanding the difference between the competing marks. I find this to be the case even for the goods which are similar only to a low to medium degree due to the identical nature of the shared element and the interdependency principle.

Final remarks

73. The opposition under section 5(2)(b) has been successful in its entirety. Subject to any successful appeal, the application will be refused registration for the class 25 goods. It may proceed to registration for the class 3 goods which were not opposed.

Costs

74. The opponent has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances I award the opponent the sum of £1,350 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Preparing a statement and considering the other side’s statement: £250

Preparing evidence: £600

Preparing submissions-in-lieu: £400

Official fees: £100

75. I therefore order Jon Cawdron to pay Roots Corporation the sum of £1,350. 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 8th day of September 2025

K SERRAVALLE

For the Registrar

Annex A

Class 3: Cosmetics; Skincare cosmetics; Moisturisers [cosmetics]; Cosmetics and cosmetic preparations; Hair cosmetics; Skin fresheners [cosmetics]; Cosmetics for eye-lashes; Cosmetics for suntanning; Organic cosmetics; Anti-aging moisturizers used as cosmetics; Lip cosmetics; Nail cosmetics; Non-medicated cosmetics; Natural cosmetics; Skin moisturizers used as cosmetics; Cosmetics preparations; Mousses [cosmetics]; Make-up palettes containing cosmetics; Tanning oils [cosmetics]; Tanning gels [cosmetics]; Cosmetics in the form of lotions; Facial creams [cosmetics]; Beauty care cosmetics; Colour cosmetics; Self-tanning preparations [cosmetics]; Cosmetics for animals; Eyebrow cosmetics; Tanning preparations [cosmetics]; Suncare lotions [for cosmetic use]; Decorative cosmetics; Multifunctional cosmetics; Eye cosmetics; Milks [cosmetics]; Body creams [cosmetics]; After-sun oils [cosmetics]; Skin masks [cosmetics]; Cosmetics for eye-brows; Tanning milks [cosmetics]; Functional cosmetics; Suntan oils [cosmetics]; Facial gels [cosmetics]; Skin care cosmetics; Fluid creams [cosmetics]; Cosmetics for children; Suntan lotion [cosmetics]; Non-medicated cosmetics and toiletry preparations; Humectant preparations [cosmetics]; Emollient preparations [cosmetics]; Cosmetics in the form of creams; Powder compacts [cosmetics]; Sun-tanning preparations [cosmetics]; Cosmetic hair lotions; Suntanning oil [cosmetics]; Colour cosmetics for the skin; After-sun milk [cosmetics]; After-sun milks [cosmetics]; Cosmetic moisturisers; Sunscreens [for cosmetic use]; Cosmetic creams and lotions; Bath powder [cosmetics]; Skin recovery creams [cosmetics]; Night creams [cosmetics]; Body gels [cosmetics]; Body and facial creams [cosmetics]; Cosmetic products in the form of aerosols for skincare; Sun blocking lipsticks [cosmetics]; Cosmetics for use on the skin; Lip stains [cosmetics]; Sunscreen [for cosmetic use]; Cosmetic soaps; Sunscreen creams [for cosmetic use]; Cosmetic creams; Creams (Cosmetic -); Body care cosmetics; Cosmetics in the form of powders; Cosmetics for the use on the hair; Cosmetics containing keratin; Hair care lotions [for cosmetic use]; Cosmetic skin fresheners; Dyes (Cosmetic -); Cosmetic dyes; Cosmetics in the form of oils; Beauty lotions; Facial lotions [cosmetic]; Cosmetic facial lotions; Cosmetics containing panthenol; Nail paint [cosmetics]; Cosmetic suntan lotions; After-sun lotions [for cosmetic use]; Perfume oils for the manufacture of cosmetic preparations; Skin care lotions [cosmetic]; Nail hardeners [cosmetics]; Anti-aging creams [for cosmetic use]; Tissues impregnated with cosmetics; Nail tips

[cosmetics]; Colour cosmetics for children; Nail primer [cosmetics]; Sun protecting creams [cosmetics]; Cosmetic products for the shower; Anti-ageing creams [for cosmetic use]; Smoothing emulsions [cosmetics]; Skin cleansers [cosmetic]; Perfumed powders [for cosmetic use]; Liners [cosmetics] for the eyes; Cosmetic creams for the skin; Skin creams [cosmetic]; Skin creams [for cosmetic use]; Body and facial gels [cosmetics]; Cosmetic oils; Moisturising skin lotions [cosmetic]; Perfume; Perfumes; Perfume oils; Perfumery and fragrances; Amber [perfume]; Fragrances; Oils for perfumes and scents; Fragrance sachets; Musk [perfumery]; Cologne; Perfume water; Aromatics for perfumes; Room perfume sprays; Liquid perfumes; Potpourris [fragrances]; Colognes; Scents; Fragrance emitting wicks for room fragrance; Aromatics for fragrances; Perfumery; Perfumes for cardboard; Fragrance refills for non-electric room fragrance dispensers; Cedarwood perfumery; Extracts of perfumes; Extracts of flowers [perfumes]; Flowers (Extracts of -) [perfumes]; Extracts of flowers being perfumes; Body deodorants [perfumery]; Eau de cologne [cologne water]; Perfumes for ceramics; Ionone [perfumery]; Deodorants for personal use [perfumery]; Aftershave lotions; Body fragrances; Perfumeries; Fragrance preparations; Fragrances for automobiles; Vanilla perfumery; Household fragrances; Perfumed potpourris; Perfumed sachets; Room perfumes in spray form; Natural oils for perfumes; Fragrance sachets for eye pillows; Room fragrances; Perfumery products; Aftershave; Perfumed soaps; Feminine deodorant sprays; Cologne water; Mint for perfumery; Solid perfumes; After-shave lotions; Air fragrance preparations; Peppermint oil [perfumery]; Perfumed soap; Perfuming sachets; Aftershave balms; Scented oils; Scented linen sprays; Synthetic perfumery; Scented sachets; Aftershave balm; Air fragrance reed diffusers; Scented body lotions; Synthetic vanillin [perfumery]; Aftershaves; Geraniol for fragancing; Perfumed powder [for cosmetic use]; Scented soaps; Incense spray; Perfumed powders; Scented body spray; Perfumed creams; Essential oils as perfume for laundry purposes; Eau de Cologne; Eau de cologne; Sachets for perfuming linen; Linen (Sachets for perfuming -); Perfumed powder; Fumigation preparations [perfumes]; Scented room sprays; Eau de colognes; Perfumed lotions [toilet preparations]; After-shave; Fragrance for household purposes; Aromatherapy lotions; After-shave balms; Scented body lotions and creams; Aftershave creams; Scented fabric refresher sprays; Perfumery, essential oils; Eaux de cologne; Eaux de Cologne; Deodorant soap; Soap (Deodorant -); Perfumed body lotions [toilet preparations]; Fragrant sachets; Incense sachets; Aftershave milk;

Agarwood [incense]; Geraniol fragrancng compounds; Roll-on deodorants [toiletries]; Natural perfumery; Perfumed water; Scented body creams; Scented fabric refresher spray; Eau de parfum; Toiletries; Antiperspirants [toiletries]; Non-medicated toiletries; Talc [toiletries]; Sanitary preparations being toiletries; Sponges impregnated with toiletries; Mousses [toiletries] for use in styling the hair; Douching preparations for personal sanitary or deodorant purposes [toiletries]; Toiletry preparations; Non-medicated toiletry preparations; Non-medicated toilet soaps; Toilet soaps; Laundry soaps; Paper hand towels impregnated with cosmetics; Oils for toiletry purposes; Bath lotions (Non-medicated -); Shower creams; Liquid soaps for laundry; Shampoos; Bath and shower gels; Shampoo; Soaps and gels; Bath soaps; Bath and shower oils [non-medicated]; Non-medicated toothpaste; Shaving lotions; Shower gels; Scented linen water; Sunscreen lotions; Non-medicated shampoos; Soaps for toilet purposes; Toothpaste; Shaving soaps; Cosmetic preparations for bath and shower; Liquid bath soaps; Non-medicated hair lotions; Bath gels (Non-medicated -); After shave lotions; Preparations for use after shaving; Preparations for use before shaving; Shave gel; Shave creams; Shave balm; After sun creams; After sun moisturisers; Hair removal and shaving preparations; Shaving sets, comprised of shaving cream and aftershave; Oils for moisturising the skin after sunbathing; Shaving preparations; Shaving lotion; Shaving gel; Shaving soap; Shaving cream; Shaving balm; Shaving sprays; Shaving gels; Shaving balms; Shaving sticks [preparations]; Shaving creams; Day lotion; Shaving oil; Shaving mousse; Shaving oils; Shaving stones; Rinsing aids for use when washing clothes; Foams for use in shaving; Shaving foams; Cosmetic preparations for dry skin during pregnancy; Hair removing cream; Day cream; Shaving foam; Foam for use in shaving; Make up removing preparations; Hair and body wash; Wax strips for removing body hair; Alum blocks for shaving; Day creams; Hair grooming preparations; Cosmetic preparations for the hair and scalp; Facial wash; Shaving preparations in liquid form; Hair rinses; Hair removal preparations; Hair treatment preparations; Face wash; Hair rinses [for cosmetic use]; Beard care preparations; Preparations for removing gel nails; Face wash [cosmetic]; Hair rinses [shampoo-conditioners]; Compounds for skin care after exposure to the suns rays; Hair relaxing preparations; Facial washes; Shaving stones [astringents]; Hair lotion; Hair wax; Hair straightening preparations; Wax treatments for the hair; Epilating waxes; Non-medicated scalp treatment cream; Shower and bath preparations; Preparations for use in the bath or shower; Preparations for the bath and shower; Bath and shower

preparations; Preparations for setting hair; Cosmetic hair regrowth inhibiting preparations; Hair cleaning preparations; Creams for fixing hair; Hair cream; Gels for use on the hair; Bath preparations, not medicated; Facial peel preparations for cosmetic use; Wrinkle removing skin care preparations; Night cream; Bath soak for cosmetic use; Wax stripping preparations; Hair shampoo; Hair shampoos; Hair dye; Hair relaxers; Hair pomades; Hair texturizers; Hair conditioner; Hair mousse; Dyes for the hair; Hair dyes; Hair mascara; Hair lighteners; Hair bleaches; Hair colourants; Hair serums; Hair bleach; Hair lotions; Hair gel; Hair moisturizers; Hair color; Hair mousses; Hair conditioners; Hair colouring; Hair sprays; Hair styling lotions; Hair moisturisers; Hair oils; Hair spray; Shampoos for human hair; Hair styling gel; Hair creams; Hair gels; Hair colorants; Hair nourishers; Hair powder; Hair emollients; Styling sprays for the hair; Hair oil; Tints for the hair; Hair chalks; Hair tonics; Baby hair conditioner; Hair styling waxes; Hair lacquer; Hair masks; Hair lacquers; Hair balsam; Hair styling spray; Styling gels for the hair; Hair styling gels; Hair balm; Hair balms; Hair tonic; Colouring lotions for the hair; Styling paste for hair; Hair liquid; Hair glaze; Hair glazes; Non-medicated hair shampoos; Hair liquids; Soap; Detergent soap; Bath soap; Shower soap; Soaps; Toilet soap; Antiperspirant soap; Soap (Antiperspirant -); Aloe soap; Soap powder; Liquid soap; Handmade soap; Soap powders; Bars of soap; Creams (Soap -) for use in washing; Almond soap; Cosmetic soap; Bar soap; Skin soap; Waterless soap; Liquid soap for laundry; Soap products; Sugar soap; Liquid bath soap; Loofah soaps; Carbolic soaps; Cakes of soap; Soap (Cakes of -); Soap sheets; Saddle soap; Liquid soap for dish washing; Hand soap; Dish soaps; Granulated soap; Soap pads; Beauty soap; Industrial soap; Body soap; Cakes of toilet soap; Liquid soaps; Soap solutions; Cakes of soap for body washing; Cream soaps; Aloe soaps; Body cream soap; Almond soaps; Liquid soap used in foot bath; Soap for brightening textile; Saddle soaps; Liquid soap used in foot baths; Sponges impregnated with soaps; Soap free washing emulsions for the body; Facial soaps; Soaps for laundry use; Non-medicated soaps; Granulated soaps; Hand soaps; Soap for foot perspiration; Foot perspiration (Soap for -); Soaps in gel form; Cakes of soap for household cleaning purposes; Soaps for household use; Soaps in liquid form; Soaps for brightening textiles; Soapy gels; Liquid soaps for hands and face; Refill packs for hand soap dispensers; Washing-up detergent; Bath lotion; Soaps for body care; Dishwashing detergents; Pre-moistened towelettes impregnated with dishwashing detergent; Liquid laundry detergents; Shampoo bars; Cloths impregnated with a detergent for cleaning;

Powder laundry detergents; Washing balls filled with laundry detergents; Foaming bath gels; Moist paper hand towels impregnated with a cosmetic lotion; Cleansing lotions; Makeup; Make-up; Facial makeup; Lip makeup; Nail makeup; Eye makeup; Theatrical makeup; Natural makeup; Make-up remover; Skin make-up; Make-up primer; Organic makeup; Make-up removers; Make-up primers; Eye makeup remover; Powder for make-up; Powder (Make-up -); Make-up powder; Multifunctional makeup; Make-up pencils; Foundation make-up; Make-up foundation; Make-up for compacts; Make-up for the face; Eye make-up; Make-up foundations; Chalk for make-up; Make-up removing lotions; Eyes make-up; Eye make-up removers; Make-up base; Make-up kits; Make-up preparations; Make-up removing creams; Eyelid doubling makeup; Makeup setting sprays; Make-up removing gels; Make-up for the face and body; Facial concealer; Make-up preparations for the face and body; Make-up removing preparations; Hairstyling serums; Make-up removing milk; Make-up removing milks; Hairstyling masks; Eyeliner; Compacts containing make-up; Mascara; Eye-shadow; Fake blood being theatrical make-up ;Eyeshadow; Facial moisturisers [cosmetic]; Facial cleansers [cosmetic]; Lipstick; Facial beauty masks; Cosmetic facial masks; Facial masks [cosmetic]; Cosmetic hair dressing preparations; Eyeshadow palettes; Nail polish removers [cosmetics]; Facial creams [for cosmetic use]; Facial creams [cosmetic]; Hair care creams [for cosmetic use]; Facial wipes impregnated with cosmetics; Nail varnish remover [cosmetics]; Beauty preparations for the hair; Skin moisturizer masks; Baby lotions; Baby shampoo; Baby lotion; Baby powder; Baby powders; Baby oil.

Class 25: Clothing; Knitwear [clothing]; Jackets [clothing]; Ready-to-wear clothing; Woolen clothing; Furs [clothing]; Clothing layettes; Layettes [clothing]; Garments for protecting clothing; Linen clothing; Headbands for clothing; Headbands [clothing]; Clothes; Gloves as clothing; Gloves [clothing]; Aprons [clothing]; Maternity clothing; Kerchiefs [clothing]; Jerseys [clothing]; Shorts [clothing]; Denims [clothing]; Cashmere clothing; Capes (clothing); Oilskins [clothing]; Gabardines [clothing]; Silk clothing; Clothing of leather; Leather clothing; Leather (Clothing of -); Parts of clothing, footwear and headgear; Collars [clothing]; Veils [clothing]; Knitted clothing; Corsets [clothing, foundation garments]; Embroidered clothing; Hoods [clothing]; Windproof clothing; Wristbands [clothing]; Belts for clothing; Belts [clothing]; Casual clothing; Rainproof clothing; Bandeaux [clothing]; Waterproof clothing; Jackets being sports clothing;

Visors [clothing]; Jackets (Stuff -) [clothing]; Stuff jackets [clothing]; Clothing for leisure wear; Ready-made clothing; Bottoms [clothing]; Latex clothing; Trunks being clothing; Playsuits [clothing]; Woven clothing; Infant clothing; Drawers [clothing]; Drawers as clothing; Clothing for sports; Sports clothing; Leisure clothing; Athletic clothing; Ties [clothing]; Clothing for children; Muffs [clothing]; Bodies [clothing]; Clothing for infants; Clothing for babies; Tops [clothing]; Weatherproof clothing; Clothing for cycling; Water-resistant clothing; Fabric belts [clothing]; Pockets for clothing; Handwarmers [clothing]; Clothing for skiing; Beach clothing; Triathlon clothing; Chaps (clothing); Thermal clothing; Cowls [clothing]; Fishing clothing; Men's clothing; Dance clothing; Mitts [clothing]; Braces for clothing; Plush clothing; Baby clothes; Baby layettes for clothing; Baby shoes; Baby doll pyjamas; Knitted baby shoes; Baby bodysuits; Baby pants; Swaddling clothes; One-piece clothing for infants and toddlers; Bootees (woollen baby shoes); Baby sandals; Baby boots; Plastic baby bibs; Nappy pants [clothing]; Baby bottoms; Babies' clothing; Babies' pants [clothing]; Infant wear; Baby tops; Underpants for babies; Girls' clothing; Baby bibs [not of paper]; Maternity underwear; Clothing made of fur; Clothing for gymnastics; Party hats [clothing]; Lingerie; Maternity lingerie; Bodices [lingerie]; Underwear; Undergarments; Jockstraps [underwear]; Teddies [undergarments]; Maillots [hosiery]; Underwear for women; Nightwear; Hosiery; Negligees; Swimwear; Panties; Corsets [underclothing]; Shapewear; Sweat-absorbent underclothing [underwear]; Strapless bras; Bras; Bra straps [parts of clothing]; Briefs [underwear]; Strapless brassieres; Pantyhose; Teddies [underclothing]; Men's underwear; Gussets for underwear [parts of clothing]; Sleepwear; Underclothes; Bridal garters; Knitted underwear; Underwear (Anti-sweat -); Anti-sweat underwear; Maternity sleepwear; Bikinis; Stockings; Slips [undergarments]; G-strings; Gussets for stockings [parts of clothing]; Sweat-absorbent underwear; Body stockings; Underclothing; Disposable underwear; Camisoles; Corsets being foundation clothing; Corsets [foundation clothing]; Nightgowns; Bralettes; Brassieres; Underclothing for women; Bustiers; Nipple pasties being underclothing; Trunks [underwear]; Women's underwear; Bra straps; Beachwear; Straps for bras; Peignoirs; Swimsuits; Nighties; Babies' pants [underwear]; Functional underwear; Fitted swimming costumes with bra cups; Loungewear; Ladies' underwear; Maternity dresses; Gussets for tights [parts of clothing]; Nursing bras; Sweat-absorbent stockings; Stockings (Sweat-absorbent -); Stockings [sweat-absorbent]; Thong sandals; Boas [clothing]; Thermal underwear; Babies'

undergarments; Leather dresses; Slips [underclothing]; Girdles [corsets]; Chemises; Knickers; Anti-sweat underclothing; Underclothing (Anti-sweat -); Bridal gowns; Dresses; Corsets; Boy shorts [underwear]; Bathing costumes for women; Sports bras; Sportswear; Casualwear; Footwear for sports; Sports footwear; Shoes for leisurewear; Sports garments; Footwear for sport; Footwear for use in sport; Athletic footwear; Menswear; Athletics footwear; Leisurewear; Footwear; Leisure footwear; Sneakers [footwear]; Outerwear; Sports clothing [other than golf gloves]; Footwear for snowboarding; Gymwear; Casual footwear; Moisture-wicking sports shirts; Gloves for apparel; Golf footwear; Clothes for sports; Surfwear; Footwear for women; Footwear for men; Sports shirts; Clothes for sport; Beach footwear; Sport shirts; Sportswear incorporating digital sensors; Knitwear; Trainers [footwear]; Footwear not for sports; Moisture-wicking sports pants; Footwear [excluding orthopedic footwear]; Sports jackets; Golf clothing, other than gloves; Fishing footwear; Sports shoes; Quilted jackets [clothing]; Articles of sports clothing; Jogging bottoms [clothing]; Tennis pullovers; Jogging sets [clothing]; Clothing for cyclists; Sport shoes; Rainwear; Sports pants; Foulards [clothing articles]; Tennis shirts; Moisture-wicking sports bras; Climbing footwear; Soccer shirts; Clothing for wear in judo practices; Sports jerseys and breeches for sports.