O/0865/25

TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL REGISTRATION NO. WO0000001774991

IN THE NAME OF JOSEPH J. GARTNER

FOR THE FOLLOWING TRADE MARK:

Savage Shark

IN CLASS 25

AND

THE OPPOSITION THERETO UNDER NO. 446910

BY KAVEH SAVAGE

Background and pleadings

1. Joseph J. Gartner is the holder of the International Registration ("the IR") "Savage Shark". The IR is registered with effect from 2 January 2024. With effect from the same date, the holder designated the UK as a territory in which it seeks to protect the IR in respect of the following goods and services:

> *Class 25: Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms.*

2. On 15 April 2024, Kaveh Savage ("the opponent") opposed the trade mark, based upon section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). This is on the basis of its earlier UK trade mark:

> **SAVAGE**
>
> UK registration number: UK00003910866
>
> Filing date: 12 May 2023
>
> Registration date: 4 August 2023

3. The following goods are relied on in this opposition:

> *Class 18: Bags; wallets; purses; briefcases; key cases; articles of leather, namely leather bags, boxes of leather, card cases of leather, key cases of leather, labels of leather, leather straps, luggage tags, wallets of leather, purses of leather, belts of leather; articles of artificial leather, namely bags, boxes, card cases, key cases, labels, straps, luggage tags, wallets, purses, belts; belts.*
>
> *Class 25: Clothing, footwear, headgear.*
>
> *Class 35: Retail services connected with Bag, wallets, purses, briefcases, key cases, belts, articles of leather, namely leather bags, boxes of leather, card cases of leather, key cases of leather, labels of leather, leather straps, luggage tags, wallets of leather, purses of leather, belts of leather; retail services connected with articles of artificial leather, namely bags, boxes, card cases, key*

cases, labels, straps, luggage tags, wallets, purses, belts; retail services connected with clothing, footwear and headgear.

4. By virtue of its earlier filing date, the above registration constitutes an earlier mark in accordance with section 6 of the Act. In accordance with section 6A of the Act, the earlier mark is not subject to proof of use as it hadn't been registered for over five years at the relevant date (i.e. the date on which the UK was designated). The opponent may therefore rely upon all the goods for which the mark is registered.

5. Under section 5(2)(b), the opponent claims that the opposed goods are identical to the IR holder's goods and that the marks are similar to a high degree. As such, it claims that there will be a likelihood of confusion between the marks.

6. The IR holder filed a counterstatement in which it denies that the marks are similar. The IR holder states that there is no likelihood of confusion.

7. The opponent filed written submissions at the close of the proceedings, whereas the IR holder filed written submissions during the evidence rounds. No hearing was requested. This decision is taken following a careful perusal of the papers.

8. The opponent is represented by Katarzyna Eliza Binder-Sony. The IR holder is represented by Sonder & Clay.

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 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.

Decision

Section 5(2)(b)

10. 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".

Section 5A

11. Section 5A of the Act is as follows:

> "5A 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."

The principles

12. The following principles are gleaned from the decisions of the Court of Justice of the European Union ("CJEU") 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 C120/04, *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 Page 5 of 17 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 and services

13. In *Gérard Meric v Office for Harmonisation in the Internal Market,* Case T- 133/05, the General Court 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 fur 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."

14. The goods and services to be compared are shown in the table below:

The opponent's goods and services:	**The IR holder's contested goods:**
Class 18: Bags; wallets; purses; briefcases; key cases; articles of leather, namely leather bags, boxes of leather, card cases of leather, key cases of leather, labels of leather, leather straps, luggage tags, wallets of leather, purses of leather, belts of leather; articles of artificial leather, namely bags, boxes, card cases, key cases, labels, straps, luggage tags, wallets, purses, belts; belts.	
Class 25: Clothing, footwear, headgear.	*Class 25: Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms.*
Class 35: Retail services connected with Bag, wallets, purses, briefcases, key cases, belts, articles of leather, namely leather bags, boxes of leather, card cases of leather, key cases of leather, labels of leather, leather straps, luggage	

tags, wallets of leather, purses of leather, belts of leather; retail services connected with articles of artificial leather, namely bags, boxes, card cases, key cases, labels, straps, luggage tags, wallets, purses, belts; retail services connected with clothing, footwear and headgear.	

Athletic apparel, namely, shirts, pants, jackets, […] athletic uniforms

15. The above goods all fall within the scope of the opponent's 'clothing'. These goods are therefore considered identical according to the principles set out in *Meric*.[1]

Athletic apparel, namely, […] footwear

16. The above goods all fall within the scope of the opponent's 'footwear'. These goods are therefore considered identical according to the principles set out in *Meric*.[2]

Athletic apparel, namely, […] hats and caps

17. The above goods all fall within the scope of the opponent's 'headgear'. These goods are therefore considered identical according to the principles set out in *Meric*.[3]

Comparison of marks

18. 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 Court of Justice of the European Union stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

[1] Case T-133/05
[2] Case T-133/05
[3] Case T-133/05

> ".....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."

19. 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.

20. The respective trade marks are shown below:

The opponent's earlier marks	**The IR holder's contested mark**
SAVAGE	Savage Shark

21. In its written submissions, the IR holder's states that the word "Shark" is the dominant element in the contested mark. It also states that the divergence in the conceptual nature of the marks minimises the likelihood of confusion.

22. In contrast, the opponent submits in its written submissions that the term 'Savage' of the contested mark is where the attention of the consumer would be focused and where the visual impression of the mark is greatest.

Overall impression

23. The opponent's mark is a word-only mark consisting of the word "SAVAGE". There are no additional elements that contribute to the overall impression of the mark, and it is in that element alone that the overall impression resides.

24. The IR holder's mark is a word-only mark consisting of the two words "Savage" and "Shark". I note the word "Savage" is at the beginning of the mark where the consumer tends to pay more attention, however, in my view, "Savage" qualifies

"Shark". It is therefore my view that both elements contribute equally to the overall impression of the mark.

25. The earlier mark consists of the word "SAVAGE" in uppercase letters, while the contested mark consists of the word in one uppercase letter and the remainder lowercase letters. As both marks are word marks, these differences in case do not amount to differences in the marks.[4]

Visual comparison

26. The earlier mark coincides visually with the contested mark through the use of the word "Savage". However, the contested mark also comprises the word "Shark" placed after this, creating a clear difference between the marks. Overall, I consider the marks to be visually similar to a medium degree.

Aural comparison

27. The earlier mark comprises the word "Savage", which will be pronounced in the known way. The contested mark comprises the words "Savage" and "Shark", which will also be pronounced in the known way. The overlap of the word "Savage" creates some aural similarity, but the presence of the one syllable word "Shark" after the two syllable word "Savage" results in an aural difference between the marks. Overall, I consider the marks to be aurally similar to slightly above medium degree.

Conceptual comparison

28. Both the earlier mark and the contested mark include the word "Savage", meaning 'of an animal: wild, undomesticated, untamed'.[5] I note that it may also be used to refer to behaviour that is particularly violent or cruel. This is the only concept in the earlier mark.

29. The contested mark also comprises the word "Shark". The consumer will understand this word to relate to the marine animal. Together, the words "Savage

[4] Mr Iain Purvis QC, sitting as the Appointed Person in *Groupement Des Cartes Bancaires v China Construction Bank Corporation*, case BL O/281/14
[5] Oxford English Dictionary, https://www.oed.com/dictionary/savage_adj?tab=meaning_and_use#24321128, accessed 23 July 2025.

Shark" convey the meaning of a wild, undomesticated or untamed shark that is particularly vicious.

30. The concept conveyed by the word "Savage" acts as a point of conceptual similarity between the marks, whilst the absence of the word "Shark" acts as a point of conceptual difference. Overall, I find the marks to be conceptually similar to a medium degree.

Average consumer and the purchasing act

31. As the case law above indicates, it is necessary to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited,* [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

> "60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

32. The average consumer of the applicant's goods is likely to be a member of the general public. The purchasing process will entail the average consumer browsing the goods on shelves or rails in shops, or in images online or in a catalogue and where they will see the marks used as labelling or branding or in advertising. The purchase process is therefore a primarily visual one. Aural considerations may also play a part, by way of word-of-mouth recommendations or verbal assistance from retail staff, the aural impact of the marks must also be taken into account in the assessment. Case law suggests that visual similarity (and difference) is most important in the case of

goods (such as clothing) that are self-selected or where the consumer sees the mark when purchasing the goods.[6]

33. The goods, whilst not every day purchases, will likely be a relatively frequent purchase. During the purchasing process, consideration will be taken of factor such as material, colour, pattern, cut and style, as well as price. Consequently, I find that in general a medium level of attention will be taken by the general public buying the goods at issue in this case.

Distinctive character of the earlier trade mark

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

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

[6] See for example paragraphs 68 and 69 of the ruling of the General Court in Quelle AG v OHIM, Case T-88/05.

35. 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 distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

36. There is no evidence regarding the use of the earlier mark. Consequently, I have only the inherent position to consider.

37. The earlier mark consists of the word “Savage”. In its written submissions, the IR holder submits that “Savage” is not inherently distinctive as a trade mark because it is descriptive or laudatory as it means ‘untamed, wild or fierce’. Although I accept this definition of the word, I do not consider that “untamed, wild or fierce” is either descriptive or allusive of the goods at issue.

38. Taking this into consideration, I find that the opponent’s mark possesses a medium level of inherent distinctive character for all of the opponent’s goods and services.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion

39. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle, i.e., a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa (*Canon* at [17]). It is necessary to keep in mind the distinctive character of the opponent’s trade mark, the average consumer of the goods and services and the nature of the purchasing act. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind (*Lloyd Schuhfabrik* at [26]).

40. 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.

41. Earlier in this decision, I found the contested goods to be identical to the opponent's goods. I found the marks to have a medium degree of visual and conceptual similarity, with a slightly above medium degree of aural similarity. I found the earlier mark to possess a medium level of distinctive character. I identified the average consumer would pay a medium level of attention. I found that the goods would be selected by both visual and aural means, with visual means dominating.

42. As noted above, 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 (*Lloyd Schuhfabrik* at [26]).

43. Taking all of the above factors into account, I am satisfied that the average consumer would not directly mistake the parties' marks for each other on the applied for goods and services. I therefore do not find there to be a likelihood of direct confusion between the parties' marks for the applicant's goods and services.

44. I will therefore proceed to consider whether there is a likelihood of indirect confusion, whilst reminding myself that, 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".

45. In *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, 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).

(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)."

46. I do not consider this 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 vs Thomson*[7] and the subsequent case law. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. (as he then was) considered the impact of the CJEU's judgment in *Bimbo,* Case C-591/12P, on the court's earlier judgment in *Medion v Thomson.* 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

[7] Case C-120/04

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

47. Earlier I found that both words of the contested mark "Savage Shark" contribute equally to the impression of the mark and that the words hang together to result in the concept of a wild marine animal. Considering this combined meaning and the overall impression of the mark, I do not consider in this instance that either of the words of the contested mark has distinctive significance independently of the whole.

48. In the present proceedings, the earlier mark has a medium degree of distinctive character and the words “Savage Shark” have a combined meaning. Due to this, I do not consider that a consumer would assume that no one else other than the opponent would be using the word “Savage” in a trade mark, particularly, that no one would be using it in the context of the contested mark.

49. I consider that a consumer who is aware of the opponent’s earlier mark may note the use of “Savage” in both marks. However, I do not see any logical reason for the consumer to conclude that the “Savage Shark” mark is another brand of the owner of the earlier mark, or a brand extension. I find it likely that any consumers noticing the use of “Savage” both as the opponent’s earlier mark and the contested mark, would simply assume that the marks represented goods deriving from two different entities, and put the use of “Savage” in both (if noticed) down to coincidence.

50. I therefore do not consider there to be a likelihood of indirect confusion.

Final Remarks

51. The opposition under Section 5(2)(b) has been unsuccessful in respect of all of the contested goods. Subject to any successful appeal, the IR will proceed to be granted protection in the UK.

COSTS

52. The IR holder has been successful in these proceedings and is therefore entitled to a contribution towards its costs. In the circumstances, I award the IR holder the sum of £600 as a contribution towards the cost of the proceedings, in accordance with Tribunal Practice Notice 1/2023. The sum is calculated as follows:

Considering the TM7 and statement of grounds and preparing and filing the TM8 and counterstatement:	£250
Preparing written submissions:	£350
Total:	**£600**

53. I therefore order Kaveh Savage to pay Joseph J. Gartner the sum of £600. 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 22nd day of September 2025

K HARBACH

For the Registrar