o/0929/24

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003864092

BY PERRI'S CORPORATION

TO REGISTER THE TRADE MARK:

IN CLASS 25

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 440350

BY RABE MODEN GMBH

BACKGROUND AND PLEADINGS

1. On 3 January 2023, Perri's Corporation ("the applicant") applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 20 January 2023. The applicant seeks registration for the following goods:

Class 25 Leggings; Underwear; Socks.

2. The application was fully opposed by Rabe Moden GmbH ("the opponent") on 20 April 2023. The opposition is based upon section 5(2)(b) of the Trade Marks Act ("the Act"), and the opponent relies upon the following mark:

EVERYDAYS.

Comparable UK trade mark (EU) registration no. UK00917848813[1]
Filing date 22 February 2018.
Registration date 13 June 2018.
Relying upon some of the goods for which the earlier mark is registered, namely:

Class 18 Handbags, purses and wallets.

Class 25 Clothing; Footwear; Headgear; Waist belts; Leather belts [clothing].

3. The opponent claims there is a likelihood of confusion because the marks are highly similar and the goods are identical or highly similar.

4. The applicant filed a counterstatement denying the claims made.

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

5. The opponent is represented by DUMMETT COPP LLP and the applicant is represented by Katarzyna Eliza Binder-Sony of Trademarkia. Neither party requested a hearing nor filed written submissions in lieu, however, the applicant filed written submissions. I make this decision having taken full account of all the papers, referring to them below as necessary.

6. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

DECISION

Section 5(2)(b)

7. Section 5(2)(b) reads as follows:

> "5(2) A trade mark shall not be registered if because –
>
> (a)…
>
> (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected
>
> there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

8. The opponent's mark qualifies as an earlier mark in accordance with section 6(1)(aa) as its filing date is earlier than the filing date of the applicant's mark. The opponent's mark had not completed its registration process more than five years

before the relevant date (the filing date of the applicant's mark). Accordingly, the use provisions at section 6A of the Act do not apply. The opponent may rely upon all of its goods without demonstrating that it has used its mark.

Section 5(2)(b) case law

9. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG,* Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc,* Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV,* Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH,* Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM,* Case C-334/05P and *Bimbo SA v OHIM,* Case C-591/12P:

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

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

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

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall 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

10. The competing goods are as follows:

Opponent's goods	**Applicants' goods**
Class 18 Handbags, purses and wallets.	Class 25 Leggings; Underwear; Socks.

Class 25 Clothing; Footwear; Headgear; Waist belts; Leather belts [clothing].	

11. In *Gérard Meric v Office for Harmonisation in the Internal Market (OHIM),* Case T-133/05, the General Court ("GC") stated that:

> "29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysterne 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."

12. All of the applicant's applied-for goods fall within the broader category of "clothing" in the opponent's specification. The goods are identical on the principle outlined in *Meric*.

The average consumer and the nature of the purchasing act

13. As the case law above indicates, it is necessary for me 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."

14. The average consumer for the goods will be members of the general public. The cost of purchase is likely to vary, and the goods will be purchased relatively frequently. However, various factors are still likely to be taken into consideration during the purchasing process, such as materials used, cut, aesthetic appearance and durability. Consequently, I consider that a medium degree of attention will be paid by the average consumer when selecting the goods.

15. The goods are likely to be obtained by self-selection from the shelves of a clothing retail outlet, online or catalogue equivalent. This means that visual considerations will be the most significant.[2] Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount that there will also be an aural component to the purchase, as advice may be sought from a sales assistant or representative.

Comparison of the marks

16. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated, at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

> "… it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall

[2] *New Look Limited v OHIM*, Joined cases T-117/03 to T-119/03 and T-171/03, paragraph 50.

impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion."

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

18. The respective trade marks are shown below:

Opponent's mark	Applicant's mark
EVERYDAYS.	EVERY DAY Perri's Socks

19. The opponent's mark consists of the word "EVERYDAYS", presented in a standard capitalised typeface. I note that all of the letters are presented in the colour black, apart from the letter "S" at the end, which is presented in the colour pink. The word is ended by a full stop, which is also presented in the colour black. I consider that the word "EVERYDAYS" plays a greater role in the overall impression of the mark, with the full stop and the colourisation of the letter "S" in pink playing a lesser role.

20. The applicant's mark consists of the words "EVERY" and "DAY" presented on top of each other, in a standard capitalised black typeface. Underneath these are the words "Perri's Socks" presented in a standard lower-case black typeface, but in a significantly smaller size. On the right-hand side of the word "EVERY" is a black sun device. I bear in mind that the eye is naturally drawn to the element of the mark that can be read,[3] and therefore I consider that the biggest words "EVERY" and "DAY", will

[3] *Wassen International Ltd v OHIM (SELENIUM-ACE)*, Case T-312/03, paragraph 37.

play a greater role in the overall impression of the mark, with the smaller words “Perri’s Socks” presented at the end of the mark, and the sun device, playing a lesser role.

21. Visually, the marks coincide in the presence of the word, or words, EVERYDAY/EVERY DAY. These elements appear at the beginning of the marks, a position to which the average consumer pays more attention to.[4] These act as a visual points of similarity. However, the opponent’s mark ends in the pink letter “S” followed by a full stop, and there is a space between the words EVERY and DAY in the applicant’s mark, which is followed by the words “Perri’s Socks”. The applicant’s mark also consists of the sun device, which albeit plays a lesser role, it is not negligible. Therefore, these all act as visual points of difference. Consequently, I consider that the marks are visually similar to a medium degree.

22. Aurally, the average consumer will not attempt to articulate the non-verbal elements in the parties’ marks, including the full stop in the opponent’s mark and the sun device in the applicant’s mark. Therefore, I consider that the opponent’s mark is likely to be pronounced as EVERY-DAYS, and the applicant’s mark is likely to be pronounced as EVERY-DAY PEAR-EES-SOCKS. Thus the beginning of the marks are aurally identical. However, as a whole, I consider that the marks are aurally similar to a medium degree.

23. Conceptually, “everyday” is an ordinary dictionary word which will be known and recognised by the UK average consumer. I note that the opponent’s “EVERYDAYS” is not an ordinary dictionary word, however, it appears to be a pluralised version of the word “everyday” and therefore will still evoke this concept. Moreover, the space between the words “EVERY” and “DAY” does not stop it from evoking the same meaning as “everyday”. I also consider that the sun device in the applicant’s mark reinforces the meaning of “DAY” in the applicant’s mark. However, I consider that the words “Perri’s Socks” at the end of the applicant’s mark evokes the concept of socks that belongs to someone called “Perri”, which is a conceptual point of difference between the marks. Therefore, taking the above into account, I consider that the marks are conceptually similar to a medium degree.

[4] *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

Distinctive character of the earlier trade mark

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

> "22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C108/97 and C-109/97 Windsurfing Chiemsee v Huber and Attenberger [1999] ECR 1-2779, 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 promotion of 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)."

25. 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.

26. As the opponent has not filed any evidence to show that the distinctiveness of its mark has been enhanced through use, I only have the inherent position to consider.

27. As highlighted above, the opponent's "EVERYDAYS." mark will be recognised as the pluralised version of the ordinary dictionary word "everyday". Therefore, whilst it is not directly descriptive of the goods, I consider it is highly allusive as to the purpose of its clothing goods; that they are to be worn every day, or they are "everyday items of clothing". I also do not consider that the full stop or colourisation of the mark (all of the letters being black apart from the S being pink) particularly adds to the distinctiveness.

28. As per *Formula One Licensing BV v OHIM*[5], the earlier mark must be considered to have at least some distinctive character. Therefore, I consider that the opponent's mark is inherently distinctive to a low degree.

Likelihood of confusion

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

30. The following factors must be considered to determine if a likelihood of confusion can be established:

- I have found the marks to be visually similar to a medium degree.

[5] Case C-196/11P, paragraphs 41 to 44

- I have found the marks to be aurally similar to a medium degree.
- I have found the marks to be conceptually similar to a medium degree.
- I have found the opponent's mark to be inherently distinctive to a low degree.
- I have identified the average consumer for the goods to be the general public, who will select the goods primarily by visual means, although I do not discount an aural component.
- I have concluded that a medium degree of attention will be paid during the purchasing process for the goods.
- I have found the parties' goods to be identical.

31. I bear in mind the decision of the CJEU in *L'Oréal SA v OHIM*, Case C-235/05 P, in which the court confirmed that weak distinctive character of the earlier trade mark does not preclude a likelihood of confusion.

32. Therefore, taking all of the above into account, considering the principle of imperfect recollection, and bearing in mind that both marks begin with the words "EVERYDAY"/"EVERY DAY", (which play a greater role in the overall impression of the marks and establishes a medium degree of conceptual similarity between them), I consider that there is a likelihood of direct confusion. Whilst the opponent's mark ends in the pink coloured "S" and full stop, I consider that this would be easily overlooked by the average consumer, especially as the beginning of marks tend to make more of an impact than its ends, and the colourisation and full stop plays a lesser role in the overall impression of the mark. I also note that the words "EVERY" and "DAY" are separated by the sun device in the applicant's mark, and that this would be easily overlooked or misremembered (especially as the sun device plays play a lesser role in the overall impression). Moreover, the words "Perri's Socks" would be easily overlooked by the average consumer because they are presented significantly smaller in size, and at the end of the applicant's mark. Furthermore, given that the average consumer rarely has the opportunity to compare marks side-by-side and will instead encounter them in different settings at different times, to my mind, the medium degree of visual similarity between the marks will lead the average consumer to mistake one mark for the other, especially as the purchasing process is predominantly visual. Even where aural considerations apply, the medium degree of aural similarity between the

marks will have the same result. Moreover, the medium degree of conceptual similarity, arising from the part of the marks which play a greater role in the overall impression, means there is less of a conceptual hook to assist in differentiating between them. Therefore, bearing in mind the interdependency principle, I find that there is a likelihood of direct confusion on the parties' identical clothing goods.

33. For the sake of completeness, I will also assess if there is a likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C. sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

> "16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of 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."

34. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

35. I consider that the shared common use of EVERYDAY/EVERY DAY in the parties' marks will lead the average consumer to conclude that they originate from the same

or economically linked undertakings. Whilst the letter "S" at the end of the opponent's mark is presented in the colour pink, I do not underestimate the "importance of imperfect recollection",[6] and I consider that "EVERYDAYS." could be imperfectly recalled without the letter "S" and full stop at the end.

36. Whilst the words EVERY and DAY are presented separately in the applicant's mark, I consider that the average consumer could still imperfectly recall them without the separation between them. However, if the average consumer did remember the separation alongside the use of the sun device, they may perceive this as an updated presentation/stylisation of the opponent's mark. Moreover, the addition of the smaller words "Perri's Socks" at the bottom of the applicant's mark could be indicative of a sub-brand mark (with the consumer imperfectly recalling EVERYDAY being the house-brand, and EVERY DAY Perri's Socks being the sub-brand focused on socks). Therefore, bearing in mind the interdependency principle, I find there to be a likelihood of indirect confusion on the parties' identical goods.

CONCLUSION

37. The opposition is successful in its entirety and the application is refused.

COSTS

38. 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 **£350** as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Filing a Notice of opposition and considering the applicant's counterstatement	£250
Official Fee	£100

[6] *T-LAB WISSOTZKY (figurative mark)* BL O/0918/23, paragraph 35

Total	**£350**

39. I therefore order Perri's Corporation to pay Rabe Moden GmbH the sum of £350. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 24th day of September 2024

L FAYTER

For the Registrar