o/1030/24

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003885102

BY BARAQAH. LTD

TO REGISTER THE TRADE MARK:

IN CLASS 25

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 441384

BY G. & G. S.R.L.

BACKGROUND AND PLEADINGS

1. On 4 March 2023, BARAQAH. LTD ("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 17 March 2023. The applicant seeks registration for the following goods:

Class 25 Modest clothing; Abayas;.

2. The application was opposed by G. & G. S.r.l. ("the opponent") on 16 June 2023. The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opponent relies upon the following trade mark:

BARACUTA

Comparable UK trade mark (EU) registration no. UK00917963302[1]
Filing date 1 October 2018.
Registration date 14 February 2019.
Seniority date 9 May 1947.
Relying upon some of the goods for which the earlier mark is registered, namely:

Class 25 Clothing; Top clothes; Hosiery; Underwear; Swimming costumes; Nightwear; Footwear; Headgear; Waist belts; Shawls and stoles; Neckties; Foulards [clothing articles]; Kerchiefs [clothing]; Gloves [clothing]; Neckwear; Sportswear; Training shoes; Headgear for use in sports.

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

[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.

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

5. The opponent is represented by Bromhead Johnson LLP and the applicant is represented by Briffa. Both parties filed evidence in chief, and the opponent filed written submissions during the evidence rounds. Neither party requested a hearing but both parties filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

RELEVANCE OF EU LAW

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

EVIDENCE AND PRELIMINARY ISSUE

7. The opponent's evidence consists of the witness statement of Marine Body dated 20 November 2023. Ms Body is a Chartered Trade Mark Attorney at Bromhead Johnson LLP the representatives of the opponent. Ms Body's statement is accompanied by 5 exhibits (MB1-MB5).

8. The applicant's evidence consists of the witness statement of Khadiza Khanum dated 19 January 2024. Miss Khanum is the owner of the applicant and her statement is accompanied by 6 exhibits (KK1-KK6). I note that Miss Khanum's statement contains the heading "The Applicant's Submissions", which includes those in regard to the goods and mark comparison and the level of attention to be paid by consumers. Whilst this is contained within the witness statement, it will be treated as submissions (as it is correctly headed) and not as evidence of fact.

9. I have taken all of the evidence and submissions into consideration in reaching my decision and will refer to them where necessary below.

DECISION

Section 5(2)(b)

10. 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."

11. 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

12. In making this decision, I bear in mind the following principles 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

13. The competing goods are as follows:

Opponent's goods	**Applicant's goods**
Class 25 Clothing; Top clothes; Hosiery; Underwear; Swimming costumes; Nightwear; Footwear; Headgear; Waist belts; Shawls and stoles; Neckties; Foulards [clothing articles]; Kerchiefs [clothing]; Gloves [clothing]; Neckwear; Sportswear; Training shoes; Headgear for use in sports.	Class 25 Modest clothing; Abayas;.

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

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

where the goods designated by the trade mark application are included in a more general category designated by the earlier mark."

15. The applicant's "modest clothing" falls within the broader category of "clothing" in the opponent's specification. The goods are identical on the principle outlined in *Meric.*

16. Whilst Ms Body and Miss Khanum have both provided me with dictionary definitions of the word "abaya" in **exhibits MB1** and **KK1**, I note that in its submissions in lieu, the applicant "concedes that an Abaya is an item of clothing". Therefore the applicant's "abaya" falls within the broader category of "clothing" in the opponent's specification, making them identical on the principle outlined in *Meric.*

The average consumer and the nature of the purchasing act

17. 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 (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."

18. In its submissions in lieu, the applicant states that "whilst both marks provide clothing goods to the general public, this does not mean that the same individuals are seeking out the goods provided by both marks". The applicant states that the opponent's mark "is aimed predominantly at western men, with high end expensive clothing", as supported by **exhibits KK4** and **KK5** whereas "the application is solely

aimed for Muslim women with a modest price point". However, in reply, the opponent has provided extracts from WOMAN magazine which notes that the high-end brand, Dolce & Gabbana, launched its first line of abayas in 2016 (**exhibit MB3**).

19. Nonetheless, the applicant's above submissions regarding how the parties goods are used and sold in practice, which impacts the type of consumer that they attract, is not relevant to my assessment. I have carried out a notional assessment at paragraphs 15 to 16 above, based upon the specifications before me (how the goods within the parties' specifications could be used and sold), and all the circumstances in which the mark applied for might be used if it were registered,[2] and, in this case, the opponent's broader category of clothing encapsulates all of the applicant's goods.

20. Therefore as rightly noted by the applicant, both parties are providing clothing goods. Therefore the average consumer for this 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.

21. The goods are likely to be obtained by self-selection from the shelves of a retail outlet, online or catalogue equivalent. Alternatively, the goods may be purchased following the perusal of advertisements. This means that visual considerations will be the most significant.[3] However, I do not discount that there will also be an aural component to the purchase of the goods, as advice may be sought from a sales assistant or representative and word-of-mouth recommendations may play a part.

Comparison of the trade marks

22. 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

[2] *O2 Holdings Limited & Anor v Hutchison 3G UK Limited*, Case C-533/06, paragraph 66.
[3] *New Look Limited v OHIM*, Joined cases T-117/03 to T-119/03 and T-171/03, paragraph 50

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

23. 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.

24. The respective trade marks are shown below:

Opponent's trade mark	Applicant's trade mark
BARACUTA	BARAQAH.

25. The opponent's mark consists of the word "BARACUTA". There are no other elements to contribute to the overall impression which lies in the word itself.

26. The applicant's mark consists of word "BARAQAH", presented in a standard black capitalised typeface, followed by a full stop. These elements are presented on a neutral-coloured rectangular background. I consider that the word "BARAQAH" plays a greater role in the overall impression, with the full stop, stylisation and background playing a lesser role.

27. Visually, the marks coincide in the letters BARA at the beginning of the words, a position which the average consumer tends to pay more attention to.[4] These act as visual points of similarity. However, the opponent's mark ends in the 4 letters CUTA, whereas the applicant's word ends in the 3 letters QAH, followed by a full stop. The applicant's word and full stop elements are also presented on the neutral-coloured rectangular background. These act as visual points of difference. I therefore consider that the marks are visually similar to no more than a medium degree.

28. Aurally, I have not been provided with any submissions from either party as to the pronunciation of the marks. However, I consider that the opponent's mark is likely to be pronounced as BARA-COO-TAH, and the applicant's mark is likely to be pronounced as BARA-KAH. Whilst the beginning of the marks are aurally identical, and they overlap in the ending "AH" element, the marks differentiate in the number of syllables (3 vs 2), the "COO" syllable, and the T vs K aural elements. On this basis, I consider that the marks are aurally similar to a medium degree.

29. Conceptually, I consider that both marks will be seen as invented words with no conceptual meaning, and thus, they are conceptually neutral.

Distinctive character of the earlier trade mark

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

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

> "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)."

31. 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 and services, 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.

32. The opponent has not pleaded that its mark's distinctiveness has been enhanced through use, but has provided evidence in **exhibit MB4** in regard to its mark. I note that the exhibit contains undated screenshots of the .com website "Mason & Sons" which talks about the history of the "Baracuta G9" jacket. I also note that it contains undated screenshots from the opponent's own website (uk.baracuta.com) which also talks about the 85-year history of the "G9 Harrington Jacket", and it shows the "G9 Harrington Jacket" being sold on its Baracuta site for £360.

33. The opponent has not provided me with any evidence of turnover figures, numbers of units sold, example invoices, marketing figures or examples of this. I also have not been provided with a market share figure, nor could I determine the opponent's share of the market based on the minimal evidence before me. On this basis, I do not consider the evidence sufficient to establish enhanced distinctiveness.

34. I will therefore determine the inherent distinctiveness of the opponent's mark. The average consumer will see the word "BARACUTA" as an invented word with no conceptual meaning. Therefore, the opponent's mark is inherently distinctive to a high degree.

Likelihood of confusion

35. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. 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.

36. 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 no more than a medium degree.
- I have found the marks to be aurally similar to a medium degree.

- I have found the marks to be conceptually neutral.
- I have found the earlier mark to be inherently distinctive to a high degree.
- I have identified the average consumer for the goods to be members of 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.
- I have found the parties' clothing goods to be identical.

37. Whilst the beginning of the marks tend to make more of an impact than the ends, and the first four letters of the marks are identical, in *CureVac GmbH v OHIM*, T-80/08, it was determined that this was not always a decisive matter in the finding of a likelihood of confusion. I also bear in mind that the average consumer does not dissect the marks, and the distinctiveness of both the parties' marks lies in them as a whole, as they are both invented words. Therefore, the average consumer will not dissect the "BARA" element out of either mark and overlook or misremember the clearly differing ending elements, CUTA vs QAH, especially as they are not visually similar and the purchasing process is predominantly visual. I also consider that, in the absence of a conceptual hook, the average consumer will not have a strong conceptual message to connect, call to mind and confuse both of the marks. For all of the above reasons, I am satisfied that the marks are unlikely to be mistakenly recalled or misremembered as each other, even when used on identical class 25 goods. Taking the above into account, I do not consider there to be a likelihood of direct confusion.

38. 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."

39. 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.

40. Having noticed that the competing trade marks are different, I see no reason why the average consumer would assume that they come from the same or economically linked undertakings. I do not consider that the average consumer would think the applicant's trade mark was connected with the opponent or vice versa. They are not natural variants or brand extensions of each other. Consequently, I consider there is no likelihood of indirect confusion.

CONCLUSION

41. The opposition is unsuccessful, and the application may proceed to registration.

COSTS

42. The applicant has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023. As noted above, the applicant's evidence was of no assistance. On this basis, I shall not be awarding any costs in relation to it. Consequently, I award the applicant the sum of

£1,200 as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Considering the Notice of opposition and preparing a counterstatement	£250
Preparing and filing written submissions in lieu of a hearing	£350
Considering the opponent's evidence	£600
Total	**£1,200**

43. I therefore order G. & G. S.r.l. to pay BARAQAH. LTD the sum of £1,200. 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 31st day of October 2024

L FAYTER

For the Registrar