O/1118/25

TRADE MARKS ACT 1994

IN THE MATTER OF UK TRADE MARK REGISTRATION NO. 3792756

IN THE NAME OF ODIMBA OKUTU

IN RESPECT OF THE FOLLOWING TRADE MARKS:

IN CLASSES 25 AND 42

AND

THE APPLICATION FOR THE INVALIDATION THEREOF UNDER NO. 506122

BY NELWOOD CORP

BACKGROUND AND PLEADINGS

1. On 26 May 2022, Odimba Okutu ("the proprietor") applied to register the series of trade marks shown on the cover page of this decision in the UK ("the contested marks"). The application for the contested marks was accepted and published in the Trade Marks Journal on 2 September 2022, and was registered on 11 November 2022 in respect of the following goods and services:

   Class 25: Clothes; Clothing; Jackets [clothing]; Belts [clothing]; Windproof clothing; Silk clothing; Hoods [clothing]; Leather clothing; Waterproof clothing; Jerseys [clothing]; Weatherproof clothing; Casual clothing; Denims [clothing]; Embroidered clothing.

   Class 42: Designing; Industrial design; Technical design; Packaging designs; Furniture design; Architectural design; Website design; Graphic design; Fashion design; Pattern design; Design services; Jewelry design; Product design; Graphic designing; Commercial art design; Product design services; Graphic art design; Industrial art design; Designing of clothing; Design of prototypes; Packaging design services; Vehicle design services; Design of typefaces; New product design; Graphic arts design; Designing of furniture.

2. On 19 May 2023, Nelwood Corp ("the cancellation applicant") applied to invalidate the contested mark on the basis of sections 47(2)(a) and 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The application for invalidation relies upon the cancellation applicant's earlier UK designation of International Trade Mark No. WO0000001467919 (the "earlier mark"), namely the mark set out below:

   kuru

   Designation date: 1 April 2019
   IR registration date: 1 April 2019
   Date of protection in the UK: 15 August 2019
   Priority date: 3 October 2018 (US)

Relying upon some of the goods for which it has been registered, namely:

Class 25: Clothing, namely, beach clothes in the nature of shirts, hats, and footwear, beach shoes, boots, boots for sports, caps being headwear, footwear, hats, inner soles, sandals, shirts, shoes, short-sleeve shirts, slippers, socks, soles for footwear, sports shoes.

3. The cancellation applicant submits that the marks in issue are “similar” and are registered for “identical and/or similar” goods and services. It therefore submits that there is a likelihood of confusion and that the contested marks should be declared invalid under section 5(2)(b) of the Act.

4. The proprietor filed a counterstatement denying the similarity between the marks. Specifically, the proprietor submits that the cancellation applicant has oversimplified and distorted the visual, phonetic and conceptual reality of the contested marks, and that its application to invalidate the contested marks misrepresents the broader commercial context.

REPRESENTATION

5. The cancellation applicant is represented by Tierney IP.

6. The proprietor is self-represented.

EVIDENCE AND SUBMISSIONS

7. Both parties filed witness evidence in support of their respective claims, which I have discussed in further detail in paragraphs 18 to 28 of this decision. The cancellation applicant filed evidence in chief in the form of a witness statement signed by Bret Rasmussen, dated 22 January 2024, in his capacity as founder of Nelwood Corp. This was accompanied by 1 exhibit (BR1). It was also accompanied by written submissions dated 30 January 2024.

8. A witness statement was also filed by the proprietor, dated 9 December 2024, in their capacity as Creative Director of Okuru Ltd (the company the proprietor submits has been using the proprietor's mark since its filing date). This was accompanied by 1 exhibit (OK1).

9. In response, the cancellation applicant also filed a witness statement signed by Niall Tierney, dated 26 March 2025,[1] in his capacity as the Registered Trade Mark Attorney for the cancellation applicant. This was accompanied by 1 exhibit (NT1).

10. No hearing was requested in this matter, but both parties filed written submissions in lieu of a hearing, which will not be summarised but will be referred to as and where appropriate during this decision. This decision is therefore taken following a careful consideration of the papers.

PRELIMINARY ISSUES

11. The cancellation applicant's submissions in these proceedings refer to a previous decision of the UK IPO Tribunal (O/485/21). Those proceedings concerned a prior dispute between the cancellation applicant and the proprietor relating to largely the same marks, albeit the contested mark in decision number O/485/21 was presented horizontally, whereas it is presented vertically in this instance. In any event, the cancellation applicant has attributed a great deal of weight to the findings of that decision in support of its arguments in the present proceedings. Whilst it is important to note the contents and findings of previous decisions, decisions of this Tribunal are not binding authority on subsequent hearing officer decisions.

12. In that regard, I note the comments of Mr James Mellor QC (as he then was) sitting as the Appointed Person in *Ants R Us*,[2] that:

[1] Albeit it is noted that an amended copy of the witness statement of Niall Tierney was filed on 19 May 2025 with an amendment to the trade mark number printed in the top right hand corner of the witness statement. Save for this amendment, the witness statement was identical to the version filed on 26 March 2025.
[2] BL O/478/20

> "32. In paragraph 29, it can be seen that the Hearing Officer took the view that 'R US' was not 'particularly distinctive in itself' and also that it was 'inherently weakly distinctive'. This is the only point in the Decision which has given me pause for thought. In this regard, I refer to the prior decisions to which the Appellant draws attention – namely O/213/03 TOYS AREN'T US at §37, and O/224/06 'WINDOWS "R" US' at §17 – in which it asserts it was held that the element 'R US' and TOYS R US are distinctive. In both sets of proceedings, the Opponent relied on various UK and Community Trade Marks, including a CTM for 'R US'. The first case was an opposition which succeeded but only under ss5(3) and 3(6), and failed under s.5(4)(a), the second was an invalidity claim which failed in its entirety including under s.5(4)(a). The circumstances of each were different in material respects to the situation in this opposition, and neither decision establishes the propositions advanced, at least not without some qualification. <u>Although a measure of consistency in the assessment of marks is desirable, it is not mandatory. In any event, the Hearing Officer had to decide this opposition on the basis of the evidence before her."</u> (my emphasis added)

13. As has been clearly established, each case must be assessed on its own merits and, as such, I do not consider it appropriate to derive my findings or conclusions wholly from the decision to which the cancellation applicant refers. My determination of each of the cancellation applicant's claims must take into account all the relevant factors, following an assessment of the papers before me.

<u>**DECISION**</u>

14. 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.

15. The relevant part of section 47 of the Act states as follows:

> "47. –
>
> (1) […]
>
> (2) The registration of a trade mark may be declared invalid on the ground -
>
> (a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain,
>
> […]
>
> unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.
>
> …
>
> (2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –
>
> (a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,
>
> (b) the registration procedure for the earlier trade mark was not completed before that date, or
>
> (c) the use conditions are met

16. An earlier trade mark is defined in section 6 of the Act as "a registered trade mark or international trade mark (UK) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks".

17. As the earlier mark had not been granted protection for a period of five years or more at the date on which the invalidation was filed, it is not subject to the use provisions set out at section 47(2A) of the Act.

Witness Evidence

18. As outlined above, the cancellation applicant filed two witness statements, a witness statement signed by Bret Rasmussen and a witness statement signed by Niall Tierney.

19. The witness statement of Bret Rasmussen filed on 22 January 2024, was three pages in length and sought to evidence use of the earlier mark by the cancellation applicant. In summary, the witness statement confirmed the following:

    a. That the cancellation applicant's company first started selling its products in the United Kingdom on 4 January 2016;

    b. That since the cancellation applicant started selling its products in the UK it has generated approximately $30,700 in annual sales turnover; and

    c. That the cancellation applicant had 23,741 users of its website (www.kurufootwear.com) from the UK in 2022 and 32,358 users of its website from the UK in 2023.

20. The witness statement of Bret Rasmussen also included extracts from four positive reviews received from consumers in the UK between 2013 and 2022 (one from 2013, one from 2017 and two from 2022).

21. Exhibited to the witness statement of Bret Rasmussen (exhibit BR1) were the following:

    a. A screen shot of an article from Fiona Outdoors' webpage dated 17 July 2023 referencing "KURU Footwear";

b. A screen shot from “healthandfitnesscentre.co.uk” referencing the “Kuro Atom Sneaker”. However, I note that the earlier mark is not clearly evident in this screenshot; and

c. An undated screenshot from “ridleyroad.co.uk” referencing “KURU Footwear”.

22. The proprietor subsequently filed a witness statement explaining the history behind the brand utilising the contested marks (the “Okuru Brand”) and evidencing the proprietor’s use of the contested marks. In summary, the proprietor’s witness statement confirmed the following:

    a. That OKURU Ltd has been using the contested marks since 26 May 2022; and

    b. That the Okuru brand sells a “diverse collection of apparel”, as well as “digital gift cards”, and that it arranges live events.

23. Exhibited to the witness statement were the following, which the proprietor submits evidence that the Okuru brand has established a distinctive “presence in the fashion industry”:

    a. A screenshot from an article on SS Editorial’s webpage (sseditorial.com) referencing the Okuru brand and specifically showing images of items of clothing which appear to have the contested marks printed on them. Unfortunately, the quality of the screen shot provided does not allow me to make out the date the article was published.

    b. A screen shot taken from “marketing materials” showing an image of a hooded jumper displaying the contested marks. It is noted that I have not been provided with confirmation of where this marketing material was distributed, nor have I been provided with confirmation of the dates that this marketing material was produced.

c. A screenshot from London Fashion Week's Urban MBA runway presentation titled "Emerging Futures". The screenshot contains images of goods from the brand’s Spring Summer 2024 collection with the contested marks printed on them.

24. Whilst the parties have both filed witness evidence of their use of their respective marks, for the reason outlined in paragraph 17 above, proof of use of the earlier mark is not required by the cancellation applicant. However, I will reconsider the evidence contained in the witness statement of Bret Rasmussen when it comes to determining whether the earlier mark has established enhanced distinctive character through its use.

25. There is also no requirement for the proprietor to evidence use of the contested marks for the purposes of this application to invalidate. This is because the application to invalidate is being pursued under section 5(2)(b) of the Act which requires me to carry out a notional assessment based upon all the ways in which the parties’ respective marks could be used. Further, any assessment of enhanced distinctive character through use will only be relevant for the purposes of this decision with respect to the earlier mark. Consequently, whilst I have reviewed the witness evidence provided by the parties, any evidence contained within these statements regarding the parties’ use of their respective marks will have no bearing on my decision, beyond my consideration of whether the earlier mark has enhanced its distinctive character through use.

26. In response to the proprietor’s witness statement, the cancellation applicant filed a further witness statement signed by Niall Tierney. This witness statement is just two pages in length and addresses two points. Firstly, it notes that the proprietor has conceded that it has been using the contested marks since 26 May 2022, which is later than the date of protection afforded to the earlier mark.

27. Secondly, Niall Tierney asserts that the witness statement of Odimba Okutu “does not comply with Rule 20.2 of Practice Direction 32 of the Civil Procedure

Rules" given that it does not incorporate the statement of truth wording stipulated in Rule 20.2.[3]

28. It should be noted that the Civil Procedure Rules apply to County Court, High Court and the Civil Division of the Court of Appeal, not Tribunal proceedings.[4] Guidance on the wording of statements of truths in Tribunal proceedings can be found in section 4.8.3.1 of the Manual of Trade Marks Practice, but this is, of course, guidance and not binding. However, given my finding that the proof of use evidence contained in the proprietor's witness statement will not impact this decision, and my finding below regarding enhanced distinctiveness, I do not consider that a further discussion on the suitability of the statement of truth in the proprietor's witness statement is necessary.

Section 5(2)(b)

29. This application for invalidation is based upon section 5(2)(b) of the Act which stipulates the following:

> "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".

30. Section 5A of the Act states as follows:

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[3] It is noted that in paragraph 6 of the witness statement of Niall Tierney it incorrectly stipulates that "the Applicant's Witness Statement does not comply with Rule 20.2..." and that the "Applicant's Witness Statement is defined as the Witness Statement of Bret Rasmussen. However, it is clear to me that this is a typographical error, and it should in fact have stated that "the Proprietor's Witness Statement does not comply with Rule 20.2…"

[4] Rule 2.1 of the Civil Procedure Rules 1998 - albeit the tribunal does adhere to the same overriding objective as that set out in rule 1.1 of the Civil Procedure Rules (section 1.8 of the Manual of Trade Marks Practice).

"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

31. 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 C425/98, Matratzen Concord GmbH v Office for Harmonization in the Internal Market (Trade Marks and Designs) ("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 and service

32. The competing goods and services are as follows:

The cancellation applicant’s goods	The proprietor’s goods and services

Class 25 Clothing, namely, beach clothes in the nature of shirts, hats, and footwear, beach shoes, boots, boots for sports, caps being headwear, footwear, hats, inner soles, sandals, shirts, shoes, short-sleeve shirts, slippers, socks, soles for footwear, sports shoes.	Class 25 Clothes; Clothing; Jackets [clothing]; Belts [clothing]; Windproof clothing; Silk clothing; Hoods [clothing]; Leather clothing; Waterproof clothing; Jerseys [clothing]; Weatherproof clothing; Casual clothing; Denims [clothing]; Embroidered clothing. Class 42 Designing; Industrial design; Technical design; Packaging designs; Furniture design; Architectural design; Website design; Graphic design; Fashion design; Pattern design; Design services; Jewelry design; Product design; Graphic designing; Commercial art design; Product design services; Graphic art design; Industrial art design; Designing of clothing; Design of prototypes; Packaging design services; Vehicle design services; Design of typefaces; New product design; Graphic arts design; Designing of furniture.

33. The cancellation applicant submits that the marks in issue are registered for “many goods which are identical and/or similar”. Specifically, the cancellation applicant submits that the “nature, use, intended purpose and end user of the goods of the [marks in issue] are all the same” and that, whilst “the goods of the [earlier mark] are qualified as being intended for use on the beach, this in no way lessens the identical and similar nature of the goods” in issue, as many of the goods “could be equally used in the same way”.

34. The proprietor submits that the earlier mark is “primarily associated with orthopaedic and functional footwear”, whereas the contested marks product range encompasses “Limited-run monogram streetwear collections, repurposed denim, cultural capsule drops, and fashion accessories”, Digital fashion experiences and gift cards, targeting consumers with hybrid physical-digital interests” and “Event production and brand collaborations, extending beyond fashion into curated cultural storytelling”. The proprietor therefore submits that the Tribunal must not apply a generic clothing/footwear overlap presumption in this instance.

35. It should be noted, however, that I must compare the goods and services in the parties’ specifications on the basis of the ‘notional’ coverage of the goods and services listed in the specifications, not those currently provided. Any differences between the actual goods and services offered by the parties or the parties’ marketing/trading styles will, as a matter of law, have no bearing on the outcome of my assessment of similarity between the goods and services in issue, unless those perceived differences are apparent from the specifications. This is because a trade mark registration is essentially a claim to a piece of legal property (the trade mark). Every registered mark is entitled to legal protection against the use, or registration, of the same or similar trade marks for the same or similar goods/services if there is a likelihood of confusion, and the scope of protection afforded to that mark will be identified in its specifications. It is only if an application for a declaration of invalidity is received more than five years after the date the earlier mark is registered that the cancellation applicant can be required to provide evidence of use of its mark within the UK. Until that point, however, the earlier mark is entitled to protection in the UK in respect of the full range of goods and services for which it is registered.

36. Section 60A of the Act provides:

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

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

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

(2) In subsection (1), the "Nice Classification" means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1979."

37. In *Canon*, Case C-39/97, the Court of Justice of the European Union ("CJEU") stated (at paragraph 23) that, when making the comparison, "all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary".

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

a. The respective uses of the respective goods or services;

b. The respective users of the respective goods or services;

c. The physical nature of the goods or acts of service;

d. The respective trade channels through which the goods or services reach the market;

e. In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

f. The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

39. In *Gérard Meric v OHIM*, the General Court 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)[5]:

> "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."

40. As per the case of *Separode,*[6] I bear in mind that it is permissible to group the goods together, for the purpose of comparison.

Clothes; Clothing;

41. I consider that some of the terms in the cancellation applicant's specification, such as "beach clothes in the nature of shirts" would fall within the proprietor's wider terms "Clothes" and "Clothing". Consequently, I consider them to be identical in line with the principle established in *Meric.*

Jackets [clothing]; Belts [clothing]; Windproof clothing; Silk clothing; Hoods [clothing]; Leather clothing; Waterproof clothing; Jerseys [clothing]; Weatherproof clothing; Casual clothing; Denims [clothing]; Embroidered clothing.

[5] Case T-133/05
[6] BL O/399/10

42. These goods would be sold through the same trade channels as the cancellation applicant's goods; the same retailers usually sell a range of footwear, hats and clothing items. The users will plainly be the same. The method of use and purpose of the goods will overlap as they are all intended to be worn on the body for the purposes of warmth/protection. There may be some overlap in nature, where goods are made using the same materials. In my view, these goods are similar to at least a medium degree.

<u>Designing; Fashion design; Designing of clothing; Design services; Product design; Product design services; New product design;</u>

43. The above referenced services are all terms which may include the designing of clothing and footwear. Whilst the contested marks' specification does not include such services, it's class 25 goods include various types of clothing and footwear. The nature of these goods and services differ, as does the method of use. However, there will be an overlap in the end purpose (for the ultimate provision of clothing and footwear), albeit the primary purpose differs, with the purpose of clothing and footwear to be worn, and the purpose of the various design services referenced above being to design goods. In any event, I find that the design of the goods is important and arguably essential to the provision of the goods themselves.

44. Further, occasionally users may overlap in terms of the general public, for example where the general public engages fashion/clothing design services, perhaps in the case of special occasion wear or one-off items, but also buys off the rack items to wear alongside the same, and these users may well believe that the goods and services will be offered by the same entities. As such, there is a level of complementarity, and trade channels may sometimes be shared. To an extent, there may also be a level of competition between the goods and services, for example in the case of a consumer choosing between purchasing pre-designed off the rack clothes, or engaging design services to design these for them. Overall, I find the proprietor's services to be similar to the cancellation applicant's goods to a medium degree.

Industrial design; Technical design; Packaging designs; Furniture design; Architectural design; Website design; Graphic design; Pattern design; Jewelry design; Graphic designing; Commercial art design; Graphic art design; Industrial art design; Design of prototypes; Packaging design services; Vehicle design services; Design of typefaces; Graphic arts design; Designing of furniture.

45. I do not see any basis for finding the above referenced services to be similar to the cancellation applicant's goods. This is a comparison of goods against services, and by virtue of that fact, they will differ in nature and method of use. They also differ in purpose, with one being to be worn and the other being to design. I have no evidence to suggest that the trade channels would overlap. I also do not consider there to be any competition between the goods and services in issue, nor do I consider that the average consumer would believe the goods and services derive from the same undertaking. There is, inevitably, some very broad overlap in users of the goods and services as the user of the services underlined above will also purchase clothing goods. However, I am conscious of the judgment of Iain Purvis KC in *Unicorn Studio Inc v Veronese* in which he stipulated that "any finding of similarity in the end requires the exercise of common sense and requires the hearing officer to stand back and consider the overall question" rather than by engaging "in a box-ticking exercise, asking how many of the factors identified in *TREAT* or in *Canon* could be said to have been satisfied".[7]

46. In light of the above, I do not find any similarity between the services underlined above and the cancellation applicant's goods, nor have I been provided with any submissions by the cancellation applicant explaining why any such similarity might exist.

47. As some degree of similarity between the goods and services is required for a successful claim under section 5(2)(b) of the Act, the application for invalidation must fail in respect of those services that I have found to be dissimilar.[8]

[7] [2024] EWHC 1098 (Ch) - paragraph 24
[8] *eSure Insurance v Direct Line Insurance* [2008] ETMR 77 CA

The average consumer and the purchasing act:

48. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question (see Lloyd Schuhfabrik Meyer, Case C-342/97).

49. 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. held:

> "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."

50. In respect of the class 25 goods and the cancellation applicant's fashion/clothing design services, which I have found to be similar, I note there will be multiple groups of consumers. First, there will be members of the general public, looking to purchase the class 25 goods. They will consider the size, price, suitability, aesthetics, quality and material of the goods and will therefore generally pay a medium level of attention in respect of the same.

51. There will also be members of the general public looking to get a bespoke item designed for a special occasion, and these consumers are likely to pay a higher level of attention on the basis that these will likely be one off, more expensive purchases to be worn on an important day.

52. There will also be professional consumers who are looking to engage design services. These consumers will likely pay between a medium and high level of attention when engaging the services, as the services will have a direct impact on the success of their business.

53. The goods themselves will be sold in online or physical retail stores or via websites, whilst the services are likely to be marketed on websites or promoted using visual advertising campaigns. In both cases, visual considerations will be key. However, I note that verbal recommendations of the goods and services may be made, and there may also be verbal advertisements (for example, in respect of podcasts). I do not therefore discount that there may be an aural element to the purchasing process.

Comparison of marks:

54. 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.[9] 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 states at paragraph 34 of its judgment in *Bimbo,*[10] 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."

[9] Case C-251/95
[10] *Bimbo SA v OHIM*, Case C-591/12P

55. 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.

56. The marks to be compared are as follows:

<table>
<tr><th>The earlier mark</th><th>The contested marks</th></tr>
<tr><td rowspan="2">kuru</td><td>送
The “first contested mark”</td></tr>
<tr><td>送
The “second contested mark”</td></tr>
</table>

57. The cancellation applicant submits that the marks in issue are conceptually similar because of the “presence of the ‘kuru’ element” in all of the marks. The

cancellation applicant also submits that the marks in issue are "visually similar… because they incorporate the element 'kuru' which is identical to the earlier trade mark", and "the presence of the letter 'o' at the start of the [contested marks] will not be enough to visually distinguish them". The cancellation applicant also submits that "the graphic symbol" within the [contested mark] is so small and inconsequential that it would not be enough to distinguish it from the earlier trade mark".

58. Further, the cancellation applicant submits that the marks in issue are phonetically similar "because they incorporate four characters which, when pronounced…., would be identical", the presence of the letter "O" at the start of the contested marks "would not be enough to phonetically distinguish them" from the earlier mark and "may well be silent when the relevant goods are ordered orally".

59. Conversely, the proprietor submits that the marks in issue differ visually, phonetically and conceptually, and submits that the cancellation applicant "underestimates the visual impact of the first letter and overall styling" in the contested mark "which in the fashion industry, is crucial for brand identity". The proprietor further submits that the "O" syllable "alters the phonetic impression of the mark significantly, making it distinct when spoken or heard", and that the symbol at the top of the contested marks "is not merely a stylistic feature but plays a vital role in distinguishing the brand in a market that appreciates multicultural influences."

Overall Impression

60. The earlier mark is a word only mark, consisting of the word "kuru". There are no other elements in the mark which contribute to its overall impression, so the overall impression lies in the word itself.

61. The two contested marks are figurative marks and, save for the fact that the first contested mark is more stylised to the extent that its various elements appear to have a shadow (and therefore it appears to be three dimensional), the earlier

marks are presented identically. As I do not consider that this additional element of stylisation in the first contested mark would be perceived by the average consumer as being anything more than a shadow, I am of the view that it may well be overlooked by the average consumer, and therefore that it plays a very limited role in the overall impression of the first contested mark. I do not therefore consider that this difference will have any material impact upon the outcome of my comparison of the marks in issue. Consequently, all of my findings in that respect will apply equally to both of the contested marks.

62. The contested marks include, what appears to be, a foreign language symbol, specifically East Asian. The cancellation applicant submits that the average British consumer ordering goods over the internet will disregard the presence of the foreign language symbol due to the fact that keyboards within the UK do not generally include it. Whilst it is factually correct to say that the average keyboard in the UK does not have the foreign language symbol on its face, I am conscious that the goods and services in issue are not only purchased online. Further, even when such goods and services are purchased online, the purchasing act can occur as a result of perusing websites and not just as a result of searching for specific goods through search engines. Consequently, I do not consider this factor to be persuasive in my determination of the significance, or lack thereof, of the foreign language symbol in the overall impression of the contested marks.

63. Having said that, I note that the cancellation applicant has also asserted, when discussing the phonetic similarities between the marks in issue, that the presence of the foreign language symbol "would be meaningless to the average British consumer who would not know or understand its meaning" and, as a consequence, it would be "disregarded". I do agree with the cancellation applicant that the average UK consumer would not understand the foreign language symbol and that their attention would be drawn to the other characters in the contested marks.

64. The foreign language symbol is stacked above, what both parties appear to accept in their respective submissions are, five letters stacked on top of each other, albeit each letter is highly stylised and not fully formed. Whilst the

proprietor does confirm that this was the intention of the contested mark, there does not appear to be an admission from the proprietor that this is how the average consumer would perceive the mark. Indeed, I do not accept that the average consumer would identify the word “OKURU” in the contested marks, and it is how the average consumer would perceive the marks in issue that I must consider here, regardless of whether that aligns with the views of the parties.

65. It is my view that the characters in the contested marks will be identified by the average consumer as a number of stacked shapes/symbols. This is particularly the case because the characters are presented vertically. In that regard, I once again note the cancellation applicant’s reliance on case number O/485/21, in which it was determined that the contested mark in that instance (which was effectively the same as these contested marks, but presented horizontally), would be read as “OKURU”. Whilst, once again, I note that I am not bound by that decision, I would note that words in the English language are read from left to right and, given that the characters in case number O/485/21 are presented from left to right, this may have resulted in the Hearing Officer making such a finding. In any event, the contested marks being considered in that decision and this one clearly do differ in that respect.

66. Unlike the foreign language symbol, the characters below in the contested marks are presented in a much larger, bold font. As a result, I find that the foreign language symbol plays a lesser role in the overall impression of the mark, with the characters below playing a dominant role.

Visual, Aural and Conceptual Comparison

67. As outlined above, I do not consider that the characters in the contested mark would be read as “Okuru”. Consequently, I do not agree that both marks contain the word “kuru”, and I can therefore see no basis for finding of visual similarity between the marks. I find the marks to be visually dissimilar.

68. I am of the view that the only element of the marks in issue that will be pronounced is the “kuru” in the earlier mark. This is because, as discussed

above, I do not believe that the average UK consumer would understand the foreign language symbol in the contested marks, and the other characters in the contested marks would be identified as symbols/shapes, rather than letters. Consequently, I cannot see any basis for a finding of aural similarity between the marks. I therefore find the marks in issue to be aurally dissimilar.

69. Conceptually, it is noted that in the witness statement of Bret Rasmussen it is submitted that “Kuru” is a Japanese word meaning “to come”, and that it is also Japanese slang for “cool, hip, fashionable, stylish”. However, I do not consider that the average UK consumer would understand this meaning. Instead, I consider that the average UK consumer would believe the word “Kuru” to be an invented word with no conceptual meaning.

70. The cancellation applicant submits that the marks in issue are conceptually similar as a result of the mutual presence of the “kuru” element. However, as discussed above, I do not consider that the average consumer will identify the characters in the contested marks as “Okuru”. I consider that they would simply be viewed as a number of symbols or shapes stacked upon each other, with no further meaning. Whilst I have found that the average UK consumer would understand the foreign language symbol in the contested mark to be an East Asian symbol, I do not consider that they would be able to identify the meaning of the symbol in the contested marks, and I do not consider that the stylisation in the contested marks has any conceptual significance.

71. Overall, I do not consider that the marks in issue convey a concrete conceptual message to the average consumer, I therefore consider them to be conceptually neutral.

72. As some degree of similarity between the marks is required for a successful claim under section 5(2)(b) of the Act, the application for a declaration of invalidity must fail on this basis.

73. The above finding is based on my view that the average consumer would not read the characters in the contested mark as “Okuru”. If, however, I am wrong in

that finding, I still would have found "Okuru" to be the dominant element of the contested marks given that it is presented in a much larger, bold font than the other elements of the contested marks. In such circumstances, visually, both of the marks would have overlapped in their final four letters ("Kuru"). However, the contested marks would be read as having an "O" before the letters "Kuru", as well as the additional foreign language symbol before the "Okuru". The contested marks are also presented vertically, whereas the earlier mark is presented horizontally. All of these additional elements in the contested marks do amount to points of visual differences between the marks. I am also conscious that the General Court in *El Corte Inglés, SA v OHIM* noted that the beginning of words tend to have more visual and aural impact than the end.[11] I also bear in mind that differences to shorter marks tend to have more of an impact.[12] Weighing up all of these factors, if I did consider that the characters in the contested marks would be perceived as "Okuru", I still would only have found the marks in issue to be visually similar to a low degree.

74. Aurally, in such circumstances, whilst the cancellation applicant submits that the "O" "may well be silent", I can see no basis for this assertion. If I was to find that the characters in the contested marks would be read as "Okuru" by the average consumer, I consider that the "O" in the contested marks would be pronounced, resulting in a clear phonetical difference between the marks. Once again, I am also conscious that the beginning of words tends to have more visual and aural impact than the end.[13] Consequently, in such circumstances, I would have found the marks to be aurally similar to a medium degree.

75. Conceptually, for the reasons outlined above, I consider that the average consumer would perceive "kuru" as an invented word with no conceptual meaning. In respect of Okuru, the proprietor submits that it derives from the Japanese verb "okuru", meaning "to send, symbolising movement, connection and cultural transmission". However, I do not consider that the average UK consumer would understand the meaning of "Okuru". Instead, I am of the view

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[11] Cases T-183/02 and T-184/02
[12] See, for example, *F1T* BL O/013/21
[13] Cases T-183/02 and T-184/02

that the average consumer would perceive it as an invented word with no conceptual meaning.

76. I do not consider that the other elements of the contested marks identify any meaning (beyond the foreign language symbol being identified as an East Asian symbol with no clear meaning). Consequently, even if I did consider that the average consumer would identify the characters in the contested mark as the word "Okuru", I still would have found that the marks in issue do not convey a concrete conceptual message to the average consumer, and that they are therefore conceptually neutral.

77. As discussed above, it is my primary finding that the average consumer would not read the characters in the contested marks as "Okuru", that the marks in issue are therefore dissimilar, and the declaration of invalidity fails on this basis. However, if I am wrong in that finding then, for the reasons outlined above, I would consider the marks in issue to be visually similar to a low degree, aurally similar to a medium degree and conceptually neutral. For completeness, I will therefore proceed to undertake a full assessment of the likelihood of confusion between the marks in issue, should my primary finding be incorrect, including a consideration of the distinctive character of the earlier mark.

Distinctive character of the earlier trade mark

78. 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).

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)."

79. Distinctiveness is a scale along which marks of various types sit. A mark which is allusive of the goods/services will have less distinctive character than one that is not; dictionary words will also be less distinctive than words which are entirely fanciful. However, all will turn on the particular facts. For example, there are "invented" words which are really just composites of two allusive words and only distinctive as a result, and dictionary words which are more or less common than others.

80. As discussed above, I consider that the average UK consumer would identify the word "Kuru" as an invented word which is neither descriptive nor allusive of the cancellation applicant's goods. On this basis, I am of the view that the earlier mark has a high level of distinctive character.

81. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it, and such enhanced distinctiveness may affect the likelihood of confusion between that mark and a later mark including the same, or a similar, element. Whilst the cancellation applicant has filed the witness statement of Bret Rasmussen which confirms that the cancellation applicant has been selling goods in the UK since January 2016 and that it has generated approximately

$30,700 in annual sales turnover, in the context of what is undoubtedly a huge market, this average sales turnover is very small.

82. Further, whilst the cancellation applicant has confirmed the number of hits it received on its webpage from the UK in 2022 and 2023, I do not consider this to be sufficient to show that the earlier mark has come to the attention of enough UK average consumers to establish that its distinctive character has been enhanced through use, as many of these “hits” may reflect visits to the website from the same consumer rather than a large number of consumers. I also note that the cancellation applicant has failed to provide evidence of market share figures or advertising expenditure. Consequently, I do not consider the evidence filed by the cancellation applicant to be sufficient to establish that the earlier mark has enhanced its distinctive character through use.

Likelihood of Confusion

83. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, whilst 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/services down to the responsible undertakings being the same or related.

84. 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 (see Sabel, C-251/95, para 22). 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/services and vice versa (see Canon, C-39/97, para 17). It is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods/services, 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.

85. As a preliminary point, the proprietor has submitted that there have been "no reported instance of consumer confusion, not in online reviews, fashion media, social media mentions, or customer feedback" despite the marks' "side-by-side existence …in the UK, and their market activity". The proprietor therefore requests that I "place greater weight on actual marketplace conduct over theoretical similarity". Whilst not necessary, evidence of a lack of confusion by consumers over an extended period of time may point towards there being no likelihood of confusion.[14] In this instance, whilst both parties have filed some evidence of use of their respective marks, I do not consider the evidence that has been filed to be sufficient to give me a full understanding of how they have used their respective marks in practice and why no confusion has arisen (if that is, indeed, the case). By way of example, I do not have a full understanding of whether the parties are trading in the same geographical locations in the UK. Whilst protection is, as discussed above, afforded to registered marks throughout the UK, if the parties are providing their goods and services in specific but opposing locations within the UK, this may explain why there has been no confusion to date, but it does not reflect the fact that there may actually be a likelihood of confusion between the marks in the context of national registrations. Further, I am also conscious of the fact that the proprietor has submitted that there is no overlap in the goods and services actually sold by the parties, despite this not being apparent from the parties' respective specifications. This may therefore be the reason why there has been no actual confusion, but it does not mean that there is no likelihood of confusion.

86. As outlined above, it is my primary finding that the declaration of invalidity fails under section 5(2)(b) on the basis that I have found no similarity between the marks in issue. However, if I am wrong in my determination in paragraphs 65 of this decision, and the average consumer would identify the characters in the contested marks as "OKURU", then I would find the marks to be visually similar to a low degree, aurally similar to a medium degree and conceptually neutral.

[14] Paragraphs 34 and 35 of the decision of Dr Brian Whitehead in Azumi Limited v Nick Robinson, Case No. O/078/22

87. I have also determined that some of the goods and services vary from being similar to a medium degree to identical, and that the average consumers for the goods and services in issue would be members of the general public, or professional consumers, who will demonstrate either a medium or between a medium and high degree of attention during the purchasing process. I have also found that the purchasing process will be primarily visual, though I do not discount that there may be an aural element to the purchasing process. Further, I have found that the earlier mark has a high level of distinctive character.

88. Weighing up all of the above, and notwithstanding the principle of imperfect recollection, if I had found the contested marks to contain the word "Okuru", I still do not consider that the marks in issue would be mistakenly recalled for one another. This is because I would have found the word elements in all of the marks to be the dominant element, and the difference between the marks in such circumstances would be the "O" at the beginning of the word element of the mark, and the beginning of words tend to have more visual and aural impact than the end.[15] The difference created by this additional letters is more noticeable as both words are fairly short in length. Further, the presentation of the contested marks, with the word element being presented vertically would not be overlooked. There is no likelihood of direct confusion.

89. In the interest of completeness, I will also now go on to consider whether, if the characters in the contested mark were read as Okuru, I would have found there to be a likelihood of indirect confusion.

90. Indirect confusion was described in the following terms by Iain Purvis KC (as he then was), sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*:[16]

"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

[15] *El Corte Inglés, SA v OHIM* Cases T-183/02 and T-184/02
[16] BL O/375/10

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 recognised 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)."

91. As discussed above, I am of the view that the average consumer would recognise the differences between the marks in issue during the purchasing process. Whilst I have found the earlier mark (i.e., the word "Kuru") has a high level of inherent distinctive character, I do not consider it to be so strikingly distinctive that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark, even when it is combined with an additional letter to

form an entirely different word to “kuru”. The word “kuru” does not retain an independent distinctive role within the contested marks.[17] I can see no basis for finding that the addition of the O at the beginning of the word would be perceived as a logical sub-brand or brand extension. Whilst I note that the categories in *LA Sugar* are not exhaustive, I can see no other basis upon which indirect confusion would occur. Consequently, even if I had found that the contested marks would be perceived as containing the word “Okuru”, I would not find there to be a likelihood of indirect confusion between the marks in issue.

92. For the reasons outlined above, regardless of whether the characters in the contested mark are read as symbols/shapes or the word “Okuru”, I can see no basis for a finding of likelihood of confusion between the marks in issue, whether directly or indirectly.

CONCLUSION

93. The application for a declaration of invalidity under section 47(2) of the Act, based on section 5(2)(b) grounds fails in its entirety. Subject to any successful appeal, the contested marks will remain registered for all of the goods and services listed in paragraph 1 of this decision.

COSTS

94. The proprietor has been successful and is entitled to a contribution towards its costs. However, as the proprietor is not legally represented, in its letter to the proprietor of 17 May 2025, the Tribunal said:

“If you intend to make a request for an award of costs you must complete and return the attached pro-forma and send a copy to the other party. Please send these by e-mail to tribunalhearings@ipo.gov.uk.

[17] *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch)

If there is to be a “decision from the papers” this should be provided **on or before 16 June 2025.**

If a hearing is taking place you will be advised of the deadline to do so when the Hearing is appointed.

If the proforma is not completed and returned, costs, other than official fees arising from the action (excluding extensions of time), may not be awarded. You must include a breakdown of the actual costs, including accurate estimates of the number of hours spent on each of the activities listed and any travel costs. Please note that The Litigants in Person (Costs and Expenses) Act 1975 (as amended) sets the minimum level of compensation for litigants in person in Court proceedings at £19.00 an hour.”

95. No cost pro forma has been received to date. Since the proprietor did not file a cost pro forma by the deadline given in the Tribunal’s letter of 17 May 2025, and has paid no statutory fees in these proceedings, I will make no costs order against the cancellation applicant in this matter.

Dated this 27th day of November 2025

B HARTLAND
For the Registrar