**O/1132/25**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NUMBER 4023283**
**BY MOONWAY GLOBAL RETAIL LIMITED**

**TO REGISTER THE FOLLOWING TRADE MARK:**

# SOXCO

**IN CLASS 25**

**AND**

**AN OPPOSITION THERETO UNDER NUMBER 448350**
**BY LEGACY KNITTING LLC**

## Background and pleadings

1. MOONWAY GLOBAL RETAIL LIMITED ("the applicant") applied to register the Trade Mark, SOXCO, (UK trade mark no: UK00004023283) in the UK on 7 March 2024), claiming a priority date of 26 February 2024 (based upon a European Union Intellectual Property Office ("EUIPO") mark) ("the contested mark"). The mark was accepted and published for opposition purposes on 29 March 2024 in respect of the following goods:

> Class 25 - Men's dress socks; water socks; sweatsocks; socks; plastic slippers used in the airport environment when going through security to keep feet and socks clean, dry, and sanitary; men's socks; Japanese-style socks (tabi); Japanese-style socks (tabi covers); adult novelty gag clothing item, namely, socks; paper shoes used when going through metal detectors to keep feet and socks clean; anti-perspirant socks; ankle socks; woollen socks; plastic socks used in the airport environment when going through security to keep feet clean, dry, and sanitary; sweat-absorbent socks; socks and stockings; boat socks; slipper socks; jackets and socks; anklets [socks]; anklet socks; cassocks; yoga socks; toe socks; socks incorporating digital sensors; thermal socks; non-slip socks; trouser socks; boxer briefs; briefs; briefs as underwear; panties, shorts, and briefs.

2. On 28 June 2024, Legacy Knitting LLC ("the opponent") opposed the application in full under section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The Opponent relies upon the following trade mark ("the earlier mark"):


UKTM no. 3584726

Filing date 26 January 2021; registration date 23 July 2021.

Relying on all goods in Class 25, namely *Beanies, hats, headbands, headwear, socks, sweatshirts, T-shirts, visors.*

3. In accordance with section 6 of the Act, the mark relied upon by the opponent is considered an earlier mark. The mark had not been registered for five years as at the date of application for the contested mark and so, in accordance with section 6A of the Act, it is not subject to proof of use; the opponent may rely upon all the goods of its registration.

4. Under section 5(2)(b) of the Act, the opponent claims that there is a likelihood of confusion on the basis that the marks are similar, and the goods are either identical or highly similar leading to a likelihood of confusion, including a likelihood of association, and that the contested mark should be refused registration.

5. The applicant filed a counterstatement denying the claims made. The applicant submits "….that there is no likelihood of confusion between the Applicant's trademark and the Opponent's trademark. The marks in question are distinct and easily differentiable in the context of the relevant market."

**Representation**

6. The opponent is represented by Appleyard Lees IP LLP and the applicant is represented by Santosh Pandey[1]. In this case, neither party filed evidence. A hearing was initially requested, but on 7 April 2025, the parties jointly wrote to the Registry to confirm that they wished to file submissions in lieu rather than attend a hearing. Both parties' submissions in lieu of a hearing were dated 21 April 2025 and 22 April 2025 respectively. Whilst I do not propose to summarise the submissions, I shall refer to them as and where appropriate during this decision. This decision is taken following a careful consideration of all papers on file.

**Relevance of EU LAW**

7. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated

[1] The applicant was initially represented by TB CONSULTANCY LTD until a TM33 was filed on 4 April 2025 appointing Santosh Pandey as the applicant's legal representative.

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)

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

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

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

> "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."

### Relevant law

10. The following principles are gleaned from the decisions of the Court of Justice of the European Union ("CJEU") in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

> The principles

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the 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**

11. The competing goods are shown in the table below:

| **The earlier mark** | **The contested mark** |
|---|---|
| Class 25 - *Beanies, hats, headbands, headwear, socks, sweatshirts, T-shirts, visors.* | Class 25 - *Men's dress socks; water socks; sweatsocks; socks; plastic slippers used in the airport environment when going through security to keep feet and socks clean, dry, and sanitary; men's socks; Japanese-style socks (tabi); Japanese-style socks (tabi covers); adult novelty gag clothing item, namely, socks; paper shoes used when going through metal detectors to keep feet and socks clean; anti-perspirant socks; ankle socks; woollen socks; plastic socks used in the airport environment when going through security to keep feet clean, dry, and sanitary; sweat-absorbent socks; socks and stockings; boat socks; slipper socks; jackets and socks; anklets [socks]; anklet socks; cassocks; yoga socks; toe socks; socks incorporating digital sensors; thermal socks; non-slip socks; trouser* |

| | |
|---|---|
| | *socks; boxer briefs; briefs; briefs as underwear; panties, shorts, and briefs.* |

12. The opponent submits as follows:

> "All of the goods covered by the Application are identical and if not identical, then highly similar to the goods covered by the Earlier Registration. The goods circulate in the same trade channels, have the same or similar nature, intended purpose and end users".

I note that the Opponent then proceeded to provide specific submissions for some of the goods, but not all.

13. The applicant submits as follows:

> "5.1 The Applicant's trademark SOXCO is exclusively used for high-quality socks focussing on technical performance, whereas the opponent's trademark SOCCO covers a broader range of products including beanies, hats, headbands, headwear, sweatshirts, T-shirts and visors.
>
> 5.2 The exclusive focus on socks by the applicant ensures rigorous standards for comfort, durability and softness. In contrast, the opponent's broader product range dilutes the focus on any single product type, thereby reducing the likelihood of confusion among consumers who the opponent argues might associate the applicant's brand with specialised expertise in socks".

14. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account, as per *Canon*, where the CJEU stated at paragraph 23 of its judgement:

> "In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, 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."

15. 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.

16. In *Gérard Meric v Office for Harmonisation in the Internal Market,* 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 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."

17. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)***,** Case T-325/06, the GC stated that "complementary" means:

> "...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking."

18. In *Sanco SA v OHIM,* Case T-249/11, the GC indicated that goods may be regarded as 'complementary' and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods is to assess whether the relevant public are liable to believe that responsibility for the goods lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amalia Mary Elliot v LRC Holdings Limited* BL O/255/13*:*

> "It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes."

Whilst on the other hand:

> ".....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together."

19. I bear in mind that it is permissible to group goods together for the purposes of the assessment[2].

Class 25

*Socks*

20. The opponent's class 25 specification includes the term *socks* which is self-evidently identical.

*Men's dress socks; water socks; sweatsocks; men's socks; Japanese-style socks (tabi); Japanese-style socks (tabi covers); adult novelty gag clothing item, namely, socks; anti-perspirant socks; ankle socks; woollen socks; plastic socks used in the airport environment when going through security to keep feet clean, dry, and sanitary; sweat-absorbent socks; socks and stockings; boat socks; slipper socks; anklets [socks]; anklet socks; yoga socks; toe socks; socks incorporating digital sensors; thermal socks; non-slip socks; trouser socks;*

21. The applicant's above terms are all different types of socks and stockings. Stockings are close-fitting garments that cover the foot and extend up the leg. They are typically made from materials such as nylon, wool or cotton and are worn to provide warmth and enhance an outfit, in the same way as socks. The opponent's class 25 specification includes the term*, […] socks […].* I consider that the opponent's term is broad, and as this includes socks at large, this would encompass the applicant's terms and are therefore identical on the principles outlined in *Meric*.

*Plastic slippers used in the airport environment when going through security to keep feet and socks clean, dry, and sanitary; paper shoes used when going through metal detectors to keep feet and socks clean;*

22. The above terms both include types of footwear. Whilst these are not identical to the opponent's goods, they are items which are worn on the feet. The opponent's specification includes *socks* as well as other items of clothing. There is an overlap in purpose, as both socks and slippers/paper shoes may be worn to protect the feet and

[2] *Separode Trade Mark* O/399/10

keep them clean and dry. They also share the same methods of use, as they are all worn on the feet. Their nature may be different to the extent that they are made of different materials, however, their respective trade channels may overlap. I find that there may be competition, as you may choose to wear a plastic slipper instead of a sock. I do not find complementarity. Taking all of this into account, I consider these goods to be similar to between a medium to high degree.

*Jackets and socks;*

23. As per my earlier finding, in so far as the term *"..socks"* this is self-evidently identical to the same in the opponent's specification.

24. *Jackets* are types of clothing which are worn on the body and would be considered as outerwear, whereas sweaters and t-shirts are usually worn underneath a jacket, on the body, however, there may be some overlap as the average consumer may use both a jacket and a sweater for warmth. The items will take different forms, and the materials used on the respective goods may differ, as well as their uses. The respective goods will reach the market through overlapping trade channels and may sometimes be produced by the same undertakings, although they may appear in different sections of retail outlets. The respective goods share users. There is no competition between the respective goods and as they are neither important nor indispensable to one another, they are not complementary. Overall, I find that there is a medium to high degree of similarity between the respective goods.

*Boxer briefs; briefs; briefs as underwear; panties, shorts, and briefs;*

25. As stated above, the opponent's specification includes the term *Beanies, hats, headbands, headwear, socks, sweatshirts, T-shirts, visors.* The applicant's goods are all types of clothing which are worn on the body, next to the skin, under clothes. This is the same for *socks* which are worn underneath shoes. The items will take different forms, and the materials used on the respective goods may differ, although, I do consider that there will be some overlap in use. The respective goods reach the market through overlapping trade channels and may sometimes be produced by the same undertakings, although they may appear in different sections of retail outlets. The respective goods share users. There is no competition between the respective goods

and they are not complementary. Overall, I find that there is a medium degree of similarity between the respective goods.

*Cassocks;*

26. In the absence of submissions, I understand *cassocks* to be a long garment, such as a robe, which is worn by members of the clergy. I see no obvious similarity with any of the opponent's goods, taking the ordinary meaning of its terms, as there is no direct comparator within its specification. However, in case I am wrong, I note that the opponent's specification includes *headwear* at large. The clergy wear various types of headwear depending upon their denomination and role, and it is foreseeable that this would be sold in the same stores as cassocks. I consider that the nature and purpose of the goods will differ, although there may be some overlap in use. There may be an overlap in trade channels and the goods may sometimes be produced by the same undertakings, although they may appear in different sections of retail outlets. There is no competition between the respective goods, nor are they complementary. Therefore, my primary finding is that these respective goods are dissimilar but if I am wrong, then I find a low degree of similarity.

27. I will proceed on the basis of my secondary finding, that there is a low degree of similarity, only returning to consider my primary finding if it becomes necessary to do so.

**Average consumer and the purchasing act**

28. 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 word "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

29. 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, aesthetic appearance and durability. Consequently, I consider that a medium degree of attention will be paid by the average consumer when selecting the goods.

30. 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 and are 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 marks**

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

> ".....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."

32. 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.

33. The respective trade marks are shown below:

| Earlier trade mark | Contested trade mark |
|---|---|
|  | **SOXCO** |

34. The opponent submits as follows:

> "10. The Opponent's Mark is made up of the letters SOCCO, which forms the dominant and distinctive component of the Opponent's Registration. The figurative elements contained in the Opponent's Mark play less of an impactful role in the overall assessment and does not detract from the dominant and distinctive component being the letters SOCCO. The Applicant's Mark is wholly made up of the letters SOXCO.
>
> 11. The letter sequence between the marks are highly similar, namely, SOCCO versus SOXCO.
>
> 12. Accordingly, the marks are visually and aurally similar...Consequently, the marks must be considered similar overall".

35. The applicant submits as follows:

> "3.1.2 The Applicant's trademark, SOXCO, is derived from the concepts of softness ('SO') and comfort ('CO'). This name was chosen to highlight the premium quality of the socks, which are known for their exceptional softness and comfort. This trademark significantly differs from the Opponent's logo featuring the text 'SOCCO'. Specifically, the Opponent's trademark is registered as the text 'SOCCO' in a logo form, surrounded by multiple lines and a star. It is, therefore, distinct in terms of colour, shape, and imagery compared to the Applicant's purely text-based trademark SOXCO.

3.1.3 Visual Distinction: The Applicant's trademark SOXCO features a distinctive "X" in the middle, which introduces a more angular and dynamic element compared to the rounded "C" in the Opponent's mark. In contrast, the Opponent's trademark SOCCO presents a more symmetrical appearance due to the repeated "C", with a mirrored effect around the central "C".

3.1.4 Phonetic Distinction: The Applicant's trademark SOXCO is pronounced "Sox-co", where the "X" introduces a harder, sharper sound. The "X" is used to connote cross-functionality between softness and comfort, and to present a cutting-edge brand image. When read phonetically, the Opponent's trademark SOCCO is instead pronounced "Sok-co", with a soft "C" sound. The audible perception of both marks to the average consumer is therefore significantly differentiated".

**Overall Impression**

36. The opponent's mark is a figurative mark which consists of the word SOCCO presented in a bold slightly stylised uppercase font. The letters are all connected to each other. Above the letters there is a star to the right-hand side of the mark, and there are diagonal lines connecting the star to the letters. Both the word and the figurative design contribute roughly equally to the mark given that the graphical elements are integrated to the word[3]. The overall impression resides in both elements but weighted slightly in favour of the word, given that generally, words tend to have more impact.

37. The applicant's mark is a word only mark consisting of the word SOXCO. The mark is presented in a plain typeface. There are no other elements contributing to the mark and so the overall impression lies in the entirety of the word.

**Visual Impression**

[3] As per Iain Purvis KC sitting as the Appointed Person in *C & J Clark International Ltd v Global Trademark Services Ltd*, BL O/992/22, at [17] *"There is clearly no general rule that a verbal element in a mark which is a combination of verbal and graphic elements should always be treated as 'dominant'. It all depends on the way the different elements are arranged"*

38. The competing marks include words each made up of five letters, four of which are the same and appear in the same order. The third letter in the earlier mark is a 'C', whereas the third letter in the contested mark is an 'X'. The word SOCCO in the earlier mark is heavily stylised and includes overlapping letters. The mark also includes a device consisting of a star and diagonal lines joining the star and the word. I have found that both the word and the figurative design contribute roughly equally to the opponent's mark and these figurative elements will be a point of difference. Weighing up the similarities as against the differences I find that the marks are visually similar to a medium degree.

**Aural Impression**

39. Neither mark is an English dictionary word and therefore, to the average consumer, it is not clear how either will be pronounced.

40. No articulation will be given to the figurative element of the earlier mark and therefore it will be referred to by the word only. Both marks are made up of two syllables. The earlier mark will be pronounced as SOK-OH, whereas the contested mark will be pronounced as SOX-CO. The point of aural overlap lies at the beginning and end of the word. This is the same in both marks[4]. The difference in pronunciation arises from the letter 'X' as opposed to the letter 'C' in the middle of the words, which creates an obvious point of difference. Overall, I find a medium degree of aural similarity between the marks.

**Conceptual Comparison**

41. The opponent submits:

> "Conceptually, SOC is phonetically identical to the word sock and wholly contained within the Challenged Mark "SOX". The element "CO" is at the end of each mark and frequently used as a suffix in business names and trade marks to refer a company. Accordingly, the marks are conceptually identical given their pronunciation – "SOCK-CO" (singular) and "SOCKS-CO" (plural)

[4] *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, the General Court noted that the beginnings of word tend to have more visual and aural impact than the ends.

and so allude to the concept of a company which manufactures or sell socks. The Opponent notes in its TM7 and statement of grounds under paragraph 12 it said: "*Neither mark has a conceptual meaning for the average consumer*", however, on reflection, it is clear that conceptual similarity is identical and not absent"

42. The applicant submits:

"4.3.1 The applicant's trade mark SOXCO reflects its mission and values which have been associated with softness and comfort. SOXCO is derived from the first two letters of "soft" and "comfort". 'SO' from "Soft" and 'CO' from comfort and 'X' symbolising the merging of both.

4.3.2 In contrast to this SOCCO is inspired by the 1970s styles and modern technology, creating a distinct conceptual separation from the Applicant's brand. This is reflected in the marketing materials published by both the Applicant and the Opponent.

4.3.3 The conceptual divergence further ensures that consumers will associate the marks with different brand identities and market positions, reducing any likelihood of confusion"

43. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer, as highlighted in numerous judgments of the GC and the CJEU[5].

44. In regard to the applicant's submissions, I do not consider that the average consumer would understand the meaning of the mark, SOXCO, to be as they have set out in paragraph 4.3.1 of their submissions (above). However, neither do I agree with the opponent's submissions that the marks are conceptually identical for the reasons that they have set out.

45. The opponent's mark, SOCCO, will be considered to be a meaningless term by the average consumer. I consider that the average consumer would see the term SOX

[5] *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R 29

as a misspelling of socks, but as a complete word, SOXCO, will be considered by the majority of average consumers to be a meaningless term. However, as the applicant's mark is primarily registered to include different types of socks, I accept that their mark could be considered to allude to a company which manufactures or sells socks. As I find that a greater proportion of average consumers will find SOXCO to be a meaningless term, I find the marks to be conceptually neutral.

**Distinctive character of the earlier trade mark**

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

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

47. 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.

48. The earlier mark consists of the word, SOCCO, presented in a bold slightly stylised uppercase font with a figurative star design which is connected to the word via diagonal lines. The overall impression of the mark resides roughly equally in both elements, (although weighted slightly in favour of the word) and SOCCO will be interpreted as an invented word which does not allude to or describe the goods provided. Therefore, I am of the view that the mark as a whole is inherently distinctive to a high degree.

**Conclusions on Likelihood of Confusion**

49. 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.

50. 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. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade 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.

51. I have found as follows:

- The goods at issue are range from being identical (either self-evidently or on the principles in *Meric*) to being similar to a low degree.

- The average consumer will be members of the general public. They will select the goods primarily by visual means, although I do not discount an aural component;

- I have concluded that an average degree of attention will be paid;

- The marks are visually similar to a medium degree;

- The marks are aurally similar to a medium degree;

- The marks are conceptually neutral;

- I have found the earlier mark to be inherently distinctive to a high degree;

52. I begin by considering a likelihood of direct confusion. The earlier mark consists of the word SOCCO presented in a bold overlapping uppercase font with a figurative star design which is connected to the word via diagonal lines. I have found that the overall impression of the mark resides roughly equally in both elements although weighted slightly in favour of the word. In this instance, I find that the stylisation of the earlier mark goes beyond normal and fair use, so whilst the contested mark is a word-only mark which could be used in any typeface or font, it is unlikely to extend to the stylisation used by the earlier mark[6]. The words SOCCO and SOXCO share the first two and last two letters. In this instance, although the marks are both relatively short, I consider that the differences identified earlier insofar as the visual and aural aspects of the marks are likely to be easily identified by the average consumer. I find this notwithstanding the fact that the words themselves differ only in one letter in the middle of the words. Further the figurative elements of the earlier mark, the stylisation of the word SOCCO and the device will not be overlooked. Taking the above into account, it is my view that the differences between the competing marks are likely to be sufficient for consumers – paying an average level of attention – to distinguish between them and avoid mistaking them for one another. Accordingly, notwithstanding the principles of imperfect recollection and interdependency, it follows that there will be no direct confusion.

[6] *Migros-Genossenschafts-Bund v EUIPO*, Case T-189/16

53. This leads me to consider indirect confusion. In *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

> "16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: 'The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark'.
>
> 17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:
>
> (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).
> (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).
> (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)."

54. These three categories are not exhaustive; rather, they were intended to be illustrative of the general approach, as has been confirmed by the Court of Appeal[7]. I recognise that a finding of indirect confusion should not be made merely because the competing marks share a common element. In this connection, it is not sufficient that a mark merely calls to mind another mark; this is mere association not indirect confusion[8]. The Court of Appeal has also emphasised that, where there is no direct confusion, there must be a "proper basis" for finding indirect confusion.

55. For indirect confusion to arise the average consumer must consider that as a result of the common element, there is an economic connection between the respective marks, such that the goods provided under one are regarded as a brand extension or sub brand of the other, for example.

56. In this instance, both marks share overlapping elements, however, the earlier mark overall is highly distinctive due to it consisting of an invented word with figurative elements which contribute to the distinctiveness of the mark. In my view, none of the categories set out in *LA Sugar* apply in this case and I can see no other basis upon which the average consumer would conclude that there is an economic connection between the marks; the removal of one letter in the middle of the mark is not consistent with a sub-brand or brand extension, and as the stylisation and device in the earlier mark have been found to contribute roughly equally to the overall impression of the mark, they will not be overlooked. Taking all of the above into account, I do not consider that there exists a likelihood of indirect confusion between the marks, even when used on identical goods.

**Conclusion**

57. The opposition has failed entirely and, subject to any successful appeal, the applicant's mark will proceed to registration.

**Costs**

58. As the applicant has been successful it is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023. In

[7] *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207
[8] *Duebros Limited v Heirler Cenovis GmbH,* BL O/547/17

considering the costs award, I note that neither party filed any evidence. In the circumstances, I hereby award the applicant the sum of £750 calculated as follows:

| | |
|---|---|
| Considering the Notice of Opposition and filing a Counterstatement | £250 |
| Preparing written submissions | £300 |
| Considering the submissions of the Opponent | £200 |
| **Total** | **£750** |

59. I therefore order Legacy Knitting LLC to pay MOONWAY GLOBAL RETAIL LIMITED the sum of £750. 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 2nd day of December 2025**

**LA Bailey**

**For the Registrar**