

O/0653/23

TRADE MARKS ACT 1994

TRADE MARK APPLICATION No. 3773496

BY LEATHERMAN FASHION PRIVATE LIMITED

AND

OPPOSITION 435034

BY SAN ANTONIO SHOE, INC.

Background and pleadings

1. This is an opposition by San Antonio Shoe, Inc. (“the opponent”) to an application filed on 4th April 2022 (“the relevant date”) by Leatherman Fashion Private Limited (“the applicant”) to register the trade mark shown below.

SASSORA

2. The applicant seeks to register the mark in class 18 in relation to:

Fashion handbags; Toiletry bags; Toiletry cases sold empty; Vanity cases sold empty; Leather boxes; Bags; Key-cases; Suitcase packing organizers/ Luggage organizers set; Travel cases; Travel bags; Travelling sets [leatherware]; Leather cases; Pouches; Notecases; Card cases [notecases]; Clutch bags; Clutch purses; Document cases; Credit-card holders; Handbags, purses and wallets; Luggage, bags, wallets and other carriers; Beauty cases.

3. The opponent is the proprietor of the following earlier trade marks.

International registration 1618180

SAS

UK registration 913126537

SAS



4. IR1618180 designated the UK for protection on 22nd October 2021, but claims priority from an earlier filing of the same mark in the USA on 23rd April 2021. The mark was protected in the UK on 5th May 2022 in relation to *Footwear* in class 25.

5. UK registration 2003723 was applied for on 18th November 1994 and registered on 20th October 1995. It also covers *footwear* in class 25.

6. UK registration 913126537 was applied for on 30th July 2014 and registered on 13th November the same year. It covers a range of goods and services in classes 10, 18, 25 and 35. However, the only goods/services for which the opponent still contends the mark is entitled to protection are “*footwear, insoles, socks and handbags and retail services of these products*” in classes 18, 25 and 35.¹

7. According to the opponent, the contested mark is similar to the earlier marks and proposed to be registered in relation to identical and similar goods. Therefore, the opponent claims there is a likelihood of confusion on the part of the public. Further, the opponent says that the earlier ‘537 and ‘723 marks have been extensively used in the UK since at least 2017 and acquired a reputation.² The opponent claims that use of the contested mark would, without due cause, take unfair advantage of, and be detrimental to, the reputation and distinctive character of the earlier marks.

8. The opponent also claims to have acquired common law rights to SAS as a result of the use of that mark in the UK. According to the opponent, use of the contested mark would constitute passing off.

¹ Per paragraph 18 of the opponent’s written submissions dated 18th May 2023

² The Statement of Grounds claimed that the earlier marks had been used in the UK since at least 2010, but paragraph 61 of the opponent’s written submissions appears to have modified this claim as stated above.

9. The opponent's case is, therefore, that registration of the contested mark would be contrary to sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act"), which are as follows:

"(2) A trade mark shall not be registered if because—

(a) -

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

-

"(3) A trade mark which—

(a) is identical with or similar to an earlier trade mark,

(b) –

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark."

-

"(4) A trademark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented—

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(aa) –

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

10. The applicant filed a counterstatement denying the claims made and requesting that the opponent provides proof of use of earlier ‘537 and ‘723 trade marks.³

11. I note the following points from the applicant’s counterstatement:

- (1) The respective marks are not similar;
- (2) The earlier marks bear the word SAS whereas the contested mark is SASSORA in a highly stylised font;
- (3) The goods at issue are selected mainly by eye, and the marks are not similar from a visual perspective;
- (4) The earlier marks have one syllable, whereas the contested mark has three (SA-SO-RA), and so is aurally different;
- (5) The earlier marks are not distinctive at all;
- (6) In view of the above there is no likelihood of confusion;
- (7) The opponent was put to proof of its claims under section 5(3) and 5(4)(a) of the Act.

12. Both sides seek an award of costs.

Representation

13. The applicant is represented by Accolade IP Limited. The opponent is represented by Marks & Clerk LLP. Neither side requested a hearing. The opponent filed written submissions in lieu. This decision is therefore based on the papers before me.

³ IR1618180 having only recently been protected in the UK, is not yet subject to proof of use under section 6A of the Act

Evidence

14. This consists of a witness statement by Neal Dellocono who is Head of International Sales for the opponent. The purpose of Mr Dellocono's evidence is to show that the opponent has made extensive use of the earlier marks in the UK in the period 2017 -2022 and that they have acquired a reputation for quality footwear, bags and related products. The opponent's goods are available in the UK from its website www.sasshoes.com and from authorised UK distributors. From the beginning of 2019 to 30th March 2022, the opponent sold about £40k worth of goods to UK customers from its website.⁴ Between 2017 and 2022, the opponent also supplied its UK distributors with 9200 units of shoes and bags for re-sale in the UK.⁵ Third parties also offer the opponent's products for sale on the 'Shoes & Bags' section of Amazon's UK website.⁶

Overall outcome

15. The opposition fails. The contested mark will proceed to registration. These are my reasons.

The Section 5(2(b) ground of opposition

16. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to the case law of the EU courts.

17. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson*

⁴ See exhibit ND6

⁵ See exhibit ND8

⁶ See exhibit ND7

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.

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/services

18. The opponent submits that the evidence shows genuine use of the earlier ‘537 and ‘723 marks during the five year period specified in section 6A of the Act in relation to *footwear, insoles, socks and handbags and retail services of these products*. For the purposes of this decision, I have accepted that submission. However, the earlier ‘537 mark is only registered for retail services relating to footwear and leather goods. This does not cover *socks*. Therefore, the respective goods/services for comparison purposes are shown below.

Applicant’s goods	Opponent’s goods/services
Class 18: Fashion handbags; Toiletry bags; Toiletry cases sold empty; Vanity cases sold empty; Leather boxes; Bags; Key-cases; Suitcase packing organizers/ Luggage organizers set; Travel cases; Travel bags; Travelling sets [leatherware]; Leather cases; Pouches; Notecases; Card cases [notecases]; Clutch bags; Clutch purses; Document cases; Credit-card holders; Handbags,	Class 18: Handbags Class 25: Footwear, insoles and socks Class 35: Presentation of handbags footwear and insoles on communications media, for retail purposes, all with respect to the sale of footwear and leather goods.

purses and wallets; Luggage, bags, wallets and other carriers; Beauty cases.	
--	--

19. I accept that *fashion handbags, bags and clutch bags* are identical to *handbags*. For the purposes of this decision, I have also accepted that the remaining goods covered by the contested mark are similar to *handbags*.

Average consumer

20. The average consumer is a buyer of bags and similar goods. i.e. a member of the general public. The opponent submits that the average consumer will pay an average (i.e. 'normal') degree of attention when selecting the goods at issue. I have accepted that submission.

21. The opponent further submits that aural similarity cannot be disregarded because it is likely that consumers would receive word of mouth recommendations regarding footwear or bags, and would discuss products with sales assistants at physical stores. I have accepted that submission too. Nevertheless, as the opponent's evidence confirms, footwear, handbags etc. are primarily selected by eye from websites, brochures and shop displays. Therefore, although aural similarity has been considered, visual similarity carried more weight in my assessment of the likelihood of confusion.

Distinctive character of the earlier trade marks

22. The opponent submits that as SAS has no meaning in relation to the goods/services at issue it has an above average degree of inherent distinctiveness and an enhanced degree of distinctiveness as a result of the use made of it.

23. As noted above, the applicant submits that SAS has no distinctive character.

24. In *Lloyd Schuhfabrik Meyer & Co.* 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 Windsurfing Chiemsee 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).”

25. Section 3(1)(c) of the Act prohibits the *prima facie* registration of marks which describe the goods/services for which they are put forward for registration. Not surprisingly therefore, the majority of registered marks are not descriptive. It follows that the absence of descriptive character *per se* cannot mean that a mark is ‘above average’ in terms of its inherent distinctiveness. Although it may be meaningless (at least in relation to the goods/services at issue), SAS is a simple mark composed of just three letters (two of which are the same letter). Whether considered as letters or a short word it is not especially striking or memorable. In my view, SAS has an average degree of inherent distinctiveness. It is true that the earlier marks include a stylised form of presentation (the opponent calls it “*the SAS design*”) and, in the case of the ‘537 mark, the colour orange. However, the opponent cannot rely on these features as factors which contribute towards the similarity of the parties’ marks and the likelihood of confusion. Consequently, any additional distinctiveness those features convey on the earlier marks does not assist the opponent.⁷

⁷ See *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person

26. As to the opponent's claim that the earlier marks have acquired an enhanced distinctive character through use, I note that:

- (1) The opponent claims to have sold around £40k worth of SAS goods to UK consumers via its .com website between 2019 and March 2022;⁸
- (2) The opponent says that between December 2017 and December 2022, approximately 95k UK users visited its .com website in 105k sessions;
- (3) The opponent's shoes appear to typically retail at £120 – £280 suggesting the opponent sold about 200 – 300 products from its .com website to UK consumers over a period of over 3 years;
- (4) The opponent sold 9200 SAS products to its UK distributors between 2017 and 2022;⁹
- (5) The opponent's products are also sold on eBay's UK website and there are nine examples of SAS shoes being sold on the website in 2022 with indications they were 'first available' prior to the relevant date;
- (6) There is no evidence as to the amount spent promoting the products in the UK.



27. The earlier marks appear to have been present on the UK market for around 5 years prior to the relevant date. The number of UK users of the opponent's .com website is not massive, especially over a five year period, and the number of 'new users' (also 95k) and sessions (105k) indicates that not many were repeat users. This is not surprising because the website appears at first blush to be aimed at US users with prices in dollars. Even the opponent's total UK sales are likely to have accounted for no more than a tiny fraction of the UK market for footwear and handbags etc. Therefore, in the absence of evidence of extensive promotion of the marks prior to the relevant date, they were unlikely to have become more distinctive through use to a significant proportion of the relevant UK public.

⁸ See exhibit ND6

⁹ See exhibit ND8

Comparison of marks

28. The marks to be compared are shown below.

Contested mark	Earlier marks
	

29. The opponent submits that the respective marks are visually similar to a medium to high degree because the earlier marks are “*wholly comprised at the start of the contested mark.*” In support of this submission the opponent relies on decisions of the EU courts to the effect that where the marks at issue “*coincide in their initial elements, the public is highly likely to view the marks as similar since they read left to right.*”¹⁰ Furthermore, the EU’s most senior court has found that “*two marks are similar when, from the point of view of the relevant public, they are at least partially identical as regards one or more relevant aspects.*”¹¹

30. Whether two marks are similar is a question of fact which must be assessed from the perspective of the average consumer. Thus the finding of the General Court in

¹⁰ *Sanofi-Aventis v OHIM - GD Searle*, General Court, Case T-146/06

¹¹ *Matratzen Concord GmbH v OHIM*, CJEU, Case C-3/03

¹² that the word mark CK CREACIONES KENNYA was not similar to the following stylised letter mark.



31. The CJEU's Order in *Matratzen Concord GmbH v OHIM* concerned an EUTM including the (separate) word MATRATZEN. The application had been opposed by the proprietor of an earlier trade mark consisting of the same word. This is what the court had in mind when it said that marks are similar when, from the point of view of the relevant public, they are "*partially identical as regards one or more relevant aspects.*" The court did not rule that any marks with a common initial letter sequence are similar. Rather, as the CJEU stated in *Bimbo SA v OHIM*:

".....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. I accept there is no minimum threshold for establishing similarity between marks. Therefore, even where the degree of similarity between the marks is slight, a global assessment is required of the likelihood of confusion.

33. Turning to the marks at issue, I observe that the opponent is wrong to submit that the earlier marks are "*wholly comprised*" at the start of the contested mark. This is to

¹² Case T-185/07, upheld by the CJEU in Case C-254/09 P

ignore the stylisation of the letters making up the respective marks, which is manifestly different.¹³

34. More importantly, although it is true that consumers generally attach more importance to the first part of word marks, this does not mean that consumers pay little or no attention to the remainder of the word(s). On the contrary, the case law tells us that “*the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.*” Consequently, it is not appropriate to treat the average consumers of bags etc. seeking to choose between the offerings of rival traders as though they were word search fanatics sitting at home trying to find one word within another in order to solve a puzzle.

35. The contested mark has seven letters compared to the earlier marks which have three. In my view, the letters or word SAS will not be recognised by average consumers as a specific visual element of the contested mark, which will instead be perceived as the whole word SASSORA. There is an additional significant visual difference from the use of an unusual font for SASSORA, in which significant parts of the letters (although still recognisable as such) are missing, and the use of SAS in forms in which the letters are joined together, or overlap, creating the impression of a specific logo.

36. In my view, there is no recognisable visual similarity between the marks.

37. The opponent submits that the marks are highly similar from an aural perspective. The parties appear to agree that the earlier marks have one syllable – SAS. The opponent says the contested mark has two – SASS-ORA, and that SAS sounds the same as SASS. I accept the second point, but I consider that ORA actually has two vowel sounds and therefore two syllables – OR and AH. The applicant says the contested mark has three syllables – SA-SO-RA. In my view, some consumers will pronounce the contested mark this way, but others will pronounce it as SASS-OR-AH. Those that hear it pronounced as the applicant contends will detect no aural similarity between the marks. Those that hear it pronounced as SASS-OR-AH will detect a low degree of overall aural similarity between the marks.

¹³ Use of a word in stylised font is not necessarily use of the word in standard characters: see *Migros-Genossenschafts-Bund v EUIPO*, Case T-189/16, the General Court

38. The opponent submits that neither mark conveys any meaning. The applicant does not appear to dispute this. Consequently, I accept that the marks are meaningless. Therefore, no conceptual comparison is possible.

39. I was initially of the view that there is no similarity at all between the marks that would be apparent to average consumers. However, I have made my decision on the basis that there is a very low degree of similarity between them, at least from an aural perspective.

Likelihood of confusion

40. The opponent submits there is a likelihood of direct and indirect confusion. As to direct confusion, the opponent says that *“In the fashion sector, trade marks can often be presented in smaller sizes on products themselves or are obscured when seen on shelves because of placement among other goods, storage or positioning of the goods. As such, this increases the likelihood consumers would focus on the first “SAS” part of the Contested Mark when seeing it in use.....”*

41. The second part of the argument seems to be that products bearing the contested mark could be positioned on shelves so that only the beginning of the SASSORA mark is visible. However, as average consumers are deemed to be *“reasonably circumspect and observant”* I do not think it would be too much to expect such a consumer, paying a normal degree of attention, to turn the product round, or move surrounding products aside, and look at the product of interest before selecting it.

42. The first part of the argument seems to be that the SASSORA mark could be so small or difficult to see that consumers will not be able to distinguish it from the SAS marks. However, the likelihood of confusion must be assessed in normal marketing conditions,¹⁴ not just in one exceptional and hypothetical scenario. This includes a scenario in which the marks are so small or difficult to see that average consumers (who must also be considered to have reasonable eyesight) cannot make out the obvious visual differences between the SAS and SASSORA marks, not the least of

¹⁴ See *Rani Refreshments FZCO v OHIM*, Case T-523/12, the General Court, paragraphs 40 - 42

which being that the latter is much longer than the former. I find these arguments farfetched and lacking any merit. This is why I rejected them.

43. For the avoidance of doubt, I have also considered the likelihood of direct confusion through imperfect recollection and/or through aural use of the marks. However, even after having taken account of the tendency of consumers to attach more importance to the beginnings of words than the ends, I cannot see how an average consumer paying a normal degree of attention could confuse the contested mark with the earlier marks. They simply look and sound too different.

44. The second part of the opponent's section 5(2) case is based on the likelihood of indirect confusion. In *L.A. Sugar Limited v By Back Beat Inc.*¹⁵ 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

¹⁵ Case BL O/375/10

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)."

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

46. The opponent submits that (1) SAS or SASS will be seen as a *"prominent unit"* within the contested mark, (2) the difference between SAS and SASS will not prevent confusion with the earlier SAS marks because SS has no distinctive impact over a single S (no impact at all from an aural perspective), and (3) ORA is *"inherently likely"* to be seen as a sub-brand of SAS/SASS. In support of point (3) the opponent says that -ORA is a common suffix used in words such as plethora, Pandora and diaspora. According to the opponent, this creates a risk that the SASSORA mark will be seen as a member of a family of SAS marks. The opponent also draws attention to decisions of the UKIPO and EUIPO in which it was held there is a likelihood of confusion between MIKLA and MIK and SASOM and SAS.

47. I accept that -ORA could be seen as the suffix of the word SASSORA. However, that does not mean that consumers will see that single word as essentially two separate elements conjoined. For example, no one would consider 'pleth' to be a divisible element of plethora. Applying the same analysis to trade marks, no one would

¹⁶ BL O/219/16

regard YAM to have separate trade mark significance within the well-known mark YAMAHA. Further, even if the opponent is correct, the “*prominent unit*” within the SASSORA mark would be SASS not SAS. In reality, with the possible exception of the opponent, no one will see or hear SAS as a “*prominent unit*” within the contested mark. Rather, the average consumer will naturally regard the SASSORA mark as a single indivisible (stylised) word.

48. There is no need to adjust this analysis to account for the fact that the SASSORA mark will be seen as another member of a ‘family’ of SAS- marks. This is because there is no evidence that the opponent has ever used SAS as a prefix in a family of longer word marks. Further, the very different visual stylisation applied to the contested mark, as compared to the earlier SAS marks, makes it even less likely that anyone would see the former as a variant of the latter.

49. The approach advocated by the opponent’s representative is a classic example of impermissible artificial dissection of a mark with just one element. This is essentially why I also reject the opponent’s case based on indirect confusion.

50. I have considered the earlier decisions to which the opponent drew my attention. They are decisions on their specific facts. Therefore, they cannot bind me in any way in evaluating the likelihood of confusion in this case where the marks are different. In any event, I note that (1) the marks in both those cases comprised three letters versus five, not three versus seven as in this case, (2) the likelihood of indirect confusion was rejected in the *MIK v MIKLA* case, and (3) the EUIPO’s finding that there was a likelihood of confusion between SAS and SASOM was based on the likely reaction of the public in Germany, not the UK.

The section 5(3) ground of opposition

51. The relevant case law can be found in the following judgments of the CJEU: *General Motors*,¹⁷ *Intel*,¹⁸ and *Adidas-Salomon*.¹⁹ The law appears to be as follows:

¹⁷ Case C-375/97

¹⁸ Case C-252/07

¹⁹ Case C-408/01

(a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel*, paragraph 42.

Reputation

52. For the reasons given at paragraph 27 above, I do not accept that the opponent has established that the earlier marks are known to a significant proportion of the UK public for footwear and/or handbags. Consequently, the opponent's section 5(3) case falls at the first hurdle.

53. However, even I am wrong about this, the opponent's case would have fallen at the next hurdle, i.e. the requirement to establish that the relevant public would make a link between the marks. The assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* are:

The degree of similarity between the conflicting marks

54. If the marks are similar, they are similar to only a very low degree.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

55. The goods are identical or similar.

The strength of the earlier mark's reputation

56. If the earlier marks have a qualifying reputation in the UK, it is a modest one.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use

57. The earlier marks are inherently distinctive to a medium degree. If they have acquired an enhanced distinctive character through use, the enhancement is relatively modest. SAS is far from being a household name in the UK for footwear and handbags.

Whether there is a likelihood of confusion

58. There is no risk of confusion.

Overall assessment

59. The relevant UK public will not make any link between the contested mark and the earlier marks.

60. In reaching this conclusion I did not overlook the opponent's argument that "*when searching for 'SAS' products on Amazon UK it is possible that the search engine will identify brands that wholly encompass this word element, e.g. 'SASSORA', which is the word element of the Contested Mark.*" There is no evidence that a search for SAS on Amazon would in fact return SASSORA as a hit. Further, even if this were to happen, it would show no more than the search engine making a link between the words, not consumers. Consumers are used to online searches bringing back mixed results, some of which are relevant and some of which are not. The ones that are not are quickly dismissed. Therefore, the opponent's suggestion is no more relevant than that a search for SAS might return 'Sasquatch'.

61. For the record, I would have reached the same conclusion even if I had accepted the opponent's claims that the earlier marks have a strong reputation in the UK and a high degree of distinctive character.

62. In the light of these findings I did not need to consider the opponent's arguments about the contested mark taking unfair advantage of, or being detrimental to, the reputation or distinctive character of the earlier marks. As the public will not link the marks, none of these things can happen.

The section 5(4)(a) ground of opposition

63. The opponent acknowledges that in order to establish passing off a three-part test must be satisfied.²⁰ It must be shown that:

(1) The owner of the earlier right has goodwill or reputation in the UK under the mark;

(2) Use of the contested mark would amount to a misrepresentation leading or likely to lead the public to believe that the goods offered by the applicant are the goods of the opponent; and

(3) This would result in damage to the opponent's goodwill, as a result of this misrepresentation.

64. The law of passing off protects even local businesses whose marks are known to only a tiny proportion of the total UK public. The threshold for protection is therefore lower than the threshold required to establish a qualifying reputation under section 5(3) of the Act. The opponent has established sufficient trade in the UK to cross this threshold.

65. However, the opponent's case fails because use of the contested mark would not cause any substantial number of the opponent's customers or potential customers to believe that the goods offered by the applicant are the goods of the opponent. Indeed,

²⁰ *Reckitt & Colman Products Ltd v Borden Inc.* [1990] UKHL 12

I do not think it would cause any of them to believe this. Consequently, the question of damage does not arise.

66. This is why the section 5(4)(a) ground of opposition also failed.

Costs

67. The applicant is entitled to a contribution towards its costs. I assess this as follows:

£450 for considering the opponent's notice of opposition and filing a counterstatement;

£300 for considering the opponent's evidence.

68. I therefore order San Antonio Shoe, Inc. to pay Leatherman Fashion Private Limited the sum of £750. This must be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings (subject to any order of the appellate tribunal).

Dated 11 July 2023

Allan James
For the Registrar