

**O-197-19**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION NO 3292869  
BY URBAN EQUALITY CLOTHING LTD  
TO REGISTER THE FOLLOWING TRADE MARK IN CLASSES 18, 25 AND 35:**

**Urban Equality**

**AND**

**OPPOSITION THERETO (NO. 413524) BY  
CBM CREATIVE BRANDS MARKEN GMBH**

## **Background and pleadings**

1. On 27 February 2018 Urban Equality Clothing Ltd (“the applicant”) applied to register the trade mark “Urban Equality” (“the applied for mark”) for goods and services in classes 18, 25 and 35. The application was published for opposition purposes on 1 June 2018.
2. CBM Creative Brands Marken GmbH (“the opponent”) oppose registration under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon European Union Trade Mark (“EUTM”) registration EU012011797 (“the earlier mark”), for goods and services in classes 18, 25 and 35. The earlier mark was filed on 24 July 2013 and registered on 18 December 2013. The earlier mark is as follows:



3. The opponent filed a notice of opposition and statement of grounds and the applicant filed a notice of defence and counterstatement. The applicant filed written submissions on 5 February 2019 and 11 March 2019. The opponent filed written submissions on 19 December 2018 and 10 March 2019. Neither party filed evidence or requested a hearing. This decision is reached following careful consideration of the papers.
4. The applicant is self-represented. The opponent is represented by Bird and Bird LLP.

## **Section 5(2)(b)**

5. Section 5(2)(b) of the Act states:

“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.”

6. The opponent’s mark is an earlier trade mark within the meaning of section 6(1) of the Act. It is not subject to a requirement to provide proof of use.

## **Section 5(2)(b) – The Principles**

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

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

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

- rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
  - (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
  - (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
  - (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
  - (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
  - (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
  - (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
  - (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
  - (k) if the association between the marks creates a risk that the public will wrongly 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 services

8. When making a comparison, all relevant factors relating to the goods and services in issue should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the Court of Justice of the European Union (“CJEU”) stated at paragraph 23 of its judgment:

“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.”

9. Guidance on this issue has also come from Jacob J in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

“(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.”

10. I also note the judgment of Mr Justice Floyd (as he then was) in *YouView TV Limited v Total Limited* where he stated:

“...Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IPTRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless, the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of "dessert sauce" did not include jam, or because the ordinary and natural description of jam was not "a dessert sauce". Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

11. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05, the General Court (“GC”) stated:

“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 the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

12. The competing goods and services are as follows:

<b>Earlier Mark</b>	<b>Applied For Mark</b>
<p><b>Class 18:</b> Leather and imitation of leather, and goods made of these materials and not included in other classes; Animal skins, hides; Trunks and travelling bags; Umbrellas and parasols; Walking sticks; Whips, harness and saddlery.</p>	<p><b>Class 18:</b> Leather and imitations of leather; animal skins and hides; luggage and carrying bags; umbrellas and parasols; walking sticks; whips, harness and saddlery; collars, leashes and clothing for animals.</p>
<p><b>Class 25:</b> Clothing, footwear, headgear.</p>	<p><b>Class 25:</b> Clothing, footwear, headgear.</p>
<p><b>Class 35:</b> Advertising; Business management; Business administration; Office functions; Retailing, including via websites and teleshopping, of clothing, footwear, headgear, bleaching preparations and other substances for laundry use, cleaning, polishing, scouring and abrasive preparations, soaps, perfumery, essential oils, cosmetics, hair lotions, dentifrices, sunglasses, precious metals and their alloys and goods in precious metals or coated therewith, jewellery, precious stones, horological and chronometric instruments, leather and imitations of leather, and goods made of these materials, animal skins, hides, trunks and travelling bags, bags, handbags, pocket wallets, purses, key cases, backpacks, pouches, umbrellas and parasols, walking sticks, whips, harness and saddlery; Arranging and conducting of advertising events and customer loyalty programmes</p>	<p><b>Class 35:</b> Advertising; business management; business administration; office functions.</p>

13. The opponent submits that the respective goods and services are either identical or similar. The applicant has not commented on the issue.

14. Both parties having “Clothing, footwear, headgear” in class 25. These are self-evidently identical.
15. The applicant’s “Advertising; business management; business administration; office functions” in class 35 also have identical counterparts in the opponent’s class 35 specification.
16. Within class 18, “Leather and imitations of leather”, “animal skins”, “hides”, “umbrellas and parasols”, walking sticks”, “whips, harness and saddlery” are identical terms in both specifications.
17. The applied for specification has “luggage and carrying bags.” These are identical (or, if not, they would undoubtedly be highly similar) to the opponent’s “Trunks and travelling bags.”
18. The applied for specification has “collars, leashes and clothing for animals.” Where clothing for animals is made of leather or imitation leather it would be identical, under the *Meric* principle, to the opponent’s broader term of “Leather and imitation of leather, and goods made of these materials and not included in other classes.” Non leather/imitation leather clothing for animals must therefore be highly similar to leather/imitation leather clothing for animals bearing in mind the nature, purpose and channels of trade and they are, in effect, the same goods made out of different materials. It follows that such non leather/imitation clothing must be highly similar to the opponent’s broader term of leather/imitation leather goods in class 18. Alternatively, a comparison can be made with the broad term “clothing” in class 25, which is focussed on clothing for humans. There are obvious differences between the end users, but “clothing” in class 25 and “clothing for animals” do share similar functions, purpose and purchasers. The channels of trade will not have a significant overlap. There is no competitive or complementary relationship. There is therefore a medium level of similarity between the earlier mark’s clothing in class 25 and clothing for animals.



19. Where “collars” and “leashes” are made of leather or imitation leather they would be identical, under the *Meric* principle, to the opponent’s broader term of “Leather and imitation of leather, and goods made of these materials and not included in other classes.” Further, collars and leashes of any material would be highly similar to “harnesses” covered by the earlier mark on account of their nature, purpose and channels of trade. Collars and leashes not made of leather or imitation leather would also be highly similar to the opponent’s “Leather and imitation of leather...goods...not included in other classes” bearing in mind I have already found this broad term must include collars and leashes made of leather/imitation leather. Such products would have the same nature, purpose and channels of trade and are, in effect, the same goods but simply made of different materials.

**The average consumer and the nature of the purchasing act**

20. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

21. In *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03, the General Court stated:

“50. The applicant has not mentioned any particular conditions under which the goods are marketed. Generally, in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly the visual aspect plays a greater role in the global assessment of the likelihood of confusion.”

22. The applicant has not commented on the question of the average consumer and the purchasing process. The opponent submits the average consumer will be the general public, paying a normal/average or “relatively low” degree of attention when carrying out the purchasing process.
23. I agree that where the class 18 and 25 goods are concerned the average consumer will be a member of the general public. Such goods will vary in price but generally they are not overly expensive and are purchased fairly frequently. This suggests a purchasing process and degree of attention paid that is no higher or lower than the norm. The goods are likely to be selected from retail outlets or from websites, brochures or catalogues. The manner of selection indicates that the visual impact of the marks will take on more importance. That said, such goods may also be the subject of, for example, word-of-mouth recommendations or oral requests to sales assistants and aural considerations therefore must also be born in mind. For goods such as saddlery, the purchasing process may be slightly more considered as such goods are purchased less frequently and may be more expensive than other goods within the classes.
24. The average consumer of the class 35 services “Advertising; business management; business administration; office functions” is more likely to be a professional user seeking to purchase advertising (although a member of the public could also buy advertising services), or business administration services

and services which provide particular office functions. The selection process is likely to again be primarily visual, involving, for example, perusal of websites or brochures, although I do not discount the consideration that there may be some aural element through oral recommendations. Some contracts which involve a more substantial investment in, for example, business management services, may well also involve some oral negotiation, although there will invariably be written dealings too, so that here too the selection process is likely to be largely visual. Some selection processes may therefore involve a slightly higher than average degree of attention when selecting the services at issue. Overall, however, there will be at least an average degree of attention paid to the selection of all the services.


### **Comparison of trade marks**

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

“...it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

26. It would be wrong, therefore, artificially to dissect the trade marks, although it is necessary to take into account their distinctive and dominant components and to

give due weight to any other features which are not negligible and therefore contribute to the overall impressions they create. The trade marks to be compared are:

Earlier trade mark	Applied for trade mark
	Urban Equality

### Overall Impression

27. The opponent submits that the dominant and distinctive component of the earlier mark is the word EQUAL, with the stylisation reinforcing that word but playing a minor role bearing in mind that the word elements of a figurative mark will generally make a stronger impression on the average consumer. They assert that in the applied for mark URBAN is descriptive, referring to a style of clothing, and has no distinctive character for the goods and services in question. They submit that EQUALITY is the dominant and distinctive element and furthermore that the EQUAL prefix of that word is particularly dominant as being the first part of the non-descriptive element of the mark. They argue that the comparison of the marks should focus primarily on a comparison between the applicant’s EQUAL prefix and the opponent’s EQUAL word element. Further, they submit that the applicant’s additional components of URBAN and the suffix ITY do not alter the overall impression of the applied for mark compared to the earlier mark. The applicant asserts that the overall impression of the marks is very different.
28. The earlier mark consists of the common English word “EQUAL” presented in block capital letters in a bold font together with the mathematical symbol “=”. The letters making up the word “EQUAL” are divided across two lines and are also segmented by the “=” symbol. The first line is constructed of the letters “EQ” followed by the “=” symbol. The second line comprises the letters “UAL” such that overall there

are three characters on each line. In my view, the average consumer is likely to see the word “EQUAL” within the mark. Whilst I note the opponent’s argument that average consumers may give more weight to the word component of a mark rather than its figurative elements, each case must be assessed on its own facts. Here, the stylisation and presentation of the mark, including the dividing of the letters over two lines and the inclusion of the “=” symbol within the mark which effectively inserts the “=” in the middle of the word, are far from negligible, make a strong contribution to the overall impression and are likely to be noticed by the average consumer when considering the mark as a whole. I consider it unlikely that the average consumer would have an overall impression of the mark being a mathematical equation of “E-Q equals/= U-A-L”.

29. The applied for mark consists of the words “Urban Equality”. URBAN and EQUALITY are standard English words. In my view, URBAN EQUALITY will be seen as a unitary phrase with an overall meaning of either equality between people taking place within a town or a city, or equality between the conurbations themselves. The overall impression rests in the mark as a whole and neither word is negligible or dominates the mark. As a matter of overall impression, I therefore do not find that EQUALITY has an independent distinctive role in the mark separate to its role within URBAN EQUALITY as a unitary whole.
30. As I address below, if for some average consumers URBAN brings to mind a style of clothing, as an individual component it may have low distinctiveness for the goods, or some of the goods, in play but not the services. However, it does not follow that URBAN plays no role in the overall impression. As the first word it strikes the eye and the ear of the average consumer first and will be noticed<sup>1</sup>. Furthermore, an awareness of a descriptive connotation will not prevent such average consumers also seeing the mark as a unitary phrase with the meaning set out above. Therefore, even for such average consumers, URBAN is not negligible

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<sup>1</sup> See for example the judgment of the General Court in *CureVac GmbH v OHIM* case T-80/0

and EQUALITY does not dominate the overall impression of the mark which continues to rest in the mark as a whole.

### **Visual Similarity**

31. The applicant submits the marks are visually very different. They argue the symbol “=” placed between “EQ” and “UAL” in the box like format is confusing to the eye whereas their applied for mark is a straightforward word mark with no figurative element. They assert that visually the competing word components are different as their first word URBAN has no counterpart in the earlier mark and will make a visual impression as it is the first word in the mark. They point out that the opponent uses capital letters and bold typeface whereas their mark is in standard lower case with capitalisation of the first letters in each word.
32. The opponent submits that the marks are visually highly similar. They submit that the comparison should primarily be between the dominant and distinctive elements, namely the applicant’s prefix EQUAL and their word EQUAL creating a clear visual link between the marks. They argue the addition of the common suffix ITY or the descriptive prefix URBAN in the applied for mark will not reduce the high visual similarity as the visual focus will be upon EQUAL/EQUALITY. Nor will the figurative elements in their own mark, as the word component of a figurative mark usually has a stronger impact on the public than the figurative component.
33. Here the visual similarity lies in the common letters/component EQUAL.
34. There are visual differences between the word elements of the marks. The applied for mark consists of two words, and the earlier mark is one. Therefore URBAN has no equivalent component in the earlier mark. In the earlier mark EQUAL is segmented by the = symbol whereas in the applied for mark EQUAL has the letters ITY added to the end producing a longer word. In the earlier mark, the common

element are the only letters and are five out of six of its overall characters. That common component is five out of thirteen letters in the applied for mark.

35. A further visual difference lies in the stylisation applied to the earlier mark with the addition of the symbol "=", and the dividing of the 5 letters (and 6 characters overall) between two lines such that the overall mark is made up of a balance of 3 characters on each line.
36. None of components in either mark are negligible and I have to undertake a whole mark comparison. In my view, the complexity and form of presentation of the earlier mark and the additional word and suffix in the applied for mark do create significant visual differences between the marks such that I find the marks are visually similar to a low degree.
37. I should add that the applicant's argument that a distinguishing feature is that its applied for mark is primarily in lower case and not in bold font has not been a factor in my assessment. A word trade mark registration protects the word itself written in any normal font and irrespective of capitalisation or highlighting in bold.<sup>2</sup> If registration of the applied for mark were allowed, the applicant under notional and fair use, would be able to present the mark in any normal font or capitalisation. Therefore the current chosen presentation does not affect the mark comparison.

### **Aural Similarity**

38. The opponent submits that in line with their submissions about visual similarity, there is a corresponding high aural similarity between the marks. They submit that the suffix ITY does not make a significant difference to the articulation of the applied for mark, and neither does the descriptive first element URBAN.

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<sup>2</sup> see *Present-Service Ullrich GmbH & Co. KG v. OHIM*, T-66/11 at [57]

39. There are two main ways in which the earlier mark could be articulated. The first is as the two syllable word “EE- KWAL”, with the “=” symbol or the space between the syllables not being vocalised. The second way would be for the mark to be vocalised as a mathematical equation of “E-Q-equals-U-A-L”. I find the latter articulation is unlikely as the average consumer is most likely to articulate the mark in a way that resembles a common word known to him<sup>3</sup>. Further, as I find that the average consumer will see the word EQUAL in the earlier mark, it is my view that the average consumer will most likely articulate the mark in the first way described.
40. In the applied for mark URBAN with be articulated as the standard, two syllable, English word. EQUALITY will also be articulated as the common English word with four syllables: “EE- KWOLL – I – TEE”. Aurally the applied for mark therefore differs from the earlier mark as it is two words as opposed to one, and it is seven syllables in length compared to two. The addition of ITY also changes the pronunciation of EQUAL as it softens the second syllable “KWALL” to a “KWOLL.” Overall there is a low degree of aural similarity.

### **Conceptual Similarity**

41. The opponent submits there is conceptual identity or high similarity. They state that EQUALITY and EQUAL are common English words with a common meaning, being the noun and the adjective for the same word. They refer to the definition of EQUALITY in the Oxford English dictionary which is:

“1 [mass noun] The state of being equal, especially in status, rights, or opportunities. *“an organisation aiming to promote racial equality”.*

2 Mathematics.

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<sup>3</sup> *Vitakraft-Werke Wurhmann v OHIM – Krafft [Vitacraft]* [2004] T-356/02



A symbolic expression of the fact that two quantities are equal; an equation”

The opponent asserts there is no conceptual difference between EQUALITY and EQUAL as the concept in both is EQUAL. They point out that ITY is a common suffix added to adjectives to form nouns referring to the state, quality, or behaviour described by the adjective. They state that one is not more focussed on people than the other and both are generally applicable terms which can be used in connection with objects, concepts, mathematics, animals etc as well as people.

42. The opponent submits that the addition of URBAN does little to alter the meaning of EQUALITY. They state the word may be understood as describing the characteristics of a town or city, or as a reference to a particular style or subculture in fashion/clothing but in the context of the mark does not remove or significantly alter the identical concept. In particular, they submit that “URBAN” is of low distinctiveness as a commonplace descriptor of a style of the applied for goods and services in indicating a style of such goods or services. They submit that URBAN EQUALITY is likely to be perceived as a sub-brand or product line or style of the main EQUAL/EQUALITY house mark/brand name; for example, one targeted at young people/adults. They state that consumers are used to being presented with a house mark or brand name plus descriptor, especially for clothing and accessories.

43. The opponent further submits that the stylisation of their mark reinforces the EQUAL word element. In particular:

“[T]he addition of the equal symbol to create an even balance of three characters on each line emphasises the concept of equality, as does the mathematical equal symbol itself.”

44. The applicant submits there is no conceptual similarity. They refer to the same dictionary definition of EQUALITY and provide a dictionary meaning for URBAN as:

“1. in, relating to, or a characteristic of a town or city. *“the urban population”.*”

45. The applicant submits that the two words have clear meanings as individual words and when they are put together. They submit the average consumer would notice URBAN first and then look at EQUALITY and that “when these are put alongside each other the meanings are detached and then used in harmony.” The applicant refers to the Equality Act 2010 and states that the reason they chose “Equality” for their brand is “it doesn’t narrow down to equal measures in people.” They state that they chose “Urban Equality for the definition and what they both stands for as the word Urban is associated globally and Equality is everyone (globally) regardless of Gender, Age, Race, Sexuality, Religion.”
46. The applicant states that, in contrast, the opponent’s sign is broken up with an equal sign which they submit is confusing and does not give one specific meaning. They state the earlier mark could be interpreted as an equation and therefore assumed to be a mathematical term.
47. When making the conceptual comparison, it is the viewpoint of the average consumer which is relevant, not the subjective intentions of the parties when choosing or designing their marks. Further, the average consumer may not have a dictionary or legislative definition in mind and will not engage in a process of semantical analysis to determine whether words are a noun and adjective of the same word root but will have an instinctive reaction to the marks when engaged in the purchasing process.

48. I note the applicant's argument that the average consumer would have to look at the earlier mark more carefully to take a meaning from it, as the word is interrupted by its spacing and the insertion of the "=". In my view, however, the average consumer is still likely to understand that the earlier mark contains the word "EQUAL" and is unlikely to instead understand the mark as a mathematical equation of "EQ equals/= UAL". The average consumer, whilst perceiving a mark as a whole, will generally look for something that suggests a concrete meaning or a word known to them. The addition of the "=", whilst on the one hand disrupts the word due to its positioning in the mark, does also reinforce the concept of "EQUAL" as the average consumer will recognise it as the mathematical symbol meaning "equals."
49. The average consumer will therefore see the earlier mark contains the word "EQUAL" and will not, in my view, analyse the mark to unpick a particularly focussed conceptual meaning for "EQUAL." It is likely to convey a broad, general notion of something being the same as something else (for example, in amount, number (giving a mathematical significance), size, standard or importance). Due to the inclusion of the "=" symbol, some average consumers will focus more on the mathematical significance, others on the word more generally.
50. For the applied for mark URBAN EQUALITY will be perceived as a unitary phrase evoking a meaning of either equality between people within a town or city, or equality between conurbations themselves. The URBAN qualifies the EQUALITY or vice versa. There is a significant conceptual difference when compared to the earlier mark as URBAN EQUALITY has the more particular concept of equality between people within a town or city or equality between conurbations whereas the earlier mark conveys the broad general notion described above. There some conceptual overlap as both encompass the broad notion of something "ending up the same", but overall the conceptual similarity is low. For those average consumers who focus on the mathematical connotations of the earlier mark the

concepts are even further apart and the conceptual similarity will be particularly low.

51. I have no evidence before me as to the propensity of the average consumer to perceive URBAN as referring to a particular style or subculture in fashion/clothing. I have some reluctance, absent evidence, to find that a significant proportion of average consumers would have such an understanding, as I am unconvinced that it is a sufficiently notorious fact that I can take judicial notice of. Further, I do not consider that it is a term which could be considered descriptive or allusive or of low distinctiveness for the particular services in play as they do not relate to the retailing of clothing. However, in any event, even if a significant proportion of average consumers did perceive URBAN as an individual component having a descriptive connotation for the goods or some of the goods, such an average consumer would, in my view, still be likely to perceive the mark as a whole with its different overall unitary meaning. The conceptual difference therefore remains.

### **Distinctive character of the earlier trade mark**

52. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, based either on inherent qualities or because of use made, the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999

in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, count 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).”

53. There is no evidence of enhanced distinctiveness to be considered. This leaves the question of inherent distinctive character. The opponent submits that its earlier mark has a high inherent capacity to identify the goods and services for which it is registered as coming from the opponent. The applicant has not made submissions on the issue. The word EQUAL, per se, is not an invented word and whilst it is not allusive of any of the relevant goods or services, or a characteristic of them, I do not consider its level of distinctiveness to be particularly striking. The presentation might add to the distinctiveness, however, as this is something which is not present in the applied for mark, this will not increase the likelihood of confusion.<sup>4</sup> In my view, overall, the mark is possessed of an average degree of inherent distinctive character.

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<sup>4</sup> See *Kurt Geiger v A-List Corporate Limited*, BL O-075-13 where Mr Iain Purvis Q.C. at [38] to [39] held that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said: “if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

## **Likelihood of confusion**

54. The factors considered above have a degree of interdependency (*Canon* at [17]), so that a higher degree of similarity between the goods and services may offset a lower degree of similarity between the marks, and vice versa. I must make a global assessment of the competing factors (*Sabel* at [22]), considering them from the perspective of the average consumer and deciding whether the average consumer is likely to be confused. In making my assessment, I must keep in mind 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 he has retained in his mind (*Lloyd Schuhfabrik* at [26]).
55. In *Whyte and Mackay Limited v Origin Wine UK limited, Dolce Co Invest Inc* [2015] EWHC 1271 (Ch) Arnold J. summarised the findings of the CJEU in *Bimbo* as including three important points:

“19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks – visually, aurally and conceptually – as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20. The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the

composition mark as a unit having a different meaning to the meanings of the separate components. This includes the situation where the meaning of one of the components is qualified by another component, as with a surname and first name (e.g. BECKER and BARBARA BECKER).

21. The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

56. Confusion can be direct (which effectively occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same, but puts the similarity that exists between the marks/goods down to the responsible undertakings being the same or related).
57. Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10 explained:

“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 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).

58. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr. James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made simply because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

59. The applicant submits that the difference between the respective marks is such that the average consumer would not be confused. The opponent argues that given a high level of similarity between the marks and identity or high similarity between the respective goods and services, the average consumer is likely to be either directly or indirectly confused and believe the goods and services come



from the same or economically linked undertaking. They submit that the average consumer is unlikely to notice the minor differences between the marks. In particular, given the degree of attention being paid, and the absence of a side by side comparison of the marks, there could be a “blurring” of EQUAL and EQUALITY in the imperfect recall of the average consumer. They further argue that URBAN has low distinctiveness as a component and would be viewed as a descriptor of a product line/style with EQUAL/EQUALITY being seen as the misremembered house mark or brand name. They also argue that even if the marks have a lesser degree of similarity, it would in any event be offset by the greater degree of similarity/identity between the goods.

60. Earlier in this decision I concluded:

- The respective goods and services are identical, highly similar or similar to a medium degree;
- They cover a wide range of goods and services for which the average consumer will be a member of the public or a business user paying at least a medium level of attention during the selection and purchasing process;
- The selection process is likely to be primarily visual, though I do not overlook an aural element;
- There is a low degree of aural, visual and conceptual similarity between the marks;
- The earlier mark has an average degree of inherent distinctive character.

61. In terms of direct confusion, even taking into account imperfect recollection, the absence of a side by side comparison of the marks in the purchasing process and an average degree of attention being paid, I do not consider it likely that the average consumer, with overall impressions in mind, will mistake the applicant’s mark for the opponent’s. The significant visual differences between the marks, including the visually memorable figurative elements of the earlier mark, the additional word URBAN and the longer word EQUALITY in the applied for mark, together with the conceptual difference between the marks and the fact that I have

found URBAN EQUALITY is likely to be viewed and remembered as a whole unit with its own particular meaning, means that the differences in the overall impressions of the marks are sufficient to ensure one will not be misremembered or mistaken for the other.

62. In my view it is unlikely that the average consumer would misremember EQUAL for EQUALITY or vice versa at the degree of attention being paid. The opponent explains that the presentation of the earlier mark was a deliberate stylistic choice, with the insertion of “=” within the word, and the dividing of the six characters to create an even balance of 3 characters on each line to both reinforce the EQUAL concept. Even subject to imperfect recollection, and acknowledging the average consumer will not spend time analysing the mark, in my view, that cohesive structure of that figurative mark makes it more likely the average consumer will instinctively recall the word within the mark was EQUAL not EQUALITY. Further, in the applied for mark, the longer visual and syllabic length of EQUALITY and its role as part of URBAN EQUALITY with its own independent meaning again make it unlikely EQUALITY will be mis-recalled as EQUAL. However, even if I were to accept that the average consumer could “blur” EQUAL and EQUALITY in their recollection, the other significant visual differences between the marks together with the conceptual difference still means the differences in the overall impressions of the marks are sufficient to prevent direct confusion occurring.
63. The absence of direct confusion will also be the case for any average consumers who understand URBAN as describing a particular style or subculture in fashion/clothing and therefore potentially of low distinctiveness as an individual component for some goods. I have found that even in such circumstances URBAN would still be noticed in the overall impression of the earlier mark as would the overall conceptual meaning evoked by URBAN EQUALITY as a whole. Again, therefore the differences in overall impressions are sufficient to ensure the marks will not be mistaken or mis-recalled for any such grouping of average consumers.

64. This leaves the question of indirect confusion. I have borne in mind that the examples given by Mr Purvis in *L.A. Sugar* were intended to be illustrative in the context of that case, and not to impose rigid rules.<sup>5</sup> The categories of case where indirect confusion may be found are not closed. Each case must be assessed on its own facts, and my assessment must take account of the overall impression created by the marks. I must try to envisage the instinctive reaction in the mind of the average consumer when encountering the later mark with an imperfect recollection of the earlier, or vice versa. I must assess whether the average consumer will make a connection between the marks of the type that would lead them to assume that the goods or services in question are from the same or economically linked undertakings.
65. Even if I were to accept that imperfect recall could lead to a blurring effect between EQUAL and EQUALITY, I find that the other differences between the marks are too stark for the average consumer to consider that the goods or services derive from the same or linked undertakings. First, the figurative elements of the earlier mark are striking and play a significant role in the overall impression. In my view were the opponent to branch out into an URBAN named range the average consumer would anticipate that figurative stylisation to still be part of the overall get up to indicate a same stable range. Second, if URBAN is not seen as an element with a potentially descriptive meaning, its addition would not strike the average consumer as a normal or logical way in which a sub or variant brand or brand extension for the goods and services would be presented. Furthermore, the combination of dropping the figurative aspects and the addition of URBAN would make it even more unlikely the applied for mark would be viewed that way.
66. In addition, EQUAL as a common component is not so striking that average consumers would consider that no other traders would use it for the goods and services such that the applied for mark must derive from a common trade source.

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<sup>5</sup> See *Duebros Limited v Heirler Cenovis GmbH* at paragraphs [81] to [82]

I have also found that URBAN EQUALITY hangs together as a cohesive whole with its own new meaning and that unitary phrase is an important part of the overall impression held by average consumers. That unitary impression would mitigate against an instinctive reaction that the marks are variants or sub-brands or that the goods and services are from the same or economically linked undertakings. Instead, taking all of these factors into account, in my view the average consumer, if indeed they notice the common EQUAL component at all, would consider that two traders are coincidentally using the component as part of their own separate branding.

67. I consider that remains the position if indeed there is a significant average consumer grouping who perceive URBAN as referring to a particular style or subculture in fashion/clothing. Here the opponent argues that URBAN would be seen as a sub brand of the EQUAL/EQUALITY house mark and therefore would be seen as having a common or linked trade source. However, in my view, even if such consumers would see URBAN as a component that is potentially descriptive of some goods, it does not necessarily follow they will further see URBAN EQUALITY as being constructed of a descriptor and a house mark or that it is a house mark attributable to a same stable provider as the earlier mark.
68. I have found that if average consumers consider URBAN to have a descriptive meaning as a component they will still see URBAN EQUALITY as a unitary phrase. That unitary phrase has a meaning which is different to its constituent components and one component qualifies the other. As explained by Arnold J in *Whyte and Mackay Ltd* in such circumstances EQUALITY (or EQUAL) would not have independent significance in the mark which points away from a likelihood of confusion. The point being that if URBAN EQUALITY is seen as a unitary phrase with its own meaning the average consumer with such a perception of the overall mark is unlikely to rely on EQUAL/EQUALITY alone in order to identify the trade source of the goods. Furthermore, even if some average consumers did see EQUALITY alone functioning as a brand name, for the other reasons already

given, I do not consider they would in any event then assume that the applied for mark is a variant or a brand extension or has a common trade connection with the earlier mark as opposed to there being two independent operators.

69. My conclusions above on the likelihood of confusion apply irrespective of the degree of similarity found for the goods and services in play.
70. For completeness sake I will also address the argument raised by the applicant that there are other trade marks owned by third parties containing the word “equal” or “equality” which have not been opposed by the opponent. I do not consider this “state of the Register” evidence is of any assistance to the dispute in question<sup>6</sup> as there is nothing to show that such marks are in use and that they have had any impact on the consumer. I have therefore not taken those arguments into account when reaching my decision above.

## **Conclusion**

71. The opposition fails. Subject to appeal, the applicant’s mark may proceed to registration.

## **Costs**

72. Under cover of a letter dated 12 February 2019 the applicant was sent a costs proforma which they were directed to complete and return by 12 March 2019 if they intended to request an award of costs. The letter informed the applicant that

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<sup>6</sup> See for example *British Sugar [1996] RPC 281* at 305 where Jacob J said: “In particular the state of the register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led the registrar to put the marks concerned on the register. It has long been held under the old Act that comparison with other marks on the register is in principle irrelevant when considering a particular mark tendered for registration, see e.g. *MADAME Trade Mark* and the same must be true under the 1994 Act. I disregard the state of the register evidence.”

if the proforma was not completed and returned no costs would be awarded other than any official fees paid. The proforma has not been returned and I therefore do not make any costs award in favour of the applicant. There are no official fees to reimburse.

**Dated 11 April 2019**

**Rachel Harfield  
For the Registrar,  
The Comptroller-General**