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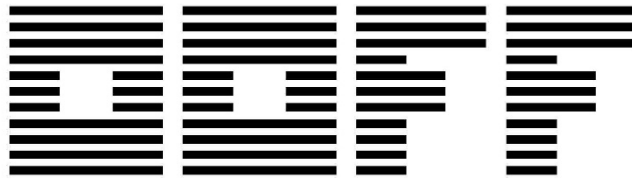
TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3364245

BY

JACK CLARK

TO REGISTER:



AS A TRADE MARK IN CLASS 25

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NO. 415752

BY

OFF-WHITE LLC

BACKGROUND & PLEADINGS

1. On 2 January 2019, Jack Clark (“the applicant”) applied to register the trade mark shown on the cover page of this decision for “Clothing” in class 25. The application was published for opposition purposes on 11 January 2019.

2. On 11 March 2019, the application was opposed by Off-White LLC (“the opponent”). The opposition is based upon sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). In relation to its objection based upon section 5(2)(b), the opponent relies upon all the goods (shown in paragraph 19 below) in European Union Trade Mark (“EUTM”) no. 17237645 for the trade mark **OFF** which was applied for on 21 September 2017 and entered in the register on 5 February 2018.

3. The opponent claims that as the competing trade marks are highly similar and the goods are identical or highly similar, a likelihood of confusion will result.

4. In relation to its opposition based upon section 5(4)(a) of the Act, the opponent relies upon the following signs:

1.

“OFF”

2.



3.



5. The opponent states that it has used all the signs being relied upon throughout the UK in relation to:

Clothing; headgear; footwear; jewellery; phone cases; bags; luggage; wallets; purses; sports bags; rucksacks and the retail of the aforementioned goods.

6. It further states that signs 1 and 2 have been used since “at least” 1 January 2019 and sign 3 since January 2014. It claims that its use of these signs has generated goodwill and that the applicant’s trade mark will constitute a misrepresentation which will lead to actual or likely damage to its reputation and goodwill and the risk of trade diversion.

7. The applicant filed a counterstatement in which the basis of the opposition is denied. It contains a number of comments (repeated in his various submissions), which I will return to below.

8. In these proceedings, the opponent is represented by Stobbs IP; the applicant is represented by Andrew Clarke. Although only the opponent filed evidence, the applicant filed written submissions during the evidence rounds. Neither party requested a hearing, preferring instead to file written submissions in lieu of attendance. I have read all of these submissions and will, to the extent I consider it necessary, refer to them later in this decision.

The opponent's evidence

9. This consists of a witness statement from Andrea Grilli, accompanied by twenty-six exhibits. Ms Grilli is the Chief Commercial Officer of Off-White Operating S.r.l., a position she has held since December 2015. The main points arising from her evidence are as follows:

- The opponent is owned by Virgil Abloh who is “an internationally renowned DJ, fashion designer and music producer, and former Creative Director to the artist, Kayne West”;
- The opponent is a trade mark holding company “for the OFF-WHITE trade marks and grants an exclusive licence [to Ms Grilli’s company] for the use of the OFF-WHITE trade marks”;
- Ms Grilli’s company “is exclusively responsible for all operational aspects and general management of the OFF-WHITE business...”;
- Mr Abloh created the OFF-WHITE fashion brand in 2013;
- In 2014, Mr Abloh and Off-White were nominated for the LVMH prize (exhibit AG1 refers);
- Exhibit AG2 consists of a range of articles from, for example, www.independent.co.uk (17 August 2014), vogue.co.uk (4 December 2017) and vogue.com (28 March 2018) in relation to Mr Abloh and the Off-White brand;
- The Off-White brand has been widely promoted since its launch and has received recognition in the fashion industry and amongst a wide range of celebrities. Exhibit AG3, which contains what appear to be mostly undated photographs of Chloe Grace Moretz, Justin Bieber, Rita Ora, Hailey Baldwin,

Bella Hadid, Carmelo Anthony, Drake, Chris Brown, Kylie Jenner and Beyonce, refers;

- In March 2018 Mr Abloh was appointed artistic director of Louis Vuitton;
- As of 21 August 2019, the OFF-WHITE brand had over 280 stockists around the world, including in the UK;
- The black and white stripes are a “key brand element”. Exhibit AG4 which consists of articles from vogue.co.uk (26 March 2018) and theguardian.com (from after the material date) are provided in support;
- OFF-WHITE has engaged in many collaborations with, for example, SSENSE, Nike, Moncler, Levis, Heron Preston, A\$AP Rocky, Jimmy Choo and Kith. Exhibit AG5 contains articles from www.independent.co.uk (from after the material date) and fashionista.com (dated 29 November 2017) in support;
- Ms Grilli states that OFF-WHITE is “currently one of the most successful and well-known fashion brands in the world.” Exhibit AG6 consists of pages from the Lyst online fashion site which, Ms Grilli explains, is “based in the UK and claims to be the largest fashion search platform.” Ms Grilli notes that OFF-WHITE was, inter alia, ranked no. 1 in “Q1 2019 HOTTEST BRANDS” and no. 2 in Q4 2018. Exhibit AG7 consists of an article from independent.co.uk dated 24 October 2018 entitled “OFF-WHITE NAMED AS WORLD’S HOTTEST FASHION BRAND”;
- The @off_white Instagram account is the main social media account used by the opponent. OFF-WHITE “currently” has 7.9m followers having had 849k at the beginning of 2017, 2.6m at the beginning of 2018 and 6.5m at the beginning of 2019. In addition, Mr Abloh has 4.2m followers. Exhibit AG8 contains pages from instagram.com in support;

- Ms Grilli states that because, inter alia, press and social media has been so successful, OFF-WHITE is not “promoted in the traditional way”. Fashion shows are, however, “a specific area of expenditure.” Exhibit AG9 consists of details of “Paris Runway Show Expenditures” between what, given the references to, for example, “SS16” and “FW18”, I infer is 2016 and 2019, “Pitti Uomo Florence Runway Show Expenditures” in, I infer, 2018 and “Adv Pages” between 2016 and 2017. Excluding the figures for “SS19” total expenditure amounts to in the order of €3.3m;
- OFF-WHITE products have been sold in the UK since 2014;
- In the UK, products are sold through retailers such as Autograph, Browns, Net-A-Porter, Giulio Ltd, End Clothing, zoofashions.com and Matches Fashion, in retail outlets in department stores, i.e. Selfridges in London and Manchester and Harrods and Harvey Nichols in London, and on the opponent’s own website www.off-white.com/en/GB. Exhibits AG10, 11 and 12 which consist of pages from the websites of the undertakings mentioned are provided in support;
- In the period 2014-2018, “total sales of OFF-WHITE products in the UK” amounted to €41m;
- Although OFF-WHITE products are also available to consumers in the UK via online retailers outside of the UK (exhibit AG13 refers), as Ms Grilli explains that she does not have sales figures in this regard, I need say no more about this aspect of the opponent’s evidence;
- In addition to the OFF-WHITE brand, Ms Grilli explains that the opponent’s business has a “number of other key branding elements”. These include the OFF trade mark, the “Crossed OFF” logo (no. 2 in paragraph 4) and “diagonal black and white stripes” (no. 3 in paragraph 4);

- The OFF trade mark has, she states, been used “as part of the OFF-WHITE brand in the UK since at least as early as February 2016”;
- The OFF trade mark has been used upon a range of clothing and accessory products including t-shirts, sweatshirts, hoodies, dresses, shorts, trousers, trainers, sliders, bags and phone cases;
- In the period 2016 to 2018, sales of products in the UK to third party retailers bearing the OFF trade mark amounted to €922k. Exhibits AG14 (which consists of a table listing all invoices issued in the period mentioned) and AG15 (which consists of sample invoices) are provided in support. All of the invoices relate to goods in class 25;
- My comments in relation to exhibit AG13 also apply to exhibit AG16;
- Exhibit AG17 consists of what Ms Grilli describes as “pages from OFF-WHITE line sheets and look books” many of which are undated. Those that can be dated appear to be from 2017 and 2018;
- The “Crossed OFF” logo debuted at the Pitti fashion show in June 2017. Exhibit AG18 which consists of, inter alia, pages from pittimmagine.com dated 15 June 2017, refers;
- Products bearing the “Crossed OFF” logo have been sold in the UK since 2018. It has been used upon products including t-shirts, sweatshirts, hoodies, dresses, shorts, trainers, sliders, bags and phone cases;
- In 2018 sales to third party retailers bearing the “Crossed OFF” trade mark amounted to €947k. It is not clear if this figure only relates to retailers in the UK. Exhibits AG19 (which consists of a table listing all invoices issued in the period mentioned) and AG20 (which consists of sample invoices) are provided in support. All of the invoices relate to goods in class 25;

- My comments in relation to exhibit AG13 also apply to exhibit AG21;
- Exhibit AG22 consists of what Ms Grilli once again describes as “pages from OFF-WHITE line sheets and look books...showing use of the Crossed OFF logo on product”. All are dated in 2018;
- Ms Grilli states that “A key branding element since OFF-WHITE’s inception is the use of diagonal black and white stripes on product...”;
- The black and white stripes have, states Ms Grilli, “been used...in the UK since... 2014”;
- Exhibit AG23 contains what Ms Grilli describes as “third party references to this brand element” and she points to the following: (i) a reference from GQ magazine (said to be from 2016) i.e. “Off-White’s designs – brash and loud and graphic, branded with the black-and-white diagonal stripes you can recognise from 30 yards away – are everywhere”, (ii) an article from highsnobiety.com (said to be from 2016) i.e. “The “Diagonals” (probably named after the brand’s signature diagonal stripe graphic)...”, (iii) and (iv) articles from www.complex.com (from 2015 and 2016) i.e. “...are accented by Off-White’s trade mark stripe pattern and eponymous branding...” and “How Virgil Abloh Turned Diagonal Lines into a Brand...imagine hundreds of thousands of Off-White fans seeing diagonal lines all the time and automatically thinking of Abloh’s label”, and (v) an article from esquire.com (said to be from 2017) i.e. “...His signature graphic-bold diagonal stripes...”;
- Ms Grilli explains that there are three distinct versions of the diagonal stripes i.e. the “square stripes”, “vertical stripes” and “horizontal stripes” logos all of which, she states are used as “source indicators” and all of which “are distinctive of OFF-WHITE”. What appear to be undated examples of such usage are provided as exhibit AG24;

- Between 2014 and 2017, the “square stripes” logo was used on the product label on all OFF-WHITE clothing and headgear;
- Exhibit AG25 consists of what Ms Grilli explains are “examples from various look books, collections and product lines, which clearly show the use of diagonal stripes across a range of products.” Many of the pages in the exhibit are undated. Those that are, date from 2014-2015 and 2017-2018;
- Ms Grilli states that a version of the “square stripes” logo “appears as the favicon on the browser tab...when viewing the OFF-WHITE website and online shop...”. An example from, it appears, 2019 is provided as exhibit AG26.

10. Ms Grilli concludes her statement in the following terms:

“64. I consider the OFF-WHITE brand to be a very well-known fashion brand in the UK.

65. I consider that the OFF mark, the “Crossed OFF” logo and diagonal black and white stripes would be recognised by consumers in the UK and seen as trade marks of the opponent.”

11. That concludes my summary of the evidence filed to the extent I consider it necessary.

DECISION

12. The opposition is based upon sections 5(2)(b) and 5(4)(a) of the Act which read as follows:

“5 (2) A trade mark shall not be registered if because –

(a)...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

5A 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.”

And:

“(4) A trade mark 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, or

(b)...

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.”

Subsection (4A) of Section 5 states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

13. Under section 5(2)(b) of the Act, the opponent is relying upon the trade mark shown in paragraph 2 above, which qualifies as an earlier trade mark under the provisions of section 6 of the Act. Given the interplay between the dates on which the opponent’s trade mark was entered in the register and the filing date of the application for registration, this trade mark is not subject to the proof of use provisions contained in section 6A of the Act. As a consequence, the opponent can rely upon all the goods for which it is registered and upon which it relies without having to demonstrate that it has been used in relation to such goods.

The objection based upon section 5(2)(b) of the Act

The correct approach to the comparison

14. In his counterstatement, the applicant states:

“The market pricing for the two brands will be very different;: OOFF hoodies and t-shirts are priced at 65 pounds and 30 pounds respectively. The OFF-WHITE garments above are priced at: \$355, \$325, \$585, \$1,105 respectively. The disparity in price point would suggest that the clothes are in different sectors of the fashion industry; e.g. that OOFF is affordable skate/streetwear and OFF-WHITE is high-end fashion. OFF-WHITE sells at an extravagant price point, i.e. some hooded garments that are retailed at \$645. OOFF's hoodies will be priced at 65GBP, demonstrating further the disparity between the two companies.

This point goes further into the desired target market: OOFF is a skate/streetwear brand, with current operations to provide video and photographic media involving members of a skateboarding team, in which apparel is advertised. OFF-WHITE retains its focus on an upper-class, higher income bracket audience, focusing on high-end fashion fanatics, catwalks, runways, and fashion shows. OFF-WHITE does not have a skateboarding team, and chooses to promote its product in an entirely different way.

OFF WHITE sells its goods through its own website, and a variety of high-end clothing retailers on the high street, whereas I will be selling my goods strictly through my own website.”

15. In *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06, the Court of Justice of the European Union (“CJEU”) stated at paragraph 66 of its judgment that when assessing the likelihood of confusion under Section 5(2) it is necessary to consider all the circumstances in which the trade mark applied for might be used if it were registered.

16. In *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P, the CJEU stated:

“59. As regards the fact that the particular circumstances in which the goods in question were marketed were not taken into account, the Court of First Instance was fully entitled to hold that, since these may vary in time and depending on the wishes of the proprietors of the opposing marks, it is inappropriate to take those circumstances into account in the prospective analysis of the likelihood of confusion between those marks.”

17. While I fully understand the applicant’s submissions, they proceed on a misunderstanding of the comparison I am required to make. As neither party’s

specification is limited in any way, the fact that the parties may operate in different sectors of the market or make their goods available to the public in different ways are not factors I can take into account. Rather, what I must do in relation to the objection under section 5(2)(b) of the Act, is compare the competing specifications and trade marks on the basis of notional and fair use.

Case law

18. 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.

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 greater 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

19. The competing goods are as follows:

The opponent's goods	The applicant's goods
<p>Class 18 - All-purpose carrying bags; travel bags; luggage; trunks; gym bags; sports bags; clutches; purses; handbags; shoulder bags; tote bags; beach bags; wallets; business card cases; backpacks; courier bags; messenger bags; briefcases; umbrellas.</p> <p>Class 25 - Apparel, namely, jackets, sweatshirts, coats, blazers, suits, pants, jeans, pullovers, sweaters, vests, shorts, shirts, dresses, skirts, neckwear, shawls; scarves; socks, leggings; stockings; belts, suspenders; braces; hats, caps, gloves, shoes, boots; flip flops, sandals and sneakers.</p>	<p>Class 25 - Clothing</p>

20. In *Gérard Meric v Office for Harmonisation in the Internal Market*, 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 trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where

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

21. Although the opponent relies upon its goods in classes 18 and 25, it is only necessary for me to comment upon its goods in class 25. The opponent’s specification in class 25 includes the word “namely”. The Classification Section of the Trade Mark’s Registry’s Work Manual states:

“Note that specifications including “namely” should be interpreted as only covering the named Goods, that is, the specification is limited to those goods. Thus, in the above “dairy products namely cheese and butter” would only be interpreted as meaning “cheese and butter” and not “dairy products” at large. This is consistent with the definitions provided in Collins English Dictionary which states “namely” to mean “that is to say” and the Cambridge International Dictionary of English which states “which is or are”.

22. As the applicant’s “clothing” is broad enough to include all the named items of clothing in the opponent’s specification in class 25, the competing goods are to be regarded as identical on the inclusion principle outlined in *Meric*.

The average consumer and the nature of the purchasing act

23. As the case law above indicates, it is necessary for me to determine who the average consumer is for the goods at issue. I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. 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.”

24. The average consumer of clothing is a member of the general public. As a member of the general public will, for the most part, self-select such goods from the shelves of a bricks-and-mortar retail outlet or from the equivalent pages of a website or catalogue, visual considerations are likely to dominate the selection process. That said, as such goods may also be the subject of, for example, word-of-mouth recommendations or oral requests to sales assistants (both in person and by telephone), aural considerations must not be forgotten.

25. As to the degree of care the average consumer will display when selecting the goods at issue, the cost of such goods can vary considerably. However, as the average consumer will be alive to factors such as cost, size, colour, material and compatibility with other items, the average consumer can, in my view, be expected to pay at least an average degree of attention to their selection. As the cost and/or importance of the item increases, so too is likely to be the degree of care paid to its selection

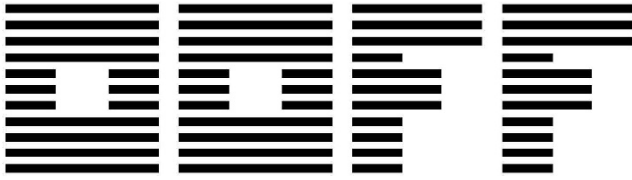
Comparison of trade marks

26. 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.”

27. 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 as follows:

Opponent’s trade mark	Applicant’s trade mark
OFF	

28. The opponent’s trade mark consists of the well-known English language word “OFF” presented in block capital letters. As no part of this trade mark is highlighted or emphasised in any way, the overall impression it conveys and its distinctiveness lies in the single word of which it is composed.

29. The applicant’s trade mark consists of four characters, the first two of which will, in my view, be construed by the average consumer as the stylised letters “O-O”. The following two characters will, I have no doubt, be construed as the letters “F-F”. All four characters are made up of alternating black and white horizontal lines. In his

submissions filed during the evidence rounds, the applicant refers to: “opposition to my trade mark for OOFF”. That accords with my own view of how the average consumer will construe the applicant’s trade mark. While the word “OOFF” will make the greatest contribution to both the overall impression conveyed and distinctiveness, its presentation in alternating black and white horizontal lines will make a lesser, but important contribution.

The visual comparison

30. Both trade marks begin with a character that either is, or will be construed as, a letter “O” and both end with what is or will be construed as the letters “F-F”. The trade marks differ to the extent that the applicant’s trade mark contains what will be construed as a letter “O” in the second character position and the stylised manner in which it is presented. Weighing the similarities and differences I have identified, results in what I regard as a between low and medium degree of visual similarity between the competing trade marks.

The aural comparison

31. In its submissions, the opponent states:

“6. Phonetically, the repeated first letter from OFF to OOFF does little to alter the mark. The alteration of “O” to “OO” is not a very big phonetic difference. Since the marks are both short, beginning with a similar vowel sound and finishing with the “FF” there is strong phonetic similarity.”

32. In his submissions filed during the evidence rounds, the applicant states:

“By way of the International Phonetic Alphabet (IPA), the breakdown of the lexical nature of "OOFF", "OFF", dictate that the two trademarks sound

fundamentally different just by saying them aloud one can understand that there is very significant disparity between the two.”

33. As the word “OFF” will be very well-known to the average consumer its pronunciation as a single syllable word is predictable. Other than it too is likely to be pronounced as a single syllable word, the same cannot be said of the applicant’s trade mark. In my view, the applicant’s trade mark is most likely to be pronounced in a very similar fashion to the last three characters of the word “hoof” or, as the applicant suggests in relation to conceptual similarity (see below), like the sound one might make following, for example, a sudden exertion. In my view, any aural similarity that may exist between the competing trade marks is, at best, very low.

Conceptual similarity

34. In its submissions, the opponent states:

“6. Conceptually, OOFF can be interpreted as a stretched version of the word OFF, leading to conceptual similarity. OOFF has no meaning of its own.”

35. In his submissions filed during the evidence rounds, the applicant states in relation to his trade mark:

“Onomatopoeia:

1. Expressing discomfort, as from sudden exertion or blows to the body.”

36. As the applicant points out in his submissions, the word “OFF” has a range of meanings. I accept the average consumer will be familiar with many of the meanings the applicant has identified. In its submissions, the opponent argues that as “OOFF” has no meaning of its own, it will be understood as a “stretched version” of the word “OFF”,

whereas the applicant has identified a meaning for the word “OOFF”. He does not, however, explain the source from which this meaning has been obtained.

37. While some average consumers may construe the applicant’s trade mark in the manner he suggests, it is, in my view, equally likely that as the opponent suggests, the word “OOFF” will be accorded no meaning. I see no reason why the average consumer would construe the applicant’s trade mark as a “stretched version” of the word “OFF”. While the various meanings of the word “OFF” will be well-known to the average consumer, the word “OOFF” may convey either the meaning the applicant suggests or no meaning at all. As none of the meanings of the word “OFF” is similar to the concept the applicant has identified, in the first scenario the competing trade marks are conceptually different and in the second, the opponent’s trade mark will convey one of a number of conceptual messages whereas the applicant’s trade mark will convey none.

Distinctive character of the earlier trade mark

38. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

39. As I mentioned earlier, the word “OFF” and its various meanings will be well known to the average consumer. However, none of these meanings is descriptive of the goods at issue nor is the word “OFF” non-distinctive for such goods. Consequently, considered

absent use, the word “OFF” is, in my view, possessed of a medium degree of inherent distinctive character.

40. That, however, is not the end of the matter as in her statement Ms Grilli provides evidence to demonstrate that the opponent’s “OFF” trade mark has been used in the UK since “at least as early as February 2016” and that in the period 2016 to 2018 sales of articles of clothing in the UK have amounted to some €922k. While a not insignificant sum, when considered in the context of the UK clothing market as a whole (which must run to many billions of pounds each year), it is unlikely to have enhanced, at least to any material extent, the inherent distinctive character of the opponent’s “OFF” trade mark. I shall, however, return to this point when I consider the likelihood of confusion.

Likelihood of confusion

41. In determining whether there is a likelihood of confusion, 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 also necessary for me to keep in mind the distinctive character of the opponent’s trade mark as the more distinctive it is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and 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 he has retained in his mind.

42. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods down to the responsible undertakings being the same or related. Earlier in this decision I concluded that:

- the applicant's goods are to be regarded as identical to the opponent's goods in class 25;
- the average consumer of the goods at issue is a member of the general public who, whilst not forgetting aural considerations, will select such goods using primarily visual means whilst paying at least an average degree of attention during that process;
- the competing trade marks are visually similar to a between low and medium degree and aurally similar to a very low degree;
- the opponent's trade mark will send a range of conceptual messages to the average consumer whereas the applicant's trade mark will either send a differing conceptual message or no conceptual message at all;
- The opponent's earlier trade mark is possessed of a medium degree of inherent distinctive character which has not, at least to any material extent, been enhanced by the use that has been made of it.

43. In its written submissions, the opponent states:

“13. The likelihood of confusion is increased by the fact that the Opponent is known to use all the rights which form the basis of this opposition, namely:

[the trade marks shown in paragraph 4 above].

14. The fact that the Opponent is known to use these three elements will greatly increase the chances of the public assuming a connection between the Opponent and the use of the Contested Mark which in turn contains a combination of the word OFF, with a doubling of the letter O, and also black and white parallel stripes.”

44. Although the opponent makes no claim to a “family” of trade marks in either its Notice of opposition or written submissions, the comments of the CJEU in *Il Ponte Finanziaria SpA v OHIM*, Case C-234/06 are, I think, helpful:

“62. While it is true that, in the case of opposition to an application for registration of a Community trade mark based on the existence of only one earlier trade mark that is not yet subject to an obligation of use, the assessment of the likelihood of confusion is to be carried by comparing the two marks as they were registered, the same does not apply where the opposition is based on the existence of several trade marks possessing common characteristics which make it possible for them to be regarded as part of a ‘family’ or ‘series’ of marks.

63 The risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94 (see *Alcon v OHIM*, paragraph 55, and, to that effect, *Canon*, paragraph 29). Where there is a ‘family’ or ‘series’ of trade marks, the likelihood of confusion results more specifically from the possibility that the consumer may be mistaken as to the provenance or origin of goods or services covered by the trade mark applied for or considers erroneously that that trade mark is part of that family or series of marks.” (my emphasis).

45. Although the opponent’s evidence indicates that it has used its “OFF” trade mark in association with the signs shown above, the opposition is based solely upon the word only trade mark “OFF”. In those circumstances, the opponent is not entitled to ask for the use of the other signs mentioned to be taken into account in the assessment of the likelihood of confusion between its trade mark and that of the applicant.

46. The fact that the goods at issue are identical is a point in the opponent’s favour. However, the competing trade marks are visually similar to between only a low to

medium degree and aurally similar to a very low degree. In *The Picasso Estate v OHIM*, Case C-361/04 P, the CJEU found:

“20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law.”

47. The meanings of the word “OFF” will be “grasped immediately” by the average consumer, whereas the applicant’s trade mark will, at the very least, convey no conceptual message. Even if contrary to my primary finding the opponent’s trade mark is felt to possess an enhanced degree of distinctive character by virtue of the use that has been made of it, I am satisfied that an average consumer paying even a relatively low degree of attention during the purchasing process is unlikely to mistake the applicant’s trade mark for that of the opponent. The applicant’s position is, of course, even stronger if, as I have found, the average consumer displays at least an average degree of attention during the purchasing process (thus making him/her less susceptible to the effects of imperfect recollection) and/or if he/she conceptualises his trade mark in the manner he suggests.

48. Having concluded that there is no direct confusion, I must also consider whether there is a likelihood of indirect confusion. In *L.A. Sugar Limited v By Back Beat Inc*, Case 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.”

49. 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 merely because the two trade marks share a common element. In this connection, he pointed out that it is not sufficient that a trade mark merely calls to mind another trade mark. This is mere association not indirect confusion.

50. Having reached what I regard as a very clear conclusion in relation to direct confusion, I see no reason why an average consumer might speculate on any of the bases outlined by Mr Purvis or indeed on any other basis. In my view there is no likelihood of indirect confusion.

Conclusion under section 5(2)(b)

51. The opposition based upon section 5(2)(b) of the Act has failed.

The objection based upon section 5(4)(a) of the Act

52. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the Jif Lemon case (Reckitt & Colman Product v Borden [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “*a substantial number*” of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

53. *Halsbury's Laws of England* Vol. 97A (2012 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 309 it is noted (with footnotes omitted) that:

“To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be

completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.”

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

The relevant date

54. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC as the Appointed Person considered the relevant date for the purposes of section 5(4)(a). He stated:

“43. In *SWORDERS TM O-212-06* Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.’ ”

55. In his counterstatement, the applicant states:

“I started using the OOFF mark publicly on 1st August 2018. Email records show collaboration between myself, Dylan Stott (OOFF website designer), and Nicoleta Ionescu, in a Google Doc containing the design for OOFF's logo to be used on the website. My use of the mark predates the date on which OFF WHITE client started using the mark as set out in paragraph 13 of the Statement of Grounds.”

56. Although the applicant indicates that he started using his trade mark prior to the date on which it was filed, as he has provided no evidence in this respect, the relevant date is the date of application i.e. 2 January 2019.

The signs being relied upon

57. For the sake of convenience, the signs being relied upon are as follows:

1.

“OFF”

2.



3.



Goodwill

58. In *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL) it was stated:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

59. In approaching the matter, I note that there is nothing in either the applicant's counterstatement or written submissions which, in any meaningful way, challenges the claims made in the opponent's evidence. In her evidence, Ms Grilli states that sign no. 3 has been used in the UK since 2014, sign no. 1 from 2016 (with sales of €922k) and

sign no. 2 from 2018 (with sales of €947k). Although not being relied upon, Ms Grilli further explains that the opponent's OFF-WHITE sign has also been used in the UK since 2014 (with sales of €41m). All these signs have, she states, been used upon a range of goods including articles of clothing.

60. Having considered the evidence as a totality, I am satisfied that by the relevant date the opponent's business had a protectable goodwill in relation to sign no. 1 and, despite only having been used since 2018, also in relation to sign no. 2. That goodwill is predominantly in relation to articles of clothing. In relation to sign no. 3, in his submissions filed during the evidence rounds, the applicant argued:

“...There are a multitude of trademarks that incorporate the use of parallel lines as a form of stylization - it is a generic method of design. OFF WHITE cannot conceivably have a monopoly in the use of any type of parallel lines.

There are many examples of fashion retailers who have used this stylization and that is before the formation of Off White as a company.”

61. The applicant has, however, provided no evidence in support of these assertions. Whilst I note the various references in the evidence to the use of sign no. 3 as a branding element (exhibit AG23 for example), I am, given what I regard as its non-distinctive nature, less convinced about this sign.

62. However, for reasons which will shortly become clear, I shall proceed on the basis most favourable to the opponent i.e. that by the relevant date of 2 January 2019, the business which the opponent had conducted in relation to articles of clothing had resulted in a protectable goodwill of which all three signs being relied upon were distinctive. Although not being relied upon, I note the opponent's further claim that the signs that are being relied upon also benefit from the goodwill its business has

generated from its use of the OFF-WHITE sign from 2014 also in relation to articles of clothing. I shall keep that submission in mind.

63. In *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, Kitchin LJ considered the role of the average consumer in the assessment of a likelihood of confusion. Kitchen L.J. concluded:

“... if, having regard to the perceptions and expectations of the average consumer, the court concludes that a significant proportion of the relevant public is likely to be confused such as to warrant the intervention of the court then it may properly find infringement.”

64. Although this was an infringement case, the principles apply equally under 5(2): see *Soulcycle Inc v Matalan Ltd*, [2017] EWHC 496 (Ch). In *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, Lewinson L.J. had previously cast doubt on whether the test for misrepresentation for passing off purposes came to the same thing as the test for a likelihood of confusion under trade mark law. He pointed out that it is sufficient for passing off purposes that “a substantial number” of the relevant public are deceived, which might not mean that the average consumer is confused. However, in the light of the Court of Appeal’s later judgment in *Comic Enterprises*, it seems doubtful whether the difference between the legal tests will (all other factors being equal) produce different outcomes. This is because they are both normative tests intended to exclude the particularly careless or careful, rather than quantitative assessments.

65. I begin by reminding myself that the opponent’s business has generated a goodwill as a result of its trade in clothing i.e. exactly the same field in which the applicant wishes to trade.

Sign no. 1

66. Having already concluded under section 5(2)(b) that the opponent's "OFF" trade mark will not result in a likelihood of confusion, given the comments above, I see no reason to reach a different conclusion in relation to misrepresentation. Without misrepresentation there can be no damage and the objection based upon this sign fails.

Sign no. 2

67. The opponent is in no better position in relation to this sign which is visually less similar to the applicant's trade mark than its "OFF" trade mark. Although the opponent refers to it as the "Crossed-OFF" logo, aurally it is, in my view, most likely to be referred to by the relevant public as either "OFF" or "OFF-OFF". The opponent's best case is that the relevant public will refer to it by the word "OFF" alone. However, even if that is the case, I have already concluded under section 5(2)(b) that it results in a very low degree of aural similarity with the applicant's trade mark. Finally, this sign is conceptually no more similar to the applicant's trade mark than its "OFF" trade mark. Once again there will be no misrepresentation and the objection based upon this sign also fails.

Sign no. 3

68. Although in her evidence Ms Grilli refers to the use of three versions of the diagonal stripes logo, as no request was made to amend the pleadings in this regard, it is only the version shown above that I can take into account. In his submissions filed during the evidence rounds, the applicant argued:

"The stripes sign relied upon in the form TM7 are in any event totally different from the lines used in my OOFF mark - the former are thick and at an

approximately 45 degree angle to the vertical whereas the lines in my OOFF mark are thin and horizontal.”

69. I agree with the applicant’s submissions. There is a significant difference between a sign consisting of diagonal stripes and a composite trade mark in which horizontal lines are used to create a word in which the horizontal lines are subordinate to the word they create. It is that word which will fix itself in the relevant public’s mind and act as a “hook” to aid their recall and not the horizontal lines of which it is composed. In those circumstances, I see no reason why a substantial number of consumers would be deceived into thinking that an undertaking using the figurative sign being relied upon was connected with an undertaking using the word “OOFF” formed in the manner indicated. There will, in my view, be no misrepresentation and the objection based upon this sign also fails.

70. In its submissions, the opponent repeats a submission it made in relation to section 5(2)(b) namely:

“20. The fact that the Opponent has goodwill in these three elements will greatly increase the chances of the public assuming a connection between the Opponent and the use of the Contested Mark which in turn contains a combination of the word OFF, with a doubling of the letter O, and also black and white parallel stripes.”

71. I accept that the fact that the relevant public will be familiar with the use of, inter alia, signs nos. 1 and 3 may improve the opponent’s position. However, it does nothing to change my conclusions on the degree of aural and conceptual similarity between the applicant’s trade mark and the signs being relied upon. There is not, as far as I can tell (and the opponent has not pointed to) any evidence indicating that, for example, the relevant public has been exposed to the opponent’s “OFF” trade mark presented in the form of diagonal stripes. In my view, the very clear conceptual messages the

opponent's word trade marks will convey as opposed to the differing or no conceptual message the applicant's trade mark is likely to convey, is sufficient to avoid a substantial number of consumers being deceived into thinking that goods sold under the applicant's trade mark are from the same source as, or in some way connected with, the opponent's goods.

Conclusion under section 5(4)(a)

72. The opposition based upon section 5(4)(a) also fails.

Overall conclusion

73. The opposition based upon sections 5(2)(b) and 5(4)(a) has failed and, subject to any successful appeal, the application will proceed to registration.

Costs

74. As the applicant has been successful, he is, in principle, entitled to a contribution towards his costs. Awards of costs in proceedings are governed by Annex A of Tribunal Practice Notice ("TPN") 2 of 2016.

75. Although the official record shows that the applicant has been represented by Mr Andrew Clark, I note that Mr Andrew Clark has the same address as the applicant. As there is nothing to suggest that Mr Andrew Clark is a professional representative, at the conclusion of the evidence rounds, the tribunal wrote to Mr Andrew Clark. In that letter, dated 8 November 2019, the tribunal stated:

"If you intend to make a request for an award of costs you must complete and return the attached pro-forma and send a copy to the other party..."

If there is to be a “decision from the papers” this should be provided by **6 December 2019**.

If the pro-forma is not completed and returned, costs, other than official fees arising from the action (excluding extensions of time), may not be awarded...”

76. The applicant did not respond to that invitation either by the deadline set or by the date of the issuing of this decision. As the applicant has not incurred any official fees in the defence of his application, I make no order as to costs.

Dated this 25th day of February 2020

C J BOWEN
For the Registrar