

O-499-21

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3358569 BY
EDWEAR LIMITED**

TO REGISTER:



AND



AS A SERIES OF 2 TRADE MARKS IN CLASS 25

AND

**OPPOSITION THERETO UNDER NO. 415451 BY
ERREA' SPORT S.p.A**

Background & pleadings

1. On 5 December 2018, EDWEAR LIMITED (“the applicant”) applied to register the trade marks shown on the cover page of this decision for a broad range of goods in class 25 (shown in Annex at the end of this decision). The application was accepted and published in the Trade Marks Journal on 14 December 2018.

2. On 14 February 2019, the application was opposed in full by Errea’ Sport S.p.A. (“the opponent”). The opposition is based on section 5(2)(b) and section 5(3) of the Trade Marks Act 1994 (“the Act”), with the opponent relying upon all of the goods under European Union Trade Mark (EUTM) 12739462 which was filed on 28 March 2014 and registered on 22 August 2014, for the plain word mark ‘**3DWEAR**’.¹

3. The goods relied upon by the opponent are the following:

Class 25: Clothing for men, women, and children; Sports clothing and leisurewear for men, women and children, Including sports jerseys, Undershirts, Tee-shirts, Tank tops, Sweat shirts, Pullovers, Polo-neck jerseys, Shirts, Skirts, Pants (Am), Trousers shorts, Bermuda shorts, Jackets [clothing], Jackets, Denim jeans, Ties, Gowns; Combinations (clothing); Full tracksuits for sports teams; Jogging suits; Sports kits, including kits for football, five-a-side football, volleyball, rugby and basketball; Soccer clothing, Five-a-side football, Volleyball, Rugby, Basketball, Tennis, Skis, Cycling, Golf, Baseball, Spinning, Running and exercisewear in general not included in other classes; Belts for clothing; Belts for sports; Footwear; Footwear; Sports shoes, including shoes for football, five-a-side football, volleyball, rugby, basketball, tennis, skiing, cycling, golf, baseball, spinning, running, gymnastics and exercise in general, not included in other classes, ski boots; Swimshoes; Mules; Headgear, including hats, berets, bonnets, ear muffs, headbands and sweat bands, hats and berets for sport in general, bandanas; Gloves [clothing]; Sashes for wear; Cuffs; Stockings; Socks; Stockings (Sweat-absorbent -); Slippers; Pant

¹ Although the UK has left the EU and the EUTM relied upon by the opponent now enjoys protection in the UK as a comparable trade mark, the EUTM remains the relevant right in these proceedings. That is because the application for opposition was filed before the end of the transition period and, under the transitional provisions of the Trade Marks (Amendment etc.) (EU Exit) Regulations 2019, I am obliged to decide the matter on the basis of the rights as they existed at the date on which opposition proceedings were launched.

stockings; Lingerie, Including briefs, Brassieres, Vest tops, Pants (Am), Boxer shorts, Thongs; Lingerie, In particular for sport, Namely leg warmers, Bermuda shorts, Elasticated t-shirts, Sleepwear; Beach clothes and swimwear, Including bathing suits, Swimming trunks, Bath robes; Rainsuits.

4. The trade mark upon which the opponent relies qualifies as an earlier trade mark under section 6 of the Act. As this earlier trade mark had not been registered for more than five years at the date the application was filed, it is not subject to the proof of use provisions contained in section 6A of the Act.

5. The opponent is, as a consequence, entitled to rely upon its trade mark in relation to all of the goods indicated above without having to prove that it has made genuine use of it.

6. In its statement of grounds, the opponent claims that the marks at issue are highly similar visually and phonetically because they differ by only the initial letter/numeral “3” v “E”. It asserts that it is established practice that a capital letter ‘E’ is often replaced by the numeral ‘3’. It also asserts that the goods at issue are identical and similar. As such, the opponent states that there is a likelihood of confusion, which includes a likelihood of association, between the marks at issue and that the application should therefore be refused in its entirety under section 5(2)(b) of the Act.

7. The opponent also claims that it has made considerable use of its 3DWEAR mark since as early as 2014 and has acquired a substantial reputation throughout the UK and the European Union (EU). It claims that the contested mark will gain an unfair advantage and cause detriment to the reputation and distinctive character of its earlier mark if allowed to proceed to registration. Under the provisions of section 5(3) of the Act, the opponent submits that the contested mark be refused entirely.

8. The applicant filed a Form TM8 and counterstatement, denying the claims of the opponent and stating that its mark “is not a whimsical name creation by a brand marketer nor is it a copycat brand name which supposedly ‘seeks to ride on the coat tails’ on the reputation of the existing trademark 3DWEAR”. The applicant also stated that the mark EDWEAR was created by Ed Dunford, with the element ‘ED’ of the mark ‘EDWEAR being chosen to represent his name, “and also his own initials ED, then combined to the term ‘WEAR’ to give the brand a personal association”.

9. The applicant asserts that the letter 'E' is not related in any way visually or linguistically to the number '3'. It denies that it is established practice to replace a capital letter 'E' with the numeral '3' or vice-versa. It argues that the goods at issue have different target markets and that there would be no confusion between the marks at issue.

10. Neither party filed written submissions and only the opponent submitted evidence, in support of the section 5(3) ground and reputation of the earlier mark relied upon.

11. In these proceedings the opponent is represented by Stobbs IP Limited, whilst the applicant is unrepresented.

12. The applicant requested to be heard on this matter and that hearing took place before me, via video conference, on 27 May 2021. Mr Julius Stobbs represented the opponent at the hearing; Mr Richard Dunford represented the applicant.

Evidence

13. I will begin by assessing the evidence provided by the opponent in support of the claim under section 5(3), that it has a substantial reputation under the mark 3DWEAR in the UK.

14. The opponent's evidence comprises a witness statement of Rosanna Fabbiani, who states that she is the Managing Director at ERREA' SPORT S.p.A. The witness statement is dated 18 December 2020 and is accompanied by Exhibits RF1 – RF15.

15. Ms Fabbiani states that the opponent owns word and logo registrations for the 3DWEAR mark – information about these registrations is provided in Exhibit RF1. She states that the opponent enjoys a strong reputation in the 3DWEAR marks that it owns, throughout the EU and the UK specifically. She adds that the earlier mark relied upon has been in continuous use throughout the UK since its adoption in 2014. Ms Fabbiani also provides detailed history and background information about the opponent Errea' Sport.

16. I will briefly summarise the evidence and exhibits insofar as I deem it necessary to do so.

17. Much of the information provided by Ms Fabbiani in her witness statement and in the exhibits, relates to the opponent's primary brand name 'Errea' rather than to the mark 3DWEAR; and to the sponsorship of various sports teams in the UK by 'Errea'.

18. I note that there is no sign of, or reference to the mark relied upon in Exhibits RF2, RF4, RF5, RF6, RF7, RF8, RF9, RF11, RF12, RF14 or RF15.

19. In Exhibit RF3 there is some very limited use of the term '3DWEAR' on six pages of the opponent's website, however only one of these pages displays the sign in a manner other than simply as a line of text to denote the page header - 'ERREA 3DWEAR – Errea' and, other than the date '08/12/2020', which I assume is the date on which these pages were printed out for the purposes of this matter, this information is undated. On the few pages that are headed 'ERREA 3DWEAR – Errea', items of clothing are shown with prices in euros rather than pounds sterling.

20. In exhibit RF10 only a single undated page refers to the mark relied upon, with the goods under the mark being referred to as a 'technical underwear range'.

21. Exhibit RF13 provides a "Statement of Sale and Advertising volume from 2008 – 2012 for all countries", and a page showing turnover for the years 1998 – 2010 for the UK. This exhibit also shows that for the financial year 1 July 2015 – 30 June 2016, the turnover of the opponent in the UK was 7,425,388.49 euro, and that for the period 1 July 2017 – 30 June 2018, advertising expenditure of the opponent in the UK was 63,198.30 euro and the turnover was 7,672,899.97 euro. However, none of the sales figures refer to the mark relied upon or provide any breakdown into sales of the opponent's goods, to show the volume of sales of the 3DWEAR range of products.

22. Exhibit RF15 comprises a range of sales invoices between the years 2008 and 2017, showing sales of the opponent's goods in the UK, however none of these invoices make reference to the mark relied upon. Whilst the sales figures provided cannot be said to be insubstantial, they lack specificity and it is not possible to conclude whether, or to what extent, they relate to goods sold under the 3DWEAR brand.

Section 5(3)

23. Section 5(3) states:

“5(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

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

25. The relevant case law can be found in the following judgments of the Court of Justice of the European Union (CJEU): Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Addidas-Salomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows.:

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

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

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

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant

consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel*, paragraph 42

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel*, paragraphs 76 and 77 and *Environmental Manufacturing*, paragraph 34.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel*, paragraph 74.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV*, paragraph 40.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is

clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

Reputation

26. The contested application was filed on 05 December 2018. This is the relevant date in these proceedings and the date when I must decide whether the opponent's mark had the requisite reputation.

27. In *General Motors*, Case C-375/97, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.”

28. Based on the evidence before me, I conclude that the opponent has not demonstrated that it has acquired a reputation in the mark 3DWEAR within the EU. Much of the evidence does not refer at all to the earlier mark, focusing rather on the opponent's primary brand name 'ERREA'. What little evidence there is that does show use of the mark 3DWEAR is entirely lacking in information as to the number of products sold under the 3DWEAR brand, the revenue coming from sales of that brand name, geographical extent of the use of the mark in the EU, market share, or promotional and advertising information pertaining specifically to the 3DWEAR range of goods on offer by the opponent. I find that the earlier mark cannot be said to be known by a

significant part of the EU public concerned with the products or services covered by that trade mark.

29. As the opponent has not established that the earlier mark relied upon in these proceedings enjoys a reputation in the EU, the opposition, insofar as it is based on section 5(3) of the Act is dismissed.

Section 5(2)(b)

30. The opposition is also based upon section 5(2)(b) of the Act, which reads as follows:

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

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

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.”

31. As noted above, the opponent’s earlier mark qualifies as an earlier trade mark under the provisions of section 6 of the Act

32. 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 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

33. The competing goods are set out above in paragraph 3 (earlier goods) and in the Annex to this decision (contested goods).

34. In the judgment of the CJEU in *Canon*, Case C-39/97, the Court stated at paragraph 23:

“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”.

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

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

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

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

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

36. 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 fur Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

37. I note that the earlier mark relied upon by the opponent includes the broad terms ‘clothing for men, women and children’; ‘footwear’ and ‘headgear’ under its registration. Applying the principle established in *Merici* I find that all of the applicant’s contested goods, with the exception of ‘Football boots (Studs for -); Studs for football boots’, being finished articles of clothing, footwear or headgear, are wholly encompassed within the broader terms of the earlier mark and can therefore be said to be identical.

38. With regard to the contested ‘Football boots (Studs for -); Studs for football boots’, I note that the opponent’s earlier registration includes ‘Sports shoes, including shoes for football, five-a-side football, volleyball, rugby, basketball, tennis, skiing, cycling, golf, baseball, spinning, running, gymnastics and exercise in general’. I find these goods to be complementary, in the sense that the manufacturer of a football shoe or boot is also likely to produce the studs which are intended to be fitted to that footwear. The studs are important and indispensable to the football shoe and vice versa, and are likely to be provided by the same undertaking. They are also likely to be retailed in the same areas and channels of trade will be shared. These goods are therefore similar to a low degree.

The average consumer and the nature of the purchasing process

39. 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 such 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.”

40. In *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03, the GC stated that:

“49. However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (BUDMEN, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumer choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs.”

And

“50..... 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.”

41. The average consumer of the goods at issue in class 25 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.


42. When selecting the goods at issue, the average consumer will be alive to factors such as cost, size, colour, material and compatibility with other items. As a consequence, they can, in my view, be expected to pay at least a normal (medium) degree of attention to their selection.

Comparison of trade marks

43. 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*:

“.....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.”

44. 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 competing trade marks are as follows:

The opponent's trade mark	The applicants' trade marks
<p>3DWEAR</p>	

45. The opponent's trade mark comprises the expression "3DWEAR" presented in upper case letters in a standard typeface. The '3D' component and the 'WEAR' component will be readily perceived, however, as no part of the trade mark is highlighted or emphasised in any way, those elements combine to form a unit, with neither component dominating. The overall impression the earlier mark conveys lies in the single term of which it is composed.

46. The contested application consists of a series of two marks however each series appears to contain five versions of the EDWEAR mark. It was established during the hearing that the applicant had intended to apply for ten marks but, as an unrepresented applicant with no prior knowledge of the IP system or the application process, it seems that an error was made during the filing of the application. It appears that the applicant intended to file ten marks, five showing the 'EDWEAR' mark in upper case and with a variety of backgrounds and five with the mark 'Edwear' in capital and lower-case lettering on the same backgrounds.

47. During the hearing Mr Stobbs and I agreed that whilst this technicality could not be overlooked, it did not, on the face of it, materially affect the comparison that I am required to make between the marks at issue. For example, when considering the aural similarities between the marks at issue later in this decision, I do not intend to suggest that the contested mark would be articulated five times.

48. The contested marks are comprised essentially of the word 'EDWEAR'. The backgrounds of each of the ten marks can be said to be quite basic and of no great weight when considering the distinctiveness of the marks. The dominant and distinctive elements in all of the contested marks is the word EDWEAR.

49. I bear the above conclusions in mind for the purposes of the following comparisons. For simplicity, I will approach the issue of similarity between the marks based upon the single word EDWEAR and I will discuss the implications of this later in the decision.

Visual similarity

50. The marks at issue share the letters 'DWEAR' which form the ending of each mark. The marks differ in their beginnings, as the earlier mark starts with the numeral '3' whilst the contested marks begin with the letter 'E'. The marks also differ visually in the stylised aspects of the contested marks, which are not found in the plain word earlier mark. As the words forming these marks will be read from left to right, the differences between the initial elements, particularly as one is a numeral, which in and of itself is somewhat unusual, plays a significant role in the visual impact of each mark. As such I consider there to be a medium degree of visual similarity between the competing trade marks.

Aural similarity

51. It is possible that the contested mark may be pronounced in two ways, however it is most likely, in my opinion, that it will be articulated in two syllables: *ED/WEAR*.

52. I note that the applicant has suggested that as the mark was created based upon the personal name Ed Dunford and the initials thereof, that the mark may be pronounced in three syllables: *EE/DEE/WEAR*. I reject this suggestion however, as I find that the average consumer is not used to breaking down words in this way. For example, it might be possible to articulate the word UNUSUAL as U-N-USUAL, but it is highly likely that this would occur. It is not relevant for the purposes of these proceedings to understand how the mark came to be created, as the average consumer of the goods in issue would have no knowledge of this.

53. The earlier mark will be pronounced in three syllables as: *THREE/DEE/WEAR*.

54. As the contested mark will, in my opinion, be pronounced as *ED/WEAR*, the marks at issue share the same final sound only, resulting in a low degree of aural similarity.

Conceptual similarity

55. As has been established above, and taking note of the guidance in *Sabel v Puma*, it is important not to dissect a trade mark artificially for the purposes of comparison. However, it is also important to consider whether there are elements within a mark that convey a meaning to the average consumer. In this instance both marks contain the word 'WEAR' which is a common word that will be readily understood, not least because of the nature of the goods at issue. This element of the marks conveys the concept of something that will be worn on the body.²

56. The initial part of the earlier mark will be perceived by the average consumer as the term 3D, which has a clear meaning.³ The term conveys the message of something that is three dimensional. Due to this widely understood meaning, the average consumer will appreciate it as a whole and will not, as a matter of course, breakdown this aspect of the mark into the two components '3' and 'D'. The concept conveyed by the term 3D is not shared by the contested mark.

57. The element 'ED' that forms the beginning of the contested mark may be perceived as the common English forename 'Ed' being a well-known shortening of the common male forenames Edward and Edmund and also used as a full name in its own right. This perception of that element will convey a message about a person named Ed. It is also possible however, that the element ED in the contested mark will be perceived as simply the initial part of a single invented word 'EDWEAR' rather than an element which is naturally distinct from the word 'WEAR'.

58. I find that whilst the marks at issue share the concept of 'WEAR', this element is relatively weak due to the non-distinctive and descriptive nature of the word within the context of the goods at issue. I find that both marks form a unit in the sense that the average consumer will appreciate the earlier mark as conveying a message about three dimensional products for wear. I find that the contested mark, taken as a whole,

² <https://www.collinsdictionary.com/dictionary/english/wear>

³ <https://www.lexico.com/en/definition/3D>

might be perceived in one of two ways, the first being an invented single word, and the second describing products to be worn that come from a person called Ed.

59. As the only shared concept between the marks at issue is the relatively non-distinctive term 'WEAR', and as the overriding concepts of each mark are quite different to the other, I find them to be conceptually similar to only a low degree.

Distinctive character of the earlier trade mark

60. The distinctive character of a trade mark can be appraised only by reference to the goods in respect of which registration is sought and 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.

61. Whilst the word 'WEAR' in the earlier mark will likely be perceived as indicative of a characteristic of the goods at issue, its combination with the element 3D, suggests that, in the context of the goods in class 25, the average consumer is likely to treat it as an allusive or fanciful expression. The evidence provided by the opponent has been found to be insufficient to establish a reputation in the earlier mark in the EU. As the evidence provided almost no information relating to use of the mark in the UK, I find that the opponent cannot be said to enjoy an enhanced degree of distinctiveness in its mark. I find that the earlier mark can be said to be inherently distinctive to a medium degree.

Likelihood of confusion

62. 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.

63. 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.

64. Earlier in this decision I concluded that the majority of the competing goods are identical and that some were similar to a low degree, and that the opponent's earlier trade mark has a medium degree of inherent distinctive character. I further concluded that, for the average consumer, paying at least a normal or medium degree of attention, the competing trade marks are visually similar to a medium degree, aurally similar to a low degree and conceptually similar to a low degree.

65. In *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, the GC noted that the beginnings of words tend to have more visual and aural impact than the ends.

66. Having considered carefully all of the above, I am satisfied that the visual differences between the competing trade marks, occurring as they do at the beginnings of the marks, combined with the differing conceptual impacts of each mark, are sufficient to rule out a likelihood of direct confusion.

67. In this instance, the beginnings of the marks are obvious and will be immediately perceived. The use of a numeral as the first letter of a word is unusual. This is a different issue to that made by the opponent regarding the 'common practice' of replacing a letter 'E' with a numeral '3', a claim that the applicant has denied to be the case, and which, absent evidence, I also reject. The additional impact of the concept of something 3D in the earlier mark, ensures, I believe, that these marks will not be mistaken for the other.

68. As I have found that direct confusion will not occur, I now move on to consider the possibility 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.”

69. Mr Purvis also stated in *L.A. Sugar*:

“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”).

70. It cannot be said to be the case that the common element ‘WEAR’ is strikingly distinctive or that the average consumer would only assume one undertaking would wish to use that term in a trade mark. In fact, I have found the opposite to be the case. The word ‘Wear’ is non-distinctive within the context of the goods at issue.

71. Equally, I do not accept that the use in the contested mark of the element ‘ED’ in place of the ‘3D’ aspect of the earlier mark would be considered an obvious brand extension or sub-brand of the opponent’s ‘3DWEAR’ brand.

72. Whilst the categories set out above by Mr Purvis are not exhaustive, I find no reason why the average consumer of the opponent’s ‘3DWEAR’ branded goods would, when exposed to the contested mark, assume that those goods came from the same or an economically linked undertaking, or vice-versa.

73. 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 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.

74. In this instance I find the initial visual differences combined with the different aural impressions and the significance of the conceptual impact of the term 3D, sufficient to make it highly unlikely that one of the marks at issue would call to mind the other, however, in the event that this was to occur, this would be no more than mere association and not indirect confusion.

75. For the sake of completeness, I return briefly to the issue set out above in paragraphs 46-49. I have compared the marks at issue on the basis that the contested mark comprises the single term ‘EDWEAR’. If I were to compare the earlier mark 3DWEAR against the contested marks comprising a series of 2 marks, each containing 5 versions of the word EDWEAR, this would clearly result in an even lower

level of similarity between the marks and, as a result, a likelihood of confusion is even less likely to exist.

76. As I have found that neither direct nor indirect confusion will occur, the opposition insofar as it is based on section 5(2)(b) fails.

Conclusion

77. The opposition has failed on both grounds and therefore, subject to any successful appeal, the application will proceed to registration.

Costs

78. The applicant has been successful and would normally be entitled to a contribution towards its costs in accordance with the scale of costs published in Tribunal Practice Notice 2/2016. As a matter of practice, litigants in person are asked to complete a costs proforma. The purpose of this is to ensure that the costs awarded do not exceed the amount spent on the proceedings. The applicant was sent a blank costs pro-forma on 6 March 2021 however it did not submit a completed claim and therefore, I make no award of costs.

Dated this 30th day of June 2021

ANDREW FELDON

For the Registrar

ANNEX – Contested goods

Class 25: Bandanas; Baseball caps; Baseball caps and hats; Baseball hats; Baselayer bottoms; Baselayer tops; Basketball sneakers; Bath robes; Bathrobes; Beach clothes; Beach clothing; Beach hats; Beachwear; Beanie hats; Beanies; Belts [clothing]; Belts for clothing; Belts made from imitation leather; Belts made of leather; Belts made out of cloth; Belts (Money -) [clothing]; Belts of textile; Bermuda shorts; Blazers; Blouses; Blouson jackets; Blousons; Blue jeans; Board shorts; Boardshorts; Bobble hats; Bomber jackets; Boots; Boots for sport; Boots for sports; Bottoms [clothing]; Boxer briefs; Boxer shorts; Boxing shorts; Boy shorts [underwear]; Boys' clothing; Briefs; Briefs [underwear]; Bucket caps; Bucket hats; Button down shirts; Button-front aloha shirts; Corduroy pants; Corduroy shirts; Corduroy trousers; Cotton coats; Crew neck sweaters; Cycling caps; Ear muffs; Ear muffs [clothing]; Ear warmers; Earbands; Earmuffs; Espadrilles; Esparto shoes or sandals; Esparto shoes or sandals; Evening coats; Evening suits; Evening wear; Exercise wear; Fabric belts; Fabric belts [clothing]; Fashion hats; Fedoras; Fishermen's jackets; Fishing jackets; Flat caps; Flat shoes; Fleece jackets; Fleece pullovers; Fleece tops; Fleeces; Flip-flops; Flip-flops for use as footwear; Football boots; Football boots (Studs for -); Football jerseys; Football shirts; Footwear; Footwear [excluding orthopedic footwear]; Footwear for men; Footwear for men and women; Footwear for snowboarding; Footwear for sport; Footwear for sports; Footwear for track and field athletics; Footwear for use in sport; Footwear for women; Footwear made of vinyl; Footwear not for sports; Gilets; Gloves; Gloves as clothing; Gloves [clothing];Gloves for apparel; Golf caps; Golf clothing, other than gloves; Golf footwear; Golf pants, shirts and skirts; Golf shirts; Golf shoes; Golf shorts; Golf trousers; Gym shorts; Gymwear; Hats; Head bands; Head scarves; Head sweatbands; Head wear; Headbands; Headbands against sweating; Headbands [clothing]; Headbands for clothing; Headgear; Headgear for wear; Hooded pullovers; Hooded sweat shirts; Hooded sweatshirts ;Hooded tops; Hoodies; Jackets; Jackets being sports clothing; Jackets [clothing];Jackets (Stuff -) [clothing]; Jeans; Jerseys; Jerseys [clothing];Jogging bottoms; Jogging bottoms [clothing]; Jogging outfits; Jogging pants; Jumpers; Jumpers [pullovers]; Jumpers [sweaters]; Jumpsuits; Khakis; Knit jackets; Knit tops; Knitted tops; Knitwear; Knitwear [clothing]; Men's and women's jackets, coats, trousers, vests; Men's clothing; Men's socks; Men's suits; Men's underwear;

Menswear; Moisture-wicking sports pants; Moisture-wicking sports shirts; Money belts [clothing]; Neckscarves; Neck tubes; Neckerchiefs; Neckerchieves; Neckties; Neckwear; Nightwear; Outer clothing; Outerclotthing; Outerclotthing for boys; Outerclotthing for men; Outerwear; Overcoats; Overshirts; Padded jackets; Padded pants for athletic use; Pajama bottoms; Pajamas; Pants (Am.); Parkas; Pea coats; Peaked caps; Peaked headwear; Plimsolls; Polar fleece jackets; Polo sweaters; Printed t-shirts; Pullovers; Pyjamas; Quilted jackets [clothing]; Rain hats; Rain jackets; Rain suits; Rain trousers; Rain wear; Raincoats; Rainproof clothing; Rainproof jackets; Rainwear; Ready-to-wear clothing; Reversible jackets; Roll necks [clothing]; Rugby boots; Rugby jerseys; Rugby shirts; Rugby shoes; Rugby shorts; Rugby tops; Sarongs; Scarfs; Scarves; Shell jackets; Shell suits; Shirts; Shoes; Shoes for casual wear; Shoes for leisurewear; Shoes with hook and pile fastening tapes; Shorts; Shorts [clothing]; Short-sleeve shirts; Short-sleeved shirts; Short-sleeved T-shirts; Silk clothing; Silk scarves; Silk ties; Singlets; Ski balaclavas; Ski hats; Ski jackets; Ski wear; Sleeved jackets; Sleeveless jackets; Sleeveless jerseys; Sleeveless pullovers; Slip-on shoes; Sneakers [footwear]; Snoods [scarves]; Snowboard jackets; Soccer shirts; Socks; Socks for men; Sport coats; Sport shirts; Sport shoes; Sports caps; Sports caps and hats; Sports clothing; Sports clothing [other than golf gloves]; Sports footwear; Sports headgear [other than helmets]; Sports jackets; Sports jerseys; Sports jerseys and breeches for sports; Sports shirts; Sports shirts with short sleeves; Sports shoes; Sports singlets; Sports socks; Sports vests; Sports wear; Sportswear; Studs for football boots; Suede jackets; Sun visors; Sun visors [headwear]; Surf wear; Surfwear; Sweat bands; Sweat bands for the head; Sweat bands for the wrist; Sweat bottoms; Sweat jackets; Sweat pants; Sweat shirts; Sweat shorts; Sweat suits; Sweat-absorbent socks; Sweatbands; Sweaters; Sweatjackets; Sweatpants; Sweatshirts; Sweatshorts; Sweatsuits; Swim briefs; Swim shorts; Swim suits; Swim trunks; Swim wear for gentlemen and ladies; Swimming trunks; Swimwear; Tank tops; Tank-tops; Tee-shirts; Thermal clothing; Thermal headgear; Thermal socks; Thermal underwear; Thermally insulated clothing; Thong sandals; Three piece suits [clothing]; Ties; Ties [clothing]; Track and field shoes; Track jackets; Track pants; Track suits; Tracksuit bottoms; Tracksuit tops; Tracksuits; Trainers; Trainers [footwear]; Training shoes; Training suits; Trousers; Trunks (Bathing -); Trunks [underwear]; T-shirts; Turtleneck pullovers; Turtleneck sweaters; Underwear; Vest tops; Vests; Visors; Visors [headwear]; V-neck sweaters; Warm up suits; Warm-up jackets; Warm-up pants;

Warm-up suits; Warm-up tops; Waterproof clothing; Waterproof jackets; Waterproof outerclothing; Waterproof pants; Waterproof suits for motorcyclists; Waterproof trousers; Water-resistant clothing; Weather resistant outer clothing; Weatherproof clothing; Weatherproof jackets; Weatherproof pants; Wet suits; Wet suits for surfing; Wet suits for water-skiing; Wet suits for water-skiing and sub-aqua; Wet suits for windsurfing; Wetsuits; Wetsuits for surface watersports; Wetsuits for surfing; Wetsuits for water-skiing; Wind resistant jackets; Windcheaters; Wind-jackets; Windproof clothing; Windproof jackets; Wind-resistant jackets; Winter boots; Winter coats; Winter gloves; Woolen clothing; Woollen socks; Woolly hats; Woven clothing; Woven shirts; Wrist bands; Wrist warmers; Wristbands; Wristbands [clothing]; Aloha shirts; American football shirts; Ankle boots; Ankle socks; Anklets [socks]; Anoraks; Anoraks [parkas]; Articles of clothing; Articles of clothing made of leather; Articles of outer clothing; Articles of sports clothing; Articles of underclothing; Athletic clothing; Athletic footwear; Cap visors; Caps; Caps being headwear; Caps [headwear]; Caps with visors; Cargo pants; Cashmere clothing; Casual clothing; Casual footwear; Casual jackets; Casual shirts; Casual trousers; Casual wear; Casualwear; Children's headwear; Children's wear; Clothes; Clothes for sport; Clothes for sports; Clothing; Clothing for men, women and children; Clothing for sports; Clothing made of imitation leather; Clothing made of leather; Clothing of imitations of leather; Clothing of leather; Coats; Coats for men; Coats made of cotton; Coats of denim; Coats (Top -); Collared shirts; Deck shoes; Deck-shoes; Denim coats; Denim jackets; Denim jeans; Denim pants; Denims [clothing]; Desert boots; Dinner jackets; Dinner suits; Down jackets; Down vests; Dressing gowns; Duffel coats; Duffle coats; Dungarees; Dust coats; Leisure clothing; Leisure footwear; Leisure shoes; Leisure suits; Leisure wear; Leisurewear; Light-reflecting coats; Light-reflecting jackets; Linen clothing; Long jackets; Long sleeve pullovers; Long-sleeved shirts; Lounge pants; Loungewear.