

O-1028-22

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO. UK3587154

IN THE NAME OF BRAND CONSCIENCE LTD IN RESPECT OF THE SERIES OF  
TRADE MARKS

**SUS'D**

**sus'd**

IN CLASSES 18 & 25

AND THE APPLICATION FOR A DECLARATION OF INVALIDITY THERETO  
UNDER NO. 504442

By Esprit International

## **BACKGROUND AND PLEADINGS**

1. UK Registration No. 3587154 stands in the name of Brand Conscience Ltd (“the Registered Proprietor”). The series of marks as shown on the cover page of this decision, was filed by the Registered Proprietor on 29 January 2021. The registration date for the marks was 4 June 2021. The goods as registered are as follows:

Class 18: Leather cloth; Cloth bags.

Class 25: Clothing; Clothes; Wristbands [clothing]; Tops [clothing]; Knitted clothing; Oilskins [clothing]; Motorcyclists' clothing; Hoods [clothing]; Leisure clothing; Infant clothing; Children's clothing; Childrens' clothing; Sports clothing; Leather clothing; Gloves [clothing]; Waterproof clothing; Plush clothing; Girls' clothing; Swaddling clothes; Knitwear [clothing]; Cloth bibs; Cyclists' clothing; Playsuits [clothing]; Slipovers [clothing]; Jerseys [clothing]; Weatherproof clothing; Casual clothing; Denims [clothing]; Combinations [clothing]; Furs [clothing]; Shorts [clothing]; Collars [clothing]; Babies' clothing; Ties [clothing]; Outer clothing; Cashmere clothing; Bandeaux [clothing]; Women's clothing; Bodies [clothing]; Embroidered clothing; Layettes [clothing]; Jackets [clothing]; Kerchiefs [clothing]; Chaps (clothing); Maternity clothing; Thermal clothing; Belts [clothing]; Muffs [clothing]; Capes (clothing); Motorists' clothing; Slips [clothing]; Athletic clothing.

2. On 16 December 2021, Esprit International (“the Cancellation Applicant”) filed an application for invalidation against all of the above goods under section 5(2)(b) of the Trade Marks Act 1994 (the Act). Section 5(2)(b) is relevant in invalidation proceedings under section 47(2) of the Act. The application for invalidation under section 5(2)(b) is on the basis of the following mark and goods.

### **UK918272466**

Mark: SUSIE T.

Filing date: 14 July 2020

Registration date: 11 December 2020

Relying on some of the goods for which the mark is registered namely:

Class 25: Clothing, footwear, headgear; clothing for men, women and children; outer clothing; formal wear; casual wear; leisure wear; sportswear; waterproof wear; rainwear; suits, waistcoats, coats, overcoats, parkas, jackets, vests, windbreakers, tops for wear, blouses, shirts, t-shirts, polo shirts, sweatshirts, sport shirts, golf shirts, rugby shirts, tunics, camisoles, jogging suits, snow suits, knitwear, jerseys (clothing), sweaters, pullovers, cardigans, trousers, jeans, pants, slacks, sweat pants, shorts, dresses, skirts, culottes, socks, leggings, stockings, tights; sleepwear, pyjamas, nightshirts, nightgowns, dressing gowns; bathrobes; swim wear, bathing suits, bathing trunks, bathing drawers, beach clothes; hosiery; women's lingerie, brassieres, panties, slips; underwear; costume; uniforms; smocks; scarves, pelerines, shawls; hats, caps, toques, sunvisors; ear-muffs; neckties; gloves (clothing); belts (clothing); sweat bands, headbands (clothing), wristbands; trouser straps; footwear for ordinary use and for use in sport, boots, sneakers, loafers, shoes, leisure shoes, sandals, slippers; shoes and footwear for golf; all included in Class 25.

3. In the statement of grounds the Cancellation Applicant claims that marks share the first three letters 'SUS' so they are visually similar. It further adds that different possible pronunciations means that they are phonetically similar. The Cancellation Applicant argues that the marks cannot be compared conceptually as neither mark has any meaning. It adds that the goods are identical.

4. In response, the Registered Proprietor denied that there was a likelihood of confusion between the marks. It put forward the position that the earlier mark is a girl's name whereas its own mark is an abbreviation of sussed or play on the word 'sustainability' and so the meanings are completely different. It argues that the earlier mark is 3 syllables compared to their mark being 1 syllable, with 8 characters vs 5 characters in each mark. It says these differences make the marks visually very different. It also claims that the marks sound completely different when read aloud.

5. Neither party provided evidence in these proceedings. Both parties filed submissions and no hearing was requested so this decision is taken following a careful perusal of the papers before me.

6. The Registered Proprietor is unrepresented and the Cancellation Applicant is represented by Cam Trade Marks & IP Services.

7. 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 Trade Marks 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.

#### **Section 47:**

8. Section 47 of the Act states as follows:

“47. –

(1) [...]

(2) The registration of a trade mark may be declared invalid on the ground –

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) [...]

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2A) But the registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if –

(a) within the period of five years ending with the date of the application for the declaration the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) For these purposes –

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(2D) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (2B) or (2C) to the United Kingdom shall be construed as a reference to the European Union.

(2E) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the

purposes of this section as if it were registered only in respect of those goods or services.

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c)

(3) An application for a declaration of invalidity may be made by any person, and may be made either to the registrar or to the court, except that-

(a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and

(b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(4) In the case of bad faith in the registration of a trade mark, the registrar himself may apply to the court for a declaration of the invalidity of the registration.

(5) Where the grounds of invalidity exists in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made.

Provided that this shall not affect transactions past and closed.”

9. The trade mark upon which the opponent relies qualifies as an earlier trade mark because it was applied for at an earlier date than the contested marks pursuant to section 6 of the Act. The earlier mark is not subject to the proof of use requirements pursuant to section 6A of the Act. This is because it had not completed its registration processes more than 5 years before the filing date of the mark in issue. The opponent can, therefore, rely upon all of the goods for which its mark is registered.

## Section 5(2)(b)

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

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

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

## Case law

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

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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



- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

## **Comparison of goods**

12. Section 60A of the Act provides:

“(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the “Nice Classification” means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975.”

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

“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”.

14. 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.

15. In *Gérard Meric v Office for Harmonisation in the Internal Market (OHIM)* ('Meric'), Case T-133/05, the General Court ("the GC") stated that:

"29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut 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".

16. For the purposes of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

17. The Parties' respective specifications are:

Registered Proprietor's Goods	Cancellation Applicant's Goods
<p>Class 18: Leather cloth; Cloth bags.</p> <p>Class 25: Clothing; Clothes; Wristbands [clothing]; Tops [clothing]; Knitted clothing; Oilskins [clothing]; Motorcyclists' clothing; Hoods [clothing]; Leisure clothing; Infant clothing; Children's clothing; Childrens' clothing; Sports clothing; Leather clothing; Gloves [clothing]; Waterproof clothing; Plush clothing; Girls' clothing; Swaddling clothes; Knitwear [clothing]; Cloth bibs; Cyclists' clothing; Playsuits [clothing]; Slipovers [clothing]; Jerseys [clothing]; Weatherproof clothing; Casual clothing; Denims [clothing]; Combinations [clothing]; Furs [clothing]; Shorts [clothing]; Collars [clothing]; Babies' clothing; Ties [clothing]; Outer clothing; Cashmere clothing; Bandeaux [clothing]; Women's clothing; Bodies [clothing]; Embroidered clothing; Layettes [clothing]; Jackets [clothing]; Kerchiefs [clothing]; Chaps (clothing); Maternity clothing; Thermal clothing; Belts [clothing]; Muffs [clothing]; Capes (clothing); Motorists' clothing; Slips [clothing]; Athletic clothing.</p>	<p>Class 25: Clothing, footwear, headgear; clothing for men, women and children; outer clothing; formal wear; casual wear; leisure wear; sportswear; waterproof wear; rainwear; suits, waistcoats, coats, overcoats, parkas, jackets, vests, windbreakers, tops for wear, blouses, shirts, t-shirts, polo shirts, sweatshirts, sport shirts, golf shirts, rugby shirts, tunics, camisoles, jogging suits, snow suits, knitwear, jerseys (clothing), sweaters, pullovers, cardigans, trousers, jeans, pants, slacks, sweat pants, shorts, dresses, skirts, culottes, socks, leggings, stockings, tights; sleepwear, pyjamas, nightshirts, nightgowns, dressing gowns; bathrobes; swim wear, bathing suits, bathing trunks, bathing drawers, beach clothes; hosiery; women's lingerie, brassieres, panties, slips; underwear; costume; uniforms; smocks; scarves, pelerines, shawls; hats, caps, toques, sunvisors; ear-muffs; neckties; gloves (clothing); belts (clothing); sweat bands, headbands (clothing), wristbands; trouser straps; footwear for ordinary use and for use in sport, boots, sneakers, loafers, shoes, leisure shoes, sandals, slippers; shoes and footwear for golf; all included in Class 25.</p>

### *Leather cloth*

18. I consider that the above is a material and constituent elements which could be intended to be used within the clothing manufacturing process. These goods are piece materials rather than the finished article.

19. The earlier good 'clothing' refers to the finished articles of clothing that may be constructed using the contested goods. These goods are intended for sale to the general public or as wholesale. I am reminded of the case of *Les Éditions Albert René v OHIM*, Case T-336/03, where the GC found that:

“61... The mere fact that a particular good is used as a part, element or component of another does not suffice in itself to show that the finished goods containing those components are similar since, in particular, their nature, intended purpose and the customers for those goods may be completely different.”

20. Although 'leather cloth' might be used in the production of the final garment, I do not find them similar as the respective uses and user of the two items would be very different. The trade channels would also differ. There might be a small overlap in physical nature where the materials are the same but the construction will likely differ. These goods are far more likely to be purchased wholesale to be used in the production of a finished article, which would then be on sale to the general public. Even though the contested goods might be used in the production of the finished articles, I do not find there to be complementarity here as I believe the average consumer will believe the goods to come from differing entities. I therefore find these goods to be dissimilar to the Cancellation Applicant's goods.

### *Cloth bags*

21. I have considered the case law which indicates that 'clothing' found in class 25 and clothing accessories which complement them such as handbags, purses and

wallets, are similar where the intention is to create a coordinated look.<sup>1</sup> The 'cloth bags' included in the Registered Proprietor's specification would not be the kind of accessories that would be purchased in order to create a co-ordinated look. There may be an overlap in trade channels and the average consumer might realistically expect cloth bags to be for sale in the same retail establishments as other clothing items and accessories. I do not believe them to be in competition nor complementary. I therefore find these goods to be similar to a low degree.

*Clothing; Clothes; Wristbands [clothing]; Tops [clothing]; Knitted clothing; Oilskins [clothing]; Motorcyclists' clothing; Hoods [clothing]; Leisure clothing; Infant clothing; Children's clothing; Childrens' clothing; Sports clothing; Leather clothing; Gloves [clothing]; Waterproof clothing; Plush clothing; Girls' clothing; Swaddling clothes; Knitwear [clothing]; Cloth bibs; Cyclists' clothing; Playsuits [clothing]; Slipovers [clothing]; Jerseys [clothing]; Weatherproof clothing; Casual clothing; Denims [clothing]; Combinations [clothing]; Furs [clothing]; Shorts [clothing]; Collars [clothing]; Babies' clothing; Ties [clothing]; Outer clothing; Cashmere clothing; Bandeaux [clothing]; Women's clothing; Bodies [clothing]; Embroidered clothing; Layettees [clothing]; Jackets [clothing]; Kerchiefs [clothing]; Chaps (clothing); Maternity clothing; Thermal clothing; Belts [clothing]; Muffs [clothing]; Capes (clothing); Motorists' clothing; Slips [clothing]; Athletic clothing.*

22. I find all of the Registered Proprietor's class 25 goods as above would be identical to the Cancellation Applicant's class 25 specification either because they appear in both specifications or because they are identical under the *Meric* principles.

23. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

"49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be

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<sup>1</sup> *Gitana v OHIM*, Case T-569/11 and *El Corte Ingles v OHIM*, Case T-443/05

considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.”

24. Therefore, as I have found no similarity for the Registered Proprietor’s ‘Leather cloth’ the opposition fails in relation to it. The opposition will continue in respect of the applicant’s class 25 goods and ‘Cloth bags’ in Class 18.

### **Average consumer and the purchasing act**

25. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

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

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

27. The average consumer of the goods will predominantly be the general public.

28. The selection of such goods is largely a visual process, as the average consumer (general public) will wish to physically handle the goods to ensure the correct size has been selected, whilst simultaneously appraising the overall aesthetic impact. I do not, however, ignore the potential for the marks to be spoken, for example, by sales

assistants in a retail establishment or when making a purchase from a catalogue, over the telephone. However, in the latter circumstances, the consumer will have had an opportunity to view the goods, perhaps electronically via an online catalogue or website, or on paper in the traditional sense of catalogue shopping. Therefore, when considering the aural impact of the marks, the visual impression of these goods will already have played a part in the consumer's mind.

29. Although the prices of individual items will vary greatly, I consider that the average consumer will pay at least a medium degree of attention (but not the highest level) during the purchase of the remaining goods.

### **Comparison of the marks**

30. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The 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.”

31. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

32. The respective trade marks are shown below:

Earlier mark	Contested marks
SUSIE T.	SUS'D  sus'd

33. The contested marks are a series of plain word marks which consist of one word that appears to be a contraction using an apostrophe in the middle. The overall impressions lie in the word itself.

34. The earlier mark is a plain word mark consisting of one word, most likely a name and a letter/initial followed by a full stop. I believe the overall impression lies within the mark as a whole.

35. I will now consider the visual comparison of the marks. I remind myself of the comments of Mr Iain Purvis QC, sitting as the Appointed Person in *Groupement Des Cartes Bancaires v China Construction Bank Corporation*, case BL O/281/14, who said that:

“It is well established that a ‘word mark’ protects the word itself, not simply the word presented in the particular font or capitalization which appears in the Register of Trade Marks.....A word may therefore be presented in a different way (for example a different font, capitals as opposed to small letters, or handwriting as opposed to print) from that which appears in the Register whilst remaining ‘identical’ to the registered mark.”

36. I therefore acknowledge that the marks at hand may be presented in any font, size, or combination of upper and lower-case fonts.



37. The earlier mark consists of a word made up of five letters followed by a single letter and full stop. The contested marks contain 3 letters, an apostrophe and a further letter. Both marks begin with the letters 'SUS' presented in that order. However, the earlier mark then contains a further two letters as part of that word being 'IE' followed by 'T.' which is presented like an initial. The contested marks are presented as one word with 'd' on the end as if the word is a contraction. I find that the beginning of the marks are identical but the end of the marks are fairly different and therefore, I find them to be visually similar to a medium degree.

38. I note the different pronunciations of the marks put forward by both parties. For the earlier mark, I feel that this will be pretty straightforward and that 'Susie' will be given its ordinary pronunciation- *sooz/ee* followed by '*tee*'. This will be three syllables. The contested marks I believe will be pronounced *sussed* and is one syllable. The overlap between the marks is likely to be the beginning 'ess' sound but I cannot see any further overlap. Therefore, I find them to be aurally similar to a low degree.

39. Conceptually, I do not believe the Cancellation Applicant is correct in stating that neither mark has a concept that the average consumer would understand therefore making a comparison is not possible. I believe the average consumer will see the earlier mark as being a woman's forename followed by an initial, which would either be for a middle name or surname. For the contested marks, I note the meanings put forward by the Registered Proprietor, being an abbreviation of *sussed* or play on the word 'sustainability'. I consider the first to be something that the average consumer might understand the mark to be but not the second option. I believe the comments made by Phillip Harris, as the Appointed Person in *Retail Royalty Company v Harringtons Clothing Limited O/593/20* might be appropriate here:

"75. In contrast conceptual meaning is, in simple terms, something akin to recognition in dictionaries (beyond a mere trademark acknowledgement) or a level of immediately perceptible notoriety/independent meaning, outside the confines of a purely trade mark context, of which judicial notice can be taken..."

40. I believe the mark being a play on the word 'sustainability' might not be the immediately perceptible meaning that the average consumer thinks of. I therefore consider the conceptual meanings are clearly different and I therefore find them to be conceptually dissimilar.

### **Distinctive Character of the Earlier Marks**

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

42. The Cancellation Applicant made no claim and put forward no evidence relating to an enhanced level of distinctiveness of their earlier marks. I will therefore consider the position based solely on its inherent distinctiveness.

43. The mark comprises of a word followed by one letter/initial. The mark appears to be a female name which could be fairly common. It is also not unusual to use an initial to differentiate between people with the same first name. The words are not invented and therefore I find them to be inherently distinctive to a medium degree.

### **Likelihood of Confusion**

44. There are two types of confusion that I must consider. Firstly, direct confusion i.e. where one mark is mistaken for the other. The second is indirect confusion which is where the consumer appreciates that the marks are different, but the similarities between the marks lead the consumer to believe that the respective goods or services originate from the same or a related source.

45. In *L.A. Sugar Limited v 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.

46. I have come to the conclusions above that the marks at issue are visually similar to a medium degree; aurally similar to a low degree; and conceptually dissimilar and the average consumer would pay at least a medium degree of attention. The remaining goods at issue have been found to be between identical and similar to a low degree.

The earlier marks are inherently distinctive to a medium degree. I found the overall impression of both series of marks was in the words themselves.

47. I note the beginning three letters of the marks are identical however in *CureVac GmbH v OHIM*, T-80/08 it was determined that this was not always a decisive matter in the finding of a likelihood of confusion. I actually consider that the differences in the concepts of the mark to be the most important element here. In *The Picasso Estate v OHIM*, Case C-361/04 P, the CJEU found that:

“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.”

48. I find that the marks at issue have such different conceptual meanings that this will counteract any visual similarities that the marks may have, on top of the fact I have found the ends of the marks to be very different. Even where the goods are identical, I believe that the average consumer will recall the differences, in particular noting the conceptual differences and therefore I find there to be no direct confusion.

49. I will now go on to consider the possibility of indirect confusion. Again, I take guidance from Mr Purvis in *L.A. Sugar Limited* where he stated:

“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”).

50. These examples are not exhaustive but provide helpful focus as was confirmed by Arnold LJ in *Liverpool Gin Distillery Limited & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207:

“This is a helpful explanation of the concept of indirect confusion, which has frequently been cited subsequently, but as Mr Purvis made clear it was not intended to be an exhaustive definition.”<sup>2</sup>

51. Turning to the above categories; firstly, the shared elements between the marks are the letters ‘SUS’ which are common letters and cannot be said to be strikingly distinctive.

52. Secondly, there is a difference in spelling between the marks, which also affects the meaning/concept of each mark when considering the terms SUSIE and SUS’D. The first is a female forename which is fairly common and the other is not a dictionary term but does confer a meaning that could be ‘sussed’. I therefore do not believe that the contested marks will be considered a sub brand of the earlier brand, or vice-versa

53. The change of spelling in the marks and differing elements would not be an obvious or logical brand extension in my opinion. I do not consider this to be a step that the average consumer of the goods at issue would reasonably expect a business to take.

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<sup>2</sup> Paragraph 12

54. Whilst the categories set out above by Mr Purvis are not exhaustive, I can find no other reason why the average consumer of the SUSIE T. brand would, when exposed to the contested marks, assume that the goods and services at issue came from the same or an economically linked undertaking, or vice-versa.

55. I therefore find that there would be no indirect confusion between the marks.

## **Conclusion**

56. The application for invalidity fails in its entirety and the registration will remain in place.

## **Costs**

57. The Registered Proprietor has been successful and is entitled to a contribution towards its costs. On 14 September 2022 the Registered Proprietor submitted a costs proforma setting out the costs incurred in defending these proceedings. These consisted of:

Notice of Cancellation:	2 hours
Notice of Defence:	4 hours
Considering forms filed by the other party:	5 hours
Preparing evidence/written submissions and considering the other sides' evidence/submissions	9 hours

58. Where a party is represented, the Registrar usually awards costs on a scale published in the 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. There is no right to be awarded the amount claimed. This is subject to an assessment of the reasonableness of the claim and must also take account of the Registrar's practice of awarding costs on a contributory, not compensatory, basis.

59. From the above figures, the Notice of Cancellation is actually completed by the Cancellation Applicant and so considering this form will be in the heading 'considering forms filed by the other party'.

60. Approaching the matter in the way set out in paragraph 63, I consider the following figures to be a fair and reasonable award of costs:

Notice of Defence:	4 hours	
Considering forms filed by the other party:	2 hours	
Preparing written submissions and considering the other sides' submissions	6 hours	
<b>Total</b>	<b>12 hours @ £19</b>	<b>£228.00</b>

61. I note the Registered Proprietor put forward an hourly rate of £200 however, I have calculated the total using the standard rate used to calculate costs for unrepresented parties under The Litigants in Person (Costs and Expenses) Act 1975 (as amended) which sets the minimum level of compensation for litigants in person at £19 per hour. I have not been provided any reasoning as to why this level of compensation should be moved away from. I multiplied this by the time I consider was reasonably spent on this application. I have put the 'considering forms filed by the other party' as 2 hours as the only form sent in by the Cancellation Applicant was the Notice of Cancellation and that is the amount of time the Registered Proprietor has noted within their form. I have reduced the amount awarded for preparing and considering written submissions as these were relatively short.

62. I therefore order ESPRIT INTERNATIONAL to pay BRAND CONSCIENCE LTD the sum of £228. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

**Dated this 23<sup>rd</sup> day of November 2022**

**L NICHOLAS  
For the Registrar**