

o/598/22

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3684807
AND THE APPLICATION BY KEI-KEI UK LTD
TO REGISTER THE TRADE MARK**

***Kei-Kei
Customs***

IN CLASSES 16, 24 AND 25

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 60002071
BY KEIKEI TEKSTIL VE GIYIM SANAYI TICARET ANONIM SIRKETI**

Background and pleadings

1. On 23 August 2021, Kei-Kei UK Ltd (“**the Applicant**”) applied to register the following figurative mark as a UK trade mark:

The logo for Kei-Kei Customs is written in a bold, black, cursive-style font. The words "Kei-Kei" are on the top line and "Customs" is on the bottom line, with the letters overlapping and slanted to the right.

2. On 24 September 2021, the mark was published for opposition purposes in the Trade Marks Journal in respect of the following goods:

Class 16: Pictures; Picture postcards; Picture cards; Art pictures; Watercolor pictures; Picture books; Paper picture mounts; Cardboard picture mounts; Postcards and picture postcards; Picture framing mat boards; Mounts of paper for pictures; Paintings [pictures], framed or unframed; Prints in the nature of pictures.

Class 24: Towels; Hand towels; Beach towels; Children's towels; Bath towels; Terry towels; Towelling coverlets; Towelling [textile]; Towelling material; Hooded towels; Turkish towel; Turkish towels; Golf towels; Kitchen towels; Face towels; Towel sheet; Towels [textile]; Tea towels; Bathroom towels; Glass cloths [towels]; Textile face towels; Large bath towels; Towels of textile; Bath wrap towels; Quilts of towel; Glass-cloth [towels]; Towels [of textile]; Towels of textiles; Kitchen towels [textile]; Bath sheets (towels); Textile exercise towels; Japanese cotton towels (tenugui); Face towels of textile; Face towels of textiles; Kitchen towels of textile; Hand towels of textile; Face cloths of towelling; Textile hair drying towels; Household linen, including face towels; Kitchen towels of cloth; Dish towels for drying; Towels [textile] for kitchen use; Towels [textile] for the beach; Face towels [made of textile materials]; Towels made of textile materials; Turban towels for drying hair; Hand-towels made of textile fabrics; Towelling [textile] adapted for use in dispensers; Towels [textile] for use in connection with toddlers; Towels [textile] for use in connection with babies; Towels of textile sold in pack form; Towels of textile featuring American football team logos; Textile piece goods for

making-up into towels; Make-up removal towels [textile] other than impregnated with cosmetics; Textile fabrics for use in the manufacture of towels; Make-up removal towels [textile] other than impregnated with toilet preparations.

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; Layettees [clothing]; Jackets [clothing]; Kerchiefs [clothing]; Chaps (clothing); Maternity clothing; Thermal clothing; Belts [clothing]; Muffs [clothing]; Capes (clothing); Motorists' clothing; Boas [clothing]; Slips [clothing]; Veils [clothing]; Wraps [clothing]; Athletic clothing; Triathlon clothing; Windproof clothing; Silk clothing; Work clothes; Woolen clothing; Ladies' clothing; Latex clothing; 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.

3. On 10 December 2021, the application was opposed, in full, by Keikei Tekstil Ve Giyim Sanayi Ticaret Anonim Sirketi (“**the Opponent**”). The opposition is brought under section 5(2)(b) of the Trade Marks Act (“**the Act**”) and the Opponent relies on its UK trade mark:



Trade mark no. 00916155335

Filing date 12/12/2016

Registration date 09/03/2019

Relying on goods under Class 25

4. An “earlier trade mark” is defined in section 6(1) of the Act as:

“a registered trade mark or international trade mark (UK), a which has a date of application for registration earlier than that of the trade mark in question, taking

account (where appropriate) of the priorities claimed in respect of the trade marks,”

5. The filing date of the Opponent’s registration is prior to the filing date of the contested mark. The Opponent’s mark therefore constitutes an earlier mark under the Act.

6. Under section 6A of the Act, a proprietor has a period of five years following registration in which to use its trade mark. As five years had not passed between the date of registration of the earlier mark and the application for the contested mark, the Opponent can rely on all of the goods under its trade mark and is not required to show that its mark has yet been used at all.

The Opponent’s case

7. The Opponent submits that:

- (i) the respective marks are highly similar;
- (ii) the goods under the Applicant’s Class 25 are identical and highly similar to the goods under Class 25 of the Opponent’s mark;
- (iii) the goods under the Applicant’s Class 24 are similar to the Opponent’s goods under Class 25 as they are made of towelling and are used for drying purposes. The goods will be sat alongside clothing in homes and hotels, meaning that the average consumer will believe that the Applicant’s goods are those of the Opponent;
- (iv) the goods under the Applicant’s Class 16 are similar to the Opponent’s goods under Class 25, as they are small goods, often sold as accessories in clothing stores. The goods could be sold alongside each other, leading consumers to believe they have been manufactured, or made under a licence of the Opponent;
- (v) Due to the similarity of the marks and the similarity or identity of the goods, there is a risk of confusion on the part of the public, which includes a risk of association.

The Applicant's case

8. The Applicant rejects the opposition and submits that:

- (i) there can be no likelihood of confusion without a finding of identical or similar goods and services, with reference to the nature, intended purpose and method of use of the goods and services;
- (ii) in respect of each of the classes under its application, the respective marks should be considered complementary and not in competition;
- (iii) the Applicant promotes the customisation of hoodies and t-shirts in the UK market, whereas the Opponent only uses its mark on women's dresses, in the Turkish market;
- (iv) the Applicant makes reference to "KeiKei" in the Opponent's mark being one word, whereas "Kei-Kei" is two words in the contested mark.

Representation and papers filed

9. In these proceedings, the Opponent is represented by Forresters IP LLP; the Applicant has not engaged professional representation. As this is a fast track opposition, there were no evidence rounds. I note that on 18 May 2022, the Applicant filed evidence in support of its application. The Applicant was provided with the opportunity to formally request leave to file evidence. No formal request has been received and therefore the Applicant's evidence of 18 May 2022 will not be taken into account. No hearing was requested in these proceedings, and neither party filed submissions in lieu of a hearing. This decision is taken following a review of the statement of grounds and counterstatement, which are the only documents filed, and admitted into the proceedings.

DECISION

10. In respect of the UK's departure from the EU, it should be noted that 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 1994 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.

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

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

[...]

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

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

12. The following principles are gleaned from the decisions of 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 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 might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

Comparison of the goods

13. In considering the extent to which there may be similarity between the goods, I take account of the guidance from relevant case law. Thus, in *Canon* the CJEU stated that:

“In assessing the similarity of the goods or services concerned, ... 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”.¹

14. The relevant factors identified by Jacob J. (as he then was) in the *Treat*² case 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.

¹ Case C-39/97, at paragraph 23.

² *British Sugar PLC v James Robertson & Sons Ltd.*, 1996 R.P.C. 281.

15. In *Gérard Meric v Office for Harmonisation in the Internal Market (OHIM)*, the General Court of the European Union stated that goods and/or services can be considered as identical when the goods and/or services designated by the trade mark application are included in a more general category designated by the earlier mark (and vice versa).³

16. The goods relied upon by the Opponent are:

Class 25: Clothing, including underwear and outerclothing, other than special purpose protective clothing; socks, mufflers [clothing], shawls, bandanas, scarves, belts [clothing]; footwear, shoes, slippers, sandals; headgear, hats, caps with visors, berets, caps [headwear], skull caps; clothing for women; underwear for women; women's outerclothing.

The Applicant's goods under 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; Layettes [clothing]; Jackets [clothing]; Kerchiefs [clothing]; Chaps (clothing); Maternity clothing; Thermal clothing; Belts [clothing]; Muffs [clothing]; Capes (clothing); Motorists' clothing; Boas [clothing]; Slips [clothing]; Veils [clothing]; Wraps [clothing]; Athletic clothing; Triathlon clothing; Windproof clothing; Silk clothing; Work clothes; Woolen clothing; Ladies' clothing; Latex clothing; 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.

17. Under Class 25, with one exception (“*cloth bibs*”), the Applicant’s goods are clothing at large, or specific types of clothing. The Opponent’s mark includes clothing,

³ *Gérard Meric v Office for Harmonisation in the Internal Market (OHIM)*, case T-133/05 at paragraph 29. See Case T-388/00 *Institut für Lernsysteme v OHIM — Educational Services (ELS)* at paragraph 53 for this principle applied to services.

with a specific exclusion: “*Clothing, including underwear and outerclothing, other than special purpose protective clothing*”. As far as the Applicant’s and Opponent’s goods both cover clothing, the goods are plainly identical. In respect of the different forms of clothing under the Applicant’s mark, the goods are identical to the Opponent’s clothing under the *Meric* principle.

18. I note the exclusion in the Opponent’s mark “*other than special purpose protective clothing*”, which could be read as excluding the Applicant’s “*Motorcyclists’ clothing*”. The first consideration here, is that protective clothing falls within Class 9 of the Nice classification, so it should not be possible to exclude such goods in Class 25. Second is that not all motorcyclists clothing will be protective in nature. As a result, I consider that the exclusion in the Opponent’s list of goods does not prevent a finding of identity between the respective goods under the *Meric* principle. If I am wrong in this assessment, I nevertheless find the Opponent’s “*clothing for women*” to be identical to the Applicant’s “*Motorcyclists’ clothing*” within the *Meric* principle, as the broad term “*clothing for women*” would include “*Motorcyclists’ clothing*” for women.

19. In respect of the Applicant’s “*cloth bibs*”, I consider these goods will share the same channels of trade and users as the Opponent’s “*clothing*”. “*Cloth bibs*” are items usually for babies to protect their clothing. They are regularly purchased alongside babies clothing, which is covered by the term “*clothing*” in the Opponent’s goods. The goods are also frequently sold in sets with babies clothing and therefore I consider that the goods are also complementary as consumers would expect them to be provided by the same trader. Taking account of this, I find the Applicant’s “*cloth bibs*” to be similar to the Opponent’s goods to a medium degree.

The Applicant’s goods under Class 24

20. I recall the Opponent’s view, expressed in its statement of grounds, that goods under the Applicant’s Class 24 are similar to the Opponent’s goods under Class 25 as they are made of towelling and are used for drying purposes. I disagree with the Opponent’s reasoning here as first, clothing is not for drying purposes and second, the fact that goods are made of the same material, does not, of itself make those goods similar in nature. I also disagree with the Opponent’s argument of similarity on the

basis that the goods will be sat alongside clothing in homes and hotels. This is not a basis for a finding of similarity under the precedents set out above, between my paragraphs 13 and 15.

21. I have broken down the Applicant's goods in Class 24 into four categories, which I will address separately.

Towels; Hand towels; Beach towels; Children's towels; Bath towels; Terry towels; Towelling [textile]; Towelling material; Hooded towels; Turkish towel; Turkish towels; Golf towels; Face towels; Towel sheet; Towels [textile]; Bathroom towels; Textile face towels; Large bath towels; Towels of textile; Bath wrap towels; Towels [of textile]; Towels of textiles; Bath sheets (towels); Textile exercise towels; Japanese cotton towels (tenugui); Face towels of textile; Face towels of textiles; Hand towels of textile; Face cloths of towelling; Textile hair drying towels; Household linen, including face towels; Towels [textile] for the beach; Face towels [made of textile materials]; Towels made of textile materials; Turban towels for drying hair; Hand-towels made of textile fabrics; Towelling [textile] adapted for use in dispensers; Towels [textile] for use in connection with toddlers; Towels [textile] for use in connection with babies; Towels of textile sold in pack form; Towels of textile featuring American football team logos; Textile piece goods for making-up into towels; Textile fabrics for use in the manufacture of towels;

22. The Applicant's goods listed above are all types of towels and material for making towels. The goods are used for drying the body, face or hands and are not similar in purpose to the Opponent's clothing. The goods also differ in their method or use, with towels wrapped around the body, as opposed to worn on the body in the case of clothing. The nature of the goods (even if similar material could be used) is also different to the Opponent's goods. They are not competitive or complementary. Taking account of these factors, I find that Applicant's goods listed above are dissimilar to the Opponent's goods.

Kitchen towels; Tea towels; Glass cloths [towels]; Glass-cloth [towels]; Kitchen towels of textile; Kitchen towels of cloth; Dish towels for drying; Towels [textile] for kitchen use; Kitchen towels [textile]

23. The Applicant's goods listed above are all primarily used for drying of objects. The Opponent's goods essentially cover clothing, footwear and headgear. The Applicant's goods differ from the Opponent's goods in their physical nature, their purpose and method of use. The goods are not complementary and neither are they in competition with each other. Taking account of these factors, I find that Applicant's goods listed above are dissimilar to the Opponent's goods.

Towelling coverlets; Quilts of towel

24. The Applicant's goods listed above are types of bedding, made from a towelling material. Comparing these goods to the Opponent's goods in Class 25, I consider them to be different in terms of their physical nature, their purpose and method of use. The goods are not complementary and neither are they in competition with each other. I find the Applicant's goods listed above to be dissimilar to the Opponent's goods.

Make-up removal towels [textile] other than impregnated with cosmetics; Make-up removal towels [textile] other than impregnated with toilet preparations.

25. The Applicant's goods listed above are towels for the removal of make-up. Comparing these goods to the Opponent's goods in Class 25, I consider them to be different in terms of their physical nature, their purpose and method of use. The goods are not complementary and neither are they in competition with each other. I find the Applicant's goods listed above to be dissimilar to the Opponent's goods.

Class 16

Pictures; Picture postcards; Picture cards; Art pictures; Watercolor pictures; Picture books; Paper picture mounts; Cardboard picture mounts; Postcards and picture postcards; Picture framing mat boards; Mounts of paper for pictures; Paintings [pictures], framed or unframed; Prints in the nature of pictures.

26. The Applicant's goods listed above are essentially pictures and equipment for framing or mounting pictures. Comparing these goods to the Opponent's goods in Class 25, they differ in their nature, intended purpose, uses, users and in most cases,

their channels of trade. I note the Opponent's submission that retailers such as Urban Outfitters sell goods of the type falling within Class 16, alongside their clothing. However, to find similarity on this basis would mean that similarity could be found in respect of almost any goods purchased by the average consumer. I do not accept this argument and find that the Applicant's goods under Class 16 are dissimilar to the Opponent's goods.

Conclusion on the comparison of the goods

27. I have found the following goods under the Applicant's mark to be dissimilar to the Opponent's goods:

Class 16: Pictures; Picture postcards; Picture cards; Art pictures; Watercolor pictures; Picture books; Paper picture mounts; Cardboard picture mounts; Postcards and picture postcards; Picture framing mat boards; Mounts of paper for pictures; Paintings [pictures], framed or unframed; Prints in the nature of pictures.

Class 24: Towels; Hand towels; Beach towels; Children's towels; Bath towels; Terry towels; Towelling coverlets; Towelling [textile]; Towelling material; Hooded towels; Turkish towel; Turkish towels; Golf towels; Kitchen towels; Face towels; Towel sheet; Towels [textile]; Tea towels; Bathroom towels; Glass cloths [towels]; Textile face towels; Large bath towels; Towels of textile; Bath wrap towels; Quilts of towel; Glass-cloth [towels]; Towels [of textile]; Towels of textiles; Kitchen towels [textile]; Bath sheets (towels); Textile exercise towels; Japanese cotton towels (tenugui); Face towels of textile; Face towels of textiles; Kitchen towels of textile; Hand towels of textile; Face cloths of towelling; Textile hair drying towels; Household linen, including face towels; Kitchen towels of cloth; Dish towels for drying; Towels [textile] for kitchen use; Towels [textile] for the beach; Face towels [made of textile materials]; Towels made of textile materials; Turban towels for drying hair; Hand-towels made of textile fabrics; Towelling [textile] adapted for use in dispensers; Towels [textile] for use in connection with toddlers; Towels [textile] for use in connection with babies; Towels of textile sold in pack form; Towels of textile featuring American football team logos; Textile piece goods for

making-up into towels; Make-up removal towels [textile] other than impregnated with cosmetics; Textile fabrics for use in the manufacture of towels; Make-up removal towels [textile] other than impregnated with toilet preparations.

28. The opposition fails in respect of the goods listed above, leaving the following goods under consideration in these proceedings:

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; Layettees [clothing]; Jackets [clothing]; Kerchiefs [clothing]; Chaps (clothing); Maternity clothing; Thermal clothing; Belts [clothing]; Muffs [clothing]; Capes (clothing); Motorists' clothing; Boas [clothing]; Slips [clothing]; Veils [clothing]; Wraps [clothing]; Athletic clothing; Triathlon clothing; Windproof clothing; Silk clothing; Work clothes; Woolen clothing; Ladies' clothing; Latex clothing; 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.

Average consumer and the purchasing act

29. It is necessary to determine who is the average consumer for the respective goods and how the consumer is likely to select them.

30. In *Hearst Holdings Inc*,⁴ Birss J. explained that:

⁴ *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), at paragraph 60.

“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 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 word “average” denotes that the person is typical ...”

31. It must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods in question: *Lloyd Schuhfabrik Meyer*⁵.

32. The average consumer of goods in Class 25 will be the general public at large. I consider that the goods concerned will be purchased fairly frequently, most often without a heightened degree of care and attention. Notice will be paid to the design, quality, aesthetics and practicality of the goods. Considering these factors, I find that the general public will pay at least a medium degree of attention when purchasing the goods under Class 25.

33. I find that the goods will normally be purchased following visual inspection, either in stores or online. However, I cannot discount that there may be an aural element to the purchase, as there may be verbal assistance from retail staff. Also, there is the possibility of word of mouth recommendations.

Comparison of the marks

34. It is clear from *Sabel BV v. Puma AG*⁶ (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 *Bimbo SA v OHIM*,⁷ that:

⁵ Case C-342/97.



⁶ Case C-251/95.

⁷ Case C-591/12P.

“.....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.”

35. 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.

36. The Applicant’s mark Opponent’s marks are shown below:

Opponent’s mark	Applicant’s mark
	

37. The Applicant’s mark comprises the words “Kei-Kei” separated by a hyphen, beneath which appears the word “Customs”, written at an angle, on an upward incline. The text appears in a bold, black, hand-written style. The Opponent’s mark comprises the conjoined words “KeiKei” written in white text, on a black background. The two letter “i’s” in the Opponent’s mark have an umlaut over them.

38. Neither party has provided submissions on the meaning of the words “Kei-Kei”/“KeiKei”, which in English appear to represent two invented words, although I consider they could represent a name. The overall impression of the Opponent’s mark is of the invented word, or possible name, “KeiKei”. I consider the overall impression of the Applicant’s mark to be of the same invented words, or possible name “Kei-Kei”,

together with the word “Customs”, which would refer to something being adapted or customised.

39. Visually, the marks align in respect of the six letters “KeiKei” and where the marks appear in black and white. Visually, the marks differ in respect of their type-faces and the additional word “Customs” in the Applicant’s mark. Other differences concern the umlaut over the letter “i’s” in the Opponent’s mark, the hyphen in the Applicant’s mark and where the Opponent’s mark comprises white letters, on a black background, whereas the Applicant’s mark comprises black letters on a white background. Overall, I consider the marks to be visually similar to a medium degree.

40. Aurally, the marks align in respect of the words “Kei-Kei”/“KeiKei”. While the umlaut in the Opponent’s mark would alter the pronunciation of vowel “i” in the word “Kei”, as umlauts are not commonly used in the English language, I do not consider that the average UK consumer would pronounce the words differently. Therefore I consider that both marks will be pronounced “KAY-KAY” or “KAI-KAI”. The marks differ aurally in respect of the additional word “Customs” in the Applicant’s mark, which will be pronounced “CUSS-TOMS”. Overall, I consider the respective marks to be aurally similar to a high degree.

41. Conceptually, the marks align in respect of the element “Kei-Kei”/“KeiKei”, which will be seen as either an invented word, or a name. In either case, the concept will be the same. The additional word “Customs” in the Applicant’s mark is a point of conceptual difference between the marks, however, I consider that it would be viewed descriptively as indicating a customised or adapted version. Overall, I consider the marks to be conceptually similar to a high degree.

Distinctive character of the earlier mark

42. Distinctive character is the capacity of the mark to identify the goods or services for which it is registered as coming from a particular undertaking, and to distinguish those goods or services from those of other undertakings: see *Lloyd Schuhfabrik Meyer*, paragraph 22.

43. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The inherent distinctive character may be enhanced through the use that has been made of the mark.

44. In *Lloyd Schuhfabrik Meyer*, the CJEU set out how an assessment of a mark's distinctive character should be made:

*“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).”*



a name that is common in the UK. This being the case and seeing no connection between the mark and the Opponent's goods under Class 25, I conclude that the Opponent's mark possesses a high degree of distinctive character.

Likelihood of confusion

46. I have so far considered the factors that need to be taken into account when assessing the likelihood of confusion and I now come to make a global assessment of these factors. In making this global assessment, I take stock of my findings in the foregoing sections of this decision and the authorities and principles that I have set out, in particular, at my paragraph 12 above.

47. There are two types of confusion that I may find. The first type is direct confusion which occurs where the consumer mistakes one mark for another. The second type is indirect confusion, where the consumer notices the differences between the marks, but due to the similarities between the common elements, they believe that the goods or services derive from the same, or a related economic undertaking.⁸

48. In *L.A. Sugar Limited v By Back Beat Inc*,⁹ 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

⁸ *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10

⁹ Case BL O/375/10.

context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”

49. Mr Purvis QC noted that instances where one may expect the average consumer to reach such a conclusion tend to fall into one 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. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where 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 goods and services may be offset by a greater degree of similarity between the marks, and vice versa. It is necessary for me to keep in mind the distinctive character of the earlier mark and the average consumer of the goods and the nature of the purchasing process. In doing so I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must rely upon the imperfect picture of them that they have retained in their mind.

51. In respect of the remaining Class 25 goods under consideration, I have found some of the Applicant’s goods to be identical to the Opponent’s goods, and others to be similar to a medium degree. I have found the average consumer to be a member of

the general public, who will pay at least a medium degree of attention when purchasing the goods. I have found the purchase to be predominantly a visual purchase, although aural considerations may play a part. I have found the marks to be visually similar to a medium degree, and aurally and conceptually similar to a high degree. I have found the Opponent's mark to possess a high degree of distinctive character.

52. I note the Applicant's submissions about how the Opponent uses its mark and I reiterate that, as the Opponent's mark was registered fewer than five years before the contested mark was applied for, the Opponent is entitled to rely on all of the goods under its trade mark, without needing to show how it has used its mark.

53. Taking all of the factors into account, on the one hand, I have found the purchase of the goods under consideration to be predominantly a visual purchase, with the consumer paying at least a medium degree of attention and that visually, the marks are similar to a medium degree – the lower point out of the visual, aural and conceptual comparison I have carried out. On the other hand, I have found the Opponent's mark to be highly distinctive, with its main features being reproduced in the Applicant's mark in a way that sees the respective marks being aurally and conceptually highly similar. Weighing up these factors, I conclude that, even in respect of the goods where I have identified only a medium degree of similarity, there is a clear likelihood of the marks being indirectly confused. Referring back to Mr Purvis' instances of where indirect confusion can occur, I find the addition of the element "Customs" in the Applicant's marks, will merely indicate that the Applicant's goods are customised in some way, or adapted. I find that the type of indirect confusion falls within category "b" set out by Mr Purvis, with the Applicant's mark being viewed as a sub-brand, or brand extension of the Opponent's mark, i.e. the custom version of KeiKei".

Conclusion

54. The opposition under section 5(2)(b) succeeds, in part, in respect of the following goods:

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; Layettes [clothing]; Jackets [clothing]; Kerchiefs [clothing]; Chaps (clothing); Maternity clothing; Thermal clothing; Belts [clothing]; Muffs [clothing]; Capes (clothing); Motorists' clothing; Boas [clothing]; Slips [clothing]; Veils [clothing]; Wraps [clothing]; Athletic clothing; Triathlon clothing; Windproof clothing; Silk clothing; Work clothes; Woolen clothing; Ladies' clothing; Latex clothing; 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.

55. The opposition fails in respect of the following goods:

Class 16: Pictures; Picture postcards; Picture cards; Art pictures; Watercolor pictures; Picture books; Paper picture mounts; Cardboard picture mounts; Postcards and picture postcards; Picture framing mat boards; Mounts of paper for pictures; Paintings [pictures], framed or unframed; Prints in the nature of pictures.

Class 24: Towels; Hand towels; Beach towels; Children's towels; Bath towels; Terry towels; Towelling coverlets; Towelling [textile]; Towelling material; Hooded towels; Turkish towel; Turkish towels; Golf towels; Kitchen towels; Face towels; Towel sheet; Towels [textile]; Tea towels; Bathroom towels; Glass cloths [towels]; Textile face towels; Large bath towels; Towels of textile; Bath wrap towels; Quilts of towel; Glass-cloth [towels]; Towels [of textile]; Towels of textiles; Kitchen towels [textile]; Bath sheets (towels); Textile exercise towels; Japanese cotton towels (tenugui); Face towels of textile; Face towels of textiles; Kitchen towels of textile; Hand towels of textile; Face cloths of towelling; Textile hair drying towels; Household linen, including face towels; Kitchen towels of cloth; Dish towels for drying; Towels [textile] for kitchen use; Towels [textile] for the beach; Face towels [made of textile materials]; Towels made of textile materials; Turban towels for

drying hair; Hand-towels made of textile fabrics; Towelling [textile] adapted for use in dispensers; Towels [textile] for use in connection with toddlers; Towels [textile] for use in connection with babies; Towels of textile sold in pack form; Towels of textile featuring American football team logos; Textile piece goods for making-up into towels; Make-up removal towels [textile] other than impregnated with cosmetics; Textile fabrics for use in the manufacture of towels; Make-up removal towels [textile] other than impregnated with toilet preparations.

COSTS

56. The Opponent and the Applicant have both achieved success and so I order each party to bear its own costs in these proceedings.

Dated this 12th day of July 2022

**Charlotte Champion
For the Registrar**