

O/680/22

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3575559

**IN THE NAME OF
SAHIL SHAH**

**TO REGISTER THE FOLLOWING TRADE
MARK:**



IN CLASS 25

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 424638**


BY SAMUEL ABBOTT

Background and pleadings

1. On 6 January 2021, Sahil Shah ('the applicant') applied to register the trade mark shown on the front page of this decision. It was accepted and published in the Trade Marks Journal on 26 February 2021 in respect of the following goods:

Class 25: Clothing

2. On 25 May 2021, Samuel Abbott ("the opponent") filed a notice of opposition against the application. The opposition is brought under section 5(2)(b) of the Trade Marks Act 1994 ("the Act") and is directed against all the applied for goods. This is on the basis of its earlier right, the details of which are set out below:

Earlier Mark	Registration no.	Filing/Registration date	Goods relied upon
	UK00003373627	7 February 2019 26 April 2019	Class 25: Clothing

3. By virtue of its earlier filing date, the opponent's trade mark constitutes an earlier mark, in accordance with section 6 of the Act.

4. In its notice of opposition, the opponent contends that there is a high level of visual, aural and conceptual similarity between the marks and that the respective goods are identical, giving rise to a likelihood of confusion.

5. The applicant filed a counterstatement, denying all the claims made by the opponent. At this point, I also note in their counterstatement, the applicant states the following:

“I request the application to be approved as under the name of ‘Pound Lush’ instead of the figurative configuration that was stated by the opposing mark as the word is entirely different.”

6. It is established in the Act that an application may be amended at the request of the applicant only by correcting the name or address of the applicant, errors of wording or of copying, or obvious mistakes.¹ I do not consider that the applicant’s request meets the requirements as set out in the Act and consequently, my decision will only concern the mark as shown the front page of this decision.

7. Both parties in this case are representing themselves. The opponent filed evidence whereas the applicant filed written submissions. Neither party requested a hearing, nor did they file any written submissions in lieu. I now make this decision after careful consideration of the papers before me.

8. 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.

Proof of Use

9. As the opponent’s mark had been registered for less than 5 years at the filing date of the application in issue, it is not subject to proof of use pursuant to section 6A of the Act. The opponent can, therefore, rely upon all of the goods it has identified.

EVIDENCE

10. The opponent filed its evidence in the form of a witness statement dated 7 February 2022 from the trade mark owner Samuel Abbott and two exhibits. Whilst I

¹ See Section 39(2) of the Trade Marks Act 1994

do not propose to summarise the evidence here, I have taken the evidence into account in reaching my decision and will refer to it below where necessary.

DECISION

Section 5(2)(b)

11. 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”.

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

The principles:

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

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

upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a 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

13. The goods to be compared are as follows:

Opponent's Goods	Applicant's goods
<i>Class 25: Clothing</i>	<i>Class 25: Clothing</i>

14. In their submissions, the applicant asserts "...although we are in the same class bracket our customers and target audience are completely different as OP000424638 specifically focuses on golf."

15. The goods for the respective marks concern *clothing* in general in class 25. Neither party, within the specification of goods, has limited its specification to clothing for a particular audience or gender. It is well established that it is the goods which appear on the parties' specifications that I must consider within these proceedings. Any targeted marketing that has been carried out by the parties is irrelevant to the comparison of goods in these proceedings. In *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P, the Court of Justice of the European Union stated that:

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

16. With consideration to the above, I find that the applicant's comments on this subject are of no relevance to the comparison of goods.

17. The term *Clothing* appears in both parties' specifications and is self-evidently identical.

The average consumer and the nature of the purchasing act

18. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which the services are likely to be selected by the average consumer. 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.”

19. The average consumer for the parties' goods will be a member of the general public. The goods may vary in price, but none are likely to be prohibitively expensive and all will be purchased reasonably frequently. Even where the cost of the goods is low, various factors will be considered such as aesthetics, durability, and material. Taking all of this into consideration, I consider it likely that a medium degree of attention will be paid during the purchasing process.

20. The goods are likely to be self-selected from the shelves of a retail outlet or their online or catalogue equivalent. Visual considerations are, therefore, likely to dominate the selection process. However, given that advice may be sought from retail assistants, I do not discount an aural component to the purchase.



Comparison of marks

21. 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 Court of Justice of the European Union 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 relevant 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.”

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

23. The marks to be compared are as follows:

Opponent's mark	Applicant's mark
	

Overall impression

24. The opponent's mark consists of the word FLUSH. in a black stylised typeface on a white background. In this case, I find the role of the white square background to be negligible therefore the overall impression lies in the wording itself.

25. The applicant's mark contains a £ conjoined to the letters LUSH to create the term £LUSH in a white stylised typeface. Below this, the word LONDON is presented in a standard white typeface. The wording is presented on a black square background. I find the wording £LUSH to be the most dominant and distinctive part of the mark due in part to its size and positioning. I consider that the LONDON wording of the mark plays only a secondary role, and the black square background merely serves as a backdrop rendering its impact minimal to the overall impression.

Visual comparison

26. The marks coincide in their use of the letters LUSH. The difference lies in the opponent's use of the letter F to create the word FLUSH whereas the LUSH lettering in the applicant's mark is preceded by a £ symbol. Both marks have adopted an italicized typeface and the stylistic representation of the applicant's mark leads me to consider that some consumers may perceive the £ as an alternative representation of the letter F due to the similar shape they share. The applicant's mark also contains the wording LONDON which has no counterpart in the opponent's mark. Further, the wording in the applicant's mark is presented in white on a black background whereas the opponent's mark is presented in a black font on a white background. Overall, I find the marks to be visually similar to a between a medium and high degree.

Aural comparison

27. The opponent's mark will be pronounced in one syllable as FLUSH. Due to the size of the LONDON element in the applicant's mark, whilst I found it was not negligible and helps to differentiate the mark visually, I find that this is highly likely to be aurally discounted by consumers and consequently the mark is likely to be pronounced as FLUSH. I make this finding on the basis of the cursive style conjoining the £ symbol to

the word LUSH and the stylised typeface of the applicant's mark rendering the £ shape as being highly similar to the letter F. I accept however, that a small number of consumers may pronounce the applicant's mark as LUSH. Where both marks are pronounced as FLUSH, they are aurally identical. In circumstances where the applicant's mark is pronounced as LUSH, I find the respective marks to be aurally similar to a high degree.

Conceptual comparison

28. The word FLUSH has several definitions in the English language including to glow or shine with a rosy colour, a sudden flow of water and as an informal term people use when they have a lot of money². Consumers are likely to think of one of these meanings when faced with the opponent's mark. When faced with the applicant's mark, I consider that consumers may perceive the £ as a stylised representation of the letter F and therefore interpret the mark as FLUSH and make the same conceptual comparisons. I find that the £ symbol in particular will reinforce the slang term of "flush" and convey to the consumer the idea of being flush with money. The LONDON element of the mark, when taken into context with the goods, will likely be perceived by the consumer as the location in which the clothing is produced or where the company is based and will add little to the conceptual meaning. Overall, I find the marks to be conceptually similar to a high degree.

Distinctive character of the earlier mark

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

² [Flush definition and meaning | Collins English Dictionary \(collinsdictionary.com\)](https://www.collinsdictionary.com)

Chiemsee v Huber and Attenberger Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. In *Lloyd Schuhfabrik*, 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).”

30. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

31. The earlier mark consists of the ordinary dictionary word FLUSH in a stylised font. As previously stated, this word contains several meanings in the English language however it is not descriptive nor allusive to the goods for which it is registered. The stylisation of the mark is minimal and does not particularly add to the

inherent distinctiveness. I find the opponent's mark is inherently distinctive to a medium degree.

Likelihood of confusion

32. There is no simple formula for determining whether there is a likelihood of confusion. I must make a global assessment of the competing factors (*Sabel* at [22]), keeping in mind the interdependency between them (*Canon* at [17]) and considering the various factors from the perspective of the average consumer. In making my assessment, I must bear in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

33. 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.

34. Earlier in my decision, I found the respective goods to be identical. I identified the average consumer to be a member of the general public who will purchase the goods predominantly by visual means, though I do not discount an aural element to the purchase. I also concluded that a medium degree of attention will be paid during the purchasing process.

35. I found the marks to be visually to between a medium and high degree and conceptually similar to a high degree. Where both marks are pronounced as FLUSH, I found them to be aurally identical. In circumstances where the applicant's mark is pronounced as LUSH, I found the respective marks to be aurally similar to a high degree. Further, I found the opponent's earlier mark to hold a medium level of inherent distinctiveness.

36. The respective marks share a common element (LUSH) and earlier in my decision I found that the £ symbol in the applicant's mark will likely be perceived as a stylistic representation of the letter F leading to a further similarity between the marks.

I also considered that the LONDON element in the applicant's mark played only a minor role and may be easily misremembered or go unnoticed. Considering all of the above factors, and with consideration to the consumers imperfect recollection, it is my view that given the high similarities between the marks and the identity of the respective goods, the average consumer is unlikely to recall the differences between the marks, which will lead to the consumer confusing the marks for one another. As such, there is a likelihood of direct confusion.

37. I now go on to consider indirect confusion.

38. 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.

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.)

39. These examples are not exhaustive but provide helpful focus.

40. I note that the two marks do not appear to fall into one of the categories highlighted in *L.A. Sugar*. However, I note that these categories are not exhaustive, and so I consider again all of the factors I have found within this decision. The fact that the goods are identical is a factor weighing in the opponent’s favour and I find that the similar font for the dominant FLUSH and £LUSH element of the respective marks will encourage a thought process that there is likely a connection between the same and that the £ in the applicant’s mark is a stylistic variation of the letter F. It is therefore my view that if the consumer does notice the differences between the marks, it is likely that the average consumer will conclude that they represent slightly different versions of the marks, both of which originate from the same undertaking. As such, I find there is also a likelihood of indirect confusion.

Conclusion

41. The opposition under section 5(2)(b) of the Act has succeeded in full. Subject to any successful appeal against my decision, the application will be refused in the UK for the full range of goods applied for.

COSTS

42. The opponent has been successful and is entitled to a contribution towards its costs. In the registry’s letter to the opponent dated 6 June 2022, they were invited to complete and return a costs proforma by 4 July 2022. The letter also advised the opponent that failure to return the costs proforma may result in costs (excluding official

fees) not being awarded. As the opponent did not submit a costs proforma, I calculate their official fees as follows:

Official cost of filing Form TM7:	£100
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43. I therefore order Sahil Shah to pay the sum of £100 to Samuel Abbott. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 12th day of August 2022

Catrin Williams
For the Registrar