

o/914/22

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003696220

BY RFCLOTHINGOFFICIAL

TO REGISTER THE TRADE MARK:



IN CLASS 25

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 430534

BY FOX FACTORY, INC.

BACKGROUND AND PLEADINGS

1. On 16 September 2021, rfclothingofficial limited (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on the 10 December 2021. The applicant seeks registration for 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; 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]; Boas [clothing]; Slips [clothing]; Veils [clothing]; Wraps [clothing]; Athletic clothing; Triathlon clothing.

2. The application was opposed by FOX FACTORY, INC. (“the opponent”) on 25 January 2022. The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon the following trade marks:

RF

UK registration no. 3682120

Filing date 16 August 2021; Registration date 26 August 2022.

EU Priority date 1 October 2020.

(“The First Earlier Mark”)



UK registration no. 3682104

Filing date 16 August 2021; Registration date 26 August 2022.

EU Priority date 1 October 2020.

(“The Second Earlier Mark”)

3. The opponent relies upon all of the goods for which its First and Second Earlier Marks are registered, which are in classes 9, 12, 18, 25 and 28, as set out in paragraph 10 in this decision.

4. The opponent claims that there is a likelihood of confusion because there is a high degree of aural, visual and conceptual similarity between all of the marks, and the goods are identical or highly similar.

5. The applicant filed a counterstatement denying the claims made.

6. The opponent is represented by Hogan Lovells International LLP and the applicant is unrepresented. Neither party requested a hearing, but the opponent filed submissions in lieu. This decision is taken following a careful perusal of the papers.

DECISION

7. Section 5(2)(b) reads as follows:

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

(a)...

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

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

8. The earlier marks had not completed their registration process more than five years before the relevant date (the filing date of the mark in issue). Accordingly, the use provisions at s.6(1)(a) and 6(1)(ab) of the Act do not apply. The opponent may rely on all of the goods it has identified without demonstrating that it has used its marks.

Section 5(2)(b) case law

9. 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:

(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

10. The competing goods are as follows:

Opponent's goods	Applicant's goods
<p>The First and Second Earlier Mark</p> <p><u>Class 9</u> Articles for protection against accidents or injury, namely, knee pads, leg pads, elbow pads, padded shorts, padded tops, gloves.</p> <p><u>Class 12</u> Bicycle components, namely, pedals, handlebars, handlebar stems, handlebar grips, cranks, crank spindles, chainrings, bottom brackets, seatposts, seatpost levers, wheelsets, hubs, cassette bodies, rims; tailgate pads; bicycle wheel bags.</p> <p><u>Class 18</u> Bags and backpacks, namely, bags compatible with personal hydration systems, belt bags, sport bags, sling bags, backpacks, umbrellas.</p> <p><u>Class 25</u> Clothing, namely, shirts, T-shirts, tank tops, hoodies, crew neck sweatshirts, jackets, shorts, pants, gloves, bib shorts, liners, belts; footwear, namely, socks;</p>	<p><u>Class 25</u> 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]; Boas [clothing]; Slips [clothing]; Veils</p>

<p>headwear (hats, beanies, toques); clothing for athletic use (shorts, bib shorts, tops, pants, jackets, gloves); sun protective clothing (tops); padded shorts, padded tops.</p> <p><u>Class 28</u></p> <p>Protective articles for athletic use, namely, knee pads, leg pads, elbow pads, gloves.</p>	<p>[clothing]; Wraps [clothing]; Athletic clothing; Triathlon clothing.</p>
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11. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union (“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.”

12. Guidance on this issue has come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (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

13. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“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 for 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.”

14. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR) [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of ‘dessert sauce’ did not include jam, or because the ordinary and natural description of jam was not ‘a dessert sauce’. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category

of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

15. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that “complementary” means:

“... there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think the responsibility for those goods lies with the same undertaking.”

16. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. chicken against transport services for chickens. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted, as the Appointed Person, in *Sandra Amalia Mary Elliot v LRC Holdings Limited*, BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense – but it does not follow that wine and glassware are similar goods for trade mark purposes.”
Whilst on the other hand: “... it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

Whilst on the other hand:

“... it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

17. In making my assessment, I note that the Tribunal Manual states that specifications which include the wording ‘namely’ should be interpreted as covering only the named goods within that specification. Therefore, the opponent’s specification is limited to only those goods.

Clothing; Clothes; Leisure clothing; Infant clothing; Children's clothing; Childrens' clothing; Girls' clothing; Babies' clothing; Women's clothing; Maternity clothing; Knitted clothing; Motorcyclists' clothing; Leather clothing; Waterproof clothing; Plush clothing; Knitwear [clothing]; Weatherproof clothing; Casual clothing; Denims [clothing]; Furs [clothing]; Cashmere clothing; Embroidered clothing; Thermal clothing.

18. I consider that all of the opponent’s class 25 clothing goods fall within the applicant’s above broader categories. I consider them identical on the principle outlined in *Meric*.

Sports clothing; Cyclists' clothing; Athletic clothing; Triathlon clothing.

19. I consider that the opponent’s “clothing for athletic use (shorts, bib shorts, tops, pants, jackets, gloves)” fall within the applicant’s above broader categories. I consider them identical on the principle outlined in *Meric*.

Tops [clothing]

20. I consider that the opponent’s “t-shirts” is self-evidently identical to the applicant’s “tops [clothing]”.

Gloves [clothing]

21. I consider that the opponent’s “gloves” is self-evidently identical to the applicant’s “gloves [clothing]”.

Belts [clothing]

22. I consider that the opponent's "belts" is self-evidently identical to the applicant's "belts [clothing]".

Shorts [clothing]

23. I consider that the opponent's "shorts" is self-evidently identical to the applicant's "shorts [clothing]".

Jackets [clothing]

24. I consider that the opponent's "jackets" is self-evidently identical to the applicant's "jackets [clothing]".

Outer clothing

25. I consider that the opponent's "jackets" would fall within the above broader category in the applicant's specification. I consider them identical on the principle outlined in *Meric*.

Kerchiefs [clothing]; Veils [clothing]

26. A kerchief is a piece of cloth that you can wear on your head. A veil is a headpiece composed of a thin piece of material which can cover the face. Consequently, I consider that the applicant's goods fall within the broader category of "headwear (hats, beanies, toques)" in the opponent's specification. I consider them identical on the principle outlined in *Meric*.

27. For further clarity, albeit the wording "headwear" is then followed with three terms referenced in brackets, the text preceding the round brackets is considered the most important part of the indication of the product in question. Therefore, the opponent has protection for headwear at large, to which the applicant's goods fall within.

Hoods [clothing]

28. The opponent submits that ‘hoods’ are identical to ‘headwear’ in the opponent’s specification. I consider that as ‘headwear’ is something which is worn on the head, this would include hoods. Therefore, I consider that the goods are identical on the principle outlined in *Meric*.

Oilskins [clothing]

29. Oilskins “are a coat and pair of trousers made from thick waterproof cotton cloth”.¹ Therefore, I consider that these goods fall within the broader category of “jackets” and “pants” in the opponent’s specifications. I consider them identical on the principle outlined in *Meric*.

Bandeaux [clothing]; Bodies [clothing]

30. I consider that the applicant’s above goods overlap with the opponent’s “clothing, namely, shirts, T-shirts, tank tops,”. All of the goods are types of clothing, which are to be worn on the upper half of the body. Therefore, I consider that they overlap in nature, method of use, purpose and users. I also consider that there would be an overlap in distribution channels as clothing retail stores would sell all of the goods, which would be located in the same aisle. I do not consider that the goods are complementary, however, they will be in competition. Consequently, I consider that the goods are similar to a high degree.

Jerseys [clothing]

31. I consider that the applicant’s above goods overlap with the opponent’s “tank tops”. I note that tank tops are a knitted piece of clothing that covers the upper part of the body and has no sleeves.² I note that jerseys are also a knitted piece of clothing that covers the upper part of the body and arms.³ Therefore, the goods overlap in user,

¹ <https://www.collinsdictionary.com/dictionary/english/oilskins>

² <https://www.collinsdictionary.com/dictionary/english/tank-top>

³ <https://www.collinsdictionary.com/dictionary/english/jersey>

nature, method of use and purpose. I also consider that there would be an overlap in distribution channels as clothing retail stores would sell all of the goods in the same aisle. The goods are not complementary; however, they are in competition. I consider that the goods are similar to a high degree.

Slipovers [clothing]

32. I consider that the applicant's above goods overlap with the opponent's "crew neck sweatshirts" and "hoodies". All of the goods are types of clothing that would be worn over other items of clothing to keep the user warm, or for fashionable purposes. Consequently, they overlap in nature, method of use, purpose and user. However, I note that slipovers do not usually have arms/sleeves, whereas the opponent's goods would. I consider that there would be an overlap in distribution channels as clothing retail stores would sell all of the goods, and the goods are likely to be found in close proximity in such retail settings. I do not consider that the goods are complementary, however, I consider that they may be, to some extent, in competition. Therefore, I consider that the goods are similar to a high degree.

Muffs [clothing]

33. I consider that the applicant's above goods overlap with the opponent's "gloves". They overlap in purpose, method of use and user because all of the goods are worn to keep the user's hands warm and protected from the cold weather. However, I note that the applicant's goods are a cylindrical item to which the user will slip their hands into both ends, which does differ from gloves, which covers the hands separately. Therefore, they differ in nature. I consider that there may be an overlap in trade channels because I consider that the same undertaking would sell all of the goods and other winter accessories, such as hats. I do not consider that the goods are complementary, however, the goods are in competition. Consequently, I consider that the goods are similar to a medium degree.

Playsuits [clothing]

34. A playsuit is an outfit which is comprised of a top and shorts, which are connected. Therefore, I consider that the applicant's above goods overlap with the opponent's "clothing, namely, shirts, T-shirts, tank tops, shorts". All of the goods are types of clothing that will be worn by the user, for both practical and fashionable purposes. Therefore they overlap in method of use, user and purpose. The goods to some extent will overlap in nature as the opponent's goods either cover the top half or the bottom half of the person, whereas the applicant's playsuits cover both halves. I consider that there will be an overlap in distribution channels as all of the goods would be sold in clothing retail stores, and are likely to be found in close proximity within these establishments. I do not consider that the goods are complementary, however I do consider that they would be in competition. Consequently, I consider that that the goods are similar to a medium degree.

Wraps [clothing]

35. I consider that the applicant's above goods overlap with the opponent's "jackets". All of the goods are types of outerwear that will be worn by the user, for both practical and fashionable purposes. They therefore overlap in nature, user and purpose. However, the goods do not overlap in method of use as a wrap is a rectangular piece of material which wraps around the users body whereas a jacket would have arms, and a body which would do up using either a zip or buttons. I consider that there would be an overlap in distribution channels as all of the goods would be sold in clothing retail stores, and are likely to be found in close proximity within these establishments. I do not consider that the goods are complementary, however, they may be in competition because a user may choose either goods as outerwear to keep themselves warm. Therefore, I consider that the goods are similar to a medium degree.

Combinations [clothing]

36. I note that combinations are defined as a "one-piece woollen undergarment with long sleeves and legs".⁴ I consider that this clothing would be worn under other pieces

⁴ <https://www.collinsdictionary.com/dictionary/english/combinations>

of clothing to keep the user warm. Therefore, I consider the above goods would have limited overlap with the opponent's "clothing, namely, shirts, T-shirts, tank tops, hoodies, crew neck sweatshirts, jackets, shorts, pants, gloves, bib shorts, liners". All of the goods are types of clothing, which will be worn by the average consumer. Therefore, they overlap in method of use, user and purpose. However, the specific purpose of combinations is that they are to be worn under clothing. I also consider that there may be an overlap in distribution channels as all of the goods would be sold in clothing retail stores, and are likely to be found in close proximity within these establishments. However, I do not consider that the goods are complementary nor in competition. Consequently, I consider that that the goods are similar to a medium degree.

Slips [clothing]

37. Slips are a type of undergarment which is used to stop underwear from showing through the woman's garment, as well as to keep the user warm. Therefore, I consider that the same comparison applies in paragraph 36 above.

Wristbands [clothing]

38. The opponent submits that the above goods overlap with the opponent's "clothing for athletic use (shorts, bib shorts, tops, pants, jackets, gloves)" on the basis they are all goods which are used for sporting purposes. I agree. I also consider that there would be an overlap in trade channels as the same sporting undertakings would sell all of the goods. There is also an overlap in user. However, I note that the goods do not overlap in method of use and nature as the opponent's goods are sports clothing and the applicant's goods are sports accessories. I do not consider that the goods are complementary as they are not important or indispensable to each other. Nor do I consider that the goods are in competition. Consequently, I consider that the goods are similar to a medium degree.

Chaps (clothing)

39. I consider that the applicant's above goods would overlap with the opponent's "pants". I note that the goods overlap in user and method of use because they are types of clothing, to be worn on the users bottom half. Chaps are usually made of sturdier material such as leather and denim, and I acknowledge that pants can also be made out of these materials. Consequently, the goods overlap in nature. However, they differ in purpose because chaps are to be worn over trousers and are not joined at the crotch. I consider that there may be an overlap in trade channels as some clothing retail outlets will sell both goods, however, I also appreciate that there may be some undertakings which may specialise in only selling chaps. I do not consider that the goods are in competition nor complementary. Therefore, I consider that the goods are similar to between a low and medium degree.

Ties [clothing]

40. I consider that the applicant's above goods has limited overlap the opponent's 'belts'. I consider that both goods are accessories that are to be worn by the average consumer for fashionable purposes. Therefore, they overlap in user, nature and, to some extent purpose. However, a belt is to be worn to with a pair of trousers, whereas ties are worn around the neck with, most likely, with a shirt. I consider that there would be an overlap in distribution channels as the goods would all be sold in general clothing retail outlet, and would be located in the same clothing accessories aisle. The goods are neither competitive nor complementary. Consequently, I consider the goods are similar to between a low and medium degree.

Swaddling clothes; Cloth bibs; Layettes [clothing]

41. I consider that swaddling clothes would be used to be wrapped around a baby. I also note that layettes is a broad term which covers body suits, pants and leggings, and even accessories such as bibs, for new-born babies. Therefore, all of the above goods are specifically clothing for babies, which would not be replicated for adults. I consider that although the goods are technically types of clothing, and therefore overlap in nature, they do not overlap in method of use, purpose or user. However, I do consider that there would be an overlap in distribution channels because both adult clothing and babies clothing would all be sold at a general clothing retail outlet, albeit

not in the same aisle. The goods are neither in competition nor complementary. Consequently, I consider that the goods are similar to a low degree.

Collars [clothing]

42. As set out in *Les Éditions Albert René v OHIM*,⁵ it is clear that just because a particular good is used as a part, element or component of another, it should not result in a finding of identity/similarity between those goods. However, it does not mean that there can never be similarity between such goods where there is overlap in the factors identified in *Treat*.

43. In this instance, I consider that the applicant's collars, which are parts of clothing, do not overlap with all of the opponent's clothing goods. Albeit clothing may have collars, I do not find that the use, user or nature of the goods overlap. I also consider that there wouldn't be an overlap in trade channels as the applicant's parts of clothing would be purchased wholesale to be used in the production of the finished article, which would then be on sale to the general public. I do not consider that the goods are in competition nor complementary. Taking the above into account, I consider that the goods are dissimilar.

Boas [clothing]

44. Boas are a type of "long scarf made of feathers or short pieces of very light fabric".⁶ I consider that these goods are dissimilar to the opponent's clothing goods. I consider that the applicant's above goods are accessories that are to be worn by the average consumer, most likely as a fancy dress item. Therefore, I consider that the applicant's goods are most likely to be sold through fancy dress shops. The opponent's goods are used to keep the user covered and warm, or worn for fashionable purposes. They are also likely to be sold through general clothing retail outlets. Therefore, I do not consider that the goods overlap in nature, method of use, purpose or trade channels. There may be an overlap in user, however, this is not enough on its own to establish

⁵ Case T-336/03

⁶ <https://www.collinsdictionary.com/dictionary/english/boa>

similarity. The goods are neither complementary nor in competition. The goods are, therefore, dissimilar.

45. It is a prerequisite of section 5(2)(b) that the goods be identical or at least similar. The opposition will, therefore, fail in respect of the goods that I have found to be dissimilar.⁷ The opposition under section 5(2)(b) fails for the following goods:

Class 25 Collars [clothing]; Boas [clothing].

The average consumer and the nature of the purchasing act

46. 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 goods 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.”

47. The average consumer for the goods will be members of the general public. The cost of purchase is likely to vary, and the goods will be purchased relatively frequently. However, various factors are still likely to be taken into consideration during the purchasing process, such as materials used, cut, aesthetic appearance and durability. Consequently, I consider that a medium degree of attention will be paid by the average consumer when selecting the goods.

⁷ eSure Insurance v Direct Line Insurance, [2008] ETMR 77 CA

48. The goods are likely to be obtained by self-selection from the shelves of a clothing retail outlet, online or catalogue equivalent. This means that the mark will be seen and so the visual element of the mark will be the most significant: see *New Look Limited v OHIM*, Joined cases T-117/03 to T-119/03 and T-171/03, paragraph 50. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount that there will also be an aural component to the purchase, as advice may be sought from a sales assistant or representative.



Comparison of the trade marks

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

50. 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.

51. The respective trade marks are shown below:

Opponent's trade marks	Applicant's trade mark
<p data-bbox="411 327 576 427" style="text-align: center;">RF</p> <p data-bbox="308 488 683 521" style="text-align: center;">("the First Earlier Mark")</p>  <p data-bbox="284 927 707 960" style="text-align: center;">("the Second Earlier Mark")</p>	

Overall Impression

52. The First Earlier Mark consists of the letters RF. There are no other elements to contribute to the overall impression which lies in the letters.

53. The Second Earlier Mark consists of the letters RF. They are presented in a stylised white font, with a black border, with the letter R on top, and the letter F below, which is stylised with the horizontal lines creating a diagonal line. I consider that the letters RF play a greater role in the overall impression of the mark, with the stylisation playing a lesser role.

54. The applicant's mark consists of the letters RF. The letter R is presented on top, with the letter F below. I note that the letters are presented in a white font against a black background, with a diagonal white line which cuts off the bottom of the letter R and the top of the letter F. I consider that the letters RF play a greater role in the overall impression of the mark, with the stylisation playing a lesser role.

Visual comparison

The First Earlier Mark and the applicant's mark

55. Both marks consist of the letters RF. I also bear in mind that registration of a word only mark covers use in any standard typeface, and registration of a mark in black and white covers use in any colour. I do not, therefore, consider that the slight stylisation and the fact that the applicant's text is presented in the colour white creates a real point of difference between them. The letters give rise to visual similarity. However, I note that the letter F is presented under the letter R in the applicant's mark, with the diagonal white line cutting the letters, and that they are presented against a black background. These act as visual points of difference. Taking the above into account, I consider that the marks are visually similar to between a medium and high degree.

The Second Earlier Mark and the applicant's mark

56. Both marks consist of the letters RF, with the letter R presented on top, and the letter F presented on the bottom. Both letters are in a white font, which is stylised, with the Second Earlier Mark having a black border around the text, and the applicant's mark having a black square background. The notable diagonal aspect of the F in the Second Earlier Mark has a visual overlap with the diagonal line that features in the applicant's mark. Therefore, I consider that the marks are visually similar to a high degree.

Aural comparison

The First Earlier Mark and the applicant's mark

57. Aurally, the marks coincide exactly in the pronunciation of the letters RF, on which the stylisation and background has no effect. The marks are aurally identical.

The Second Earlier Mark and the applicant's mark

58. The same comparison applies in paragraph 57 above. The marks are aurally identical.

Conceptual comparison

The First Earlier Mark and the applicant's mark

59. Conceptually, I have not been provided with submissions from either party as to what concepts would be assigned to the opponent's and applicant's marks. However, I consider that the letters RF, in both marks, will be recognised as an initialism, which is an abbreviation in which each letter is pronounced separately, rather than an acronym being pronounced as a word,⁸ with no immediate conceptual meaning, since they may stand for any number of word combinations. The stylisation present in the applicant's mark add no meaning. Therefore, since it is not clear what the letters signify, the marks are conceptually neutral. However, as both marks clearly use the same letters, 'R' and 'F', and therefore they will share a concept to that extent.

The Second Earlier Mark and the applicant's mark

60. The same comparison applies in paragraph 59 above. The marks are conceptually neutral, but they share the concept of both containing the letters 'R' and 'F'.

Distinctive character of the earlier trade mark

61. 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

⁸ <https://www.collinsdictionary.com/dictionary/english/initialism>

undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, 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 promotion of 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).”

62. 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.

63. As the opponent has not filed any evidence to show that the distinctiveness of its mark has been enhanced through use, I only have the inherent position to consider.

64. As highlighted above, both the First and Second Earlier Marks are made up of the combination of 2 letters ‘R’ and ‘F’. The letters have no immediate conceptual meaning, since they may stand for any number of word combinations.

65. However, since there is no evidence that the letters RF are commonly used in relation to the goods in issue, and they are not descriptive or allusive, I consider that the First Earlier Mark is inherently distinctive to a medium degree. I consider that as the Second Earlier Mark is presented in a stylised manner, that it is inherently distinctive to above a medium degree.

Likelihood of confusion

66. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related. 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 respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. It is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for 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 instead rely upon the imperfect picture of them that they have retained in their mind.

67. The following factors must be considered to determine if a likelihood of confusion can be established:

- I have found the First Earlier Mark and the applicant's mark to be visually similar to between a medium and high degree.
- I have found the Second Earlier Mark and the applicant's mark to be visually similar to a high degree.
- I have found all of the marks to be aurally identical.
- I have found all of the marks to be conceptually neutral, but they share the concept of both containing the letters 'R' and 'F'.
- I have found the opponent's First Earlier Mark to be inherently distinctive to a medium degree.
- I have found the opponent's Second Earlier Mark to be inherently distinctive to above a medium degree.

- I have identified the average consumer to be members of the general public who will select the goods primarily by visual means, although I do not discount an aural component.
- I have concluded that a medium degree of attention will be paid during the purchasing process for the goods.
- Excluding the goods which I found not to be similar, I have found the parties' goods to be identical to similar to a low degree.

68. Taking all of the factors listed in paragraph 67 into account, I consider that there is a likelihood of direct confusion. As mentioned above, the average consumer will select the goods by visual means, and in these circumstances, all of the marks share the initialism RF. Therefore the stylistic differences between the marks such as the black square background, or the different fonts in which the marks are presented in, will be easily overlooked. I also note that there is no conceptual hook to differentiate the marks. I bear in mind the interdependency principle, whereby the high similarity between the marks offsets the differences between the goods that I have only found to be similar to a low degree. Consequently, I consider there to be a likelihood of direct confusion on all of the goods, except for those which are dissimilar.

69. In the event that I am wrong in that regard, and for the sake of completeness, I will also assess if there is a likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

“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.”

70. If the average consumer recalls the minimal stylistic differences between the marks, then the common initialism RF, will lead the average consumer to conclude that all of the marks originate from the same or economically linked undertakings. I consider that the average consumer will see the addition of the stylistic elements and perceive them as alternative marks being used by the same or economically linked undertakings. I also consider there to be a likelihood of indirect confusion.

CONCLUSION

71. The opposition is partially successful in respect of the following goods, for which the application is refused:

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]; 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]; Slips [clothing]; Veils [clothing]; Wraps [clothing]; Athletic clothing; Triathlon clothing.

72. The application can proceed to registration in respect of the following services for which the opposition has been unsuccessful:

Class 25 Collars [clothing]; Boas [clothing].

COSTS

73. The opponent has enjoyed a greater degree of success in the opposition and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. I will make an appropriate reduction in the award of costs made to reflect the opponent's only partial success. In the circumstances, I award the opponent the sum of **£400** as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Filing a Notice of opposition and considering the applicant's counterstatement	£150
Preparing and filling written submissions in lieu	£150
Official Fee	£100
Total	£400

74. I therefore order rfclothingofficial limited to pay FOX FACTORY, INC. the sum of £400. 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 20th day of October 2022

L FAYTER

For the Registrar