

BL O/0404/23

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO. UK00003819251

BY SANTO CLOTHING LTD TO REGISTER AS A TRADE MARK:

SANTO

IN CLASS 25

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NO.

OP600002656 BY SANTO AMMO LIMITED

BACKGROUND AND PLEADINGS

1. On 12 August 2022, Santo Clothing Limited (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. On 9 September 2022, the application was accepted and published in the Trade Marks Journal in respect of the following goods:

Class 25: Clothing; clothes; tops [clothing]; hoods [clothing]; jackets [clothing].

2. On 6 December 2022, Santo Ammo Limited (“the opponent”) filed a notice of opposition on the basis of section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed at the applicant’s mark in its entirety. The opponent relies on the following trade mark:

SANTO AMMO

UK registration no. UK3488417

Filing date 10 May 2020; date of entry in register 11 August 2020

Relying on all the goods:

(“the opponent’s mark”)

Class 25: Clothing, footwear, headgear.

3. The opponent submits that there is a likelihood of confusion because the applicant’s mark is similar to its own mark and the respective goods are identical or similar. The applicant filed a defence and counterstatement denying the claims made.

4. The applicant represents itself; the opponent is represented by Jessie Tsang. Neither party filed evidence or submissions. No hearing was requested. Neither party filed submissions in lieu of a hearing. This decision is taken following a careful perusal of the papers.

5. 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.

Section 5(2)(b): legislation and case law

6. Section 5(2)(b) of the Act reads as follows:

“(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 or association with the earlier trade mark.”

7. Section 5A of the Act is as follows:

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

8. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“(6)(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) 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,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

9. Given its filing date, the opponent’s mark qualifies as an earlier mark under the above provisions. The opponent’s mark did not complete its registration process five years before the filing date of the applicant’s mark. The conditions of use, therefore, do not apply to the opponent’s mark. Therefore, the opponent can rely on all its goods in the opposition.

10. 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 impression 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 to mind the earlier mark, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

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

COMPARISON OF THE GOODS

11. The goods to be compared are as follows:

The applicant's goods	The opponent's goods
<i>Clothing; clothes; tops [clothing]; hoods [clothing]; jackets [clothing].</i>	<i>Clothing, footwear, headgear.</i>

12. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05, the General Court (“GC”) stated:

“29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark”

13. “*Clothing*” appears in both parties’ specifications and is, therefore, self-evidently identical.

14. “*Clothes*”, “*tops [clothing]*”, “*hoods [clothing]*” and “*jackets [clothing]*” in the applicant’s specification are all various items of clothing. These goods are encompassed by “*clothing*” in the opponent’s specification. Therefore, I find the goods to be identical on the principle outlined in *Meric*.

THE AVERAGE CONSUMER AND THE PURCHASING PROCESS

15. As the law above indicates, it is necessary for me to determine who the average customer is for the 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 (as he then was) described the average consumer in these terms:

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

16. The average consumer for the goods at issue is the general public at large. The goods are most likely to be sold through a range of clothing retailers and their online or catalogue equivalents. In physical retail premises, the goods at issue will be displayed on shelves or racks, where they will be viewed and self-selected by the customer. A similar process will apply to websites and catalogues, where the consumer will select the goods having viewed an image displayed on a webpage or in a catalogue. 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, therefore, dominate the selection process, although I do not discount an aural component playing a part. The price and frequency of the purchase of the goods at issue may vary. Even where the goods are of low cost and purchased relatively frequently, a number of factors will still be considered by the average consumer during the purchasing process. When selecting the goods at issue the average consumer may consider current fashion trends, price, quality and suitability. With this in mind, I consider that the average consumer will pay a medium degree of attention during the purchasing process.

COMPARISON OF THE MARKS

SANTO	SANTO AMMO
The applicant's mark	The opponent's mark

17. 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 trade marks must be assessed by reference to all the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union ("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.”

18. 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.

19. The opponent’s mark consists of the words ‘Santo Ammo’ in stylised text. The mark is dominated by the words ‘Santo Ammo’ with the stylisation playing a lesser role. The applicant’s mark consists of the word ‘Santo’. There are no other elements that contribute to the overall impression of the mark.

20. Visually, the marks share the word ‘Santo’ at the beginning of the mark. ‘Santo’ is the entirety of the applicant’s mark and the first word in the opponent’s mark. The points of difference between the marks are the word ‘Ammo’ at the end of the opponent’s mark and the stylisation of the opponent’s mark. Consequently, I consider the marks to be visually similar to a medium degree.

21. Aurally, the opponent’s mark consists of four syllables that will be pronounced as SAN-TOE-AM-OH and the applicant’s mark consists of two syllables that will be pronounced as SAN-TOE. I note that the marks share the pronunciation of SAN-TOE and differ in the pronunciation of AM-OH. Consequently, I consider the marks to be aurally similar to a medium degree.

22. Conceptually, the applicant’s mark consists of an invented term that has no ordinary dictionary meaning. Conceptually, the opponent mark consists of two words, whilst I am conscious that the average consumers do not artificially dissect marks, it is my view that whilst they will view SANTO as an invented term they will identify the word AMMO as an abbreviation for ammunition. As a concept (albeit a weak one) is present in the opponent’s mark and not present in the applicant’s mark, I find the marks to be conceptually neutral.

DISTINCTIVE CHARACTER OF THE OPPONENT’S MARK

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

"22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C108/97 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)."

24. Registered trade marks possess varying degrees of inherent distinctive character through use, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with a high inherent distinctive character, such as invented words which have no allusive qualities.

25. The opponent has not pleaded enhanced distinctive character through use and has not filed evidence to support such a claim, therefore, I have only the inherent position to consider.

26. The opponent's mark consists of the word 'SANTO AMMO' in stylised text. 'SANTO', as far as I am aware, is not an ordinary dictionary word with any obvious meaning that would be immediately graspable by the majority of average consumers. However, as for the word 'AMMO', as I have set out above, it will be viewed as an abbreviation of the word 'ammunition' which is not descriptive of the goods at issue. When considering the mark as a whole, I appreciate that 'AMMO' is an abbreviation of ammunition, however, given it has no relation to the goods at issue, it is my view that it increases the distinctive character of the opponent's mark. I am not of the view that the stylisation is enough to enhance the distinctive character of the mark. Therefore, when considered as a whole, I find the opponent's mark enjoys a high degree of inherent distinctive character.

LIKELIHOOD OF CONFUSION

27. 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. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier marks, 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 s/he has retained in his/her mind.

28. I have found the marks to be visually and aurally similar to a medium degree and conceptually neutral. I have found the goods at issue to be identical. I have identified the average consumer as the general public who will purchase/select the goods 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. I have found the opponent's mark to be inherently distinctive to a high degree.

29. Taking all the above and the principle of imperfect recollection into account, I do not consider that the parties' marks will be mistakenly recalled or misremembered for one another. I recognise that the marks share the same common element, being 'SANTO' which is in favour of the opponent. Despite this, I consider that the visual and aural differences between the marks, particularly the word 'AMMO' at the end of the opponent's mark will be sufficient to enable the average consumer to differentiate between them. This will allow average consumers to sufficiently recall the marks. Consequently, I consider there to be no likelihood of direct confusion between the marks, even for the goods that I have found to be identical and taking into consideration the highly distinctive character of the opponent's mark.

30. I will now consider whether there is a likelihood of indirect confusion. Indirect confusion involves recognition by the average consumer of the difference between the marks. Mr Purvis

QC in the *L.A Sugar Limited* case sets out three main categories of indirect confusion and that indirect confusion ‘tends’ to fall in one of them.¹ The three categories are as follows:

“(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.). BL O/375/10 Page 15 of 16

(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).”²

31. Whilst I note that the examples set out by Mr Purvis are not exhaustive, I note the recent case of *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors*,³ wherein Arnold LJ referred to the comments of James Mellor QC sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he stated that a finding of a likelihood of indirect confusion is not a consolidation prize and that there needs to be a reasonably special set of circumstances in order to get indirect confusion where there is no likelihood of direct confusion. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

32. Indirect confusion involves recognition by the average consumer of the differences between the marks. In my view, when the differences between the marks are taken into account, I do not consider that the presence of the word ‘AMMO’ at the end of the opponent’s mark will be sufficient for the average consumer to consider that that applicant’s mark originated from a different or unconnected undertaking to that of the opponent. I am of the view that the opponent’s mark could be seen as a brand extension or sub-brand of the

¹ Paragraphs 16 & 17 of *L.A Sugar Limited v By Black Beat Inc*, Case BL-O/375/10

² *Ibid*, Paragraph 17

³ [2021] EWCA Civ 1207

applicant's mark. This is on the basis that the average consumer is likely to believe that, when confronted with both marks, the addition of 'AMMO' in the opponent's mark would be a logical step for an undertaking where it was looking to extend into other areas of business. For example, the clothing brand 'Santo' may create a sub-brand or brand extension that focuses on hunting, tactical or trendy urban streetwear clothing – hence 'Santo Ammo'. This is supported by *Zero Industry Srl v OHIM* Case T-400/06 which refers to sub-brands being common in the clothing trade. In my view, this points to the marks coming from the same or economically linked undertakings. The present circumstances fall neatly into the categories outlined by Mr Purvis QC as the shared element is so strikingly distinctive that the average consumer would assume that no-one else other than the brand owner would be using it as a trade mark. Consequently, I consider that there is a likelihood of indirect confusion between the marks for all the goods at issue.

CONCLUSION

33. The opposition succeeds in full. The application will, therefore, be refused for all the goods for which registration is sought.

COSTS

34. The opponent has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2015 for fast track proceedings. In the circumstances, I award the sum of £300 as a contribution towards its costs. The sum is calculated as follows:

Preparing a statement and considering the other side's statement	£200
Official fee	£100
Total	£300

35. I, therefore, order Santo Clothing Ltd to pay Santo Ammo Limited the sum of £300 as a contribution towards its costs. 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 3rd day of April 2023

A KLASS

For the registrar