

O-522-17

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3160385
BY NADEEM ANWAR TO REGISTER THE FOLLOWING TRADE MARK**

SPRAY DRY

IN CLASS 25

**AND IN THE MATTER OF OPPOSITION THERETO UNDER NO. 407163
BY DKH RETAIL LIMITED**

Background and pleadings

1) Nadeem Anwar (hereafter “the applicant”) applied to register the trade mark 3160385 SPRAY DRY. The application has a filing date of 22 May 2016 and a publication date of 10 June 2016. It was applied for in respect of the following list of goods:

Class 25: CLOTHING : T-SHIRTS , SWEAT SHIRTS , HOODED SWEAT SHIRTS , JOGGING BOTTOMS , TRACKSUITS , SHORTS , BOXER SHORTS , UNDER GARMENTS , UNDERWEAR , POLO SHIRTS , LONG SLEEVE SHIRTS , SHORT SLEEVE SHIRTS , DENIM JACKETS , JACKETS , JEANS , CHINO TROUSERS, CASUAL WEAR , SPORTS WEAR , LEASURE WEAR , TROUSERS , BODY WARMER JACKETS , FULL ZIP HOODED SWEAT SHIRTS , HALF ZIP HOODED SWEAT SHIRTS , SLEEVE LESS HOODED SWEAT SHIRTS , SLEEVE LESS SWEAT SHIRTS , FULL ZIP SLEEVE LESS SWEAT SHIRTS , FOOTWEAR : JOGGERS , TRAINERS , CANVAS SHOES , CASUAL SHOES , FLIP FLOPS , SANDALS , SHOES , SLIPPERS , HEAD GEAR : BASEBALL HATS , WOLLEY HATS , CAPS , BANDANAS , BEANIES

3) DKH Retail Limited (hereafter “the opponent”) opposes the trade mark on the basis of section 5(2)(b), section 5(3) and section 5(4)(a) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against all of the goods set out above. The opponent relies upon the following earlier trade marks: 2510106, 2430291, EU3528403, IR899643, 2307338, 3039912, 2487680 and EU8670051. Whilst all except 3039912 are potentially subject to the proof of use provisions contained in section 6A of the Act, the applicant, in its counterstatement has not chosen to exercise his right to put the opponent to such proof. Therefore, the opponent is entitled to rely upon the full range of goods listed in all its earlier marks.

4) It appears to me that whilst the opponent relies upon eight earlier marks (the relevant details of which are listed in the annex to this decision), none of them places it in a stronger position than the one listed below. For the purposes of this decision, I will consider the opponent’s case in respect of only this earlier mark:

Mark and relevant dates	Goods include:
2510106 SUPERDRY Filing date: 3 March 2009 Date of entry in register: 17 July 2009	Class 25: <i>Clothing, footwear, headgear, trousers, socks, gloves, underwear</i>

5) The opponent's mark is an earlier mark within the meaning of section 6(1) of the Act. It claims that:

- the applicant's mark is similar to the opponent's mark and that it is in respect of identical or similar goods and, as a result, is debarred from registration under section 5(2)(b) of the Act.
- that its trade mark has a "strong reputation" and that "it is inevitable that the [opponent's mark] will be brought to mind" and, as a result the relevant public will consider that there is an economic link between the parties. It claims that, as a result of this, use of the applicant's mark is contrary to section 5(3) of the Act and will, without due cause:
 - (i) result in the applicant inevitably taking unfair advantage of the opponent's mark's distinctive character;
 - (ii) be detrimental to the reputation of the opponent's mark where the opponent has no control over the manner in which the applicant's mark is used and it may be used in a way that is adverse to the opponent's image and may be used on inferior goods and services;
 - (iii) be detrimental to the distinctive character of the opponent's mark because if the applicant's goods are purchased in the belief that they provided by the opponent or with his consent, this will lead to a loss of business and the fact that the relevant public will no longer associate the earlier mark solely with the opponent;
- The opponent's mark has, since 2003, been used extensively in the UK in relation to clothing, footwear and headgear and the retailing of the same. Its mark appears dominantly on its products and its sales in the hundreds of

millions of pounds a year. It claims that because of the high level of similarity between the marks then misrepresentation will occur resulting in damage

6) The applicant filed a counterstatement denying the claims made. As I mentioned above, it has not put the opponent to proof of use of its earlier marks.

7) The opponent filed evidence and both sides filed written submissions. I will summarise the evidence to the extent that it is considered necessary and I will keep the submissions in mind.

8) The applicant was represented by Jensen & Son who indicated that the applicant was content for a decision to be made from the papers. The opponent requested to be heard and a hearing took place on 31 August 2017 with it being represented by Mr Tom St Quintin of Counsel, instructed by Fox Williams LLP. The applicant did not attend.

Opponent's Evidence

9) This takes the form of a witness statement by James Philip Sweeting, Senior Intellectual Property Legal Counsel for SuperGroup Plc and authorised representative of the opponent that is its wholly owned subsidiary. Mr Sweeting provides evidence particularly on the issues of enhanced distinctive character of the opponent's marks, their reputation and also the goodwill enjoyed by the opponent.

10) He provides the following information:

- The opponent has been trading under the "SUPERDRY" branding for clothing since 2003, some thirteen years before the filing date of the contested application ("the relevant date");
- The success of the clothing brand led to SUPERDRY-branded retail stores, and at the end of the calendar year prior to the relevant date, the opponent had 112 stores in the UK selling SUPERDRY branded clothing (consisting of 100 standalone stores and 16 concessions);

- In addition to these stores, SUPERDRY branded clothing is also sold in store and/or online by traders such as ASOS online retailer, NEXT online, HOUSE OF FRASER, HARRODS, SELFRIDGES and LITTLEWOODS and VERY online retailers;
- The opponent operates online via its domain www.superdry.co.uk which automatically directs consumers to its .com site of the same name. Archived print-outs showing extracts from its website in September 2011, July 2012 and November 2014 are provided at Exhibit JS10 and illustrate the opponent's word mark used on most the pages shown, for example, in the heading "Superdry the brand" and its statements such as "Superdry: British design; Spirit of Japan, our extensive range features ..." and stylised marks used on various items of clothing;
- In the period of 22 months leading up to the relevant date, the opponent's website had 17.9 million unique visitors from the UK;
- At launch, the SUPERDRY brand was used on a narrow range of casual clothing, but by the relevant date in these proceedings, the brand covered a wide range of clothing, footwear and hats;
- The opponent's clothing is heavily branded with its SUPERDRY mark and numerous extracts from its lookbooks are provided at Exhibit JS12 covering the period from 2006 to 2016. These examples also show the word SUPERDRY appearing with additional matter or part of a composite mark;
- SUPERDRY clothes have been chosen and worn by a large number of extremely famous people and the opponent has collaborated with celebrities in order to promote the SUPERDRY brand;
- The opponent has spent up to £222,000 (2015) a year on marketing activities and in the five years prior to the relevant date, this has been in excess of £100,000;
- The opponent's turnover from SUPERDRY branded clothing was £139 million in 2010 and rose every year to £597 million in the year ending April 2016, the latest full year prior to the relevant date. An extract from the opponent's 2012 annual report and financial statements, shown at Exhibit JS30, states that all turnover "originates in the United Kingdom" and 67.5% was attributable to the UK;

- The opponent's SUPERDRY brand has been reported won widely in the UK press, business news and fashion publications. Examples are shown at Exhibit JS31.
- At Exhibit 22 is an interview with the opponent's marketing director, Simon Lloyd, published in *Marketing Week* on 30 June 2014. Mr Lloyd explains that in its first ten years, the opponent did not undertake what might be described as "marketing". Elsewhere he refers to use of social media such as Facebook and refers to the absence of television marketing.

DECISION

Section 5(2)(b)

11) Sections 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".

Comparison of goods

12) In the judgment of the Court of Justice of the European Union in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment 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".

13) The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services
- c) The respective trade channels through which the goods or services reach the market
- d) 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;
- e) 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.

14) In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05 (*MERIC*), the General Court stated that:

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

15) The applicant in its counterstatement states that it “...accepts that the goods are similar...”. A similar concession is also made in its written submissions. I would go further. As Mr St Quintin submitted at the hearing, the opponent’s specification of

goods includes the broad terms “clothing, footwear and headgear”. Applying the guidance of the GC in *MERIC* it is self-evident that all of the applicant’s goods are included by one of these three broad terms and are, therefore, identical to the opponent’s goods.

Comparison of marks

16) 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 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.”

17) 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.

18) The respective trade marks are shown below:

Earlier trade mark	Contested trade mark
SUPERDRY	SPRAY DRY

19) The opponent's mark consists of the two words SUPER and DRY conjoined, however, the two words retain individual character and the average consumer is likely to naturally divide the mark into these two words. Neither word is particularly

distinctive on its own, but they combine to create a distinctive whole that alludes to clothing that has a characteristic of keeping the wearer "super dry". The applicant's mark also consists of two words, but these are not conjoined. The individually descriptive words combine to create a mark that "hangs together" as an allusive term and, like the opponent's mark, its distinctive character resides in its totality.

20) Visually, Mr St Quintin submitted that the respective marks are highly similar and drew my attention to the fact that the respective marks are identical in length, share the same initial letter and the same last three letters, both recognised as consisting of two elements, where the respective first elements both consist of five letters and share the letters "P" and "R". I acknowledge all these similarities but, as the applicant points out in its written submissions, the first word in each mark is distinguishable from the other because they are different words. The visual differences between these two words will not go unnoticed by the average consumer. I keep in mind the guidance of the General Court in *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, where it noted that the beginnings of word tend to have more visual and aural impact than the ends. I also observe that in the opponent's mark, the two elements are conjoined, whereas in the applicant's mark, the two elements are separated. Taking all of these factors together, I conclude that the respective marks share a medium level of visual similarity.

21) Aurally, the opponent submits that the marks coincide in the "S _ _ _ _ DRY" pronunciation and that these results in the marks being similar. The applicant, on the other hand, submits that the opening sound of the opponent's mark is a longer, rounder syllable "SU" rather than "SP" in the opponent's mark. I would go further and also point out that the second syllable "PER" is also different to the applicant's "RAY". Taking all of the above into account, I conclude that the level of similarity is no more than medium.

22) Mr St Quintin submitted that the respective marks both similarly allude to providing a level of protection against moisture and because both marks allude to concepts that are both on the spectrum of dryness, they are conceptually similar. In the context of clothing, Mr St Quintin countered the applicant's submission, that its mark describes an industrial technique for producing dry powders, by claiming this is

irrelevant because it will not have any impact on the average consumer's conceptual appreciation of the mark. He submitted that, rather, the applicant's mark will be perceived as indicating goods that keep the user dry from spray. I agree insofar as there is an allusion in both marks to dryness. However, there is a distinction in that the opponent's mark conveys a message of being "very dry" whereas, the applicant's mark is likely to convey a message that the goods have been sprayed (with a protective material) in order to keep wetness out. To my mind, this is the obvious and most likely allusion created by the applicant's mark rather than, what Mr St Quintin submits, is an allusion to keeping the wearer dry from spray. Therefore, taking this into account, the different first words of the respective marks, this creates different concepts that are lowly similar. Even if I am wrong, and the applicant's mark would be perceived as alluding to keeping the user dry from spray, I am still of the view that the similarity is still low. The word "super" is a laudatory, indicating something extra, whereas the word "spray" indicates fine droplets of moisture. The words have entirely different meanings, which impacts on the meanings of the marks as wholes, although both allude to dryness.

Average consumer and the purchasing act

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

24) 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.”

25) The average consumer of the goods concerned is the ordinary clothes purchasing public and there is no reason why I should assume that s/he is any different to that identified by Birss J. above. The General Court (“the GC”) has continued to identify the importance of visual comparison when considering the purchasing act in respect of clothing (see for example Joined Cases T-117/03 to T-119/03 and T-171/03 *New Look Ltd v OHIM (NLSPORT et al)* [2004] ECR II-3471 at [49]-[50] and Case T-414/05 *NHL Enterprises BV v OHIM (LA KINGS)* [2009] ECR II.). I conclude that the purchasing process is primarily a visual one, however, I do not ignore that aural considerations may be involved.

26) The purchasing act will, generally involve a reasonable degree of care and attention but not the highest degree of attention.

Distinctive character of the earlier trade mark

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

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

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically

widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

28) The opponent’s mark consists of the conjoined words SUPER and DRY. As the opponent has submitted, the mark is allusive of clothing, footwear and headgear that keep the wearer very dry. This allusiveness results in the mark be endowed with only a low level of inherent distinctive character.

29) I must also consider whether the mark benefits from an enhanced level of distinctive character arising from the use made of it. In this respect, the evidence illustrates use, by the opponent, of its word mark SUPERDRY as one of a number of SUPERDRY marks. Further, the level and geographical scope of its use is significant, with UK sales being nearly £600 million in the last full year prior to the relevant date in these proceedings. I have no hesitation in concluding that the opponent’s mark benefits from an enhanced level of distinctive character as a result of this use. I would characterise the level of this enhanced distinctive character as being reasonably high.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.

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

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

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

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a 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.

31) Mr St Quintin submitted that persons other than the original purchaser will pay an even lower level of care and attention. He relied upon the guidance in *Anheuser-Busch v Budejovicky Budvar* [2005] ETMR 27, paragraph 60. In order to give that guidance context, I also reproduce the two preceding paragraphs:

58 By its second question, the national court is asking, essentially, whether and, if so, **under what conditions a trade name may be regarded as a sign** [my emphasis] for the purposes of the first sentence of Art.16(1) of the TRIPs Agreement with the result that, under that provision, the proprietor of a trade mark has an exclusive right to prevent a third party from using that trade name without his consent.

59 First, with respect to Directive 89/104 , it follows from the Court's case law on the definition of use by a third party, for which provision is made in Art.5(1) of that directive, that the exclusive right conferred by a trade mark was intended to enable the trade mark proprietor to protect his specific interests as proprietor, that is, to ensure that the trade mark can fulfil its functions and that, therefore, the exercise of that right must be reserved to cases in which a third party's use of the sign affects or is liable to affect the functions of the trade mark, in particular its essential function of guaranteeing to consumers the origin of the goods (see Case C-206/01 Arsenal Football Club [2002] E.C.R. I-10273 , [51] and [54]).

60 That is the case, in particular, where the use of that sign allegedly made by the third party is such as to create the impression that there is a material link in trade between the third party's goods and the undertaking from which those

goods originate. It must be established whether the consumers targeted, including those who are confronted with the goods after they have left the third party's point of sale, are likely to interpret the sign, as it is used by the third party, as designating or tending to designate the undertaking from which the third party's goods originate (see, to that effect, Arsenal Football Club , cited above, [56] and [57]).

32) My understanding of the above is that the court is discussing under what conditions a trade name may be considered a sign. This is a different question to that which I need to consider here, namely, what level of care and attention is paid by the consumer during the purchasing process. There may be some post-sales circumstances where confusion may be relevant, as envisaged by Arnold J. in *Da, tacard Corporation v Eagle Technologies Limited* [2011] EWHC 244 (Pat). At paragraph 288 of that decision, he offered the view:

“288. Finally, as a matter of principle, I find it difficult to see why it should matter if confusion only arises after the goods have been sold. Suppose that a consumer orders goods from a third party's website and, at the time of ordering, is not confused as the trade origin of the goods; but when the goods arrive some days later, the goods are labelled in a manner which wrongly leads the consumer to believe that the goods emanate from the trade mark proprietor. Why should such confusion not be actionable? It falls within the scope of a contextual assessment of the use of the sign. It is surely capable of being damaging to the trade mark proprietor. For example, it may cause the consumer to obtain the goods from the same website the next time he or she orders those goods under the same mistaken belief. And why should it make any difference for these purposes whether the goods are labelled with a sign identical to the trade mark or merely one that is similar to the trade mark i.e. whether the case falls within Article 5(1)(a) or 5(1)(b)?

289. Accordingly, I conclude that in appropriate circumstances post-sale confusion can be relied upon as demonstrating the existence of a likelihood of confusion under Article 5(1)(b).”

33) However, the scenario referred to by Mr St Quintin where a person may be confused into believing an item of clothing bearing the applicant's mark and worn by someone else would be perceived as originating from the opponent. Such a cursory contact with the applicant's mark in this situation would not lead to a relevant type of confusion for the purposes of section 5(2) of the Act. Even if the cursory contact had inspired the person to purchase the same item of clothing, at that point the ordinary considerations regarding likelihood of confusion during the purchasing process will come into play. Therefore, I dismiss Mr St Quintin's submission that such circumstances are relevant to my considerations.

34) I have found the following:

- The respective goods are identical;
- The distinctive character of both marks resides in their respective totalities;
- The respective marks share:
 - A medium level of visual similarity;
 - No more than a medium level of aural similarity;
 - A low level of conceptual similarity.
- The average consumer is the clothes buying general public who is reasonably well informed and reasonably circumspect;
- The purchasing process is primarily visual in nature, but I do not ignore aural considerations and that the consumer pays a reasonable degree of attention during the purchasing process;
- The opponent's mark has a low level of inherent distinctive character, but that this is enhanced through the use made of it to a reasonably high level.

35) I recognise that the visual aspects of the marks are the most important during the purchasing process. However, when taking all the above findings into account, in particular, the fact that the initial word of both marks, namely, SPRAY and SUPER are different and that they have the effect of changing the conceptual identity of the marks, I find that the average consumer is not likely to either mistake one mark for the other, or to believe that they originate from the same or linked undertaking. The second word present in each mark, namely DRY, whilst present in both marks conveys a concept that is desirable for items of clothing. The opponent has also

pointed out that both marks share the letters P and R, however, this has minimal, if any, impact in the minds of the consumer because the fact is very likely to be overridden by the conceptual differences in the words in which these letters appear. For example, the consumer would be unlikely to register the fact that GLEAN and ANGEL consist of the same five letters because the very different concepts endowed by each mark will be uppermost in the minds of the consumer. Therefore, other than the initial letter "S", common to both marks, there is no other similarity likely to be perceived between the marks. The presence of the word DRY, because it describes a desirable concept associated with clothing, will carry lesser weight in the minds of average consumers, and it is the overall impression created by the respective marks that is most important. In this respect, whilst there are some of my findings that lean towards a finding of likelihood of confusion, these are outweighed by the differences between the marks. This leads me to the conclusion that there is no likelihood of direct confusion (where one mark is mistaken for the other) or indirect confusion (where the consumer will notice the differences between the marks but still assume the goods provided under each originate from the same or linked undertaking).

36) The opposition based upon section 5(2)(b) of the Act fails.

Section 5(4)(a)

37) Section 5(4)(a) states:

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b) [.....]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark.”

38) At the hearing, Mr St Quintin conceded that the opponent's case based upon section 5(4)(a) should follow the outcome in respect of section 5(2). This is a sensible approach. I recognise that the test for misrepresentation is different to that for likelihood of confusion, namely, that misrepresentation requires "a substantial number of members of the public are deceived" rather than whether the "average consumer are confused". However, as recognised by Lewinson L.J. in *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, it is doubtful whether the difference between the legal tests will produce different outcomes. Certainly, I believe that this is the case here. Even accepting that the opponent has a large goodwill identified by its signs I, nonetheless, find that members of the public are unlikely to be misled into purchasing the applicant's goods in the belief that they are the goods of the opponent. For the reasons set out earlier, I consider that the differences between the respective marks are so great that no economic connection will be made.

39) In conclusion, I find that grounds, insofar as they are based upon section 5(4)(a), also fail.

Section 5(3)

40) The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Addidas-Salomon*, [2004] ETMR 10 and C-487/07, *L'Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29* and *Intel, paragraph 63*.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

Reputation.

41) In paragraph 28, I recognised that the opponent has made significant use of its mark in the UK. That same use is sufficient for me to conclude that it has the requisite reputation in the UK in respect of clothing footwear and headgear.

Link

42) In *Intra-Press SAS v OHIM*, Joined cases C-581/13P & C-582/13P, the Court of Justice of the European Union stated (at paragraph 72 of its judgment) that:

“The Court has consistently held that the degree of similarity required under Article 8(1)(b) of Regulation No 40/94, on the one hand, and Article 8(5) of that regulation, on the other, is different. Whereas the implementation of the protection provided for under Article 8(1)(b) of Regulation No 40/94 is conditional upon a finding of a degree of similarity between the marks at issue so that there exists a likelihood of confusion between them on the part of the relevant section of the public, the existence of such a likelihood is not necessary for the protection conferred by Article 8(5) of that regulation. Accordingly, the types of injury referred to in Article 8(5) of Regulation No 40/94 may be the consequence of a lesser degree of similarity between the

earlier and the later marks, provided that it is sufficient for the relevant section of the public to make a connection between those marks, that is to say, to establish a link between them (see judgment in *Ferrero v OHMI*, C-552/09 P, EU:C:2011:177, paragraph 53 and the case-law cited).”

43) Therefore, the level of similarity required for the public to make a link between the marks for the purposes of 5(3) may be less than the level of similarity required to create a likelihood of confusion. However, I find that the applicant’s mark will not even bring the opponent’s mark to mind. Even if I am wrong, any bringing to mind would only be fleeting and insufficient to lead to any detriment or unfair advantage.

44) The requisite link has not been established and the opposition based upon section 5(3) fails.

Summary

45) The opposition fails in its entirety and the application may proceed to registration.

Costs

46) Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 2 of 2016. I take account that the opponent filed evidence, but that the applicant did not. Consequently, the amount awarded in respect of preparing evidence and considering the other side’s evidence has been reduced (to a little below the minimum on the scale). Both sides also filed written submissions and that a hearing was held (but that the applicant did not attend). With all of this in mind, I award costs as follows:

Considering a statement and preparing the counterstatement	£350
Preparing evidence and considering other side’s evidence	£400
Written submissions	£350
Total:	£1100


47) I order DKH Retail Limited to pay Mr Nadeem Anwar the sum of £1100 which, in the absence of an appeal, should be paid within 14 days of the expiry of the appeal period.

Dated this 18th day of October 2017

**Mark Bryant
For the Registrar
The Comptroller-General**

Annex

Mark and relevant dates	Goods include:
2510106 SUPERDRY Filing date: 3 March 2009 Date of entry in register: 17 July 2009	Class 25: <i>Clothing, footwear, headgear, trousers, socks, gloves, underwear</i>
2430291 SUPERDRY Filing date: 18 August 2006 Date of entry in register: 17 April 2009	Class 25: <i>Casual clothing, hooded sweatshirts, jeans, printed t-shirts, lined and unlined jackets, short sleeve and long sleeve shirts, baggy shorts, long sleeve embroidered t-shirts, printed and embroidered sweatshirts, fleece pullovers, shorts, scarves.</i>
EU3528403 SUPERDRY Filing date: 31 October 2003 Date of entry in register: 22 June 2005	Class 25: <i>Clothing, footwear, headgear; casual clothing, hooded sweatshirts, jeans, printed t-shirts, lined and unlined jackets, shortsleeve and longsleeve shirts, baggy shorts, longsleeve embroidered t-shirts, printed and embroidered sweatshirts, trousers, fleece pullovers, socks, skirts, scarves, gloves, underwear.</i>
International Registration designating the EU, number 899643 SUPERDRY Date of protection granted in EU: 18 August 2006 Date of protection granted in EU: 10 September 2007	Class 25: <i>Clothing, footwear, headgear; casual clothing, hooded sweatshirts, jeans, printed T-shirts, lined and unlined jackets, short sleeve and long sleeve shirts, baggy shorts, long sleeve embroidered T-shirts, printed and embroidered sweatshirts, trousers, fleece pullovers, socks, shorts, scarves, gloves, underwear.</i>
3039912 	Class 25: <i>Clothing; casual clothing; formal clothing; sportswear; leisurewear; hooded sweatshirts, printed T-shirts, T-shirts, polo shirts, short sleeved and long sleeved shirts, shirts, blouses, shorts, baggy shorts, long sleeved T-shirts, rugby tops, printed and embroidered</i>

<p>Filing date: 29 January 2014 Date of entry in register: 27 June 2014</p>	<p><i>sweatshirts, cardigans, sweaters, zip tops, joggers, trousers, jeans, knitwear, jumpers, fleece pullovers, dresses, skirts, tops, lined and unlined jackets, jackets, coats, windcheater jackets, trench coats, leather jackets, flatiron jackets, wax jackets, military blazers, macs, gilets, hunting jackets, flax jackets, stormbreaker jackets, army jackets, bomber jackets, cagoules, suits, waistcoats, ties, leggings, socks, scarves, gloves, swimwear, belts, underwear, camisoles, bras, knickers, boxer shorts, underpants, slips [undergarments], nightwear, pyjamas, bathrobes, dressing gowns; footwear; sandals, beach shoes, canvas shoes, boots, shoes, leather shoes; headgear; hats, caps, bandanas, beanies.</i></p>
<p>3039912</p>  <p>Filing date: 29 January 2014 Date of entry in register: 27 June 2014</p>	<p>Class 25: Clothing; casual clothing; formal clothing; sportswear; leisurewear; hooded sweatshirts, printed T-shirts, T-shirts, polo shirts, short sleeved and long sleeved shirts, shirts, blouses, shorts, baggy shorts, long sleeved T-shirts, rugby tops, printed and embroidered sweatshirts, cardigans, sweaters, zip tops, joggers, trousers, jeans, knitwear, jumpers, fleece pullovers, dresses, skirts, tops, lined and unlined jackets, jackets, coats, windcheater jackets, trench coats, leather jackets, flatiron jackets, wax jackets, military blazers, macs, gilets, hunting jackets, flax jackets, stormbreaker jackets, army jackets, bomber jackets, cagoules, suits, waistcoats, ties, leggings, socks, scarves, gloves, swimwear, belts, underwear, camisoles, bras, knickers, boxer shorts, underpants, slips [undergarments], nightwear, pyjamas, bathrobes, dressing gowns; footwear; sandals, beach shoes, canvas shoes, boots, shoes, leather shoes; headgear; hats, caps, bandanas, beanies.</p>
<p>2487680</p>	<p>Class 25: Clothing, footwear, headgear; casual clothing, hooded sweatshirts, jeans, printed T-shirts, lined and unlined jackets, short sleeve and long sleeve shirts, baggy shorts, long sleeve embroidered T-shirts, printed and embroidered sweatshirts, trousers, fleece pullovers, socks, skirts, shorts, scarves, gloves, underwear.</p>

SuperDry

SuperDry

Filing date: 8 May 2008

Date of entry in register: 28 May
2010

EU8670051

SuperDry

Filing date: 8 May 2008

Date of entry in register: 28 May
2010

Class 25: Clothing, footwear, headgear; casual clothing, hooded sweatshirts, jeans, printed T-shirts, lined and unlined jackets, short sleeve and long sleeve shirts, baggy shorts, long sleeve embroidered T-shirts, printed and embroidered sweatshirts, trousers, fleece pullovers, socks, skirts, shorts, scarves, gloves, underwear.