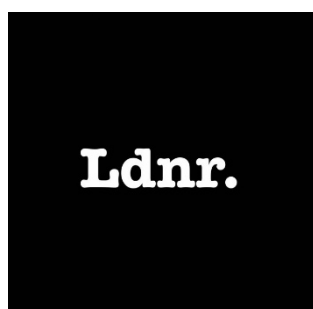


O/333/19

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION UK 3120585 IN THE NAME OF
DERRICK PLAHAR

FOR THE TRADE MARK



IN CLASS 25

AND

THE APPLICATION FOR A DECLARATION OF INVALIDITY THERETO UNDER
NUMBER 501993

BY

FRANK INDUSTRIES UK

Background and Pleadings

1. DERRICK PLA HAR (the Proprietor) is the registered proprietor of a UK trade mark number UK 3120585, shown on the front cover page of this decision, which was filed on the 3 August 2015 and registered 30 October 2015 for the following goods in class 25:

Class 25: Clothing, footwear, headgear.

2. FRANK INDUSTRIES UK (the Applicant) filed an application for invalidation of the Proprietor's registration on the 27 March 2018 under section 47(2)(b) of the Trade Marks Act 1994 (the Act). The ground for the application for invalidation is based on section 5(2)(b) of the Act and is against the Proprietor's goods in class 25.

3. The Applicant relies on ownership of its series of two earlier marks, shown below, UK registration number 3095285, filed on the 19 February 2015 and registered on the 22 May 2015; limiting its reliance to its goods in class 25¹ namely:

Earlier Mark 1.1	Earlier Mark 1.2
LNDR	LNDR

Class 25: Clothing; novelty clothing; babies' wear; men's wear; ladies' wear; costumes; printed clothing; sportswear; underwear and undergarments; knitted articles of clothing; lingerie; shapewear; stockings; hosiery; tights; pantihose; scarves; leggings; vests; tops; t-shirts; printed t-shirts; short-sleeved or long-

¹ ¶ 8: Amended statement of grounds dated 26 March 2018

sleeved t-shirts; hoodies; aprons; cleaning aprons; cooking aprons; chefs wear; jackets; blouson jackets; casual jackets; riding jackets; waterproof jackets; sleeved jackets; sleeveless jackets; fishing jackets; dinner jackets; windproof jackets; leather jackets; heavy jackets; knit jackets; snowboard jackets; suede jackets; motorcycle jackets; bed jackets; long jackets; down jackets; ski jackets; fur jackets; coats; outdoor coats; house coats; evening coats; sheepskin coats; tail coats; cotton coats; laboratory coats; top coats; fur coats; leather coats; rain coats; morning coats; dust coats; wind coats; ties; neckties; waterproof and water-resistant clothing; rainwear; suits; dinner suits; snow suits; suits made of leather; swimwear; wristbands; ear muffs; gloves and mittens; socks; stockings and hosiery; chaps; kerchiefs; roll necks; shorts; trousers; jeans; belts; jogging bottoms; slippers; body warmers; pants; camisoles; nappy pants; ski pants; jogging pants; dress pants; dresses; cowls; denims; slippers; veils; muffs; boas; furs; gabardines; layettes; combinations; ties; drawers; corsets; hats; footwear; sports footwear; ladies' footwear; beach footwear; infants' footwear; casual footwear; leisure footwear; pumps; trainers; uppers; heelpieces for footwear; welts for footwear; tips for footwear; insoles for footwear; soles for footwear; inner socks for footwear; footwear made of wood; fittings of metal for footwear; non-slipping devices for footwear; Japanese split-toed work footwear; Japanese footwear of rice straw; headgear; sports headgear; peaked headwear; headbands; bonnets; visors; sun visors; turbans.

4. The Applicant relies on all its goods in class 25 for which the earlier marks are registered, claiming that there is a likelihood of confusion because the trade marks are similar and are registered for goods identical with or similar to those for which the earlier marks are registered.

5. The Proprietor filed a defence and counterstatement denying the claims made and that there is any similarity between the goods for the respective marks. Although originally requested, the Applicant was not required to provide proof of use of its series of two earlier marks because the earlier marks have been registered for less than five

years at the date the application for invalidation was made, namely the 27 March 2018.² Consequently it can rely upon all of the goods claimed.

6. The Proprietor is unrepresented. The Applicant is represented by Osborne Clarke LLP. Both parties filed evidence but neither requested a hearing; only the Applicant filed submissions in lieu of a hearing. The Proprietor did not file further submissions, relying on his counterstatement. The decision is taken upon the careful perusal of the papers.

Preliminary issues

7. The Proprietor throughout his statement of grounds and the evidence filed, claims that use of his mark predates the Applicant's registration and therefore it is afforded a prior entitlement. I would refer the parties to Tribunal Practice Note 4/2009 and in particular Ms Anna Carboni's decision (sitting as the appointed person) in the case of *Ion Associates Ltd v Philip Stainton and Another*, BL O-211-09. In this case Ms Carboni rejected any defence, based on prior entitlement, raised in this way, as wrong in law. Furthermore, she determined that the proper course for any Proprietor wishing to invoke an earlier right was to oppose the application or submit an application to invalidate. Since the Proprietor has not submitted applications in this way, the evidence raised by him regarding any prior right will not be taken into account in my assessment and the Applicant's marks will be regarded as the earlier marks for the purposes of this decision. The Proprietor's evidence and representations will therefore only be summarised to the extent that they are relevant to the decision under section 47 and 5(2)(b) of the Act.

8. The Applicant exhibited the judgment of Mr Justice Arnold in the case of *Frank Industries PTY Ltd v Nike Retail BV and others* [2018] EWHC 1893 (CH). Whilst I have taken this decision into account in my deliberations I have only done so to the

² Sections 47(2A) – 2(E) of the Act

extent that the issues in the two cases overlap. I note that there are similarities between the *Nike* case and the one before me, however the contested marks are different. My assessment therefore will take into account the evidence and submissions before me and the relevant caselaw pertinent to an application under section 47 and 5(2)(b) of the Act.

Evidence

Applicant's Evidence

9. The Applicant's evidence consists of a witness statement from Ms Arty Rajendra dated the 13 August 2018 with 5 exhibits annexed 1-5. Ms Rajendra is the Applicant's legal representative and has conducted the matter on its behalf. The statement is completed in support of the Applicant's application for invalidity and in the main responds to those matters raised by the Proprietor in his counterstatement.

10. Ms Rajendra exhibits at annex 1 a copy of the transcript of the judgment of Arnold J. in the case of *Frank Industries v Nike*. Ms Rajendra summarises the issues in this case which involved infringement proceedings against Nike under s10 of the Act and passing off under section 5(4).

11. Ms Rajendra states that the Proprietor's blog and website refers to itself as a "guide to London's best bars, clubs and restaurants through the eyes of an adventurous Ldnr". Ms Rajendra states that the Proprietor's website does not show use of the later mark in relation to clothing or any kind of goods but argues that at best it only demonstrates use for online blogging services with no commercial use at all.

12. In response to the Proprietor's claim to earlier rights Ms Rajendra argues that the Proprietor has failed to demonstrate an earlier registered right as it has only filed evidence of 10 blog posts since it created its blog, the last in December 2013. Ms

Rajendra argues that any usage of the mark was minimal during this period arguing that the Proprietor's evidence has not sufficiently demonstrated "any earlier rights in Ldnr pre-dating the Prior Right". At Annex 5 Ms Rajendra exhibits a screenshot of a post from the Proprietor's Facebook page dated "January 31" under the account "ProudLdnr". Ms Rajendra states this post is illustrative of the Proprietor only having a small business and demonstrates limited use of the mark and why no evidence of actual confusion can be produced.

13. Paragraph 1.7 of Ms Rajendra's statement outlines why she believes the marks are similar. She describes the differences in type face, casing and punctuation and questions whether these aspects would lead to the marks being distinguished from one another adding that "Given a conceptual comparison cannot be made, the differences between the marks that the Proprietor relies on are immaterial". Ms Rajendra argues that neither of the marks are recognisable words in any English dictionary exhibiting (at Annex 2) extracts from the Collins and Oxford English online dictionary.

14. In conclusion Ms Rajendra's final paragraph questions the Proprietor's business status, occupation and ownership capacity. In my view neither this paragraph nor the annexes attached (annex 3 and 4) are relevant to my assessment regarding the similarity or otherwise of the marks under section 5(2)(b).

Proprietor's Evidence

15. The Proprietor's evidence consists of a witness statement and six exhibits by Derrick Plahar dated the 28 November 2018.³

³ The registry allowed the Proprietor to file an amended statement following an application on 7 November 2018.

16. Mr Plahar states that he is the Proprietor of the earlier mark. His statement consists of evidence in reply to the Applicant's evidence, as well as additional material in support of the counterstatement filed. I will summarise the relevant points of Mr Plahar's statement in so far as it relates to the application for invalidation under section 47 and section 5(2)(b).

17. Mr Plahar outlines the distinctive and dominant elements of his mark namely: the black box encasing the word element; the typeface; the lettering case; the position of the letters; the colour of the text; the full stop at the end of the lettering and the conceptual meaning of the word element. He considers that these amount to clear and distinct differences precluding any likelihood of confusion.

18. In response to the Applicant's argument that there can be no conceptual comparison between the marks Mr Plahar argues that:

“it is commonly known that LDN is recognised as an abbreviation for London, there is a clear association between this abbreviation and the word element in our mark, given that the first 3 letters...are LDN and because of this association, members of the public invariably always recognise LDNR, in the context of our branding, as an abbreviation for Londoner.”

19. Mr Plahar argues that there is a clear conceptual difference with the Applicant's marks as LND has no such association or recognition to London or Londoner. Exhibit 2 marked “Annex 2” produces what Mr Plahar describes as “online sources showing references to LDN meaning London”.

20. Mr Plahar states that in addition, since the Applicant did not challenge the registration of the later mark that it has accepted that there was no similarity between the marks. Further that the marks have coexisted for at least “2 years and 7 months after registration” with no examples of confusion being raised by the Applicant.

21. In reference to the comments made by Ms Rajendra concerning his occupation and business interests Mr Plahar states that these facts are irrelevant to the issue of an application for invalidation on the basis of section 5(2)(b) and I agree. I will therefore say nothing more on this point.

22. Mr Plahar refers to his mark's reputation which he says has been established by various celebrities endorsing the mark by wearing headgear bearing the mark. He exhibits at annex 4 and 5 copy screenshots taken from Instagram posts/adverts showing "celebrities" wearing baseball caps displaying the mark as reproduced below:

Annex 4



Annex 5



Decision

23. Section 5(2)(b) is relevant to the application for invalidation because section 47(2) of the Act states:

“47(2) The registration of a trade mark may be declared invalid on the ground

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.”

And

“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”.

24. Given their filing dates, the Applicant’s series of two marks qualify as earlier marks in accordance with section 6 of the Act.

25. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG, Case C-251/95*, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer*

Inc, Case C-39/97, Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V. Case C-342/97, Marca Mode CV v Adidas AG & Adidas Benelux BV, Case C-425/98, Matratzen Concord GmbH v OHIM, Case C-3/03, Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH, Case C-120/04, Shaker di L. Laudato & C. Sas v OHIM, Case C-334/05P and Bimbo SA v OHIM, Case C-591/12P.

The principles:

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

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

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

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

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

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

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

26. When conducting a goods comparison, all relevant factors should be considered as per the judgment of the Court of Justice of the European Union (CJEU) in *Canon Kabushiki Kaisha v Metro Goldwyn Mayer Inc* Case C-39/97, where 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”.

27. I am also guided by the relevant factors for assessing similarity identified by Jacob J in *Treat*, [1996] R.P.C. 281 namely:

(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.

28. In *Gérard Meric v Office for Harmonisation in the Internal Market (OHIM)*, 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 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”.

29. As the Applicant has limited its reliance on its goods to class 25, the comparison of the competing goods is set out in the following table:

Proprietor's Mark	Applicant's Earlier Marks
Class 25: Clothing, footwear, headgear.	Class 25: Clothing; novelty clothing; babies' wear; men's wear; ladies' wear; costumes; printed clothing; sportswear;

underwear and undergarments; knitted articles of clothing; lingerie; shapewear; stockings; hosiery; tights; pantihose; scarves; leggings; vests; tops; t-shirts; printed t-shirts; short-sleeved or long-sleeved t-shirts; hoodies; aprons; cleaning aprons; cooking aprons; chefs wear; jackets; blouson jackets; casual jackets; riding jackets; waterproof jackets; sleeved jackets; sleeveless jackets; fishing jackets; dinner jackets; windproof jackets; leather jackets; heavy jackets; knit jackets; snowboard jackets; suede jackets; motorcycle jackets; bed jackets; long jackets; down jackets; ski jackets; fur jackets; coats; outdoor coats; house coats; evening coats; sheepskin coats; tail coats; cotton coats; laboratory coats; top coats; fur coats; leather coats; rain coats; morning coats; dust coats; wind coats; ties; neckties; waterproof and water-resistant clothing; rainwear; suits; dinner suits; snow suits; suits made of leather; swimwear; wristbands; ear muffs; gloves and mittens; socks; stockings and hosiery; chaps; kerchiefs; roll necks; shorts; trousers; jeans; belts; jogging bottoms; slipovers; body warmers; pants; camisoles; nappy pants; ski pants; jogging pants; dress pants; dresses; cowls; denims; slips; veils; muffs; boas; furs; gabardines; layettes; combinations; ties; drawers;

	corsets; hats; footwear; sports footwear; ladies' footwear; beach footwear; infants' footwear; casual footwear; leisure footwear; pumps; trainers; uppers; heelpieces for footwear; welts for footwear; tips for footwear; insoles for footwear; soles for footwear; inner socks for footwear; footwear made of wood; fittings of metal for footwear; non- slipping devices for footwear; Japanese split-toed work footwear; Japanese footwear of rice straw; headgear; sports headgear; peaked headwear; headbands; bonnets; visors; sun visors; turbans.
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30. Taking into account the caselaw above I note that all the goods in the Proprietor's specification are identical to the Applicant's goods because either the identical words are used or because the Applicant's specification covers a wider itemised category of clothing, headgear and footwear and thus would be considered as identical according to the principles outlined in *Meric*.

Average Consumer

31. When considering the opposing trade marks, it is necessary for me to determine who the average consumer is for the respective parties' goods and the manner in which they are likely to be selected. The average consumer is deemed reasonably informed and reasonably observant and circumspect. I must bear in mind that the

average consumer's level of attention is likely to vary according to the category of goods in question.⁴

32. 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.”

33. The Proprietor submits that their clothing brand focuses on “unisex streetwear” whereas the Applicant's mark is used specifically for “women's activewear”. The Applicant submits that since the earlier mark is not subject to the proof of use requirements, it is not necessary to narrow its specification as it is entitled to rely on the entirety of its registered class 25 specification.

34. The Applicant is correct in its submissions. In *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06, the Court of Justice of the European Union (CJEU) stated at paragraph 66 of its judgment that when assessing the likelihood of confusion under Section 5(2) it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered.

35. I am also guided by *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P, where the Court of Justice of the European Union stated that:

⁴ Lloyd Schuhfabrik Meyer, case c- 342/97.

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

36. As such the respective parties' goods all fall within scope of identical goods within their general clothing classification. Therefore, despite the Proprietor submitting evidence regarding limitations on the use of his mark and that of the Applicant, this is irrelevant for the purposes of this decision.

37. The average consumer for the respective goods at issue is a member of the general public who is likely to choose the goods from a shop or online, through self-selection or by word of mouth recommendations. The purchasing process is more likely to be visual rather than aural. The average consumer is a member of the general public who will take into account the price, fit and quality of the clothing/headgear and footwear and in my mind pay an average level of care in that purchasing decision.


Comparison of the marks

38. 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 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.”

39. 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.

40. The respective marks to be compared are shown below:

Proprietor's mark	Applicant's series of marks
	Mark 1.1 LNDR Mark 1.2 LNDR

41. The Proprietor's mark consists of the letters "Ldnr" followed by a punctuation mark presented in white title case, on a black square background. The letters "Ldnr" play the greater and therefore the more dominant role in the overall impression of the mark; the box is merely a black background playing a minor role, as is the punctuation mark.

42. The Applicant's series of marks consist of the letters LNDR presented in capital letters; the second in the series being emboldened, larger in size with some spacing between the letters. Essentially both marks are of the letters LNDR in combination which are the dominant and only elements of the mark and in which the overall impression resides. The bold lettering and spacing of the second mark do not alter its distinctive character which is dominated by the letters themselves.⁵ For the purposes of the comparison the first in the series of marks represents the Applicant's strongest case. If it cannot succeed under Mark 1.1 it will be in no better position in relation to Mark 1.2. Therefore, I will confine my comparison to Mark 1.1 (the earlier mark).

Visual comparison

43. Visually both marks coincide with the identical letters "L-N-D-R" although they are presented in a different order; the middle letters are inverted in the Proprietor's mark and are presented as "d-n". Although the Applicant's mark is in capital letters, a word trade mark protects notional use of the word itself irrespective of font, capitalisation or otherwise, and therefore a trademark in capitals covers use in lower case and vice versa.⁶ I note the additional elements of the Proprietor's mark namely the black background and punctuation, however I have already regarded these elements as playing a lesser role in the overall impression. The different sequence and position of the letters d and n do not detract from the coincidence of the letters themselves and therefore I consider that the marks share a reasonably high degree of visual similarity.

Aural comparison

44. The aural similarities reside in the combination of letters of each mark which are the only elements likely to be pronounced. I do not believe that the punctuation mark will be pronounced in the later mark and therefore it will be pronounced as "L-d-n-r"

⁵ La Superquímica v EUIPO EU T:2018:668

⁶ Bentley Motors Limited v Bentley 1962 Limited BL O/159/17

whereas the Applicants mark will be pronounced as “L-N-D-R”. On this basis since each letter will be articulated in turn the marks are aurally similar to a good degree.

Conceptual comparison

45. The Proprietor submits that:

“it is commonly known that LDN is recognised as an abbreviation for London, there is a clear association between this abbreviation and the word element in our mark, given that the first 3 letters in our mark are LDN and because of this association, members of the public invariably always recognise LDNR, in the context of our branding as an abbreviation for Londoner.”

46. The Applicant however submits that both marks:

“will be seen by the average consumer as a short group of four consonants, not amounting to a word, and having no clear meaning.”

47. I note Mr Justice Arnold’s comments in the case of *Nike* as to the meaning of these letters and that in certain circumstances LDNR was capable of being used and understood as meaning Londoner when used in an appropriate context in digital media, namely, in combination with other related hashtags or in combination with a photograph of a London landmark for example. For the purpose of this comparison, the mark must be considered in its registered form, without added contextual text or photographs/logos and for a conceptual message to be relevant it must be immediately obvious to the average consumer.⁷ Whilst a small proportion of consumers especially those living in London may recognise the Proprietor’s mark as having a link with London/Londoner, overall, I do not believe that the average consumer will draw this inference. My view is that overall most consumers will see both marks as a collection of letters with no particular meaning (the punctuation mark

⁷ Ruiz Picasso v OHIM [2006] e.c.r.I-643; [2006] E.T.M.R.29.

adding very little conceptually to the Proprietor's mark) and as such the conceptual similarity between them will be neutral.

Distinctiveness of earlier mark

48. 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).”

49. Registered trade-marks possess varying degrees of inherent distinctive character, some being suggestive or allusive of a characteristic of the goods and services on offer to those with high inherent characteristics such as invented words which have no allusive qualities. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark the greater the likelihood of confusion.

50. Whilst the Applicant relies on the decision in the *Nike* case I note that it has not filed any evidence of sales figures or accounts and there is no evidence of its position in the UK market for clothing/headgear or footwear. On this basis the Applicant is unable to benefit from enhanced distinctiveness in relation to its goods and therefore I will proceed to determine the matter on inherent characteristics.

51. Bearing in mind my earlier assessment the letters LNDR do not appear to have any obvious link or association to the goods covered by the registration or in particular clothing. In my view the mark will be seen as a random selection of letters and therefore it possesses a reasonably high degree of inherent distinctiveness.

Likelihood of confusion

52. When considering whether there is a likelihood of confusion between the two marks I must consider whether there is direct confusion, where one mark is mistaken for the other or whether there is indirect confusion where the similarities between the marks lead the consumer to believe that the respective goods or services originate from the same or related source.

53. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognised 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, I conclude that it is another brand of the owner of the earlier mark.”

54. In determining whether there is a likelihood of confusion there are a number of factors to bear 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 or services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the Applicant’s two marks, the average consumer for the goods and the nature of the purchasing process. In doing so, I must consider 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 he has retained in his mind.

55. The Proprietor has submitted that the Applicant is unable to argue a likelihood of confusion because it has not filed any evidence of actual confusion between the marks and that the marks have been able to coexist for almost three years without difficulty. In *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchen L.J. stated that:

“80.the likelihood of confusion must be assessed globally taking into account all relevant factors and having regard to the matters set out in *Specsavers* at paragraph [52] and repeated above. If the mark and the sign have both been used and there has been actual confusion between them, this may be powerful evidence that their similarity is such that there exists a likelihood of confusion. But conversely, the absence of actual confusion despite side by side use may be powerful evidence that they are not sufficiently similar to give rise to a likelihood of confusion. This may not always be so, however. The reason for the absence of confusion may be that

the mark has only been used to a limited extent or in relation to only some of the goods or services for which it is registered, or in such a way that there has been no possibility of the one being taken for the other. So there may, in truth, have been limited opportunity for real confusion to occur.”

56. Also in *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283 Millett L.J. stated that:

“Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff’s registered trade mark.”

57. In light of these cases it is not necessary for the Applicant to file evidence of actual confusion and the absence of evidence in this regard will not lead me to infer that there cannot be confusion between the marks.

58. To summarise, I have found that the marks are visually similar to a reasonably high degree and that they share a good degree of aural similarity. I have found the conceptual similarity between the marks to be neutral. I have found that the earlier mark has a reasonably high degree of inherent distinctive character. I have identified the average consumer to be a member of the general public who would primarily select the goods via visual means but with aural considerations not being discounted. I have concluded that an average degree of attention will be paid in the purchasing process. I have found that the parties’ goods to be identical.

59. Taking into account these conclusions and bearing in mind the principle of imperfect recollection, when consumers come across the later mark in my view they are unlikely to recall precisely the order or sequence of the middle letters d and n. I am also of the view that consumers will not remember the punctuation mark or the black background. Since the earlier mark will be viewed as a random selection of letters with nothing attributed to it to link it with the goods in question I am satisfied that there is sufficient visual and aural similarity for consumers to mistake one mark for the other especially since the goods are identical and the purchasing process for

clothing is predominantly visual, not discounting aural considerations. In my view the differences between the marks are insufficient to enable consumers to distinguish between them. Factoring in the identity of the goods, I consider that there is sufficient commonality with the shared presence of the identical letters for the marks to be imperfectly recalled causing a likelihood of direct confusion.

Outcome

60. The application for invalidation therefore succeeds under section 47(2) and 5(2)(b) of the Act. Under section 47(6) of the Act, the registration for the trade mark number UK 3120585 for goods in class 25 is deemed never to have been made and is to be removed from the register.

61. The Applicant has been successful and is entitled to a contribution towards its costs. Award of costs in proceedings are based upon the scale governed by the Tribunal Practice Notice 2/2016. Applying this guidance, I award costs⁸ to the Applicant on the following basis:

Preparing a statement of grounds and considering the counterstatement	£200
Preparing Evidence	£500
Preparing submissions in lieu of hearing	£300

⁸ Whilst the Applicant would normally be entitled to all the fees incurred I note that initially its application was based on additional grounds which it withdrew during the proceedings. The Proprietor would have had to respond to each ground as pleaded therefore and my award for costs reflect this.

Official Fee	£100
Total	£1,100

62. I order DERRICK PLAHAR to pay FRANK INDUSTRIES UK the sum of £1,100 as a contribution towards its costs. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case, if any appeal against this decision is unsuccessful.

Dated 12 June 2019

Leisa Davies
For the Registrar