

O/496/21

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK3534834

BY MTS CLOTHING LTD

TO REGISTER THE TRADE MARK:



IN CLASS 25

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 600001600

BY AK RETAIL HOLDINGS LIMITED

Background and pleadings

1. On 18 September 2020, MTS Clothing Ltd (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on the 30 October 2020. The applicant seeks registration for the following goods:

Class 25: Parts of clothing, footwear and headgear.

2. The application was opposed by AK Retail Holdings Limited (“the opponent”) on 01 February 2021. The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies on the following trade mark:

LTS

UK trade mark no. UK3213714.

Filing date: 24 April 2017.

Registration date: 29 September 2017.

Relying upon all of the goods and services for which the earlier mark is registered, namely:

Class 3: Perfumes; toilet waters; eau de cologne; perfume oils; essential oils; massage oils; non-medicated massage preparations; perfuming preparations for the atmosphere; soaps; body washes; non-medicated toilet preparations; non-medicated toilet preparations produced from essential oils; preparations for the care of the hair, skin, scalp, face and nails; lip balms; toners; moisturisers; shampoos; conditioners; creams and lotions for removing make-up; sun-tanning preparations; sun-screening preparations; deodorants and antiperspirants; body sprays; bath and shower products; foam bath; bath salts; bath oil; shower gel; depilatory preparations; cosmetics; tissues and wipes impregnated with non-medicated toilet preparations; cotton wool and cotton wool buds.

Class 14: Jewellery; costume jewellery; ornaments for clothing and hats in the nature of jewellery; semi-precious stones; precious stones; cases;

caskets and boxes adapted to contain articles of jewellery; watches; precious stones; horological and chronometric instruments; precious metals and their alloys.

Class 16: Gift vouchers; gift certificates; vouchers; greeting cards; gift tags; gift labels; gift boxes made of paper and cardboard; giftwrapping paper and foil; ribbons.

Class 18: Skins; hides; leather bags; bags of imitation leather; bags; handbags; purses; wallets; key cases; pouches; tote bags; briefcases; suitcases; luggage; trunks (luggage); traveling bags; garment bags for travel; suit bags; sponge bags in the nature of bags for toiletries sold empty; shoe bags for travel; umbrellas; parasols; walking sticks; carrier bags of plastics; rucksacks; satchels; haversacks; holdalls; bags for campers or climbers; beach bags; sports bags; duffel bags; weekend bags; carry-on bags; insulated bags; luggage straps; luggage tags; shoulder belts.

Class 25: Clothing; articles of clothing for playing sports; footwear; headgear; trousers; leather trousers; dungarees; jeans; pants; underpants; knickers; underwear; suits; blouses; shirts; sweaters; jumpers; pullovers; tunics; tops; halter-tops; lingerie; cardigans; dresses; tennis dresses; ballgowns; evening wear; coats; leather coats; leather jackets; capes; parkas; anoraks; windcheaters; gilets; waistcoats; blazers; jerseys; jackets; raincoats; trench coats; robes; chemises; camisoles; T-shirts; pyjamas; nightdresses; slippers; vests; scarves; ties; gloves; mittens; belts; leather belts; shawls; shrugs; sarongs; sundresses; brassieres; shorts; leotards; bustiers; shorts for cycling; jogging pants; tracksuits; sweatsuits; overshirts; swimsuits; swimwear; beachwear; sweatshirts; hooded sweatshirts; kaftans; dressing gowns; bed jackets; stoles; bathrobes; yoga pants; gym pants; warm-up suits; ski suits; jump suits; shoes; sandals; slippers; moccasins; boots; riding boots; trainers; insoles; footwear inserts for primarily non-orthopaedic purposes; inner socks for footwear; heel tips; heel protectors; heel pads;

linings of leather for shoes; hosiery; tights; leggings; body stockings; stockings; socks; hats; trilby hats; caps; sunhats; visors; berets.

Class 35: Shop retail services, mail order retail services. electronic retail services, and retail services via a television channel, all connected with perfumes. toiletries, cosmetics, sunglasses, jewellery, costume jewellery, watches, gift certificates, greeting cards, bags, luggage, belts, satchels. haversacks, handbags, purses, wallets, key cases, pouches, clothing, sports clothing scarves, gloves, mittens, sleepwear, underwear, coats, suits, swimwear, beachwear, evening wear, footwear, shoes, sandals, slippers, moccasins, boots, riding boots, trainers, insoles, linings of leather for shoes, hosiery, tights, leggings, body stockings, stockings, socks, shoe laces, shoe polish, and headgear; the bringing together, for the benefit of others, of toiletries, cosmetics, sunglasses, jewellery, costume jewellery, watches, greeting cards, gift certificates, bags, luggage, belts, satchels, haversacks, handbags, purses, wallets, key cases, pouches, clothing, sports clothing, scarves, gloves, mittens, sleepwear, underwear, coats, suits, swimwear, beachwear, evening wear, footwear, shoes, sandals. slippers. moccasins; boots, riding boots, trainers, insoles, linings of leather for shoes, hosiery, tights, leggings, body stockings, stockings, socks, shoe laces, shoe polish, and headgear, enabling customers to conveniently view and purchase those goods; arranging for subscription to electronic publications, periodical publications, magazines, and newsletters; provision of web space for advertising and promoting goods and services; compilation of advertisements for use as web pages on the Internet; rental of advertising time on communication media.

3. The opponent claims that there is a likelihood of confusion because its mark is similar to the applicant's mark and the applicant's goods are identical to its class 25 goods and similar to the other goods and services included in its registration. The opponent is opposing all goods for which the applicant seeks protection. It claims that the words 'Make Them Stare' in the contested mark are small and difficult to decipher. It also states that because both marks contain the letters 'T' and 'S' in the same order,

that the marks are visually and aurally similar. It adds that the marks are conceptually similar as they are formed of individual consonants.

4. The applicant filed a counterstatement denying the similarity of the marks. It states that its mark contains significant additional elements that distinguish it from the opponent's mark, that the marks are phonetically different due to the contested mark containing the phrase "Make Them Stare", and that there is no conceptual link between the marks.

5. Regarding the goods in question, the applicant accepts its class 25 goods are similar to the opponent's class 25 goods but asserts that its goods are dissimilar to the other goods and services of the opponent's earlier mark.

6. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20 (4) shall continue to apply. Rule 20 (4) states that:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

7. The net effect of these changes is to require the parties to seek leave in order to file evidence in fast track oppositions. No leave was sought to file any evidence in respect of these proceedings.

8. Rule 62 (5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken. A hearing was neither requested nor considered necessary; however, the opponent did file written submissions in lieu. This decision is taken following a careful perusal of the papers.

9. The applicant is represented by HGF Limited and the opponent is represented by Stobbs IP Ltd.

10. 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)

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

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

(a)...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

12. 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 IR 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.”

13. The trade mark upon which the opponent relies qualifies as an earlier trade mark because it was applied for at an earlier date than the applicant's mark pursuant to section 6 of the Act. The opponent's mark is not subject to the proof of use requirements pursuant to section 6A of the Act. This is because the earlier mark had not been registered for more than 5 years at the filing date of the application in issue. The opponent can, therefore, rely upon all of the goods and services which it has identified.

Section 5(2)(b) case law

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

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only

when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

15. As noted above from the Form TM8 and counterstatement, the applicant admits that its class 25 goods are similar to the opponent's class 25 goods, but states that they are dissimilar to the other classes of goods and services included in the opponent's registration. As the applicant did not specify what degree of similarity it

considers exists between the parties' respective goods, I must undertake a comparison in order to identify the degree of similarity between them.

16. When making the comparison, all relevant factors relating to the goods and services in the specification should be taken into account. In the judgment of the CJEU 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”.

17. 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 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.

18. In *Gérard Meric v Office for Harmonisation in the Internal Market ('Merici')*, Case T-133/05, the General Court ("the 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".

19. For the purposes of considering the issue of similarity of goods and services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

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

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

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

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

22. The parties' respective specifications are:

Opponent's goods & services	Applicant's goods
<p>Class 3: Perfumes; toilet waters; eau de cologne; perfume oils; essential oils; massage oils; non-medicated massage preparations; perfuming preparations for the atmosphere; soaps; body washes; non-medicated toilet preparations; non-medicated toilet preparations produced from essential oils; preparations for the care of the hair, skin, scalp, face and nails; lip balms; toners; moisturisers; shampoos; conditioners; creams and lotions for removing make up; sun-tanning preparations; sun-screening preparations; deodorants and antiperspirants; body sprays; bath and shower products; foam bath; bath salts; bath oil; shower gel; depilatory preparations; cosmetics; tissues and wipes impregnated with non-medicated toilet preparations; cotton wool and cotton wool buds.</p> <p>Class 14: Jewellery; costume jewellery; ornaments for clothing and hats in the nature of jewellery; semi-precious stones; precious stones; cases; caskets and boxes adapted to contain articles of jewellery; watches; precious stones; horological and</p>	<p>Class 25: Parts of clothing, footwear and headgear.</p>

chronometric instruments; precious metals and their alloys.

Class 16: Gift vouchers; gift certificates; vouchers; greeting cards; gift tags; gift labels; gift boxes made of paper and cardboard; giftwrapping paper and foil; ribbons.

Class 18: Skins; hides; leather bags; bags of imitation leather; bags; handbags; purses; wallets; key cases; pouches; tote bags; briefcases; suitcases; luggage; trunks (luggage); traveling bags; garment bags for travel; suit bags; sponge bags in the nature of bags for toiletries sold empty; shoe bags for travel; umbrellas; parasols; walking sticks; carrier bags of plastics; rucksacks; satchels; haversacks; holdalls; bags for campers or climbers; beach bags; sports bags; duffel bags; weekend bags; carry-on bags; insulated bags; luggage straps; luggage tags; shoulder belts.

Class 25: Clothing; articles of clothing for playing sports; footwear; headgear; trousers; leather trousers; dungarees; jeans; pants; underpants; knickers; underwear; suits; blouses; shirts; sweaters; jumpers; pullovers; tunics; tops; halter-tops; lingerie; cardigans; dresses; tennis dresses; ballgowns; evening wear; coats; leather coats; leather jackets; capes; parkas; anoraks; windcheaters; gilets; waistcoats; blazers; jerseys; jackets; raincoats; trench coats; robes; chemises;

camisoles; T-shirts; pyjamas; nightdresses; slippers; vests; scarves; ties; gloves; mittens; belts; leather belts; shawls; shrugs; sarongs; sundresses; brassieres; shorts; leotards; bustiers; shorts for cycling; jogging pants; tracksuits; sweatsuits; overshirts; swimsuits; swimwear; beachwear; sweatshirts; hooded sweatshirts; kaftans; dressing gowns; bed jackets; stoles; bathrobes; yoga pants; gym pants; warm-up suits; ski suits; jump suits; shoes; sandals; slippers; moccasins; boots; riding boots; trainers; insoles; footwear inserts for primarily non-orthopaedic purposes; inner socks for footwear; heel tips; heel protectors; heel pads; linings of leather for shoes; hosiery; tights; leggings; body stockings; stockings; socks; hats; trilby hats; caps; sunhats; visors; berets.

Class 35: Shop retail services, mail order retail services. electronic retail services, and retail services via a television channel, all connected with perfumes. toiletries, cosmetics, sunglasses, jewellery, costume jewellery, watches, gift certificates, greeting cards, bags, luggage, belts, satchels. haversacks, handbags, purses, wallets, key cases, pouches, clothing, sports clothing scarves, gloves, mittens, sleepwear, underwear, coats, suits, swimwear, beachwear, evening wear, footwear, shoes, sandals, slippers, moccasins, boots, riding boots, trainers,

<p>insoles, linings of leather for shoes, hosiery, tights, leggings, body stockings, stockings, socks, shoe laces, shoe polish, and headgear; the bringing together, for the benefit of others, of toiletries, cosmetics, sunglasses, jewellery, costume jewellery, watches, greeting cards, gift certificates, bags, luggage, belts, satchels, haversacks, handbags, purses, wallets, key cases, pouches, clothing, sports clothing, scarves, gloves, mittens, sleepwear, underwear, coats, suits, swimwear, beachwear, evening wear, footwear, shoes, sandals. slippers. moccasins; boots, riding boots, trainers, insoles, linings of leather for shoes, hosiery, tights, leggings, body stockings, stockings, socks, shoe laces, shoe polish, and headgear, enabling customers to conveniently view and purchase those goods; arranging for subscription to electronic publications, periodical publications, magazines, and newsletters; provision of web space for advertising and promoting goods and services; compilation of advertisements for use as web pages on the Internet; rental of advertising time on communication media.</p>	
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23. The applicant's goods are 'parts of clothing, footwear and headgear', which I believe to mean the component parts of items within those three categories.

24. Turning to the opponent's class 25 goods, I find that 'insoles; heel tips; heel protectors; heel pads; linings of leather for shoes' are all parts of shoes or footwear and therefore identical to the applicant's 'parts of footwear'.

25. The remainder of the opponent's class 25 goods, namely 'Clothing; articles of clothing for playing sports; footwear; headgear; trousers; leather trousers; dungarees; jeans; pants; underpants; knickers; underwear; suits; blouses; shirts; sweaters; jumpers; pullovers; tunics; tops; halter-tops; lingerie; cardigans; dresses; tennis dresses; ballgowns; evening wear; coats; leather coats; leather jackets; capes; parkas; anoraks; windcheaters; gilets; waistcoats; blazers; jerseys; jackets; raincoats; trench coats; robes; chemises; camisoles: T-shirts; pyjamas; nightdresses; slippers; vests; scarves; ties; gloves; mittens; belts; leather belts; shawls; shrugs; sarongs; sundresses; brassieres; shorts; leotards; bustiers; shorts for cycling; jogging pants; tracksuits; sweatsuits; overshirts; swimsuits; swimwear; beachwear; sweatshirts; hooded sweatshirts; kaftans; dressing gowns; bed jackets; stoles; bathrobes; yoga pants; gym pants; warm-up suits; ski suits; jump suits; shoes; sandals; slippers; moccasins; boots; riding boots; trainers; footwear inserts for primarily non-orthopaedic purposes; inner socks for footwear; hosiery; tights; leggings; body stockings; stockings; socks; hats; trilby hats; caps; sunhats; visors; berets.' I consider to be similar to the applicant's goods to a low degree. The items are not identical or highly similar as claimed by the opponent, as the applicant has applied for 'parts of' clothing and headgear as opposed to the finished articles. Applying the criteria under *Treat*, I believe the physical nature of these goods would be similar – the parts of clothing and headgear would be made of the same materials as the finished articles themselves. I also consider that it is possible that parts of clothing and headgear would be complementary to the finished articles. Taking account of the *Kurt Hesse* case referred to above, I consider that parts of clothing and headgear are indispensable in the production of the finished article. For a professional public, I find these goods to be complementary and therefore similar to a low degree.

26. I turn next to the opponent's class 35 services which include retail services connected with e.g. clothing, footwear and headgear and linings of leather for shoes. I am reminded of *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, where the GC held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree. Retail services of these items to the relevant consumer may be complementary to the goods themselves, it would be reasonable to expect the same

undertaking who makes e.g. clothes, to then sell them and I believe the same logic extends to parts of clothing, footwear and headgear also. I also note that the retail services of the opponent are connected with linings of leather for shoes. I found the earlier goods of linings of leather for shoes to be identical to the 'parts of footwear' in the applicant's specification and therefore, I find that there would also be some level of similarity here. I therefore find these services to be similar to the contested goods to a low degree.

27. The opponent's remaining goods under classes 3, 14, 16 and 18 I find to be dissimilar to the applicant's goods. I do not believe that the users, uses or physical nature of the goods in those classes would be similar to the contested 'parts of clothing, footwear and headgear' and the channels of trade would also be different.

Average consumer and the purchasing act

28. 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.

29. 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."

30. The average consumer of clothing, footwear and headgear will predominantly be the general public but may also be a professional public buying on behalf of others.

31. The selection of such goods is largely a visual process, as the average consumer (general public) will wish to physically handle the goods to ensure the correct size has been selected, whilst simultaneously appraising the overall aesthetic impact.

32. A professional consumer will likely take more care over the visual appraisal of these goods as they will often be buying in much larger quantities and will need to assess the quality, sizing, construction etc to a higher degree.

33. I do not, however, ignore the potential for the marks to be spoken, for example, by sales assistants in a retail establishment or when making a purchase from a catalogue, over the telephone. However, in those circumstances, the consumer will have had an opportunity to view the goods, perhaps electronically via an online catalogue or website, or on paper in the traditional sense of catalogue shopping.

34. The average consumer will therefore pay a higher degree of attention in its visual assessment, during the purchase of clothing, footwear or headgear, however they will not necessarily be paying the highest level of attention.

35. In terms of the average consumer of parts of clothing, footwear and headgear, I would consider that it is more likely to be a professional consumer who would be looking to purchase the parts to put together to sell finished articles on to the public themselves. As above, I believe they will take more care over the purchase of these goods due to the quantities involved in the purchase process. I do not discount the possibility of the general public purchasing these items also and, as above, the process would be largely visual to ensure that these goods fit their requirements, maybe for making a new item or for repairing a previously owned item. In this instance, they would need to take care to make sure the item matched with what they needed. Therefore, the average consumer of these goods would again be paying a higher than normal degree of attention but not the very highest level.

36. Regarding the class 35 services 'retail connected with clothing, footwear and headgear', once again I would consider the average consumer to be the general public. The uptake of these services will be relatively frequent. The average consumer will take various factors into consideration such as the ease of use/access, type of services offered, e.g. traditional high street bricks and mortar outlets, or online

websites and the suitability of those services to the consumer's needs. Therefore, the level of attention paid during the purchasing process will be medium.

37. I consider that retail services in connection with parts of clothing, footwear and headgear would more likely be taken up by a professional consumer. I believe they will take more care over the purchase of these goods due to the quantity of the goods likely to be purchased. The selection of such services is also most likely to be a visual process, either online, via websites or through the traditional bricks and mortar high street establishments, with the possibility of aural conversations with salespersons and word of mouth recommendations. I therefore consider that the average professional consumer will pay a higher degree of attention in the uptake of these services but not the very highest level.


Comparison of 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 trade marks are shown below:

LTS	
Earlier Trademark	Contested Mark

41. The earlier mark comprises the three letters 'LTS' presented in a standard font and typeface and with no stylisation, and therefore the overall impression lies in those three letters.

42. The contested mark features the three letters 'MTS' presented in white and in a large, fairly standard font, with the words 'Make Them Stare' written through the middle of those letters in much smaller lettering. The applicant states that the words 'Make Them Stare' are the dominant element of the mark however, I disagree. The large font of the white letters 'MTS' standing out on the black background are the more dominant element in the mark, playing a greater role than the element 'Make Them Stare' due to the significant difference in sizes of those two elements. Neither element can be said to be the more distinctive, however. The letters MTS do not appear to have a specific meaning and the expression 'Make Them Stare' does not have an obvious link or association with the goods at issue.

43. The applicant asserts that the words 'Make Them Stare' give the meaning to the letters 'MTS' and therefore must be considered along with the simple stylisation found in the mark, however I find that, due to the size of the MTS element, it is that part of the mark that is the more eye-catching aspect.

44. Comparing the marks visually, the opponent claims that the marks are similar as the material particulars of the respective marks both contain the letters 'TS'. It also states that the words "Make Them Stare" are small and difficult to decipher.

45. The earlier mark is made up of the plain letters 'LTS' and I therefore remind myself of the comments of Mr Iain Purvis QC, sitting as the Appointed Person in *Groupement Des Cartes Bancaires v China Construction Bank Corporation* case BL O/281/14 who found that:

"It is well established that a 'word mark' protects the word itself, not simply the word presented in the particular font or capitalization which appears in the Register of Trade Marks.....A word may therefore be presented in a different way (for example a different font, capitals as opposed to small letters, or handwriting as opposed to print) from that which appears in the Register whilst remaining 'identical' to the registered mark."

46. I therefore acknowledge that the earlier mark may be presented in any font, sizing or combination of upper and lower-case fonts.

47. The contested mark consists of a black rectangular background with the letters 'MTS' presented in the middle, in a large white slightly stylised font. A black banner strikes through the middle of the three letters and within this banner are the words 'Make Them Stare' also presented in a white font. The Opponent argues that the wording 'Make Them Stare' is impossible to decipher however, whilst I note the font is much smaller, the wording is still able to be read without difficulty. It is also the case that the stylisation in the letters 'MTS' cannot be said to be particularly innovative or distinctive.

48. It was noted in *Deutsche Bahn v OHIM* by the GC that where the marks were two or even three letters long, the significance of any differences would be heightened by the brevity of the marks.¹ Therefore, where the length of the parties' marks are short, differences are more likely to be noticed.

49. In *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, the GC noted that the beginnings of word tend to have more visual and aural impact than the ends. The court stated:

¹ Case T-274/09 *Deutsche Bahn v OHIM* EU:T:2011:451, [78] (ICE/IC4)

“81. It is clear that visually the similarities between the word marks MUNDICOLOR and the mark applied for, MUNDICOR, are very pronounced. As was pointed out by the Board of Appeal, the only visual difference between the signs is in the additional letters ‘lo’ which characterise the earlier marks and which are, however, preceded in those marks by six letters placed in the same position as in the mark MUNDICOR and followed by the letter ‘r’, which is also the final letter of the mark applied for. Given that, as the Opposition Division and the Board of Appeal rightly held, the consumer normally attaches more importance to the first part of words, the presence of the same root ‘mundico’ in the opposing signs gives rise to a strong visual similarity, which is, moreover, reinforced by the presence of the letter ‘r’ at the end of the two signs. Given those similarities, the applicant’s argument based on the difference in length of the opposing signs is insufficient to dispel the existence of a strong visual similarity.”

50. I find the marks to be visually similar to no more than a medium degree as whilst they share the letters TS, the different initial letters in the acronyms LTS and MTS, combined with the additional words and stylisation of the contested mark serve to set them apart.

51. Turning to the aural comparison of the marks, I agree with both parties that the earlier mark will be vocalised letter by letter: EL-TEE-ESS. Regarding the applicant’s mark, again the parties are in agreement that the lettering will be vocalised letter by letter: EM-TEE-ESS.

52. The opponent argues that there would be little emphasis on the first letters and that there are only small differences between the ‘M’ and ‘L’ which would mean the marks are aurally similar to a high degree. The applicant disagrees with this and states that each letter would be distinctly articulated. After considering this, I find that any emphasis would either be equally distributed across all three letters of both marks or possibly, with the larger emphasis on the first letter. I see no reason to accept the opponent’s claim that the initial sounds in each mark would have a reduced emphasis. I also find that the two letters ‘M’ and ‘L’ are not aurally similar.

53. I must also consider whether the expression 'Make Them Stare' in the contested mark would be vocalised. The opponent argues that this expression will not be articulated due to it being too difficult to read. I disagree and believe that some consumers might articulate this either as well as or, possibly instead of the letters 'MTS'. Whilst I appreciate the argument made by the opponent that some brands are referred to by their initials, such as YSL for Yves Saint Laurent, M&S for Marks & Spencer and D&G for Dolce & Gabbana, I do consider that, in this instance, the average consumer may use both the initials and the full expression interchangeably, particularly as both 'MTS' and 'Make Them Stare' are contained within the one mark. I cannot therefore ignore the possibility that some consumers might refer to the applicant's mark with the words 'Make Them Stare' instead of, or in combination with the letters 'MTS'.

54. Therefore, if the contested mark is vocalised purely as 'MTS' I consider it to be aurally similar to the opponent's mark to at least a medium degree. If the contested mark is vocalised solely as 'Make Them Stare' then I consider this to be dissimilar to the opponent's mark. For that part of the relevant public which articulates all elements of the contested mark, the marks can be said to be aurally similar to only a low degree.

55. Conceptually, the earlier mark would appear to have no specific meaning to the average UK consumer within the context of the goods and services at issue, as it comprises three letters which do not form a word and do not appear to have any further meaning that the general public could associate with it.

56. The applicant's mark contains the three letter 'MTS' which in itself does not have a concept. This could be said to be given a meaning with the banner containing the words 'Make Them Stare', as the acronym may be perceived as comprising the initial letters of each word in the expression. Neither element can be said to be suggestive or allusive of the goods applied for but rather, when considered as a whole, the contested mark gives the consumer the idea that the goods are something that people may want to look at. Based on my assessment above, the earlier mark does not convey a conceptual message and the contested mark has a possible concept, therefore I conclude that the marks at issue are conceptually dissimilar.

Distinctive character of the earlier trade mark

57. 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).

58. 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).”

59. Whilst the opponent has claimed the earlier mark LTS benefits from enhanced distinctiveness through use made of it, it has not provided any formal evidence or a witness statement that supports this. I must therefore assess the mark purely on its inherent distinctive character.

60. In *Kurt Geiger v A-List Corporate Limited*, BL O/075/13, Mr Iain Purvis Q.C., sitting as the Appointed Person, observed that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by

use, the greater the likelihood of confusion'. This is indeed what was said in Sabel. However, it is a far from complete statement which can lead to error if applied simplistically.

It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything, it will reduce it.”

61. The mark 'LTS' does not comprise a dictionary word or have an obvious meaning to the average consumer. The mark is not descriptive of the opponent's goods or services. The average consumer in the UK is unlikely to automatically attach a meaning to the combination of the three letters, however the mark is not fanciful or overtly inventive. I would therefore say that the earlier mark has at least a medium degree of inherent distinctive character.

Likelihood of Confusion

62. There are two types of confusion that I must consider. Firstly, direct confusion i.e. where one mark is mistaken for the other. The second is indirect confusion which is where the consumer appreciates that the marks are different, but the similarities between the marks lead the consumer to believe that the respective goods or services originate from the same or a related source.

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

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms,

is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

64. I have come to the conclusions above that the marks at issue are visually similar to no more than a medium degree; aurally similar to a low or medium degree, or possibly dissimilar; they are conceptually dissimilar and the average consumer would be paying between a medium and a higher degree of attention, although not the very highest level. The goods and services at issue have been found to be identical or similar to a low degree. Although the earlier mark is inherently distinctive to at least a medium degree, I do not believe that there is any direct confusion here. The marks are sufficiently different in their visual, aural and conceptual aspects that the average consumer, general public or professional, would not mistake one for another.

65. I must therefore consider the possibility of indirect confusion. Again, I take guidance from Mr Purvis in *L.A. Sugar Limited* where he stated:

“17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example”).

66. Turning to the above categories; firstly, the shared element between the two marks is the combination of the letters 'TS' which are common letters and not strikingly distinctive.

67. Secondly, the inclusion in the contested mark of the strap line 'Make Them Stare' cannot be said to be the addition of a non-distinctive element which a consumer might expect in a sub-brand or brand extension. I have previously found 'MTS' to be the dominant, eye-catching element of the contested mark due to the differences in size and positioning of the various elements within the mark, however the words 'Make Them Stare' are not presented in a size that is so small that the expression can be said to be *de minimis* and it cannot therefore be overlooked or dismissed entirely.

68. The change of a letter 'L' to a letter 'M' at the beginning of the marks would not be an obvious or logical brand extension in my opinion. I do not consider this to be a step that the average consumer of the goods at issue would expect to be reasonable. The strapline 'Make Them Stare' is a further difference which would again not be a logical or consistent extension to the LTS brand in my view.

69. Whilst the categories set out above by Mr Purvis are not exhaustive, I can find no other reason why the average consumer of the LTS brand would, when exposed to the contested mark, assume that the goods at issue came from the same or an economically linked undertaking, or vice-versa

70. Due to the above, I do not believe that there is any reason to expect an economic connection between the two.

71. I therefore find that there would be no indirect confusion between the marks.

Conclusion

72. The Opposition has failed in its entirety and so the application will proceed to registration.

Costs

73. The applicant has been successful and is entitled to a contribution towards its costs. Award of costs in Fast Track proceedings are based upon the scale as set out in Tribunal Practice Notice 2 of 2015. The award of costs is calculated as follows:

Considering the Notice of Opposition and preparing Counter Statement	£200
Considering the Opponent's written submissions in lieu	£300
Total	£500

74. I therefore order AK Retail Holdings Limited to pay MTS Clothing Ltd the sum of £500. 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 30th day of June 2021

L Nicholas
For the Registrar