

O/924/21

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NUMBER 3535969

BY

AMRIT GHATORE

TO REGISTER THE FOLLOWING TRADE MARK IN CLASSES 6,14,18,20 AND 25

**Lespoke**

AND OPPOSITION THERETO UNDER NUMBER 423047

BY

RESPOKE LIMITED

## Background and Pleadings

1. On 22 September 2020, Mr Amrit Ghatore (“the Applicant”) applied to register the trade mark Lespoke numbered 3535969 in the UK. It was accepted and published in the Trade Marks Journal on 6 November 2020 in respect of the following goods:

Class 6: Safes; Electronic safes; Metal safes; Non-metal safes; Vaults and safes.

Class 14: Jewellery boxes; Watch boxes.

Class 18: Pet clothing; Pet leads; Bags for carrying pets.

Class 20: Furniture; Wooden furniture; Wardrobes; Beds, bedding, mattresses, pillows and cushions; Indoor blinds, and fittings for curtains and indoor blinds; Office tables; Office desks; Office shelving; Office chairs; Pet furniture; Pet cushions.

Class 25: Clothing; Footwear; Headgear.

2. Respoke Limited (“the Opponent”) partially opposes the trade mark application under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) but only in respect of the Applicant’s goods in class 25 namely “*clothing; footwear and headgear*”. For the purposes of the opposition it relies on its two UK trade marks numbered 3403529 and 3003017 both for the word only ‘SPOKE’ as set out below:

i. UKTM 3403529 (“mark 3529”)

SPOKE

Filed: 31 May 2019

Registered: 27 September 2019

Class 25: Clothing, footwear, and headgear, namely, shirts, t-shirts, sweatshirts, trousers, leggings, shorts, skirts, dresses, sweaters, pullovers, jackets and coats, raincoats, socks, underwear.

Class 35: Online retail store services connected with the sale of clothing, footwear, and headgear, namely, shirts, t-shirts, sweatshirts, trousers, leggings, shorts, skirts, dresses, sweaters, pullovers, jackets and coats, raincoats, socks, underwear; retail store services connected with the sale of clothing, footwear, and headgear, namely, shirts, t-shirts, sweatshirts, trousers, leggings, shorts,

skirts, dresses, sweaters, pullovers, jackets and coats, raincoats, socks, underwear; advertising, marketing and promotion services in the field of clothing, footwear, and headgear products; marketing research in the field of clothing, footwear, and headgear products; business consulting services in the field of clothing, footwear, and headgear products.

ii. UKTM 3003017 (“mark 3017”)

SPOKE

Filed: 22 April 2013

Registered: 2 August 2013

Class 25: Men's and women's jackets, coats, trousers, vests.

3. In its pleadings, the Opponent argues that the marks are visually, aurally and conceptually highly similar and overall are near identical and that the respective goods and services are identical/similar. Furthermore, the Opponent argues that the distinctive and dominant element of both signs is the word ‘SPOKE’ this is because the prefix ‘LE’ would be given less attention by the average consumer. When reading the sign ‘LESPOKE’ the average consumer will pay more attention to the dominant word ‘SPOKE’.

4. The Applicant filed a defence and counterstatement denying the claims made and in particular denying that there is a high level of visual similarity between the marks. He contends that in order to succeed “the Opponent must provide evidence that there is a likelihood of confusion between the respective marks by reference to the general public.” Furthermore, due to lack of similarity between the marks, there can be no likelihood of confusion on behalf of the public in respect of the application.

5. Both parties are professionally represented; the Applicant by Lawdit Solicitors and the Opponent by Gunnercooke LLP. Both sides filed evidence in these proceedings. Neither party asked to be heard on the matter and only the Opponent filed submissions in lieu of hearing. This decision is taken following a careful perusal of all the papers.

6. 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 upon

in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

## **Evidence**

7. The Opponent filed evidence in the form of a witness statement of Rosemary Burbidge dated 10 June 2021, accompanied by one exhibit marked RB1. Ms Burbidge is in the employ of the Opponent's professional representatives and has the authority to complete the statement on behalf of the Opponent.

8. The Applicant filed evidence in the form of a witness statement from Mr Amrit Ghatore dated 6 August 2021.

9. The Opponent filed further evidence in reply from Ms Burbidge dated 30 September 2021 accompanied by one exhibit marked RJB2.

10. The Opponent also filed submissions in lieu of hearing dated 4 November 2021.

11. For reasons which I will expand on further I do not propose to summarise the parties' evidence or submissions at this stage, but I have read their contents in full and have taken them into account when reaching my decision. I will refer to the salient points where necessary later in my decision.

## **Proof of use.**

12. The relevant statutory provision of section 6A is as follows:

“(1) This section applies where

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

13. In these proceedings the Opponent is relying on its two UK trade marks as shown above which given their filing dates qualify as earlier trade marks under section 6 of

the Act. As earlier mark 3529 has been registered within the five-year period ending on the date of filing of the Applicant's mark it is not subject to the proof of use provisions contained in section 6A of the Act. Consequently the Opponent is entitled to rely upon this registration without having to establish genuine use. Its 3017 mark however has been registered for more than five years and is therefore subject to proof of use. The Applicant in its counterstatement requested that the Opponent file evidence of use for all its goods and services as relied upon.

### **My approach**

14. Whilst ordinarily following the Applicant's request for the Opponent to provide proof of use for its mark it would need to file evidence of use for the entirety of its specification as relied upon. However both the marks as relied upon by the Opponent are identical word marks and the Opponent's 3529 mark (not subject to proof of use) covers a broader category of goods and services which are wider in scope than its 3017 mark. Whether the Opponent has provided sufficient evidence to substantiate its claim that it has used its 3017 mark will therefore make little difference to my assessment as it is able to rely on its 3529 mark without restriction. I shall therefore proceed initially by assessing the opposition based on mark 3529 only. If reliance on mark 3017 becomes critical to my decision I will formally consider if the use conditions are met for those goods and services later in my decision.

### **Decision**

15. Section 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”.

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

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the

trade mark is applied for, the application is to be refused in relation to those goods and services only.”

17. 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 on the goods and services**

18. When conducting a goods and services comparison, I am guided by the decision in *Gérard Meric v Office for Harmonisation in the Internal Market (OHIM)*, Case T-133/05, where 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 Applicant relies on those goods as listed in paragraph where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

19 . The respective goods and services are set out as follows:

<b>The Applicant’s goods</b>	<b>The Opponent’s goods and services</b>
Class 25: Clothing, footwear and headgear.	Class 25 Clothing, footwear, and headgear, namely, shirts, t-shirts, sweatshirts, trousers, leggings, shorts, skirts, dresses, sweaters, pullovers,



	<p>jackets and coats, raincoats, socks, underwear.</p> <p>Class 35: Online retail store services connected with the sale of clothing, footwear, and headgear, namely, shirts, t-shirts, sweatshirts, trousers, leggings, shorts, skirts, dresses, sweaters, pullovers, jackets and coats, raincoats, socks, underwear; retail store services connected with the sale of clothing, footwear, and headgear, namely, shirts, t-shirts, sweatshirts, trousers, leggings, shorts, skirts, dresses, sweaters, pullovers, jackets and coats, raincoats, socks, underwear; advertising, marketing and promotion services in the field of clothing, footwear, and headgear products; marketing research in the field of clothing, footwear, and headgear products; business consulting services in the field of clothing, footwear, and headgear products.</p>
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20. The Opponent contends that the respective goods covered by class 25 are identical or similar as both concern clothing, footwear and headwear.

21. The Applicant generally admits that “both the Application and the Opponent’s marks’ specification include class 25 for clothing, footwear and headgear” but argues that the “rest of the Applicant’s classes do not relate to class 25 in any way and as such due to the stark difference within the class specification there is a low level of similarity in respect of the goods.”

22. I note that the Opponent does not oppose the Applicant's goods in any of the classes other than in class 25 and therefore the Applicant's registration will proceed for these goods unchallenged. The goods/services comparison will only focus on the Applicant's goods in class 25 as this is the extent of the opposition.

23. The term *clothing, footwear and headgear* appear in both the Applicant and the Opponent's respective specifications which ordinarily would mean that the terms are self-evidently identical. I note, however, that the Opponent's specification includes the term "namely" followed by a list of goods. The effect of this is that its specification is limited to those items. Notwithstanding this, in reality it will make little difference, given that the Opponent's *shirts, t-shirts, sweatshirts, trousers, leggings, shorts, skirts, dresses, sweaters, pullovers, jackets and coats, raincoats, socks, underwear* will be covered by the Applicant's broader category of *clothing, footwear and headgear* goods and thus still be regarded as identical taking into account the principles in *Meric*.

24. Whilst the Opponent relies on its class 35 services, I do not consider it necessary at this stage to assess the similarity between the Applicant's class 25 goods and the Opponent's class 35 services as it will not place it in any stronger position. If the Opponent fails in its opposition for goods that are identical it will not be in any stronger position for services that are further away in terms of similarity. I shall proceed with the assessment based on identical goods, therefore, only returning to the services if it becomes necessary to do so.

### **Average consumer and the purchasing process**

25. When considering the opposing trade marks I must determine, first of all, who the average consumer is for the goods and the method of selecting these goods. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. It must also be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods in question.

26. 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 word “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

27. The Applicant did not make any specific submissions on the average consumer or the purchasing process other than arguing that its goods are “high quality and luxury products” with the focus of its business in “custom products that are not off the shelf or widely available”. He did not elaborate on this statement further, nor did he provide any detailed evidence to support his contention.

28. The Opponent submitted that:

“Clothing footwear and headgear are human necessities. Consequently the average consumer is the general public. The level of attentiveness will vary depending on the relevant price point of the products not always be particularly considered.”

29. My assessment is a notional one based on normal and fair use across the whole breadth of the goods’ specifications as they appear on the register and not how the parties/Applicant in reality provides them. In this regard, I agree with the Opponent’s evaluation.

30. In *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03, the GC stated that:

“49. However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (*BUDMEN*, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumer choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual

similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs.”

And

“50..... Generally in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly the visual aspect plays a greater role in the global assessment of the likelihood of confusion.”

31. Taking into account the nature of the goods, I consider that the purchasing process will be primarily visual with the goods selected from retail outlets or their online equivalents. I do not discount aural considerations however in the form of advice sought from sales assistants or queries over the telephone. Acknowledging that the goods may vary in price, overall, I consider that the respective parties’ goods are directed at the general public at large, purchased on a relatively frequent basis. Considerations such as fashion trends, price, quality and suitability will play a part in the selection process leading to an average degree of attention being taken, no higher or lower than the norm for such goods.

### **Comparison of the marks**

32. 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.”

33. It would be wrong, therefore, to dissect the trade marks artificially, although it is necessary to consider 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 trade marks.

34. The marks to be compared are as follows:

Applicant's mark	Opponent's mark
Lespoke	SPOKE

### **Overall Impressions**

35. The Opponent's mark is for the word only SPOKE presented in upper casing. There are no other elements to contribute to the mark and therefore the overall impression resides in the totality of the word. Similarly the Applicant's mark 'Lespoke' is a word only mark presented in title case, with no additional features or stylisation. Despite the Opponent's submissions that the element spoke is the dominant and distinctive element of the Applicant's mark I do not consider that this is the case. The overall impression lies in the totality of the word.

### **Visual Comparison**

36. The Opponent submits that the Applicant's mark will be broken down and seen as two words ie 'LE' and 'SPOKE' meaning that the marks are near identical. It is argued that "the prefix LE does not distinguish the application from the earlier marks. This word is the masculine form of 'the' in French and would widely be read as 'Le Spoke' or 'The Spoke' by a significant proportion of the relevant public." Ms Burbidge contends that the meaning of "le" as the French for "the" would be widely understood by English consumers given that there is a significant French speaking population in the UK and

that it is the most studied language in UK secondary schools. In support of this, Ms Burbidge produces data taken from the ONS website which confirms that between 2013 and 2015 there was an estimated 154,800 French citizens in the UK.<sup>1</sup>

37. The Applicant refutes that its mark will be broken down into two elements or that the letters “Le” will be extracted from the mark and seen as the French word for “the”. Mr Ghatore argues that a significant part of the UK population would not recognise the letters ‘le’ as having a French meaning and that the figures produced by the Opponent are not only outdated but also would only equate to 0.24% of the population taking the UK’s population as at 2015 as 64.85 million people.<sup>2</sup> It is submitted that the likelihood of the average UK consumer believing that the application is in any way connected to France is very low.

38. Visually, both marks present as word marks. The variance in casing between the marks will make little difference to the visual assessment given that notional and fair use allows for a word only mark to be presented in any font or typecase.<sup>3</sup> The marks coincide visually to the extent that the Opponent’s mark ‘spoke’ is wholly contained within the Applicant’s mark (being the last five letters). The difference is created with the first two additional letters ‘Le’ at the beginning of the Applicant’s mark.

39. I am not persuaded by the Opponent’s argument that the Applicant’s mark will be broken down visually into two distinct parts given that the relevant public is likely to perceive the mark in its entirety. Whilst consumers are naturally drawn to words they recognise, I do not consider that the word ‘spoke’ positioned as it is within the Applicant’s mark will be immediately recognisable without a degree of dissection that I do not consider will be undertaken by the average consumer upon an immediate and instinctive reaction to the mark on first encounter.<sup>4</sup>

40. I am fortified by this assessment taking into account the general rule, that beginnings of marks are generally more noticeable than their ends and therefore have more visual and aural impact.<sup>5</sup> On this basis I consider that the marks are visually similar to a medium degree.

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<sup>1</sup> Page 44 of Exhibit RJB1

<sup>2</sup> Par 12. Statement Mr Ghafir.

<sup>3</sup> Paragraph 47 *Sadas SA v. OHIM* Case T-364/04.

<sup>4</sup> *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

<sup>5</sup> *El Corte Inglés, SA v OHIM*, Cases T-183/02

## **Aural comparison**

41. The Opponent submits that:

“LESPOKE is near identical to SPOKE and is phonetically very similar. While LESPOKE consists of two syllables the emphasis or word stress is on the second syllable and the dominant element of the sign (ie “SPOKE”). The prefix LE is given less attention when combined with the dominant word (ie “SPOKE”) and is therefore less relevant as the average consumer is less likely to read this word out loud when referring to the Application.”

42. Whilst accepting that the marks share the same mutual element ‘Spoke’ the Applicant submits that “the pronunciation ...would differ substantially due to the inclusion of the element Le - which resonates a strong distinct phonetic sound.”

43. Aurally, acknowledging that there may be a number of ways in which the respective marks are pronounced I consider that the Opponent’s mark will be pronounced as SBOAK with the Applicant’s mark being pronounced as either LEZ-SBOAK or LUH-SBOAK depending on how the first syllable is pronounced. Whichever way the beginning of the Applicant’s mark is pronounced, the second syllable of the Applicant’s mark and the entirety of the Opponent’s mark will be pronounced identically. The aural difference therefore between the marks is only created by the first syllable. On this basis, I consider that the marks will be aurally similar to a medium degree.

## **Conceptual comparison**

44. The Opponent submits that:

“the word spoke has many meanings from a spoke on a bicycle wheel to the past participle of the verb to speak. When used in relation to clothing and luxury products the primary conceptual meaning of spoke is as a contraction of the word bespoke. The only point of difference in the application is the word “LE” which...has a conceptual meaning to consumers of “the” ie “the Spoke” due to the “le” element being seen as a French word for “the”.”

45. The Applicant denies that there is a high level of conceptual similarity submitting that:

“..the word ‘spoke’ has a number of definitions, for example the word ‘spoke’ is more commonly known as the verb used to note someone talking or making conversation. The addition of (le-) is distinctive. The Application is therefore a distinctive term and holds no dictionary definition. As noted above, the relevant consumer will directly associate the Opponent’s Marks as ‘wire rods on wheels’ or the verb to ‘make conversation’ , which highlights that the Opponent’s Marks consist purely of a descriptive and non-distinctive term. Further to the above, the Opponent has also submitted that the Application is associated with the French term ‘le Spoke’. This term does not have any direct meaning in French other than ‘the spoke’ and therefore it cannot be submitted that the Application is a common place term. Furthermore, it would also not be evident to the consumer to associate the mark with the term ‘bespoke’ or ‘spoke’ as the average consumer of the Application will not solely be buying clothing items that the Opponents argument is based upon.”

46. In my view the Opponent’s mark is unlikely to be regarded as a spoke of a wheel as no evidence has been provided that the Opponent’s goods are cycling related, and therefore I do not consider that this meaning would be an obvious one to the average consumer. Similarly, I do not accept that because the word ‘spoke’ is used in relation to clothing and luxury products it will be associated with the word bespoke as claimed by the Opponent. This is to strain the meaning of the language and dissect the word artificially which would involve a greater thought process by the consumer than I consider would be undertaken. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.<sup>6</sup> In my view, I consider that it is more likely that the Opponent’s mark will be perceived as being derived from or having a connection to the verb “to speak”, even if it is not recognised as the past participle of the verb.

47. Ms Burbidge produces an article taken from [www.babble.com](http://www.babble.com) which discusses “Franglais” namely the use of English words adopted into the French language and vice versa and which she says supports her argument that UK consumers will see the application as “le spoke”. This article does not assist the Opponent, however. The focus of the article appears to be the “Gallification”<sup>7</sup> of English words into the French

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<sup>6</sup> Case C-361/04 P *Ruiz-Picasso and Others v OHIM* [2006] ECR I-00643; [2006] E.T.M.R. 29

<sup>7</sup> that is the changing of a word to make it sound or look French



language. I accept that phrases like “le weekend” and “le sport” have become widely used by French speakers, however, there are no examples given of the use of the French definitive article before an English word being used in the UK or that this practice has become common place or customary in the English language. The examples given in the article are for the total adoption of French words such as sabotage and faux pas into the English language. I do not accept the Opponent’s contention, therefore, that the average UK consumer would perceive the application as a *franglais* word and break it down into two elements, as “le spoke” meaning “the spoke”. There is no reason for them to dissect the mark in this way.

48. Taking account of my assessment regarding the overall impression of the mark, I consider that the applicant’s mark will be perceived in its entirety as a made-up word with no meaning. On this basis I consider that the marks are conceptually dissimilar.

#### **Distinctive character of the earlier mark**

49. Registered trade marks possess varying degrees of inherent distinctive character. Those marks that are regarded as descriptive of the goods will possess a low degree of distinctiveness. Conversely invented words with no association to the goods are highly distinctive. The more distinctive the earlier mark (either *per se* or by the use that has been made of it) the greater the likelihood of confusion.<sup>8</sup>

50. 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).

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<sup>8</sup> *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)

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).”

51. Whilst the Opponent has filed evidence, this was predominantly to support the requirement to prove use of its 3017 mark. Whilst it has not specifically pleaded that its marks have acquired an enhanced degree of distinctive character through use it is still a consideration I must assess. The evidence submitted by Ms Burbidge is mostly in the form of screenshots taken from its website [www.spoke-london.com](http://www.spoke-london.com) and social media accounts (Instagram and Facebook). These documents display the use of the mark ‘Spoke’ within the names of these accounts and as displayed on clothing mainly men’s trousers, shorts, t-shirts and shirts; the mark is presented on swing tags, labels and on the items of clothing themselves. Some invoices are produced showing sales to UK consumers, however, only 9 in total have been produced dated between August 2018 and July 2020 and of these, 8 are invoices for sales of men’s trousers only. The sales taken from these invoices amount to no more than £1,500 during this two-year period. No turnover, sales or advertising figures are produced or any indication as to its market share. Whilst the Opponent has demonstrated some use of its mark, without more detailed evidence I am unable to assess the extent of use. Ms Burbidge states that in light of the way in which the public has been trained to associate ‘SPOKE’ with clothing that the Applicant’s use of his mark would lead to confusion however I do not find the evidence produced supports this contention. Insufficient evidence has been produced by the Opponent to demonstrate that the UK consumer has become educated in its mark and therefore I do not find that the mark ‘SPOKE’ has acquired an enhanced degree of distinctive character through the use made of it. On this basis I can only proceed with the assessment based on the inherent position.

52. As I have already outlined above, I consider that the word SPOKE will be seen as connected or derived from the verb “to speak”. Despite the Applicant arguing that the Opponent’s mark is descriptive and non-distinctive, I do not find this to be the case, it neither describes, nor alludes to the Opponent’s goods, nor refers to a characteristic or quality of the goods. I consider that the mark will be seen as an English word. Some consumers may immediately recognise it as the past participle of the verb “to speak”, however, it does not include an identifier (a reference as to who spoke) nor is it presented as a command. Its presentation, grammatically, is therefore unusual. On this basis, I consider that the mark possesses an average degree of distinctive character.

### **Likelihood of confusion**

53. When considering whether there is a likelihood of confusion between the respective 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 services originate from the same or related source. In determining whether there is a likelihood of confusion the assessment is a global assessment taking into account a number of factors. 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/services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the Opponent’s trade marks, the average consumer for the services 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.

54. Earlier in my decision, I identified the average consumer as a member of the general public who predominantly selects the goods via visual means (but without discounting aural considerations). I have found an average level of attention in the purchasing process no higher or lower than the norm for such goods. For the reasons already outlined, visually and aurally I found the marks to be similar to a medium degree and found that conceptually the marks were dissimilar. The Opponent’s mark

possesses an average degree of distinctive character. The respective goods were identical.

55. 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.”

56. In *Quelle AG v OHIM*, Case T-88/05, the GC found that visual similarity (and difference) is most important in the case of goods that are self-selected or where the consumer sees the mark when purchasing the goods. The Court stated that:

“68..... If the goods covered by the marks in question are usually sold in self-service stores where consumers choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any phonetic similarity between the signs (*NLSPORT*, *NLJEANS*, *NLACTIVE* and *NLCollection*, paragraph 53 supra, paragraph 49).

69. Likewise, the degree of phonetic similarity between two marks is of less importance in the case of goods which are marketed in such a way that, when making a purchase, the relevant public usually perceives visually the mark designating those goods (*BASS*, paragraph 56 supra, paragraph 55, and Case T-301/03 *Canali Ireland v OHIM – Canal Jean (CANAL JEAN CO. NEW YORK)*

[2005] ECR II-2479, paragraph 55). That is the case with respect to the goods at issue here. Although the applicant states that it is a mail order company, it does not submit that its goods are sold outside normal distribution channels for clothing and shoes (shops) or without a visual assessment of them by the relevant consumer. Moreover, while oral communication in respect of the product and the trade mark is not excluded, the choice of an item of clothing or a pair of shoes is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly, the visual aspect plays a greater role in the global assessment of the likelihood of confusion (*NLSPORT*, *NLJEANS*, *NLACTIVE* and *NLCollection*, paragraph 53 supra, paragraph 50). The same is true of catalogue selling, which involves as much as does shop selling a visual assessment of the item purchased by the consumer, whether clothing or shoes, and does not generally allow him to obtain the help of a sales assistant. Where a sales discussion by telephone is possible, it takes place usually only after the consumer has consulted the catalogue and seen the goods. The fact that those products may, in some circumstances, be the subject of discussion between consumers is therefore irrelevant, since, at the time of purchase, the goods in question and, therefore, the marks which are affixed to them are visually perceived by consumers.”

57. The Applicant argues that the Opponent has failed to provide any evidence of actual confusion between the marks and furthermore due to the Applicant’s business operating mainly through its websites and markets and sells its products via social media the trade channels would not overlap. Caselaw suggests, however, that whether there is or is not actual confusion is of little or no significance as it does not necessarily reflect the actual position regarding whether the average consumer would be aware of the respective marks on the market nor whether the consumer has been consistently exposed to them side by side in comparable market environments.<sup>9</sup> The absence of confusion is unlikely to be a determinative factor therefore, as it may be as a result of differences extraneous to the earlier mark.<sup>10</sup> It is not necessary therefore for the Opponent to provide evidence of actual confusion as the assessment must be based on an objective test of all the relevant factors.

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<sup>9</sup> *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41

<sup>10</sup> *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283

58. In making my assessment of a likelihood of confusion I bear in mind the purpose of a trade mark namely to distinguish the goods/services of one undertaking from another. Taking into account my reasons already outlined, and particularly given that the purchase of clothing is a visual process, I consider that the difference between the marks as a result of the additional letters 'Le', positioned at the beginning of the Applicant's mark is sufficient to prevent consumers mistakenly recalling or misremembering the marks, despite the goods being identical. As such I do not find that there would be direct confusion.

59. Moving on to consider whether there would be indirect confusion. Given my assessment regarding the overall impression of the respective marks, I find it improbable that the average English-speaking consumer would break down the Applicant's mark into two distinct components, as suggested by the Opponent, nor perceive the letters 'Le' separately as the French word for "the". The addition of the letters 'Le' to the word 'spoke' do not give rise to a logical brand extension or sub brand as set out in the caselaw since, in my view, the Applicant's mark will be regarded as a word in its entirety. Consumers would not consider that the goods are provided by the same or related undertaking especially given that the Applicant's mark will be regarded as a made-up word. I do not find that the element 'spoke' will be recognised within the contested mark as the dominant element leading to the average consumer believing that there would be an economic connection between the two. On this basis there would be no indirect confusion.

60. Having found no confusion in relation to mark 3527 I need not go on to consider its 3017 mark since the earlier marks are identical and the goods of its registration are narrower in scope. Similarly having not found confusion for goods that are identical it is not necessary to assess the Opponent's services as this will not place the Opponent in any stronger position.

## **Conclusion**

61. The opposition fails in its entirety under section 5(2)(b) of the Act. Subject to any successful appeal (no opposition having been raised in relation to the Applicant's goods in classes 6,14,18 and 20) the application may proceed to registration for:

Class 6: Safes; Electronic safes; Metal safes; Non-metal safes; Vaults and safes.

Class 14: Jewellery boxes; Watch boxes.

Class 18: Pet clothing; Pet leads; Bags for carrying pets.

Class 20: Furniture; Wooden furniture; Wardrobes; Beds, bedding, mattresses, pillows and cushions; Indoor blinds, and fittings for curtains and indoor blinds; Office tables; Office desks; Office shelving; Office chairs; Pet furniture; Pet cushions.

Class 25: Clothing; Footwear; Headgear.

### **Costs**

62. As the Applicant has been successful it is entitled to a contribution towards its costs. Any award of costs is governed by the published scale as set out in Tribunal Practice Notice 2 of 2016. Applying this guidance I award costs on the following basis:

Considering the notice of opposition and preparing a defence and counterstatement:	£200
Considering the Opponent's evidence and preparing evidence in reply:	£500
<b>Total</b>	<b>£700</b>

63. I order Respoke Ltd to pay Amrit Ghatore the sum of £700 as a contribution towards his costs. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case, if any appeal against the decision is unsuccessful.

Dated this 20<sup>th</sup> day of December 2021

Leisa Davies

For the Registrar