

o/1130/22

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003760644

BY RAJA SINGH

TO REGISTER THE TRADE MARK:

FLY STRAIGHT

IN CLASS 33

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 600002412

BY TYRESE BOWENS

BACKGROUND AND PLEADINGS

1. On 1 March 2022, RAJA SINGH (“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 18 March 2022. The applicant seeks registration for the following goods:

Class 25 Clothes; clothing.

2. The application was opposed by Tyrese Bowens (“the opponent”) on 17 June 2022. The opposition is based upon sections 5(1), 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon the following trade mark:

Flystr8 London

UK registration no. UK00003558215

Filing date 20 November 2020.

Registration date 2 April 2021.

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

Class 25 Sweat bottoms; Sweatshirts; Sweatshorts; Sweatsuits; T-shirts; Caps [headwear]; Socks.

3. The opponent claims that the marks have a “distinctive sound” and this “can cause confusion for customers when being directed through our marketing outlets such as word of mouth and social media marketing through influencers”.

4. The applicant filed a counterstatement denying the claims made.

5. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 No. 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.”

6. 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.

7. 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.

8. The opponent and applicant are unrepresented. A hearing was neither requested nor considered necessary, nor did the parties file any submissions in lieu. This decision is taken following a careful perusal of the papers.

9. 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.

PRELIMINARY ISSUE

10. In its Form TM8, the applicant has made a point that I intend to address as a preliminary issue. It states that:

“Another brand with a higher level of similarity ‘iFlystr8’ (UK00003720543) was opposed during their trademark procedure submitted after the oppositions, however, was allowed leniency and permission to submit their brand. This raises the question as to why our brand ‘FLY STRAIGHT’ has been opposed further by ‘Flystr8 London’ whilst ‘iFlystr8’ opposition was disregarded. ‘iFlystr8’ and ‘Flystr8 London’ have near enough the same spelling of fly straight (Flystr8) with one letter differentiating them, the ‘i’. As a more recent brand with different

visual and spelling of Fly Straight, we find this statement to be extremely confusing and unfair.”

11. In *Zero Industry Srl v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-400/06 the General Court (“GC”) stated that:

“73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word ‘zero’, it should be pointed out that the Opposition Division found, in that regard, that ‘... there are no indications as to how many of such trade marks are effectively used in the market’. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word ‘zero’ is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T-135/04 *GfK v OHIM – BUS(Online Bus)* [2005] ECR II-4865, paragraph 68, and Case T-29/04 *Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH)* [2005] ECR II-5309, paragraph 71). “

12. The mere fact that there may be other, or multiple marks on the register, containing an ‘iFlystr8’ element, or that the opponent has decided to oppose some and not others, (either in this jurisdiction or in the EU) is not relevant to my assessment. I have no evidence of how (if at all) these marks have been used in practice. This submission, therefore, does not assist the applicant.

DECISION

13. Section 5(1) of the Act reads as follows:

“5(1) A trade mark shall not be registered if it is identical with an earlier trademark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.”

14. Section 5(2) reads as follows:

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

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the trade mark is protected

(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.”

15. The earlier mark had not completed its registration process more than five years before the relevant date (the filing date of the mark in issue). Accordingly, the use provisions at s.6A of the Act do not apply. The opponent may rely on all of the goods it has identified without demonstrating that it has used the mark.

Identity of the marks

16. It is a prerequisite of sections 5(1) and 5(2)(a) that the trade marks are identical. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, the Court of Justice of the European Union (“CJEU”) held that:

“54... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by the average consumer.”

17. The word “Flystr8” in the opponent’s mark differs visually from the wording “FLY STRAIGHT” in the applicant’s mark. The opponent’s mark also contains the word

“London” which acts as a visual point of difference between the marks which will not go unnoticed by the average consumer. I do not, therefore, consider these marks to be identical.

18. As both section 5(1) and section 5(2)(a) require the marks to be identical, the opponent’s claims under these grounds falls at the first hurdle.

19. The opposition based upon sections 5(1) and 5(2)(a) is dismissed.

Section 5(2)(b) case law

20. 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

21. The competing goods are as follows:

Opponent's goods	Applicant's goods
<u>Class 25</u> Sweat bottoms; Sweatshirts; Sweatshorts; Sweatsuits; T-shirts; Caps [headwear]; Socks.	<u>Class 25</u> Clothes; clothing.

22. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 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.”

23. Guidance on this issue has come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (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

24. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, 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 for 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.”

25. The opponent’s “sweat bottoms”, “sweatshirts”, “sweatshorts”, “sweatsuits”, “T-shirts” and “socks” falls within the broader category of “clothes” and “clothing” in the applicant’s specification. I consider them identical on the principle outlined in *Meric*.

The average consumer and the nature of the purchasing act

26. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J (as he then was) described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words

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

27. The average consumer for the goods will be members of the general public. The cost of purchase is likely to vary, and the goods will be purchased relatively frequently. However, various factors are still likely to be taken into consideration during the purchasing process, such as materials used, cut, aesthetic appearance and durability. Consequently, I consider that a medium degree of attention will be paid by the average consumer when selecting the goods.

28. The goods are likely to be obtained by self-selection from the shelves of a clothing retail outlet, online or catalogue equivalent. This means that the mark will be seen and so the visual element of the mark will be the most significant: see *New Look Limited v OHIM*, Joined cases T-117/03 to T-119/03 and T-171/03, paragraph 50. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount that there will also be an aural component to the purchase, as advice may be sought from a sales assistant or representative.

Comparison of the trade marks

29. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade 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.”

30. 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.

31. The respective trade marks are shown below:

Opponent's trade mark	Applicant's trade mark
Flystr8 London	FLY STRAIGHT

32. The opponent's trade mark consists of the words "Flystr8 London". The word 'Flystr8' will be recognised as meaning "fly straight" (which will be explored further below in this decision). The word London will be recognised as the geographical location. The combination of these words do not qualify each other to create its own unitary meaning. The words remain as separate components. Therefore, the two words play independent distinctive roles, with the word "Flystr8" being the most dominant and distinctive element of the mark (a recognisable concept being presented in an unusual manner; in both letters and numbers). Consequently, I consider that the word "Flystr8" plays a greater role in the overall impression of the mark, with the word "London" playing a lesser role.

33. The applicant's trade mark consists of the words "FLY STRAIGHT". I consider that the overall impression of the mark lies in the combination of these elements.

34. Visually, the marks coincide in the first 6 letters; F, L, Y, S, T and R, albeit the applicant's mark has a space between the letters Y, and S. I note that the average consumer tends to pay more attention to the beginning of marks. These, therefore, act

as visual points of similarity. However, the opponent's first word ends in the number 8, which is followed by the word "London". The applicant's mark ends in the letters A, I, G, H and T. These all act as visual points of difference. Taking the above into account, I consider that the marks are visually similar to below a medium degree.

35. Aurally, the opponent's mark will be pronounced as FLY-ST-RH-ATE LUN-DUN. The applicant's mark will be pronounced as FLY ST-RH-ATE. Therefore, as the applicant's mark is aurally wholly contained at the beginning of the opponent's mark, I consider that they are aurally similar to between a medium and high degree.

36. Conceptually, I do not have any submissions from either party regarding the meanings of their marks. The applicant's mark is composed of 2 ordinary dictionary words, which together create the conceptual meaning of 'to fly straight'. I also consider that the "Flystr8" element of the opponent's mark, due to its aural pronunciation, will also be recognised as meaning 'to fly straight'. However, I note that this element is also followed by the word "London". I consider that, when taken into context with the goods, this element is likely to be perceived by the consumer as the location in which the clothing is produced or where the company is based. Regardless, as the marks overlap in the conceptual meaning of "fly straight", I consider that the marks are conceptually similar to between a medium and high degree.

Distinctive character of the earlier trade mark

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

"22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promotion of 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).”

38. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

39. As highlighted above, the opponent’s mark is composed of the words “Flystr8 London”. I consider that the “Flystr8” element will be conceptually recognised as meaning to “fly straight” and the “London” element will be recognised as a geographical location. In the context of the above goods, I consider that the average consumer will see the “London” element as denoting the location where the clothing is produced or where the company is based.

40. As established above, I consider that the two words play independent distinctive roles, with “Flystr8” being the most dominant and distinctive element within the mark. Therefore, when taking the mark as a whole into account, I consider that it is inherently distinctive to above a medium degree.

Likelihood of confusion

41. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the

average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. It is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

42. The following factors must be considered to determine if a likelihood of confusion can be established:

- The opponent's mark consists of the words "Flystr8 London". I consider that the two words play independent distinctive roles, with the word "Flystr8" being the most dominant and distinctive element of the mark, and therefore playing a greater role in the overall impression, with the word "London" playing a lesser role.
- The applicant's mark consists of the words "FLY STRAIGHT". The overall impression of the mark lies in the combination of these elements.
- I have found the marks to be visually similar to below a medium degree.
- I have found the marks to be aurally and conceptually similar to between a medium and high degree.
- I have found the opponent's mark to be inherently distinctive to above a medium degree.
- I have identified the average consumer to be members of the general public who will select the goods primarily by visual means, although I do not discount an aural component.
- I have concluded that a medium degree of attention will be paid during the purchasing process for the goods.

- The parties' goods are identical.

43. Taking all of the factors listed in paragraph 42 into account, particularly the visual differences between the marks, and even bearing in mind the principle of imperfect recollection, I am satisfied that the marks are unlikely to be mistakenly recalled or misremembered as each other. This is particularly the case given the lower visual similarity (to below a medium degree) between the marks, and the predominantly visual purchasing process of clothing goods (being obtained by self-selection from the shelves of a clothing retail outlet, online or catalogue equivalent), which as highlighted by *New Look Limited v OHIM*, means that the visual element of the mark will be the most significant. The average consumer may overlook the "London" element of the opponent's mark on the basis that it plays a lesser role, because it denotes the location where the clothing is produced or where the company is based. However, I do not consider that the average consumer would overlook different presentations of 'Fly Straight'. I consider that because the opponent's mark is presented in an unusual manner, with the word/concept being comprised of both letters and numbers (Flystr8), it would not be directly confused with the applicant's mark, which is simply comprised of two ordinary dictionary words, presented in its usual way (FLY STRAIGHT). Consequently, I do not consider that there would be a likelihood of direct confusion.

44. It now falls to me to consider the likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

"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.”

45. I also bear in mind the comments made in *Bimbo*. The CJEU stated (my emphasis):

“19. As to the merits, according to settled case-law, the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94 (see Case C-334/05 P *OHIM v Shaker* EU:C:2007:333, paragraph 33, and Case C-193/06 P *Nestlé v OHIM* EU:C:2007:539, paragraph 32).

20. The existence of a likelihood of confusion on the part of the public must be assessed globally, account being taken of all factors relevant to the circumstances of the case (see, to that effect, Case C-251/95 *SABEL* EU:C:1997:528, paragraph 22; *OHIM v Shaker* EU:C:2007:333, paragraph 34; and *Nestlé v OHIM* EU:C:2007:539, paragraph 33).

21. The global assessment of the likelihood of confusion, in relation to the visual, aural or conceptual similarity of the marks at issue, must be based on the overall impression given by the marks, account being taken, in particular, of their distinctive and dominant components. The perception of the marks by the average consumer of the goods or services in question plays a decisive role in the global assessment of that likelihood of confusion. In this regard, the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (see, to that effect, *SABEL* EU:C:1997:528, paragraph 23; *OHIM v Shaker* EU:C:2007:333, paragraph 35; and *Nestlé v OHIM* EU:C:2007:539, paragraph 34).

22. The assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole (*OHIM v Shaker* EU:C:2007:333, paragraph 41).

23. The overall impression conveyed to the relevant public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components. However, it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element (*OHIM v Shaker* EU:C:2007:333, paragraphs 41 and 42, and *Nestlé v OHIM* EU:C:2007:539, paragraphs 42 and 43 and the caselaw cited).

24. In this connection, the Court of Justice has stated that it is possible that an earlier mark used by a third party in a composite sign that includes the name of the company of the third party retains an independent distinctive role in the composite sign. Accordingly, in order to establish the likelihood of confusion, it suffices that, on account of the earlier mark still having an independent distinctive role, the public attributes the origin of the goods or services covered by the composite sign to the owner of that mark (Case C-120/04 *Medion* EU:C:2005:594, paragraphs 30 and 36, and order in Case C-353/09 P *Perfetti Van Melle v OHIM* EU:C:2011:73, paragraph 36).

25. None the less, a component of a composite sign does not retain such an independent distinctive role if, together with the other component or components of the sign, that component forms a unit having a different meaning as compared with the meaning of those components taken separately (see, to that effect, order in Case C-23/09 P *ecoblue v OHIM and Banco Bilbao Vizcaya Argentaria* EU:C:2010:35, paragraph 47; *Becker v Harman International Industries* EU:C:2010:368, paragraphs 37 and 38; and order in *Perfetti Van Melle v OHIM* EU:C:2011:73, paragraphs 36 and 37)."

46. In *Deakins*, BL O/421/14, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, stated:

"24. It is not correct to proceed on the basis that an element of a composite mark retains an independent distinctive role if, together with the other component or components of the mark, it 'forms a unit having a different

meaning as compared with the meaning of those components taken separately: *Bimbo SA v. OHIM C-591/12P*, EU:C:2014:305 at paragraph [25]. And even if a component of a composite mark is found to be sufficiently ‘unitary’ to retain an independent distinctive role, it still remains necessary for any assessment of ‘*similarity*’ to be made by reference to the composite mark as a whole in the manner summarised in *Bimbo SA* at paragraphs [34] and [35]:

[34] Indeed, as the Advocate General observed in points 25 and 26 of his Opinion, 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.

[35] The determination of which components of a composite sign contribute to the overall impression made on the target public by that sign is to be undertaken before the global assessment of the likelihood of confusion of the signs at issue. Such an assessment must be based on the overall impression produced by the trade marks at issue, since the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details, as has been stated in paragraph 21 above. Therefore, this does not involve an exception, that must be duly substantiated, to that general rule.”

47. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. (as he then was) considered the impact of the CJEU’s judgment in *Bimbo*, Case C-591/12P, on the court’s earlier judgment in *Medion v Thomson*. The judge said:

“18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an

earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

48. In that case, Arnold J. considered the registrability of a composite word mark - JURA ORIGIN - which included the opponent’s earlier trade mark – ORIGIN. The judge found that the mark JURA ORIGIN formed a unit having a different meaning to those of the individual components. I have found the opposite in these proceedings;

“Flystr8 London” does not form a unit; the words retain their individual meanings. “Flystr8” retains an independently distinctive role.

49. Both marks share the wording and concept of ‘fly straight’, albeit they are presented in different manners (Flystr8 vs Fly Straight). However, I consider that the common use of this concept/conceptual hook, which isn’t allusive or descriptive for clothing, and therefore distinctive (to above a medium degree), will lead the average consumer to conclude that the marks originate from the same or economically linked undertakings. I consider that the average consumer will see the presentation of Flystr8, and see it as a different expression of the same mark; FLY STRAIGHT. Therefore, I consider that the marks will be seen as alternative marks being used by the same or economically linked undertakings, perhaps being an updated version of the same mark, and therefore indicative of re-branding.

50. I find that the additional word in the opponent’s mark, ‘LONDON’, does not make a significant change to the concept of the mark. As highlighted above, in the context of the above goods, I consider that the average consumer will see the “London” element as denoting the location where the clothing is produced or where the company is based. Therefore, I find that the addition of this word will cause average consumers to consider that the mark is a sub-brand or brand extension by the undertaking responsible for Flystr8/FLY STRAIGHT. The use of sub-brands and brand extensions is common in the clothing trade. The GC stated, in *Zero Industry Sri v OHIM*, Case T-400/06, at paragraph 81:

" ... it is common in the clothing sector for the same mark to be configured in various ways according to the type of product which it designates, and second, it is also common for a single clothing manufacturer to use sub-brands (signs that derive from a principal mark and which share with it a common dominant element) in order to distinguish its various lines from one another."

51. Therefore, taking all of the above into account, I consider that the average consumer would believe that the opponent’s and applicant’s marks will be seen as alternative marks being used by the same or economically linked undertakings, being

updated versions of the same marks (re-branding), and sub-brand marks. Therefore, I consider there to be a likelihood of indirect confusion.

CONCLUSION

52. The opposition is successful in its entirety and the application is refused.

COSTS

53. Award of costs in fast track proceedings are governed by TPN 2/2015. The opponent has been successful and would normally be entitled to a contribution towards their costs.

54. However, as the opponent is unrepresented, at the conclusion of the evidence rounds the tribunal wrote to the opponent and invited them to indicate whether they intended to make a request for an award of costs. The opponent was informed that, if so, they should complete a Pro Forma, providing details of their actual costs and accurate estimates of the amount of time spent on various activities associated with the proceedings. They were informed that “if the pro-forma is not completed and returned, costs, other than official fees arising from the action (excluding extensions of time) may not be awarded”.

55. The opponent did not file a completed Pro Forma. That being the case I award the opponent the sum of £100 in respect of the official fee only.

56. I therefore order RAJA SINGH to pay Tyrese Bowens the sum of **£100**. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 20th day of December 2022

L FAYTER

For the Registrar