

O-485-21

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3481125 BY
ODIMBA OKUTU & CHRISTIAN OKUTU**

TO REGISTER:

送 OKURL

AS A TRADE MARK IN CLASS 25

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 600001430 BY
NELWOOD CORP.**

Background & pleadings

1. On 14 April 2020, Odimba Okutu and Christian Okutu (“the applicants”) applied to register the trade mark shown on the cover page of this decision for the goods in class 25 shown in paragraph 12 below.

2. On 27 July 2020, the application was opposed in full under the fast track opposition procedure by Nelwood Corp. (“the opponent”). The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), with the opponent relying upon all the goods and services (also shown in paragraph 12 below) in an International Registration designating the United Kingdom (“IRUK”) no. 1467919, for the word **kuru** which has a designation date of 1 April 2019 (claiming an international convention priority date of 3 October 2018 from an earlier filing in the United States) and which was granted protection in the United Kingdom on 15 August 2019.

3. The opposition was served upon the applicants, following which they filed a number of versions of the Form TM8 and counterstatement. In earlier (unacceptable) versions of the Form TM8 and counterstatement, the applicants filed information which the Tribunal considered to be evidential in nature as well as providing a witness statement, dated 7 November 2020, from Tana Bui who describes herself as the “director and second in command of OKURU London...” The Tribunal provided appropriate guidance in relation to these earlier unacceptable versions and, on 8 April 2021, the applicants filed a further amended Form TM8 and counterstatement which the Tribunal deemed acceptable. As these are the only comments I have from the applicants in these proceedings, insofar as they are relevant, they read as follows:

“I would like to prove that my brand is not related to kuru which is a clothing brand based in the USA that sells all types of clothing goods and services. I am going to explain why in detail how OKURU has no comparison with the current brand kuru that [the opponent] is trying to protect and that it has no similarities.

First of all to start off with OKURU is a Japanese streetwear brand based in London focusing only on street style clothes inspired by Babe, Y3, Double Taps, and Mastermind Tokyo. The meaning behind OKURU means to send in Japanese which links back to the brand slogan (Without a message, There is no meaning). The kanji character at the end of the logo which is 送 in Chinese/Japanese characters means to send. OKURU is a brand that has a story to tell about Japanese history from printmaking to the Edo period through street style and design making it more modern in today's era.

I created the logo for this in 2020 and originally I purchased the font from [ER], an independent graphic and type designer, who invested in projects such as branding, print and the design of fonts. Showing the receipt date of purchase with the exact design font, I used the text OKURU that originates from my last name Okutu, to create the logo and link it back to the meaning behind my logo with the design front layout shows that it has no comparison visually and conceptually.

The logo OKURU can be viewed from both vertically and horizontally. This shows the link behind Japanese text writing from modern to a more older generation. The older generation reading text vertically starts from right to left and the modern generation reading from right to left horizontally.

.....

[The opponent's] lack of deductive skills and research shows how futile their response was towards the logo OKURU. Clearly explaining that just because of the letter o added it is similar to their brand kuru and an earlier trade mark. I have justified that this is a Japanese brand based in London targeted towards the Asian oriental streetwear fashion market. Therefore, when they see the logo or the kanji adjacent to the logo they instantly know what it means by having an idea that I am trying to send a message to them. Providing all the evidence above on purchase day of font, from the design of the font. The end of the kanji signifying "to send" in Japanese 送 along with the text logo

conjoint to it (OKURU) shows absolutely no comparison of their trade mark that they are defending. Not mentioning anything to do with the oriental culture in their statement, clearly shows that they did not do their research well and did not even look at the meaning behind OKURU or where it originated from.”

4. In these proceedings, the opponent is represented by Tierney IP; the applicants represent themselves.

5. 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.”

6. The net effect of these changes is to require parties to seek leave in order to file evidence in fast track oppositions. 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.

7. In an official letter dated 5 May 2021, the parties were allowed until 19 May 2021 to seek leave to file evidence and/or request a hearing and until 7 June 2021 to provide written submissions. Despite the Tribunal’s comments on the evidential nature of the information provided in earlier versions of their counterstatement, the applicants did not seek leave to file this information as evidence. Although neither party requested a hearing, the opponent elected to file written submissions. In reaching a conclusion, I will bear in mind the contents of the various pleadings and written submissions.

DECISION

8. The opposition is based upon section 5(2)(b) of the Act, which reads 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.

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.”

9. The trade mark upon which the opponent relies qualifies as an earlier trade mark under section 6 of the Act. As this earlier trade mark had not been protected for more than five years at the date the application was filed, it is not subject to the proof of use provisions contained in section 6A of the Act. The opponent is, as a consequence, entitled to rely upon the trade mark in relation to all of the goods and services indicated without having to prove that it has made genuine use of it.

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) – case law

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

The principles:

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

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

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

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

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

12. The competing goods and services are as follows:

The opponent's goods and services	The applicants' goods
<p>Class 10 - Medical apparatuses, namely, orthopedic footwear.</p> <p>Class 25 - Clothing, namely, beach clothes in the nature of shirts, hats, and footwear, beach shoes, boots, boots for sports, caps being headwear, footwear,</p>	<p>Clothing; Fashion hats; Headbands [clothing]; Heavy jackets; Hooded sweat shirts; Hooded sweatshirts; Hoodies; Hoods [clothing]; Jackets; Jackets [clothing]; Japanese traditional clothing; Jerseys; Jerseys [clothing]; Jumpers</p>

hats, inner soles, sandals, shirts, shoes, short-sleeve shirts, slippers, socks, soles for footwear, sports shoes.

Class 42 - Providing temporary use of non-downloadable computer e-commerce software to allow users to manage and conduct electronic business transactions; providing temporary use of non-downloadable computer database software featuring information in the field of clothing and footwear and other related products and information, including downloadable information.

[pullovers]; Jumpers [sweaters]; Ladies' clothing; Men's clothing; Neckwear; Outerwear; Ready-made clothing; Ready-to-wear clothing; Shoes for casual wear; Snowboard jackets; Stretch pants; Studs for football boots; Stuff jackets; Stuff jackets [clothing]; Sweat bands; Sweatpants; Trousers; T-shirts; Weatherproof clothing; Windproof jackets; Wind-resistant jackets; Wind-resistant vests; Wristbands; Belts [clothing]; Belts for clothing; Bomber jackets; Casual clothing; Casual footwear; Casual jackets; Casualwear; Clothes; Clothing; Ear muffs [clothing]; Fleece tops; Fleeces; Footwear; Gloves; Gloves [clothing]; Hats; Heavy coats; Heavy jackets; Hooded pullovers; Hooded sweat shirts; Hooded sweatshirts; Hooded tops; Hoodies; Jackets; Jackets being sports clothing; Jackets [clothing]; Jackets (Stuff -) [clothing]; Japanese kimonos; Japanese traditional clothing; Jeans; Jerseys; Jerseys [clothing]; Jogging pants; Jogging sets [clothing]; Jogging tops; Men's clothing; Menswear; Ladies' clothing; Ladies wear; Outerwear; Overshirts; Padded jackets; Pants; Rain jackets; Rain trousers; Rain wear; Rainproof clothing; Rainproof jackets; Reversible jackets; Scarfs; Shirts; Shoes; Short trousers; Shorts [clothing];

	Short-sleeve shirts; Short-sleeved T-shirts; Skating outfits; Ski balaclavas; Ski hats; Ski jackets; Ski wear; Sleeved jackets; Sleeveless jackets; Sleeveless jerseys; Thermal clothing; T-shirts; V-neck sweaters; Waistbands; Waterproof pants; Waterproof trousers; Wind resistant jackets; Wind-jackets; Windproof clothing; Windproof jackets; Wind-resistant jackets; Wrist warmers; Wristbands [clothing].
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13. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the Court stated at paragraph 23:

“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”.

14. 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.

15. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of ‘dessert sauce’ did not include jam, or because the ordinary and natural description of jam was not ‘a dessert sauce’. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

16. 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 General Court (“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”.

17. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the GC stated:

“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”.

18. In its Notice of opposition, the opponent states:

“4. It is observed that the Class 25 description of the [trade mark applied for] comprises many goods which are identical and/or similar to those of the earlier Trade Mark. By way of illustration, it is observed that the Class 25 description of the [trade mark applied for] includes ‘footwear’ which is also covered by the earlier Trade Mark. The nature, use, intended purpose and end user of the goods of the [trade mark applied for] are all the same as the goods of the earlier Trade Mark. While the goods of the earlier Trade Mark are qualified as being intended for use on the beach, this in no way lessens the identical and similar nature of the goods of the [trade mark applied for] with those of the earlier Trade Mark. Many of the goods of the [trade mark applied for] could be equally used in the same way as the goods of the earlier Trade Mark.” (my emphasis)

19. As the opponent adopts a similar approach in its written submissions filed in lieu, it is upon the opponent’s goods in class 25 that I shall conduct the comparison, only returning to the goods and services in classes 10 and 42 if it is necessary to do so.

20. Although the applicants may find it somewhat surprising, as the opponent’s trade mark is not subject to proof of use, the type of goods upon which it may actually be

used is not relevant. Similarly, I note that in their Notice of defence, the applicants explain that the clothing sold under their trade mark is “street style” clothing, “targeted towards the Asian oriental streetwear fashion market.”

21. However, with the exception of references to, “Japanese traditional clothing” and “Japanese kimonos”, the remaining goods in the application are not limited. In those circumstances, what I am required to do is compare the words as they appear in the competing specifications on a fair and notional basis, whilst bearing in mind the opponent’s submission to the effect that its goods in class 25 are “qualified as being intended for use on the beach.” The goods in the application are shown below in bold:

(i) “Clothing”, “ladies’ clothing”, “men’s clothing”, “outerwear”, “ready-made clothing”, “ready-to-wear clothing”, “casual clothing”, “casualwear”, “clothes”, “menswear” and “ladies wear”;

(ii) “Short-sleeve shirts”, “short-sleeved t-shirts” and “t-shirts”;

(iii) “Shoes”, “Shoes for casual wear”, “casual footwear” and “footwear”;

(iv) “Shirts” and “Overshirts”;

(v) “Fashion hats” and “hats”.

22. As all of the terms in categories (i) to (v) above are broad enough to include, for example (i) the “shirts” and “short-sleeve shirts”, (ii) “short-sleeve shirts”, (iii) “beach shoes”, (iv) “shirts” and, (v) “hats” in the opponent’s specification in class 25, the competing goods are to be regarded as identical on the principles outlined in *Meric*.

The remaining goods in the application

23. The remaining goods in the application are either general items of clothing such as jackets, sweatshirts, jerseys, sweatpants, jogging wear, trousers, jeans and

shorts, are neckwear (such as scarfs), accessories (such as gloves, belts, headbands, wristbands, sweatbands and ear muffs,) or are more specific items such as waterproof and windproof clothing, skating outfits, ski-wear, kimonos and traditional Japanese clothing. Given the opponent's view on how its specification in class 25 should be interpreted, these remaining goods in the application are not identical to the opponent's goods in class 25. However, when one considers the likely overlap in: (i) the users of the competing goods (see paragraph 25 below), (ii) the nature of the competing goods (i.e. what they are made of), (iii) their intended purpose, (iv) the manner in which they will be used and, (v) their respective trade channels, the competing goods are, in my view, to be regarded as being similar to at least a medium degree.

The average consumer and the nature of the purchasing process

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

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

25. The average consumer of the goods at issue in class 25 is a member of the general public. As a member of the general public will, for the most part, self-select such goods from the shelves of a bricks-and-mortar retail outlet or from the equivalent pages of a website or catalogue, visual considerations are likely to dominate the selection process. That said, as such goods may also be the subject

of, for example, word-of-mouth recommendations or oral requests to sales assistants (both in person and by telephone), aural considerations must not be forgotten.

26. When selecting the goods at issue, the average consumer will be alive to factors such as cost, size, colour, material and compatibility with other items. As a consequence, they can, in my view, be expected to pay at least a normal (medium) degree of attention to their selection.

Comparison of trade marks

27. 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 them, 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*:

“.....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.”

28. It would be wrong, therefore, artificially to dissect the trade marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions they create. The competing trade marks are as follows:

The opponent's trade mark	The applicants' trade mark
kuru	

29. The opponent's trade mark consists of the word "kuru" presented in lower case letters in a standard typeface. As no part of the trade mark is highlighted or emphasised in any way, the overall impression it conveys and its distinctiveness lies in the single word of which it is composed.

30. The applicants' trade mark consists of two components. The applicants describe the first component as "a Kanji character..." which "means to send." In my view only a very small minority of average consumers in this country are likely to be familiar with the meaning of the Kanji character; the vast majority are, in my view, much more likely to treat it as a Chinese/Japanese character with no meaning. However, whether the average consumer is familiar with the meaning or not, it is distinctive and despite its relative size in relation to the second component, will make a small contribution to the overall impression conveyed. Insofar as the second component is concerned, the applicants state:

"...I used the text OKURU that originates from my last name Okutu..."

31. Thus while the second component in the applicants' trade mark is stylised, the applicants specifically state that it is to be interpreted as the word "OKURU." While some average consumers may not interpret it in that way, I am satisfied that is the manner in which many average consumers will interpret it and, of course, will no doubt be the way it is promoted to the average consumer by the applicants. As a consequence, I shall, despite its stylisation, proceed on the basis that many average consumers will interpret the second component in the applicants' trade mark as the word "OKURU". Given its size in the context of the trade mark as a whole, it is this second distinctive component which will dominate the overall impression the applicants' trade mark conveys. I will bear the above conclusions in mind in the comparison which follows.

Visual similarity

32. The opponent's trade mark consists of a four letter word presented in lower case letters in a standard typeface. The Kanji character in the applicants' trade mark is alien to the opponent's trade mark. However, based upon, inter alia, my own findings and the applicants' analysis of the second component in their trade mark, many average consumers will, in effect, understand it as a five letter word consisting of the letter "O" followed by the stylised letters "K", "U", "R" and "U" i.e. the word "OKURU". Proceeding on that basis, although the first letter will differ, the competing trade marks share the letters "kuru"/"KURU" in the same order. Bearing that in mind, but taking into account, in particular, the stylisation present in the second component of the applicants' trade mark, results in what I consider to be a low degree of visual similarity between the competing trade marks.

Aural similarity

33. It is well-established that when a trade mark consists of a combination of words and figurative components (as the applicants' trade mark does), it is by the word component that it is most likely to be referred to. The opponent's trade mark consists of two syllables and is most likely to be articulated as "coo-rue". Proceeding on the basis indicated earlier, the applicant's trade mark is most likely to be pronounced as the three syllable combination "O-COO-RUE". Although the first syllable in the applicants' trade mark differs, as the remaining two syllables will be verbalised in an identical fashion to the whole of the opponent's trade mark, it results in a medium degree of aural similarity between them.

Conceptual similarity

34. Although the Kanji character in the applicants' trade mark is likely to evoke a concept alien to the opponent's trade mark (i.e. associations with China or Japan), as neither the opponent's trade mark or the word "OKURU" in the applicants' trade mark is likely to convey a concrete conceptual message to the average consumer, the conceptual position in that regard is neutral.

Distinctive character of the earlier trade mark

35. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

36. In its written submissions, the opponent states:

“5...It is submitted that the opponent’s trade mark is inherently distinctive and does not even suggest reference to the characteristics of the goods for which it is registered.”

37. I agree. As there is nothing to indicate that the opponent’s trade mark is either descriptive of or non-distinctive for the goods in class 25 upon which it is relying, the average consumer is likely to treat it as an invented word. Absent use, it is possessed of a high degree of inherent distinctive character.

Likelihood of confusion

38. In determining whether there is a likelihood of confusion, 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. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent’s trade mark as the more distinctive it is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and 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 he has retained in his mind.

39. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods down to the responsible undertakings being the same or related.

40. Earlier in this decision I concluded that where not identical, the competing goods are similar to at least a medium degree and that the opponent's earlier trade mark enjoys a high degree of inherent distinctive character. I further concluded that for many average consumers the competing trade marks are visually similar to a low degree, aurally similar to a medium degree and, with the exception of the Kanji character in the applicants' trade mark, conceptually neutral. Having reminded myself that the average consumer will select such goods by predominantly visual means whilst paying at least a medium degree of attention during that process (thus making him/her less prone to the effects of imperfect recollection), I am satisfied that, in particular, the significant visual differences between the competing trade marks are sufficient to rule out a likelihood of direct confusion.

41. That leaves indirect confusion to be considered. 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.”

42. In case T-129/01, *José Alejandro SL v OHIM*, the Court of First Instance (now the GC) stated:

“57. It is appropriate, however, to examine the objective conditions under which the marks may be in opposition on the market. It must be observed that it is common in the clothing sector for the same mark to be configured in various different ways according to the type of product which it designates. 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 his various lines from one another (women's, men's, youth). In such circumstances it is conceivable that the relevant public may regard the clothing designated by the conflicting marks as belonging, admittedly, to two distinct ranges of products but as coming, none the less, from the same undertaking (see, to this effect, *Fifties*, paragraph 49). Accordingly, the Board of Appeal was right to find that the public might believe that the products designated by the mark BUDMEN formed part of a new range of products and were marketed by the proprietor of the 'BUD' mark or by an economically-linked undertaking (paragraph 22 of the contested decision).”

43. While I must consider the competing trade marks as a whole, earlier in this decision I concluded that for many average consumers the second component in the applicants' trade mark will be understood as the word “OKURU”. In reaching a conclusion I must keep in mind the similarities between this second component and the opponent's trade mark, together with the identity/degree of similarity in the competing goods and the high degree of inherent distinctive character the opponent's trade mark enjoys. Having done so, and notwithstanding the at least medium degree of attention that will be paid by the average consumer during the purchasing process, I am satisfied that the combination of the factors mentioned above is likely to lead many average consumers to mistakenly assume that the

applicants' trade mark is a variant brand being used by the opponent, for example, given the presence in the applicants' trade mark of the Kanji character, to identify a range of goods of Chinese/Japanese origin or style. That, in my view, is likely to result in indirect confusion. As indirect confusion is sufficient, the opposition succeeds accordingly.

Overall conclusion

44. The opposition has succeeded and, subject to any successful appeal, the application will be refused.

Costs

45. As the opponent has been successful, it is entitled to an award of costs. Awards of costs in fast track opposition proceedings are governed by Tribunal Practice Notice ("TPN") 2 of 2015.

46. Applying the guidance in that TPN, I order Odimba Okutu and Christian Okutu (jointly) to pay to Nelwood Corp. the sum of **£500** made up as follows: £300 (including the official fee of £100) in respect of its filing of the Notice of opposition and considering the counterstatement and £200 in respect of its filing of written submissions. 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 this decision is unsuccessful.

Dated this 28th day of June 2021

C J BOWEN
For the Registrar