

O/921/21

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3480042
IN THE NAME OF SMALL SEEDS LLC
IN RESPECT OF THE TRADE MARK

CONCEPT 

IN CLASS 25

AND THE OPPOSITION THERETO UNDER NO. 420716
BY RIVER ISLAND CLOTHING CO. LIMITED

AND

IN THE MATTER OF REGISTRATION NO. 3211725
IN THE NAME OF RIVER ISLAND CLOTHING CO. LIMITED
IN RESPECT OF THE TRADE MARK

CONCEPT

IN CLASS 25

AND THE CONSOLIDATED INVALIDATION THERETO UNDER NO. 503694
BY SMALL SEEDS LLC

Background and pleadings



1. Small Seeds LLC

3480042 in the UK on 8 April 2020. The application claims priority from the earlier US trade mark registration no. 88681591 with a priority date of 6 November 2019. It was accepted and published in the Trade Marks Journal on 24 April 2020 in respect of the following goods:

Class 25: Clothing, namely, shirts, t-shirts, sweatshirts, pants, leggings, shorts, skirts, tunics, tank tops, dresses, sweaters, pullovers, tracksuits, scarves, jackets and coats, athletic tights, socks; footwear.

2. River Island Clothing Co. Limited (“River”) oppose the trade mark on the basis of section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition was filed on 22 July 2020. This is on the basis of its earlier UK Trade Mark registration no. 3211725 for the mark CONCEPT. All of the goods as registered are relied upon in this opposition, namely:

Class 25: Clothing; footwear; headgear; belts for wear; parts and fittings for all the aforesaid goods

3. By virtue of its earlier filing date of 9 February 2017, the above registration constitutes an earlier mark within the meaning of section 6 of the Act.
4. River argues that the respective goods are identical and similar and that the applied for mark is “...near identical to [its] earlier trade mark”.
5. Small filed a defence and counterstatement denying the claims made.
6. On 8 March 2021, Small filed an application to invalidate the earlier mark relied upon by River in the proceedings above. The application for invalidation was made on the basis of section 47(1) and sections 3(1)(b), 3(1)(c) and 3(1)(d) of the Act. Small pleads that the word concept means “*an abstract idea; an idea or invention to help sell or publicize a commodity*” and that use of the mark will convey to the consumer a direct message that the range of goods have a thought-out concept that will play a decisive role in the advertising of the goods.

It is argued that on this basis, the mark indicates the kind or intended purpose of the goods and that it should be refused under section 3(1)(c). Under section 3(1)(b), Small argues that as the mark has a clear descriptive meaning, it lacks distinctive character. Further, Small pleads that it will be viewed by the consumer as a laudatory slogan, also rendering it devoid of any distinctive character. Small submits the mark should therefore be refused protection under section 3(1)(b). Small also argues that CONCEPT has become customary in the established practice of the trade, with it being used to describe a shop that sells a curated selection of products that connect to an overarching theme. Small therefore submits that the earlier mark should be found invalid under section 3(1)(d) of the Act.

7. River filed a defence and counterstatement denying that its mark offends under section 3(1)(b), section 3(1)(c) or section 3(1)(d) of the Act.
8. On 11 May 2021, the Tribunal wrote to the parties to inform them of the joining of the opposition and the invalidation proceedings, including the consolidation of the evidence rounds.
9. Both parties filed evidence in these proceedings. This will be summarised to the extent that it is considered necessary. Both parties filed written submissions which will not be summarised but will be referred to as and where appropriate during this decision. No hearing was requested and so this decision is taken following a careful perusal of the papers.
10. Small is represented in these proceedings by Morgan, Lewis & Bockius UK LLP. River is represented by Stevens, Hewlett & Perkins.
11. 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

River's evidence in chief

12. River filed evidence its evidence in chief in the form of two witness statements.

The first witness statement was filed in the name of Benjamin Joseph Lewis, described as the Company Director and former CEO of River. The statement is dated 21 December 2020. The statement introduces 4 exhibits, namely Exhibit BJL1 to Exhibit BJL4.



14. Exhibit BJL2 is a printout of the Wikipedia page entry for River and includes reference to the CONCEPT MAN stores. Exhibit BJL3 is an extract from River's website which refers to the first CONCEPT MAN store being opened in 1982. In his witness statement, Mr Lewis states that over the last few years, CONCEPT has been reintroduced as a heritage sub-brand for a menswear collection. No exact dates are given for this reintroduction, but pages from River's website are provided at Exhibit BJL4. Mr Lewis states these pages are from 2020. They show River Island X Concept at the top of the page, and images show a range of men's clothing bearing the word 'CONCEPT' in various forms.

15. The second statement was filed in the name of Robin Webster, described as a qualified trade mark attorney employed by River's representative. The

statement introduces nine exhibits, namely RPW1 – RPW9. The statement is dated 12 July 2021.

¹ for the mark CONCEPT in class 25, both covering clothing goods. At paragraph 12, Mr Webster provides what he states is an extract the from the Manual of Trade Mark Practice (“the Manual”):²

12. Guidance from the UK IPO “Manual of Trade Marks Practice” with regard to the word CONCEPT and how the Office is to treat applications to register the same is set out clearly. This guidance is copied verbatim below:

• **CONCEPT**

The word CONCEPT is defined as “an idea, especially an abstract idea”. Although there are goods and services where the mark, on its own, or with other matter, may be regarded as being distinctive, a cautious approach is required. Objections under section 3(1)(b) & (c) should be raised in circumstances where the word is considered to be descriptive e.g.

CONCEPT OF BIOLOGY in Class 16.

CONCEPT in relation to modern construction, design, cars, music, fashion and art etc.

The word CONCEPT is also used in advertising to denote innovative and modern ideas such as DESIGN CONCEPT & FINANCIAL CONCEPT.

17. Exhibit RPW1 is a copy of the examination acceptance notice received from the UK Intellectual Property Office in relation to application no. 3624957 owned by River for the mark CONCEPT in class 25. Exhibit RPW2 is a copy of the dictionary definition of CONCEPT as set out on the webpage dictionary.com. Several definitions are provided including those described as British Dictionary Definitions. Exhibit RPW3 is the Wikipedia page entry for the word CONCEPT.

18. Exhibit RPW4 is an examination report from 2005 refusing the UK designation of a third party International Registration for SKIN CONCEPT, and Exhibit

¹ At the time the statement was written this was confirmed as one UK trade mark registration no. 1221950 with a filing date of 3 July 1984, and one UK trade mark application no. 3624957 with a filing date of 12 April 2021.

² Whilst I accept that the statement provided by River was taken from a ‘Manual of Trade Marks Practice’, it does not appear to be copied from the most recent manual available at <https://www.gov.uk/guidance/trade-marks-manual>.

RPW5 comprises register details for a third party UK trade mark registration for UNIVERSAL SKIN CONCEPT with a filing date of 24 October 2017, showing the status of the mark as registered. Exhibit RPW6 is a print out of the UK register showing the mark CONCEPT registered in various classes. Twenty 'CONCEPT' marks are shown on the 'shortlist' provided. Exhibit RPW7 is a print out of the EU Intellectual Property Office register showing a third party trade mark for CONCEPT, with a filing date in 2005, and a refusal date in 2006.

19. Exhibit RPW8 is the Wikipedia page entry for 'Retail format'. There is a paragraph shown on the 'Concept store'. Exhibit RPW9 is a screenshot from a webpage headed www.unibox.co.uk displaying an article dated 17 May 2017 explaining what is, and what makes, a successful concept store.

Small's evidence in chief

20. Small filed evidence in the form of a witness statement dated 12 July 2021 in the name of Nicholas Bolter, described as a Partner at Small's representative. The witness statement introduces four exhibits, namely Exhibit NB1 to Exhibit NB4. Exhibit NB1 provides dictionary definitions for CONCEPT from the Oxford Dictionary on Lexico.com. Exhibit NB2 includes several articles discussing concept stores. The articles define concept stores, discuss what makes a successful concept store, as well as recommend concept stores to the reader. The dates of the articles range from 28 July 2016 with an article entitled 'What is a Concept Store?' on insidertrends.com to pages with copyright notices of 2021. Whilst I have considered all of the articles provided, I do not find it necessary to provide a summary of each at this stage.

21. Exhibit NB3 is the same 2005 provisional refusal notice of the third party trade mark SKIN CONCEPT, as filed by River at RPW4. Exhibit NB4 is a decision from the EU Intellectual Property Office dated 20 October 2005 addressed to a third party and informing them of the absolute grounds refusal against the trade mark CONCEPT in classes 9, 16, 35, 38 & 42. The letter has been translated from German as is accompanied by a translation certificate.

Evidence in reply

22. Only River filed evidence in reply. This was filed in the form of a second witness statement in the name of Robin Webster, dated 29 September 2021. The statement introduces Exhibit RPW10 which provides an extract from the UK IPO register in respect of the UK application no. 3633762 for the mark CONCEPT STORE. The application covers various goods including clothing, and the status of the application shows as opposed.³ Mr Webster states this has been opposed by River.

Preliminary issues

23. The evidence filed by both parties makes reference to other marks, including third party marks, either for or including the word CONCEPT. This includes acceptance and refusal notices, as well as evidence on the state of the UK register showing the marks CONCEPT. I note at this stage that this decision will be considered on its own merits. Whether or not particular marks have previously been accepted or refused by either the UK or EU Intellectual Property Offices is not binding.⁴ For this reason I will not be drawn on the disagreement between the parties about what the acceptance or refusal of the previous marks shows about “Office Practice” in respect of the mark CONCEPT.

Decision

24. The success of the opposition filed by River is solely reliant upon the earlier registration no. 3211725, which is the subject of the invalidation action filed by Small. I will therefore begin by considering the application for invalidation against this mark. Should the invalidation succeed, the opposition based on this registration and filed against application no. 3480042 will fall away. Should the invalidation fail, I will continue to consider the merits of the opposition filed.

³ This application now shows as ‘withdrawn’ on the register.

⁴ See *Henkel KGaA v Deutsches Patent- und Markenamt*, Case C-218/01

Invalidation no. 503694

Section 3(1)(b), 3(1)(c) and 3(1)(d)

25. Before I begin my decision, I note that the above grounds are independent and have differing general interests. It is possible, for example, for a mark not to fall foul of section 3(1)(c), but still be objectionable under section 3(1)(b) of the Act: *SAT.1 SatellitenFernsehen GmbH v OHIM*, Case C-329/02 P at [25]. This is also true for the objection under section 3(1)(d).

Legislation

26. Section 47 of the Act reads as follows:

“47 Grounds for invalidity of registration.

- (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection 1(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

27. Section 3(1) of the Act reads as follows:

“3(1) The following shall not be registered –

- (a) signs which do not satisfy the requirements of section 1(1),
- (b) trade marks which are devoid of any distinctive character,

- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,
- (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

Average consumer

- 28. The position under 3(1)(b), 3(1)(c) and 3(1)(d) must be assessed from the perspective of the average consumer. The average consumer is deemed to be reasonably observant and circumspect: *Matratzen Concord AG v HuklaGermany SA*, Case C-421/04.
- 29. The average consumer of the registered goods will primarily be the general public. These goods will be purchased fairly frequently, but considerations will be made in respect of the aesthetics, practicalities, and suitability of the goods. I find the general public consumer will pay a medium degree of attention to the goods. There will also be a group of professional consumers such as those purchasing the goods to stock retail stores. Professional consumers will have a better understanding of the goods than the general public and will pay at least an above medium level of attention due to the increased responsibility of their position, in addition to the larger volumes that are likely to be purchased.

Relevant date

30. The position under section 3 of the Act is to be considered at the relevant date, namely the filing date of the registration of 9 February 2017. The distinctive character of the mark at that date may be assessed in respect of its inherent properties, or with reference to distinctiveness acquired through use at that date. However, if I find the mark to have been registered in breach of section 3(1)(b), 3(1)(c) or 3(1)(d), I may also consider if the registration has acquired distinctive character by virtue of the use made of it after that date, in accordance with section 47(1) of the Act.

The goods

31. All three section 3 grounds must be considered in the context of the goods registered. These are as follows:

Class 25: Clothing; footwear; headgear; belts for wear; parts and fittings for all the aforesaid goods

Section 3(1)(c)

32. I will begin with the examination of the trade mark under section 3(1)(c) of the Act.

General principles of section 3(1)(c)

33. The case law under section 3(1)(c) (corresponding to article 7(1)(c) of the EUTM Regulation, formerly article 7(1)(c) of the CTM Regulation) was set out by Arnold J. in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch) as follows:

“91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:

“33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40 , p. 1), see, by analogy, [2004] ECR I-1699 , paragraph 19; as regards Article 7 of Regulation No 40/94 , see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C-191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18 , paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461 , paragraph 24).

36. ... due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94 . Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, inter alia , *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44 , paragraph 45, and *Lego Juris v OHIM* (C-48/09 P) , paragraph 43).

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all

traders offering such goods or services (see, to that effect, *OHIM v Wrigley* , paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94 , it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie* , paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (*Joined Cases C-108/97 and C-109/97 Windsurfing Chiemsee [1999] ECR I-2779*, paragraph 35, and *Case C-363/99 Koninklijke KPN Nederland [2004] ECR I-1619*, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

And

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons

other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland* , paragraph 86, and *Campina Melkunie*, paragraph 19).

There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94 , the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56)."

92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97]."

34. In assessing the mark under section 3(1)(c), I keep in mind that the objective of this section of the Act is to ensure that signs designating a characteristic of the goods remain free for use by traders of those goods.

35. Small has pleaded under this ground as follows:

8. The Owner's mark is a word mark and consists only of the word CONCEPT meaning "*an abstract idea; an idea or invention to help sell or publicize a commodity*". As a result, the relevant English-speaking public would understand the term CONCEPT as a meaningful expression.
9. The Applicant submits that the message conveyed by the Owner's mark CONCEPT, is clear, direct and immediate to the relevant public as the average consumer will understand CONCEPT to denote that the clothing, footwear and headgear goods claimed in the Contested Registration have a corresponding, thought out 'concept' that plays a decisive role in the advertising of the goods.
10. Therefore, the sign CONCEPT describes the kind and/or intended purpose of the goods in question. As a result, the Contested Registration should be declared invalid under Article 3(1)(c) TMA.

36. I accept Small's submissions that the relevant consumer at the relevant date would have understood CONCEPT to mean an abstract idea. I also accept that in some contexts the word CONCEPT would have conveyed the meaning of an idea to help publicise a commodity. For example, I accept that a brand may wish to come up with an overarching 'concept' for their line of products to use as part of a promotional strategy. However, what is not clear from Small's pleadings, nor from the evidence filed, is how the word CONCEPT will directly convey to the consumer anything about the kind or the intended purpose of the particular goods for which the mark has been filed, as was pleaded by Small. Even if the relevant consumer at the relevant date considered that the mark conveyed the idea of the goods having a thought out 'concept', I find this to be vague and at best allusive and I do not find this would have directly informed the consumer of a characteristic of the goods within the meaning of section 3(1)(c).

37. I note Small elaborated on these arguments further within its final written submissions, stating "...the relevant English-speaking public would understand the term CONCEPT as a meaningful expression, namely that CONCEPT denotes a new or modern idea, and goods claimed in the Contested Registration are new or novel clothing, footwear and headgear goods." Setting aside that this position was arguably not fully pleaded by Small from the outset, in any case I find this to be fanciful. I find it very unlikely the consumer would have believed at the relevant date that the mark CONCEPT, used in relation to the particular goods, described that the actual kind of goods being offered were

new or novel. I accept there is a possibility that the mark will have alluded to the idea of newness or modernity, but I do not believe it would have been viewed as a direct description of a characteristic of the goods. Rather, it is my view that at most this would allude to the idea that goods offered may be intended to be modern in design or ahead of the trends, but that a direct meaning in relation to the goods is impenetrable. I do not find this to directly depict a characteristic of the goods under section 3(1)(c).

38. I consider the general objective under this ground is to keep words that are descriptive of the goods free for use by other traders. However, I do not consider that the word CONCEPT was descriptive of the goods at the relevant date, and I do not find that the inherent characteristic of the mark mean it will need to remain free for other traders to use descriptively in future. I therefore find the opposition under section 3(1)(c) fails.

Section 3(1)(b)

General Principles of Section 3(1)(b)

39. The principles to be applied under article 7(1)(b) of the CTM Regulation (which is now article 7(1)(b) of the EUTM Regulation, and is identical to article 3(1)(b) of the Trade Marks Directive and s.3(1)(b) of the Act) were conveniently summarised by the CJEU in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* (C-265/09 P) as follows:

“29..... the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 32).

30. Under that provision, marks which are devoid of any distinctive character are not to be registered.

31. According to settled case-law, for a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (*Henkel v OHIM*, paragraph 34; Case C-304/06 P *Eurohypo v OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi v OHIM* [2010] ECR I-0000, paragraph 33).

32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public (*Storck v OHIM*, paragraph 25; *Henkel v OHIM*, paragraph 35; and *Eurohypo v OHIM*, paragraph 67). Furthermore, the Court has held, as OHIM points out in its appeal, that that method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per se, three-dimensional marks and slogans (see, to that effect, respectively, Case C-447/02 P *KWS Saat v OHIM* [2004] ECR I-10107, paragraph 78; *Storck v OHIM*, paragraph 26; and *Audi v OHIM*, paragraphs 35 and 36).

33. However, while the criteria for the assessment of distinctive character are the same for different categories of marks, it may be that, for the purposes of applying those criteria, the relevant public's perception is not necessarily the same in relation to each of those categories and it could therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories (see Joined Cases C-473/01 P and C-474/01 P *Proctor & Gamble v OHIM* [2004] ECR I-5173, paragraph 36; Case C-64/02 P *OHIM v Erpo Möbelwerk* [2004] ECR I-10031, paragraph 34; *Henkel v OHIM*, paragraphs 36 and 38; and *Audi v OHIM*, paragraph 37).

40. The objective of section 3(1)(b) is to prevent marks that are incapable of serving to identify goods or services derived from a single origin from being registered as trade marks.

41. Firstly, Small has pleaded the registration should be deemed invalid under section 3(1)(b) on the basis that the mark is descriptive of the goods. As I have not found the mark to be descriptive in my analysis of section 3(1)(c), I do not need to consider this any further.

42. Small has also pleaded under this ground as follows:

13. The CONCEPT mark will be seen by the relevant public as a simple laudatory slogan, the function of which is to communicate a customer service statement. The relevant public would not tend to perceive any indication of commercial origin in CONCEPT beyond the promotional information conveyed. The existence of slogans of a single word was confirmed by the General Court in Case T-654/14, *Revolution LLC v EUIPO* ("REVOLUTION").

43. It is my view that this is a separate pleading to that made under section 3(1)(c), namely that the mark CONCEPT conveys to the consumer a customer service statement, rather than depicting a characteristic of the goods themselves. I will therefore consider Small's case under section 3(1)(b) on this basis.

44. I accept Small's position that a single word may in some instances be capable of constituting a slogan. Whilst I note that neither the pleadings nor submissions made by Small under its section 3(1)(b) ground provide a detailed explanation as to the customer service statement that will be conveyed by the use of the word concept, I note Small has, within its pleadings, claimed that this position is supported by the UK IPO's position, stating as follows:

15. The Applicant's position is supported by previous decisions of the UKIPO finding signs similar or identical to the Owner's mark CONCEPT ineligible for registration under Section 3(1)(b) TMA. By way of example, the Applicant draws the attention of the Office to the following:

15.1 International Registration no. 852448, the UKIPO refused registration of the mark SKIN CONCEPT in Classes 3 and 5 pursuant to Section 3(1)(b) and 3(1)(c) of the Trade Marks Act 1994, stating *"Practice on the word CONCEPT has varied somewhat over the years. It is now widely used in advertising to denote a new or modern idea and is generally considered to be devoid of any distinctive character. Consequently, prima facie objections under Section 3(1)(b) and (c) should be taken to CONCEPT alone or as part of a meaningful whole, eg COMPUTER CONCEPT or MARKETING CONCEPT.*

45. As I have mentioned within the preliminary issues, this matter is to be decided on its own merits, and so I am not concerned with whether or not practice on the word CONCEPT has changed over the years, or even how CONCEPT is 'generally' viewed by the UK IPO during the examination of new applications. In any event I note that the comments made within the refusal notice concerning SKIN CONCEPT dates back to 2005, and so they would not necessarily be representative of the position of the UK IPO at the relevant date. However, I do consider this reference by Small to be expressing that the comments made within this notice are representative of its position within its pleadings under this ground, namely that the word CONCEPT is commonly used in advertising to denote a new or modern idea, and that as such, it should be considered as devoid of distinctive character.

46. I have already accepted under section 3(1)(c) that the relevant consumer will understand the word CONCEPT to mean an abstract idea, or in some circumstances, an idea to publicise a commodity, and I believe this would have been true at the relevant date. I have accepted under section 3(1)(c) that the word CONCEPT may allude to the idea that goods offered are intended to be modern in design or ahead of the trends. I accept therefore that there is a real possibility that the consumer would have, at the relevant date, understood the word CONCEPT to have positive connotations in relation to the goods as filed, and that, in respect of the relevant class 25 goods, the word CONCEPT may have alluded to or been associated with modernity or innovation by relevant consumer.

47. With this in mind, I also consider the comments made by the CJEU in *Audi AG v OHIM*, Case C-398/08 P below:

45. On that point, it should be noted that the laudatory connotation of a word mark does not mean that it cannot be appropriate for the purposes of guaranteeing to consumers the origin of the goods or services which it covers. Thus, such a mark can be perceived by the relevant public both as a promotional formula and as an indication of the commercial origin of goods or services. It follows that, in so far as the public perceives the mark as an indication of that origin, the fact that the mark is at the same time understood – perhaps even primarily understood – as a promotional formula has no bearing on its distinctive character.

48. I consider therefore, Small’s case under section 3(1)(b) rests on whether the consumer would have, at the relevant date, viewed the mark CONCEPT in relation to the goods simply as a laudatory slogan or service statement as pleaded, or whether the mark, whilst having positive connotations in respect of the goods, is also capable of acting as an indication of origin.

49. With consideration to all of the factors above, it is my view that the mark CONCEPT in respect of these goods will be considered as an indication of origin, at the same time as for some consumers alluding to the goods offered being modern or innovative. Whilst I therefore do not consider the mark CONCEPT to hold a high level of distinctive character in respect of the goods, I do not find that it is devoid of distinctiveness entirely. With consideration to the general objective of this ground, namely, to prevent marks that are incapable of acting as an indication of origin from achieving registrations, I find that the invalidation based on section 3(1)(b) fails.

Section 3(1)(d)

General Principles of Section 3(1)(d)

50. In *Telefon & Buch Verlagsgesellschaft GmbH v OHIM*, Case T-322/03, the General Court (“GC”) summarised the case law of the Court of Justice under the equivalent of s.3(1)(d) of the Act, as follows:

“49. Article 7(1)(d) of Regulation No 40/94 must be interpreted as precluding registration of a trade mark only where the signs or indications of which the mark is exclusively composed have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought (see, by analogy, Case C-517/99 *Merz & Krell* [2001] ECR I-6959, paragraph 31, and Case T-237/01 *Alcon v OHIM – Dr. Robert Winzer Pharma* (BSS) [2003] ECR II-411, paragraph 37). Accordingly, whether a mark is customary can only be assessed, firstly, by reference to the goods or services in respect of which registration is sought, even though the provision in question does not explicitly refer to those goods or services, and, secondly, on the basis of the target public’s perception of the mark (*BSS*, paragraph 37).

50. With regard to the target public, the question whether a sign is customary must be assessed by taking account of the expectations which the average consumer, who is deemed to be reasonably well informed and reasonably observant and circumspect, is presumed to have in respect of the type of goods in question (*BSS*, paragraph 38).

51. Furthermore, although there is a clear overlap between the scope of Article 7(1)(c) and Article 7(1)(d) of Regulation No 40/94, marks covered by Article 7(1)(d) are excluded from registration not on the basis that they are descriptive, but on the basis of current usage in trade sectors covering trade in the goods or services for which the marks are sought to be registered (see, by analogy, *Merz & Krell*, paragraph 35, and *BSS*, paragraph 39).

52. Finally, signs or indications constituting a trade mark which have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services covered by that mark are not capable of distinguishing the goods or services of one undertaking from those of other undertakings and do not

therefore fulfil the essential function of a trade mark (see, by analogy, *Merz & Krell*, paragraph 37, and *BSS*, paragraph 40).”

51. In view of the case law above, under section 3(1)(d) I am to consider if, on the relevant date, the relevant consumer of the goods would have considered it customary in the course of trade for the contested registration to be used to designate the goods for which the mark has been filed.

52. Under this ground, Small pleads:

19. Further, the Applicant submits that the sign CONCEPT has become customary in the established practices of the clothing trade, namely being used to describe a shop that sells a carefully curated and unique selection of products that connect to an overarching theme. The Applicant reserves the right to file any evidence in support of such claim.
20. Therefore, the Contested Registration should be declared invalid under Section 3(1)(d) TMA.

53. I find I am able to deal with this ground fairly swiftly. Both Small’s pleadings and evidence, including the article provided at Exhibit NB2 dated prior to the relevant date (and those filed from after the relevant date) relate to the use of the mark CONCEPT or CONCEPT STORE in respect to retail services, which do not form part of the challenged specification. There is no evidence showing the use of the mark by the trade to designate the goods themselves. As I have no evidence showing use of the mark CONCEPT to designate the goods as registered, I cannot find that the evidence shows that the relevant consumer, including the relevant professional consumer, would have, at the relevant date, considered it customary in the course of trade to use the sign CONCEPT to designate the goods. The opposition under section 3(1)(d) fails.

54. The application for invalidation against registration no. 3211725 has failed. As I have found the invalidation fails based on the inherent characteristic of the mark in respect of section 3(1)(b), 3(1)(c) and 3(1)(d), there is no need for the opponent to show it has acquired distinctive character through use of its mark. In addition, it does not appear that acquired distinctiveness has been pleaded by the opponent. However, as the opponent has filed evidence of the use of its mark within these joint proceedings, for completeness I will consider if I would

have found there to be acquired distinctiveness had I not found the mark to be inherently distinctive. I note that the evidence filed shows use of the mark CONCEPT MAN for menswear ceased in 1994 at the latest. There is little to suggest that the use of the mark CONCEPT in any form and in respect of the goods had resumed prior to the relevant date, other than a vague reference in the witness statement of Mr Lewis that it resumed "...in the last few years...". Even if this was prior to the relevant date, the extent of this use is not clear. There is little to suggest that, even if I were to find the mark (or a variant of such), had acquired a level of distinctive character by 1994 for the goods, that it would have stayed in the UK public's consciousness in such a way that a significant portion of the relevant public would have considered the goods designated by the mark to have originated from a particular undertaking at the relevant date. Further, the very limited evidence of the use resuming by the date the application for invalidation was filed, namely the screenshots of River's website confirmed by Mr Lewis as being from 2020, are not sufficient to find the mark will have acquired distinctive character after the relevant date. Had I not found the mark to be inherently distinctive, I would not have found it to have acquired distinctive character at the relevant date.

55. I will move on to consider the opposition relying on this earlier mark.

Opposition no. 420716

Section 5(2)(b)

56. 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”.

57. 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.”

Proof of Use

58. As the earlier mark had not yet been registered for a period of five years at the date on which the application was filed, the earlier mark is not yet subject to proof of use requirements under section 6A of the Act.

The principles

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

The principles

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must

instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

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

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

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

60. 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 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”.

61. With this in mind, the goods and services for comparison are below:

Earlier goods	Contested goods
Class 25: Clothing; footwear; headgear; belts for wear; parts and fittings for all the aforesaid goods.	Clothing, namely, shirts, t-shirts, sweatshirts, pants, leggings, shorts, skirts, tunics, tank tops, dresses, sweaters, pullovers, tracksuits, scarves, jackets and coats, athletic tights, socks; footwear.

62. All of the contested goods are identical to either *clothing* or *footwear* as included in the specification of the earlier mark, either self-evidently or in line with the principles as set out in *Meric*.


Comparison of marks

63. 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 Court of Justice of the European Union 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.”

64. It would be wrong, therefore, to dissect the trade marks artificially, 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.

65. The respective trade marks are shown below:

Earlier trade mark	Contested trade mark
CONCEPT	CONCEPT 

66. The earlier mark is the single word CONCEPT. The overall impression resides in the mark as a whole.

67. The contested mark is made up of the word CONCEPT in a simple slim font, with the additional device element. The parties refer to the additional device element as being the number ‘3’, and I accept it will be viewed as such by consumers. The most dominant and distinctive element of the mark is the word

CONCEPT. Whilst I note the '3' element is larger in size, it falls after the word, and it is the word element to which the consumers eye will primarily be drawn. However, the '3' is not negligible, and it still plays a part in the overall impression of the mark. The basic slim font is fairly unremarkable and adds very little to the overall impression of the mark.

Visual comparison

68. Visually, the marks coincide through the use of the word CONCEPT. The earlier mark is filed as a word mark as so it can be used in a range of standard fonts, meaning the font used by the contested mark does very little if anything to differentiate the marks visually. However, the marks differ visually through the use of the stylised '3'. Overall, I find the marks to be visually similar to a high degree.

Aural comparison

69. Aurally, the marks both begin with the same two syllable word CONCEPT, pronounced as CON-SEPT. I find the device element will be pronounced as the number 'three' in the contested mark, meaning the marks will differ aurally by way of the final syllable. The aural similarities are positioned at the beginning of the mark where they will be most noticeable, and overall I find the marks to be aurally similar to between a medium and high degree.

Conceptual comparison

70. Conceptually, the marks coincide through the meaning of the word CONCEPT, namely an abstract idea. This element of both marks may also allude to the idea of modernity and innovation. The second element of the contested mark, namely the number three, will not add greatly to the conceptual meaning of the mark, although in the context of the goods I find it likely this will be considered indicative of a particular edition or line of the goods. Overall, through the shared meaning of CONCEPT, I find the marks to be conceptually similar to a high degree.

Average consumer and the purchasing act

71. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

72. 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.”

73. All of the goods will be aimed at members of the general public, although I note there will also be a particular group of professional consumers, for example those owning a retail business or those responsible for stocking retail stores for example. All of the categories of goods will include those at the lower end of the scale price wise and those at the higher end. Whilst the prices may therefore vary considerably, I do not find this will increase the level of attention paid towards each category of goods overall. I find there will be considerations made as to the quality, aesthetics, practicality and usability of each of the categories of goods. Overall I find the level attention paid by the general public towards the categories of goods will be medium. In respect of the professional public, the increased responsibility and liability that comes with stocking a retail business and ensuring its success, in addition to the higher volumes of goods

that will be purchased means that the level of attention paid to the goods for these professionals will be at least above medium.

74. The goods covered by the marks will be primarily purchased visually, either via physical or online retail stores. However, I note the possibility for word of mouth recommendations, verbal assistance from retail staff, or in the case of the professional consumer, the possibility that orders may be placed over the phone. I cannot therefore completely discount the aural considerations.

Distinctive character of the earlier trade mark

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

76. The earlier mark is a simple English word meaning an abstract idea. In the context of the goods, it alludes to the idea of modernity or of innovation. Overall, I find the earlier mark to hold an inherently low level of distinctiveness.
77. River has filed evidence of use of its earlier mark. I note that the evidence shows use of the mark CONCEPT MAN rather than CONCEPT alone, however, I accept that it is arguable CONCEPT maintains its role as an indication of origin in the marks in relation to menswear.⁵ I note the fact that the use shown in the evidence appears to be primarily in relation to retail services. I consider Mr Lewis' statement that CONCEPT MAN was created with the intention of selling menswear,⁶ but I note I have not been provided with evidence of the mark on the goods themselves. I also consider that the use shown dates back to the 80s, although the last stores selling the goods closed in approximately 1993-1994, and there is no evidence that the CONCEPT MAN goods continued to be sold after that time, until the more recent resumption of the use of CONCEPT by River. Whilst I accept that the presence of the CONCEPT MAN stores was considerable in the UK, with the existence of approximately 100 stores confirmed by Mr Lewis in his witness statement, I have not been provided with any turnover figures for the sale of goods under the mark, nor have I been provided with any indication of the market share held at the time. I can only assume that the size of the UK market for the goods at the time was very large. In respect of the recent use, I consider Mr Lewis' statement that CONCEPT was reintroduced "...in the last few years..." and but there is little indication of exactly when this was introduced or to what extent this has been used prior to the relevant date. I have some evidence of use on River's website from 2020, but I have no figures relating to sales, turnover or advertising spend. In the years between the mark CONCEPT MAN being present on the UK high street and the mark CONCEPT being reintroduced for menswear, there appears to have been no more than a trivial effort to keep this in the consciousness of the UK consumer by way of the mention of it on River's website in the history section, and there is exceptionally limited evidence that it has been referred to or publicised by third parties, although I note its reference on the Wikipedia

⁵ See *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12

⁶ See paragraphs 5 & 6 of the witness statement of Benjamin Joseph Lewis

page provided. Overall, I do not find the evidence shows that the distinctive character of the mark has been enhanced to above its inherent level.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion

78. Prior to reaching a decision under Section 5(2)(b), I must first consider all relevant factors, including those as set out within the principles A-K at paragraph 59 of this decision. I must view the likelihood of confusion through the eyes of the average consumer, 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 they have kept in their mind. I must consider the level of attention paid by the average consumer, and consider the impact of the visual, aural and conceptual similarities of the marks by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. I must consider that the level of distinctive character held by the earlier mark will have an impact on the likelihood of confusion. I must consider that the likelihood of confusion may be increased where the distinctive character held by the earlier mark is high and may be less likely where it is low. I must remember that the distinctive character of the earlier mark may be inherent, but that it may also be increased through use, and that the distinctiveness of the common elements is key.⁷ I must keep in mind that a lesser degree of similarity between the goods and services may be offset by a greater degree of similarity between the marks, and vice versa. I must also consider that both the degree of attention paid by the average consumer and how the goods or services are obtained will have a bearing on how likely the average consumer is to be confused.

⁷ See *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, in which Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar.

79. I consider at this point that there are two types of confusion that I may find. The first type of confusion is direct confusion. This occurs where the average consumer mistakenly confuses one trade mark for another. The second is indirect confusion. This occurs where the average consumer notices the differences between the marks, but due to the similarities between the common elements, they believe that both products derive from the same or economically linked undertakings.⁸

80. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C. (as he then was), as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

81. I found the earlier mark to be distinctive to a low degree. Nonetheless, the shared element, namely CONCEPT is the entirety of the earlier mark, and I found this to be the most dominant and distinctive element of the contested mark. I found the marks to be visually similar to a high degree, and to be aurally similar to between a medium and high degree. I also found there would be a high degree of conceptual similarity. I found the average consumers being members of the general public would pay a medium level of attention towards the goods, and the professional consumer would pay at least an above medium level of attention. I found the goods will primarily be purchased visually, but that I cannot completely ignore the aural comparison.

82. Considering all of the relevant factors, and with consideration to the identity between the goods in addition to the minimum of a medium degree of attention that would be paid towards the same, it is my view that the differences between the mark, namely the large three element, are too great to be forgotten or misremembered by the consumer. For this reason, I do not find there will be a likelihood of direct confusion.

⁸ *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10

83. In respect of indirect confusion, Mr Ian Purvis Q.C. in *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10 set out some of the scenarios in which a likelihood of indirect confusion may apply. He stated:

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

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

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

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

84. I also note that these categories were not intended to be exhaustive, and so there is no requirement for the marks I am considering to be an exact fit in one of these categories in order for a likelihood of confusion to be found. I consider in this case, that the number ‘3’ alone is the only significant difference between the marks, which are joined by way of the most dominant element of the contested mark, which comprises the earlier mark in its entirety. I keep in mind that the distinctive character of the earlier mark and the common element CONCEPT is at the lower end of the scale, but I note also that the ‘3’ device alone holds, at best, a very low level of distinctive character in respect of the

same. I consider that sub brands are common in the clothing and footwear sector, and it is my view the consumer will be accustomed to the same. In light of my previous finding I consider that the number three may indicate to the consumer a particular line of goods, for example, the third edition of a particular product, particularly where the goods are identical. With consideration to all of the relevant factors in this case, it is my view that the consumer is very likely to view the use of this shared element CONCEPT in respect of the identical goods as an indicator that the marks derive from the same economic undertaking, and that the later mark indicates a later edition of the goods themselves. I therefore find there will be a likelihood of indirect confusion in respect of all of the goods as filed.

Final Remarks

85. The invalidation action has failed in its entirety. The opposition has succeeded in its entirety. Subject to any successful appeal, registration no. 3211725 will remain on the register for all goods, and application no. 3480042 will be refused in its entirety.

COSTS

86. River has been successful in both the opposition and the invalidation and is entitled to a contribution towards its costs in accordance with the standard scale as set out in Tribunal Practice Note 2 of 2016. Applying this guidance the sum is calculated as follows:

Prior to consolidation

Opposition

Official fee	£100
Preparing and filing the TM7 and considering the counterstatement	£300

Invalidation

Considering the TM26(i) and preparing and filing the counterstatement	£400
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Post consolidation

Preparing and filing the evidence and considering the other sides evidence	£650
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Preparing and filing the written submissions in lieu	£300
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Total	£1750
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I therefore order Small Seeds LLC to pay River Island Clothing Co. Limited the sum of £1750. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 17th day of December 2021

Rosie Le Breton

For the Registrar