

O/059/21

**TRADE MARKS ACT 1994**

**IN THE MATTER OF:**  
**TRADE MARK APPLICATION NO. 3438471**  
**BY QING QIN AND ZHENGNI CHEN TO REGISTER**

**WELEVEN11**

**IN CLASS 25**

**AND**

**IN THE MATTER OF OPPOSITION THERETO**  
**UNDER NO. 419367**  
**BY ELEVENTY WORLD S.R.L**

## BACKGROUND AND PLEADINGS

1. Qing Qin and Zhengni Chen ('the applicants') applied to register the trade mark **WELEVENII** in the UK on 22 October 2019. It was accepted and published in the Trade Marks Journal on 8 November 2019 in respect of the following goods:

**Class 25:** Babies' clothing; Bathing costumes; Beach clothes; Beach clothing; Beach hats; Beachwear; Belts [clothing]; Belts for clothing; Bikinis; Blouses; Body suits; Bodysuits; Bomber jackets; Capes; Children's clothing; Clothing; Clothing made of fur; Clothing of leather; Denims [clothing]; Dresses; Hats; Hoodies; Infant clothing; Jackets; Jeans; Knitted clothing; Knitwear; Ladies' clothing; Ladies wear; Leather (Clothing of -); Lingerie; Men's clothing; Menswear; Pants; Pyjamas; Shoes; Shorts; Sleepwear; Socks; Sweatshirts; Swimwear; Trousers; T-shirts; Vests.

2. On 7 February 2020, ELEVENTY WORLD S.R.L ('the opponent') opposed the trade mark on the basis of section 5(2)(b) of the Trade Marks Act 1994 ('the Act'). This is on the basis of its earlier trade marks listed in the table below<sup>1</sup> and the opposition is directed against all goods in the application. The details of the earlier marks and the goods relied upon are as follows:

<b>First Earlier Trade Mark</b>	International Registration ('IR') no. 1150280 for ELEVENTY designating the European Union ('EU') <sup>2</sup>
<b>Goods relied upon</b>	<b>Class 25: Clothing, footwear, headgear, included in this class.</b>
<b>Relevant dates</b>	<b>Date of EU designation:</b> 07 March 2013 <b>Date protection granted in the EU:</b> 15 November 2020

<sup>1</sup>For the avoidance of doubt, given the dates of its filing, these marks qualify as an 'earlier mark' in accordance with section 6 of the Act.

<sup>2</sup> Although the UK has left the EU and the transition period has now expired, EUTMs, and International Marks which have designated the EU for protection, are still relevant in these proceedings given the impact of the transitional provisions of The Trade Marks (Amendment etc.) (EU Exit) Regulations 2019 – please see Tribunal Practice Notice 2/200 for further information.

<b>Second Earlier Trade Mark</b>	 IR no. 1410789 for designating the EU
<b>Goods relied upon</b>	<p><b>Class 25:</b> Waterproof clothing; clothing of imitations of leather; clothing of leather; motorists' clothing; cyclists' clothing; clothing for gymnastics; dresses; suits; jumper dresses; bath robes; non-slipping devices for footwear; clothing; bandanas [neckerchiefs]; caps [headwear]; berets; underwear; bibs, not of paper; sweat-absorbent underwear; boas [necklets]; braces for clothing [suspenders]; galoshes; skull caps; footwear; boots for sports; stockings; sweat-absorbent stockings; socks; sweat-absorbent socks; breeches for wear; bathing trunks; albs; shirts; short-sleeve shirts; bodices [lingerie]; sports singlets; hats; top hats; paper hats [clothing]; coats; hoods[clothing]; hat frames [skeletons]; chasubles; belts[clothing]; money belts [clothing]; tights; collars[clothing]; detachable collars; camisoles; headgear forwear; layettes [clothing]; corselets; bathing suits; masquerade costumes; beach clothes; neckties; ascots; bathing caps; shower caps; panties; headbands [clothing]; pocket squares; fittings of metal for footwear; ready-madelinings [parts of clothing]; scarfs; gabardines [clothing]; boot uppers; gaiters; jackets [clothing]; garters; fishingvests; gilet; stuff jackets [clothing]; skirts; overalls; aprons [clothing]; girdles; gloves [clothing]; mittens; skigloves; welts for footwear; ready-made clothing; paperclothing; knitwear [clothing]; jerseys [clothing]; leggings[leg warmers]; leggings [trousers]; liveries; hosiery; sports jerseys; sweaters; muffs [clothing]; maniples; pelerines; mantillas; sleep masks; skorts; miters [hats]; boxer shorts; babies' pants [underwear]; underpants; wetsuits for water-skiing; vests; trousers; slippers; ear muffs[clothing]; parkas; pelisses; furs [clothing]; shirt yokes; pajamas (Am.); cuffs; ponchos; tips for footwear; stockingsuspenders; sock suspenders; brassieres; heelpieces</p>

	<i>for stockings; sandals; bath sandals; saris; sarongs; neckscarfs [mufflers]; footmuffs, not electrically heated; shoes; esparto shoes or sandals; bath slippers; gymnasticshoes; beach shoes; football boots; sports shoes; ski boots; shawls; sashes for wear; wimples; inner soles; overcoats; outerclothing; dress shields; petticoats; trouser straps; chemises; shirt fronts; half-boots; lace boots; boots; furstoles; soles for footwear; studs for football boots; heels; heelpieces for footwear; pockets for clothing; tee-shirts; togas; footwear uppers; ankle boots; turbans; combinations[clothing]; uniforms; valenki [felited boots]; veils[clothing]; dressing gowns; visors [headwear]; cap peaks; wooden shoes; bow ties; flip-flops [footwear]; blousons; Bermuda shorts; polo shirts; espadrilles.</i>
<b>Relevant dates</b>	<b>Date of EU designation:</b> 15 November 2018 <b>Date protection granted in the EU:</b> 07 December 2018

3. The opponent argues that the respective goods are identical and similar and that the marks are highly similar. Whilst the opponent stated in its statement of grounds that a detailed comparison of the goods would be provided, no submissions were filed. The opponent requests the contested mark is refused in its entirety and that an award of costs is made in their favour.
4. The applicants filed a counterstatement denying the claims made, particularly emphasising the additional and differing elements in the later mark besides the common element ‘ELEVEN’. The applicants also submitted that the marks have “*particularly distinctive visual, aural and conceptual characters*”.
5. Neither side filed evidence or written submissions. Since no hearing was requested, this decision is taken following a careful perusal of the papers.
6. The opponent is professionally represented by Boult Wade Tennant LLP and the applicants are self-represented, with the Form TM8 signed by Qing Qin.

7. Although the UK has left the EU, section 6(3)(a) of the European (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 Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

## **PRELIMINARY ISSUES**

### *Proof of Use*

8. The opponent initially based its opposition on three earlier marks and the applicants requested proof of use against all three. The Tribunal confirmed that only one of the opponent's earlier marks was subject to the proof of use requirements (as per section 6A of the Act) and the applicants amended their Form TM8 accordingly. The opponent later withdrew its reliance on the earlier mark subject to proof of use from the proceedings and thereby amended its Form TM7.
9. In view of the above, my decision proceeds on the basis that proof of use is not relevant in these proceedings.

### *State of the register*

10. In its counterstatement, the applicants submit that the word 'ELEVEN' was neither created nor owned exclusively by the opponent. The applicants also submit there are several marks already on the register including 'ELEVEN'.
11. Whilst I note the points raised, it is not entirely clear what the applicants are asking the Tribunal to take from this. If it is that the average consumer has become accustomed to such marks in the marketplace, which therefore lessens the likelihood of confusion, I bear in mind the decision in *Zero Industry Srl v Office for Harmonisation in the Internal Market* (Trade Marks and Designs) ('OHIM'), Case T400/06 where the General Court stated that:

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

12. Given the above, state of the register evidence is not relevant without accompanying use in the marketplace. In terms of the exclusivity argument, this is similarly not relevant as the test in play is simply whether the average consumer is going to be confused. Though, I keep in mind that the distinctiveness of the earlier mark (particularly of the common element) is an important factor, of which I return to later.

## **DECISION**

### **Section 5(2)(b)**

13. 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”.*

14. The opponent has based their opposition on two earlier marks. I will begin my assessment by considering the opponent's first earlier mark (IR no. 1150280 for ELEVNTY) before analysing the merits of the second mark they relied upon.

15. 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 Klijzen 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**

16. In *Gérard Meric v OHIM*, Case T- 133/05, the General Court 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 fur 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".*

17. The goods for comparison are as follows:

<b>Opponent's goods</b>	<b>Class 25: Clothing, footwear, headgear, included in this class</b>
<b>Applicants' goods</b>	<b>Class 25: Babies' clothing; Bathing costumes; Beach clothes; Beach clothing; Beach hats; Beachwear; Belts [clothing]; Belts for clothing; Bikinis; Blouses; Body suits; Bodysuits; Bomber jackets; Capes; Children's clothing; Clothing; Clothing made of fur; Clothing of leather; Denims [clothing]; Dresses; Hats; Hoodies; Infant clothing; Jackets; Jeans; Knitted clothing; Knitwear; Ladies' clothing; Ladies wear; Leather (Clothing of - ); Lingerie; Men's clothing; Menswear; Pants; Pyjamas; Shoes; Shorts; Sleepwear; Socks; Sweatshirts; Swimwear; Trousers; T-shirts; Vests.</b>

18. The earlier mark covers the broad terms clothing, footwear and headgear. All the items in the applied for specification are either items of clothing, footwear or headgear. Consequently, the goods are identical on the basis explained in the *Meric* case above.

#### **Average consumer and the purchasing act**

19. 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 in question<sup>3</sup>.

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<sup>3</sup> See *Lloyd Schuhfabrik Meyer*, Case C-342/97.

20. 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."*

21. All the goods at issue are items of clothing of one type or another, so the average consumer will be the general public. They are sold in retail outlets (physical and online) and the marks used in relation to them may be seen in advertisements and catalogues. Clothing may vary in price but generally is not overly expensive. The average consumer will take some care in their selection as they wish to see the goods and assess their size, overall aesthetic impact and quality. Overall, I consider that the selection process will be a largely visual process (although I will not discount aural use completely) with a medium degree of care and consideration being deployed.

### **Comparison of marks**

22. It is clear from *Sabel BV v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

*".....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means*

*of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion."*

23. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

24. The respective trade marks are shown below:

<b>First earlier trade mark</b>	<b>Contested trade mark</b>
ELEVENTY	WELEVENII

25. The opponent submits that the contested mark is highly similar visually, aurally and conceptually. The applicants disagree with the opponent and emphasise that the stylisation and additional elements between the marks have an "*obvious distinction*". They also submit that "*the design of the ... mark put emphasis on the brand's place of origin, Notting Hill (W11)*" [sic] and, thus, this is its conceptual meaning.

#### Overall impression

##### *The applicants' contested mark*

26. The contested mark consists of "W ELEVEN11" in a lightly stylised black uppercase font. The "W" element is additionally conjoined with a slash/oblique slanting line off the side off the letter, forming an almost graphic like component. Both "ELEVEN11" and the stylised graphic W component play a role in the overall impression.

*The opponent's first earlier mark*

27. The opponent's mark is a word mark consisting solely of the word "ELEVENCY" in normal black font. The overall impression lies in the word itself.

Visual comparison

28. There is clearly some similarity between the two marks as they both contain the letters that make up the word "ELEVEN", albeit those letters are at the beginning of the earlier mark but in the middle of the contested mark. Nevertheless, the stylised W component at the forefront of the contested mark, and the numeral "11" (which could hypothetically also be viewed as 'ii'), as opposed to the letters "TY" at the end creates a difference. Overall, I consider the visual similarity to be between low and medium.

Aural comparison

29. The opponent's "ELEVENCY" mark will be articulated in four syllables as 'el-ev-en-ty' whilst there are various potential alternatives for articulating the contested mark. I consider the most likely variants are 'double-you-el-ev-en-el-ev-en' (nine syllables) or 'el-ev-en-el-ev-en' (six syllables). Notwithstanding that the shared 'el-ev-en' elements will be identically articulated, I consider the 'ty' syllable in the opponent's mark and additional two or four syllables in the contested mark counteracts that similarity to a reasonable extent. I find a low to medium degree of similarity in each of these variants.

30. I also find it possible (albeit very unlikely) that the contested mark will be read as just 'el-ev-en' (three syllables) or with the seemingly numerical '11' read as a double 'i' and articulated as 'el-ev-en-ee' (four syllables). The latter are both closer in syllables and pronunciation to the opponent's mark, which would have created a medium level of similarity. However, as, in my view, the likelihood of the mark

being articulated in these ways is very low, average consumers who would see that level of aural similarity are not likely to be significant<sup>4</sup>.

### Conceptual comparison

31. As mentioned in paragraph 25, the applicants suggest that their mark has a specific conceptual significance relating to the area known as Notting Hill. Although I acknowledge that argument, I do not consider the average consumer would necessarily link the contested mark as referring to the Notting Hill post code and district.
32. Whilst “ELEVENTY” is an inventive word with no meaning as a whole, it nevertheless evokes the number eleven, and this will form part of the conceptual hook in the mind of the average consumer. Similar can be said of the contested mark, with the number also being part of the conceptual hook. The other aspects of the mark do not create anything different or specific. It follows that whilst there is a shared concept around the number eleven, both marks evoke this concept in different ways and, therefore, I pitch the conceptual similarity at medium.

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

33. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, the greater the likelihood of confusion (see *Sabel*). In *Lloyd Schuhfabrik Meyer & Co. GmbH* 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*

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<sup>4</sup> See *Interflora Inc v Marks and Spencer plc* [2013] EWHC 1291 (Ch)

*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)."*

34. Registered trade marks can possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words. The distinctiveness of a mark can be enhanced by virtue of the use made of it. No evidence has been filed, so I only have the inherent characteristics of the mark to consider. Although the average consumer will see the earlier mark as an inventive word as a whole, they will nevertheless recognise that it is based upon the number eleven, and numbers are not, generally speaking, greatly distinctive; I consider this equates to a medium level of inherent distinctiveness.

### **Likelihood of confusion**

35. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. I point particularly to the principles I referred above in paragraph 15. One of these 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

necessary for me to keep in mind the distinctive character of the earlier trade mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

36. There are two types of possible confusion: direct (where the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks/goods down to the responsible undertakings being the same or related). The distinction between these was explained by Mr Iain Purvis Q.C (sitting as the Appointed Person) in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C.:

*"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."*

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). ”*

37. Due to the goods at issue, I find it useful to also highlight the General Court in *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03, where it stated that:

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

...

*50. ... Generally in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the*

*visual perception of the marks in question will generally take place prior to purchase. Accordingly the visual aspect plays a greater role in the global assessment of the likelihood of confusion.”*

38. Earlier in this decision I concluded that:

- The applicants' goods are identical to the opponent's coverage in the earlier mark;
- The average consumers of the services at issue are likely to be members of the general public paying a medium level of attention during the purchasing act, in which the selection process is likely to be mostly visual;
- The overall impression of the earlier mark lies in the word “ELEVENTY” itself and, within the contested mark, “ELEVEN11” and the stylised W component at its forefront have significance in that mark's overall impression;
- The competing trade marks are visually and aurally similar between a low to medium degree;
- Whilst “ELEVENTY” is an invented word with no meaning, there is a medium degree of conceptual similarity with the contested mark since both marks evoke a concept around the number eleven, albeit in different ways.
- I consider the mark is inherently distinctive to a medium degree.

Notwithstanding the principle of imperfect recollection, and taking all of the above factors into account, I consider the differences between the marks will be sufficient to enable the average consumer to differentiate between them. Besides recognising “ELEVENTY” as an invented word, they will at least recall that the earlier mark is the word eleven with a suffix, and the contested mark has a stylisation and different W element at the forefront. I consider the marks are simply

not close enough and there are too many differences for the average consumer to directly confuse the marks.

39. In considering whether there is a likelihood of indirect confusion, I bear in mind that the three categories of indirect confusion identified by Mr Purvis QC above are just illustrative – he stated that indirect confusion ‘tends’ to fall in one of them. Having borne this in mind, I come to the view that the average consumer would not consider the goods as coming from the same or a related undertaking. Having identified the differences between the marks (particularly at their beginnings and endings), the commonality of “ELEVEN” within each of the marks will merely be viewed as a reference to the number – of which, numbers are not a particularly unusual feature on clothing. The average consumer would see this as a coincidence, not economic connection. Even should it be found that the use of “ELEVEN” and/or “11” in the contested mark brings to mind the opponent’s mark, it must be highlighted that mere association is not enough for indirect confusion. As Mr James Mellor Q.C pointed out in *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, it is not sufficient that a mark merely calls to mind another mark.

40. I should add that even if I was wrong to have held that average consumers who saw a medium degree of aural similarity was not significant, my finding would have been the same. The slightly elevated aural similarity would not have assisted, as such similarity is still not high and, in any event, visual considerations are more relevant in this comparison.

#### **The opponent’s second earlier mark and the contested mark**

41. Having found that the opponent’s first earlier mark and the contested mark will not be confused, I must consider whether their second earlier mark puts it in a better position. I will state the position shortly, namely that the opposition on the basis of the second registration would fail for the same/similar reasons as the first. For the record, and in case of appeal, I record that:

- There is a greater degree of visual difference between the marks (for instance, the stylisation and positioning of “ELEVENTY” across three lines), so that any similarity is very low.
- There is a greater degree of aural difference due to the presence of the extra words “FIRST CLASS”.
- The conceptual analysis creates a difference, due to the presence/absence in the respective marks of “FIRST CLASS”, which suggests a level of prestige.
- The average consumer analysis is the same.
- The distinctiveness of the earlier mark assessment is the same.
- Whilst the goods covered by the earlier mark are more specific and some are identical to the contested mark, the opponent’s first earlier mark is broad and still covered an identical remit (albeit more broadly). The degree of similarity for these goods would be the same (identical) or lower for some other goods.
- Bearing the above analysis in mind, I consider there is no likelihood of confusion, whether direct or indirect.

## **CONCLUSION**

42. The opposition has been unsuccessful. The application may, subject to any successful appeal, proceed to registration.

## **COSTS**

43. The applicants have been successful and is entitled to a contribution towards its costs. I bear in mind that the relevant scale is contained in Tribunal Practice Notice 2/2016. I award costs to the applicants as follows:

Preparing a counterstatement and considering the other £250  
side's statement:

44. I therefore order ELEVENTY WORLD S.R.L to pay Qing Qin and Zhengni Chen the sum of £250. 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 25<sup>th</sup> day of January 2021**

**B Wheeler-Fowler**

**For the Registrar**