

O-469-21

**TRADE MARKS ACT 1994**  
**IN THE MATTER OF**  
**TRADE MARK APPLICATION NO. 3468025**  
**BY CLARK AND BEAU LTD**  
**TO REGISTER**



**AS A TRADE MARK IN CLASS 25**

**AND**

**OPPOSITION THERETO**

**UNDER NO. 420425**

**BY C. & J. CLARK INTERNATIONAL LIMITED**

## Background and pleadings

1. On 19 February 2020, Clark and Beau Ltd (“the applicant”) applied to register the trade mark shown below under number 3468025:



2. The application was published for opposition purposes on 28 February 2020 for *casual clothing* in Class 25.
3. C. & J. Clark International Limited (“the opponent”) filed a notice of opposition on 28 May 2020. The opposition is based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”) and directed against all the goods in the application. For its claims under sections 5(2)(b) and 5(3), the opponent relies upon the following United Kingdom (“UK”) and European Union (“EU”) trade marks:

**Mark 1: CLARKS**

**UK registration no.** 504405A

**Filing date:** 11 July 1929

**Registration date:** 11 July 1929

**Goods:**

Class 25 Boots, shoes and slippers; none being for export from the United Kingdom.

**Mark 2: CLARKS**

**UK registration no.** 504405B

**Filing date:** 11 July 1929

**Registration date:** 11 July 1929

**Goods:**

Class 25 Boots, shoes and slippers; all for export.

**Mark 3: CLARKS**

**EU registration no.** 0167940

**Filing date:** 1 April 1996

**Registration date:** 16 July 1998

**Goods:**

Class 18 Belts; bags, handbags, travel bags and holdalls.

Class 25 Footwear, boots, shoes and slippers; parts and fittings therefor.

Class 26 Laces, buckles, eyelets, fasteners, hooks and ornaments, all for footwear.

**Mark 4: CLARKS**

**EU registration no.** 012953584

**Filing date:** 10 June 2014

**Registration date:** 24 March 2015

**Goods relied upon:**

Class 18 Belts; bags.

Class 25 Clothing; footwear; boots; shoes; slippers; headgear; belts for wear; parts and fittings (including replacement parts and fittings) for all the aforesaid goods, and accessories for use therewith, including inner socks for footwear, heel tips, heel protectors and heel pads.

**Mark 4:** 

**EU registration no.** 012952933

**Filing date:** 9 June 2014

**Registration date:** 19 March 2015

**Goods relied upon:**

Class 18 Belts; bags.

Class 25 Clothing; footwear; boots; shoes; slippers; headgear; belts for wear; parts and fittings (including replacement parts and fittings)

for all the aforesaid goods, and accessories for use therewith, including inner socks for footwear, heel tips, heel protectors and heel pads.

**Mark 5:** 

**EU registration no.** 0167916

**Filing date:** 1 April 1996

**Registration date:** 16 July 1998

**Goods relied upon:**

Class 18 Belts; bags, handbags, travel bags and holdalls.

Class 25 Footwear, boots, shoes and slippers; parts and fittings therefor.

Class 26 Laces, buckles, eyelets, fasteners, hooks and ornaments, all for footwear.

4. Given their filing dates, all of above marks are earlier trade marks in accordance with section 6 of the Act. Although a statement was made in the notice of opposition that some of the earlier marks had been used in relation to the goods on which the opponent relies upon, the applicant chose not to put the opponent to proof of use.
5. The opponent claims that the goods in the application are identical or highly similar to the goods covered by the earlier marks and that the marks are highly similar. As a consequence, the opponent claims that there is a likelihood of confusion including a likelihood of association under section 5(2)(b).
6. Under section 5(3), the claim is that the use of the applicant's mark would, without due cause, take unfair advantage of the reputation of the earlier marks by enjoying increased publicity and sales without the need to invest significantly in the promotion of its trade mark. The opponent further claims that the use of the applicant's mark would be detrimental to its reputation if inferior goods were sold under the mark for which registration is sought.

7. Under section 5(4)(a), the opponent claims goodwill in the sign CLARKS. The opponent further claims that it first used the sign as early as 1936 in relation to bags; purses; wallets; footwear; parts, fittings and accessories for the aforesaid. Consequently, the opponent submits that it is entitled to prevent the use of the applied-for mark under the law of passing off.

8. The applicant filed a counterstatement denying the grounds of opposition. As these are the only submissions from the applicant, they are reproduced below in full:

“I deny. Clark is an extremely common name, which is my surname & the reason why it’s my business name with a lot of other companies using the word Clark.

I have currently rebranded Clark & Beau Ltd which also renamed the Italic font “Clark”.”

9. The opponent is represented by Squire Patton Boggs (UK) LLP and the applicant is a litigant in person. Only the opponent filed evidence and written submissions. I will summarise the evidence to the extent it is necessary. I make this decision after a careful reading of all the papers filed by the parties.

## **Evidence**

10. The opponent’s evidence consists of the witness statement of Paul Antony Wakefield dated 25 November 2020 with sixteen exhibits. Mr Wakefield is the Chief Legal Officer and the Company Secretary of the parent company of the opponent.

11. An extract from the opponent’s website detailing its history including information on its formation in 1825, is provided as Exhibit PAW1.

12. Various pages from the book titled “*Clarks Made to Last The Story of Britain’s Best-Known Shoe Firm*” written by Mark Palmer are in evidence. The evidence shows some historical use of the mark Clarks in the form of advertisements dating back to the 1930s. There are also pictures of shop fronts photographed in 1946 and 1963.<sup>1</sup>
13. Reports produced for 2014 - 2020 by Kantar Worldpanel Fashion GB and Euromonitor International Limited are in evidence.<sup>2</sup> According to Mr Wakefield, Kantar is a global leader in consumer panels, and Euromonitor is the world’s leading independent provider of strategic market research. According to the reports, the opponent is ranked as number three among the top ten UK footwear retailers and UK footwear brand markets, with a 6.4% share of the UK footwear retail market and a 7% share of the UK footwear brand market. The opponent is also ranked tenth among the top twenty global brands in the UK footwear market.
14. According to Mr Wakefield, the following are the turnover figures for products sold under the marks for the years 2015 – 2019:

Year	Turnover (£’million)
2015	Over 800
2016	Over 800
2017	Over 800
2018	Over 800
2019	Over 750

15. The evidence indicates that the opponent sells footwear through its website and through third-party retailers such as ASOS, Amazon and Jacamo.<sup>3</sup>
16. The evidence also includes pages from the opponent’s social media pages. The opponent’s Instagram and Facebook pages were created in 2015 and Twitter

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<sup>1</sup> Exhibit PAW6. Mr Wakefield claims that the book was published in 2013.

<sup>2</sup> Exhibit PAW6

<sup>3</sup> Exhibit PAW7

account in 2009. Instagram, Twitter and Facebook accounts have 381,000, 50,100 and 2,484,169 followers, respectively. The pages filed in evidence show several images of footwear such as boots and slippers. The marks Clarks and  are seen throughout the social media pages.<sup>4</sup>

17. According to Trustpilot's website, "Clarks" has 2,163 reviews and has been rated as "great".<sup>5</sup> A copy of "Global Brand Equity Research - Clarks brand associations from adults in the UK, US & China" (dated October 2020), is provided as Exhibit PAW13. According to the report, Clarks scores high for brand heritage, quality, trust and high-quality materials.<sup>6</sup>

18. Mr Wakefield states that the opponent has won several awards for footwear sold under the earlier marks. In 2017, the opponent was declared the winner of the Drapers Footwear Consumer Choice and Kids Brand Awards, while in 2019, it was the winner of the Drapers Footwear Consumer Choice award.<sup>7</sup>

19. That concludes my summary of the evidence insofar as I consider it necessary.

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

20. 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".

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<sup>4</sup> Exhibit PAW8 – PAW10

<sup>5</sup> Exhibits PAW12

<sup>6</sup> Exhibit PAW13

<sup>7</sup> Exhibit PAW14 and PAW15

## Case law

21. The following principles are gleaned from the judgments 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 C3/03, *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 the mark as a whole and does not proceed to analyse its various details;

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

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

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

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

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

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

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

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

### **Comparison of goods**

22. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In *Canon*, the Court of Justice of the European Union (“CJEU”) stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or

services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

23. Guidance on this issue has also come from Jacob J. (as he then was) in *British Sugar Plc v James Robertson & Sons Ltd* (the Treat case), [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

24. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market* (Trade Marks and Designs) (OHIM), Case T-325/06, the General Court (“GC”) stated that ‘complementary’ means:

“[...] there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that

customers may think that the responsibility for those goods lies with the same undertaking”.

25. In *Gérard Meric v OHIM*, the General Court held that goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application - and vice versa.<sup>8</sup>

26. The only goods covered by the applicant’s mark is “casual clothing” in Class 25. The opponent relies on five earlier marks that mainly cover goods in Classes 18 and 25. As all of the earlier marks cover various types of footwear such as boots, it is where I will begin my comparison of goods.

27. Although the nature of boots differs from casual clothing, the competing goods to a degree share the intended purpose and method of use as both are worn on the body to protect from weather conditions or hazard, for example. However, boots are exclusively to be worn on the feet, whereas casual clothing is exclusively to be worn elsewhere on the body. The users are the same. There is likely to be some overlap in the channels of trade. The goods are neither complementary nor do they compete. Considering these factors, I find that the competing goods are similar to a medium degree.

28. Moreover, the opponent’s EU registrations 012953584 and 012952933 also cover the term clothing, which is identical to casual clothing in the application under the *Merici* principle. Other goods are also covered by the earlier marks – for example, belts and bags - but any similarity based on those goods is significantly lower than exists in relation to clothing or footwear.

### **The average consumer and the nature of the purchasing act**

29. It is necessary for me to determine who the average consumer is for the respective parties’ goods.

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<sup>8</sup> case T-133/05

30. 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”.

31. The average consumer of the competing goods is a member of the general public.

32. In *New Look Ltd v Office for the Harmonization in the Internal Market (Trade Marks and Designs)* Joined cases T-117/03 to T-119/03 and T-171/03, the General Court (“GC”) commented upon the manner in which articles of clothing are selected. It stated:

“50. The applicant has not mentioned any particular conditions under which the goods are marketed. 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.”

33. The goods are neither an infrequent nor a daily purchase. The goods are most likely to be the subject of self-selection from retail outlets, websites or

catalogues. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount an aural element to the purchase, particularly when advice is sought from a sales representative or a purchase is made further to a word-of-mouth recommendation. When making a purchase, factors such as size, material, colour, cost (which will vary according to the item) may be considered. These factors suggest that the average consumer will pay a medium level of attention when making their selection.

### **Distinctiveness of the earlier marks**

34. The distinctive character of the earlier marks must be considered. The more distinctive they are, either inherently or through use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). 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).”

35. The opponent relies on the word only mark CLARKS and the figurative mark *Clarks*. Clark, in my experience, is a common name in the UK; more common as a surname than a forename. Clarks is a likely indication of a plural nor a possessive form of Clark. The common nature of the name means that it possesses a little lower than medium degree of inherent distinctive character. However, I have factored into account the evidence of historical use of the marks dating back to the 1930s, and over 4000 million pounds of turnover recorded under the marks during the five-year period up the date when the contested mark was applied for. I have also considered the fact that the opponent ranks third among the top 10 UK footwear brands. I also note that the opponent holds a 7% share of the UK footwear brand market and has twice won the consumer choice award from Drapers who are claimed to be the UK’s leading authority on fashion retailing. Considering the evidence as a whole, I am satisfied that a proportion of the relevant public is likely to associate the marks CLARKS and *Clarks* as coming from the opponent. Some of the earlier marks registered in the EU, among other goods, cover clothing in Class 25. However, given that the opponent has shown use of the marks only in relation to various types of footwear, the marks’ distinctiveness has been enhanced to a high degree only in relation to those goods.

### **Comparison of marks**

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

37. It would be wrong, therefore, artificially to 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.

38. The trade marks to be compared are as follows:

Applicant's trade mark	Opponent's trade marks
	<p data-bbox="1029 1003 1161 1037">CLARKS</p> 

39. The applicant's mark consists of the words Clark and Beau with an ampersand symbol between them. The words and the symbol are presented in a slightly stylised script. I think a significant proportion of the average consumers are likely to read the first element as Clark. However, I also acknowledge that for some consumers, the letter "C" may appear like the letter "e", or the letters "Cl" combined may even appear like a large rendering of the letter "a" in lower case. The verbal elements are presented on two overlapping clouds shaped background in pink and blue. In the clothing sector these colours are (still) most likely to be seen as gender signifiers (pink for girls and blue for boys). A rectangle in black forms the background for all the elements in the marks I described above. Given the size and position, "Clark & Beau" dominate the overall impression of the mark. A lesser role is played by the cloud-shaped background and a very much weaker role by the background in black. Aside

from its cursive nature, there is little unusual or striking about the typeface, so it makes (at most) a marginal contribution to the overall impression of the mark.

40. I now turn to the opponent's marks. As rightly pointed by the opponent, its word only mark CLARKS affords a broader scope of protection. The normal and fair use would entitle the opponent to use that mark in upper- or lower-case letters or in any typeface, including cursive typeface. On that basis, there is no material difference between the earlier marks. Therefore, I will consider the earlier marks together, and for the sake of convenience, I shall refer to them as "the opponent's marks". The overall impression and the distinctiveness of the opponent's marks lie in the word "Clarks".

41. Visually, both marks contain the word Clark. There is also a degree of visual similarity between the marks created by the typeface. I note the applicant's submission that it has rebranded and "removed the italics font Clark". I pause here to clarify for the benefit of the applicant that a trade mark cannot be amended once filed with the registry.<sup>9</sup> Moreover, how the applicant intends to use the applied-for mark on the marketplace is not relevant to my consideration. I must compare the applied-for mark as it appears in the register. Therefore, the applicant's submission on rebranding is irrelevant to the issues before me. In terms of differences, the opponent's mark is presented as the plural of Clark. The opponent, in its submissions, reminds me that as a general rule of thumb, the average consumer will generally pay attention to the first element of the mark. I accept that point. However, I also find that the ampersand and Beau in the applicant's mark are equally visually striking as the word Clark and the eye is likely to be naturally drawn towards those elements as well. The cloud device in the background also contribute further visual differences between the marks. Considering these factors and my assessment of the overall impression of the marks, I find that the marks are visually similar to a low degree.

42. Turning to aural comparison, the background elements in the applicant's mark will not be verbalised. The ampersand symbol represents the word "and". The

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<sup>9</sup> See <https://www.gov.uk/how-to-register-a-trade-mark/apply>

applicant's mark will, therefore, be pronounced as three separate words - "Clark" "and" "Beau" - each word would be given its conventional pronunciation. The marks coincide in that they both open with the sound "Clark". In terms of differences, the opponent's marks will be pronounced as "Clarks" - the plural of Clark - and additionally, the second and third words in the applicant's mark do not have counterparts in the opponent's mark. Considering these factors, I find that the marks are aurally similar to no more than a medium degree.

43. As regards the conceptual comparison, in *Luciano Sandrone v European Union Intellectual Property Office (EUIPO)*, Case T-268/18, General Court ("GC") held that:

83. [...] In that regard, it must be borne in mind that the purpose of the conceptual comparison is to compare the 'concepts' that the signs at issue convey. The term 'concept' means, according to the definition given, for example, by the *Larousse* dictionary, a 'general and abstract idea used to denote a specific or abstract thought which enables a person to associate with that thought the various perceptions which that person has of it and to organise knowledge about it'.

84. Similarly, according to the case-law, conceptual similarity means that the signs at issue convey analogous semantic content (judgment of 11 November 1997, *SABEL*, C-251/95, EU:C:1997:528, paragraph 24).

85. Therefore, a first name or a surname which does not convey a 'general and abstract idea' and which is devoid of semantic content, is lacking any 'concept', so that a conceptual comparison between two signs consisting solely of such first names or surnames is not possible.

86. Conversely, a conceptual comparison remains possible where the first name or surname in question has become the symbol of a concept, due, for example, to the celebrity of the person carrying that first name or surname, or where that first name or that surname has a clear and immediately recognisable semantic content.

87. The Court has thus previously held that the relevant public would perceive marks containing surnames or first names of persons as having no specific conceptual meaning, unless the first name or surname is particularly well known as the name of a famous person (see, to that effect, judgments of 18 May 2011, *IIC v OHIM — McKenzie (McKENZIE)*, T-502/07, not published, EU:T:2011:223, paragraph 40; of 8 May 2014, *Pedro Group v OHIM — Cortefiel (PEDRO)*, T-38/13, not published, EU:T:2014:241, paragraphs 71 to 73; and of 11 July 2018, *ANTONIO RUBINI*, T-707/16, not published, EU:T:2018:424, paragraph 65).”

88. In the present case, the Board of Appeal did not identify any concept with which the first name and surname in question could be associated. Nor have the parties put forward any such arguments.”

44. I have already mentioned that Clark is a common name in the UK. Clark & Beau in the applicant’s mark gives the impression that Beau is another name (either a forename or a surname). Clarks is likely to be perceived either as the plural or the possessive form. Other than the fact that the average consumer will perceive the respective parties’ marks as referring to individuals, neither Clarks nor the combination Clark & Beau are likely to evoke any concept the average consumer could associate. Certainly, there is no evidence or submissions to the contrary. On that basis, in comparing the marks from a conceptual perspective I find the position to be neutral.

### **Likelihood of confusion**

45. In determining whether there is a likelihood of confusion, I need to bear in mind several factors. The first is the interdependency principle, i.e. a lesser degree of similarity between the respective goods may be offset by a greater degree of similarity between the trade marks (*Canon* at [17]). It is also necessary for me to bear in mind the distinctive character of the opponent’s trade mark, as the more distinctive the trade mark is, the greater the likelihood of confusion (*Sabel* at [24]). I must also keep in mind the average consumer for the goods, the

nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks, relying instead upon the imperfect picture of them they have retained in mind (*Lloyd Schuhfabrik* at [26]).

46. Confusion can be direct (which occurs when 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/services down to the responsible undertaking being the same or related).
47. The difference between direct and indirect confusion was explained in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, by Iain Purvis Q.C., sitting as the Appointed Person, where he explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark”.

48. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, James Mellor Q.C., sitting 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 another mark to mind. This is mere association not indirect confusion.

49. Earlier in this decision, I concluded:

- That the contested goods are either identical or similar to a medium degree;
- That the goods will be selected primarily by visual means, with a medium degree of attention by the general public;
- That the marks are visually similar to a low degree, aurally similar to no more than a medium degree, and the conceptual position is neutral;
- That the opponent's mark is inherently distinctive to no more than a medium degree and the distinctiveness has been enhanced through use to a high degree, but only in relation to footwear.

50. In my view, the non-coinciding elements, particularly the presence of the words “& Beau” in the applicant's mark is prominent enough to dispel a likelihood of direct confusion.

51. Turning to the assessment of indirect confusion, I bear in mind that the distinctive character of the similar elements in the competing marks is a key consideration in determining a likelihood of confusion.<sup>10</sup> I note that the degree of similarity between the marks arises from the common element “Clark”, which, as a common name, has no more than a medium degree of inherent distinctive character. I also remind myself that I have to assess each mark as a whole.

52. I am aware from my own experience that it is common practice for traders in the clothing and footwear sector to supply goods under their respective names or that of the company founder. The average consumer is, therefore, generally accustomed to distinguishing between traders by reference to their names. In that context, the applicant's mark is likely to be perceived as indicating the traders Clark and Beau. Given the common nature of the name Clark, it is even plausible that the average consumer may ascribe a greater distinctiveness to ‘Beau’, which is most likely to be perceived as an uncommon name. In contrast, as evidence indicates, the opponent has educated the average consumer to

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<sup>10</sup> *Kurt Geiger v A-List Corporate Limited*, BL O-075-13

recognise the word Clarks as coming from the opponent. Clarks is likely to be perceived as referring to the plural of Clark or even a miswriting of the possessive form. However, in my view, the combination “Clark & Beau” do not give any such impression – i.e. neither an indication of a plural nor a possessive. Moreover, even though the marks coincide in the element “Clark”, the words “Clark & Beau” are unlikely to lead the average consumer to think that the goods emanate from the same or linked family business. For the average consumer to perceive a brand extension, the extension has to be something that is familiar and natural so that the consumer can perceive it immediately.<sup>11</sup> Given the common nature of the name Clark and the high distinctiveness of the mark Clarks (for footwear), it would not be seen as logical or consistent to create a brand extension of the opponent’s mark by altering the distinctive character of the word Clarks and adding the uncommon name Beau (particularly along with other visual elements not present in the earlier marks). I find that due to the significant distance between the marks, the average consumer is unlikely to conclude that Clark & Beau is a sub-brand of the opponent or that the opponent has entered into a joint venture with an undertaking trading under the name Beau. In a sector where names (forenames and/or surnames) are prevalent to denote the origin of the goods, the average consumer will not put the similarity between the marks arising from a common name down to an economic connection. Considering these factors, I find that there is no likelihood of confusion, either direct or indirect.

53. The opposition, therefore, fails under section 5(2)(b).

### **Section 5(3)**

54. Section 5(3) states:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a

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<sup>11</sup>See *The Cheeky Indian (AP decision)* O219/16, para 20.

reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

55. Section 5(3A) states:

“(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.”

56. The relevant case law can be found in the following judgments of the CJEU:

*Case C-375/97, General Motors, Case 252/07, Intel, Case C-408/01, Adidas Saloman, Case C-487/07, L’Oreal v Bellure, Case C-323/09, Marks and Spencer v Interflora and Case C383/12P, Environmental Manufacturing LLP v OHIM.* The law appears to be as follows:

- a. The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.
- b. The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.
- c. It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.
- d. Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the

overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel*, paragraph 42.

- e. Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.
- f. Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel*, paragraphs 76 and 77.
- g. The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel*, paragraph 74.
- h. Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV*, paragraph 40.
- i. The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the

power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

### Reputation

57. In order to succeed under section 5(3) ground, the opponent must demonstrate by way of evidence that the earlier marks are known by a significant part of the relevant public for the goods relied upon. There is no evidence at all of the mark having been used in respect of clothing, so for the purpose of assessing reputation under this ground, I will focus on the word-only mark "CLARKS", which is registered in the UK for boots, shoes and slippers. I have already concluded that the opponent's mark benefits from enhanced distinctiveness to a high degree in respect of footwear goods. The relevant factors for assessing reputation are the same as those relevant for assessing the enhanced distinctiveness by use, namely, in particular, the market share held by the mark, how intensive, geographically widespread and long-standing use of the mark has been, and the amount invested by the undertaking in its promotion.<sup>12</sup> For the same reasons given at paragraph 24 on enhanced distinctiveness of the mark, I find that the opponent's mark has a strong reputation in the UK, but only in relation to footwear.

### Link

58. The next step is to assess whether the public will make a link between the competing marks. This is a multi-factorial assessment taking into account the

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<sup>12</sup> See *General Motors* paras 26 and 27

strength of reputation of the earlier mark, the degree of distinctiveness of the earlier marks, the extent of the overlap between the relevant consumers for those goods and the degree of similarity between the respective marks and the goods.

59. I have found that the marks are visually similar to a low degree, aurally similar to no more than a medium degree and the conceptual position is neutral. The average consumers in the clothing and footwear sectors are used to distinguishing undertakings by their forenames/surnames, particularly where the coinciding element is a common surname in the UK. The earlier mark's reputation lies in the word Clarks. However, the element giving rise to similarity between the marks is "Clark" - a common name in the UK that possesses only a limited inherent distinctive character. Moreover, the additional elements, in particular the "& Beau", contribute to a significant difference between the marks. In the circumstances, I do not consider that a significant proportion of consumers are likely to link the contested mark to the earlier mark. The ground is dismissed.

60. The opponent has no stronger case based on its EU trade marks, for the same reasons as given above. Therefore, all the section 5(3) grounds fail.

#### **Section 5(4)(a)**

61. Section 5(4)(a) of the Act reads as follows:

"5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

b) [...]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark”.

62. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “a substantial number” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

63. There is no evidence that the contested mark was used in the UK prior to the date of application. That being the case, the matter must be assessed only as at the application date of the contested mark (19 February 2020).

64. Reputation constitutes a knowledge threshold and, therefore, reputation of the earlier mark in the UK is helpful in establishing goodwill. I have already concluded that the earlier mark CLARKS enjoys a strong reputation and it follows from my findings that I accept that the earlier mark has substantial goodwill in the UK in relation to boots, shoes and slippers.

65. In relation to the assessment of misrepresentation, I am not convinced that there is a misrepresentation leading to deception or a likelihood of deception as to the trade origin of the goods offered. This is because, for the reasons given

in my findings under section 5(2)(b) ground, even though the goods are similar to a medium degree, the distance between the competing trade marks is such that the use of the contested mark is not likely to deceive a substantial number of the opponent's customers or potential customers. I find this would be the case even if the goods were considered to be highly similar. The consumers are unlikely to regard the applicants' goods as sourced from the opponent. I recognise that there is a difference between the test for misrepresentation and the test for likelihood of confusion. However, both tests are intended to be normative measures to exclude those who are unusually careful or careless (as per Jacob L.J. in *Reed Executive Plc v Reed Business Information Ltd* [2004] RPC 40). Therefore, there are parallels between the two. Section 5(4)(a) ground of opposition is dismissed.

## **Conclusion**

66. The opposition is unsuccessful. The application will proceed to registration in relation to casual clothing in Class 25.

## **Costs**

67. Under cover of a letter dated 2 March 2021, a costs proforma was sent to the applicant. The letter informed the applicant that no costs would be awarded if the proforma was not completed and returned by 30 March 2021. As the applicant has not returned the proforma, I do not make any costs award in favour of the applicant.

**Dated this 21st June 2021**

**Karol Thomas**

**For the Registrar**

**The Comptroller-General**