

O-798-21

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3625755 BY
LEWIS LIVESEY**

TO REGISTER:

***FIERCE
APPROACH***

AS A TRADE MARK IN CLASS 25

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 600001829 BY
NICHOLAS BOLAND**

Background & pleadings

1. On 13 April 2021, Lewis Livesey (“the applicant”) applied to register the trade mark shown on the cover page of this decision for the goods in class 25 shown in paragraph 18 below.

2. On 21 July 2021, the application was opposed in full under the fast track opposition procedure by Nicholas Boland (“the opponent”). The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), with the opponent relying upon the following trade marks/goods:

918080465 – FIERCE – filed on 7 June 2019 and entered in the register on 20 September 2019:

Class 25 - Clothing; Footwear; Headwear; Hats; Caps; Articles of sports clothing; Shoes; Tee-shirts; Jackets; Pullovers; Shorts; Shirts; Trousers; Wristbands; Neckwear.

916310468 – #Fierce – filed on 2 February 2017 and entered in the register on 22 May 2017:

Class 25 – Clothes.

3. In relation to the 465 trade mark, the opponent states:

“The opposed trademark FIERCE APPROACH includes the earlier trademark FIERCE. This is a clear indication of a likelihood of confusion. It should be pointed out that the element FIERCE is the first element in the trademark FIERCE APPROACH, thus its importance for determining confusing similarity is high. Furthermore, the opposed and the earlier trademarks both cover clothing-related products which is a clear indication of the similarity between the goods/services of the two trademarks.”

The opponent provides a very similar statement in respect of the 468 trade mark.

4. The applicant filed a counterstatement. As these are the only comments I have from him, they are reproduced below in full:

“Opposition is based on similarity of name. This is denied: the applicant’s mark will be clearly distinguished by the use of the additional word “APPROACH”. The opponent’s trademarks do not give the right to exclusive use of the word “FIERCE” where that word is included in another mark. Neither is confusion likely to arise because the applicant will use the full mark “FIERCE APPROACH”.

Opposition is also based on identical or similar goods. It is admitted that the applicant will use the mark for goods in the same class, namely Class 25. Subject to that, it is denied that the applicant will use the mark for goods which are identical or similar goods as goods which are sold using the opponent’s marks inasmuch as goods produced and sold under the applicant’s mark will not be copies of the goods which use the opponent’s marks.

Additional points:

1. The opposer’s mark is not complex and there is no dominant component in the opposer’s mark that is offended in the application.
2. The opposer’s mark is not a “well known” earlier mark.
3. There are some 25 other marks registered including the word “Fierce”: including 17 marks registered prior to the earlier of the opposer’s marks and 8 marks registered after the earlier of the opposer’s mark....”.

5. Brief details of the trade marks referred to are attached to the counterstatement; I shall return to the relevance of these trade marks later in this decision.

6. In these proceedings the opponent is represented by Daniel Dimov and the applicant by Clough & Willis.

7. Rule 6 of the Trade Marks (Fast Track Opposition)(Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

8. The net effect of these changes is to require parties to seek leave in order to file evidence in fast track oppositions. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken.

9. In an official letter dated 16 September 2021, the parties were allowed until 30 September 2021 to seek leave to file evidence and/or request a hearing and until 14 October to provide written submissions. Although neither party sought leave to file evidence nor requested to be heard, the opponent elected to file written submissions. I shall refer to these submissions, as necessary, below.

DECISION

10. The opposition is based upon section 5(2)(b) of the Act, which reads as follows:

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

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

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

11. The trade marks upon which the opponent relies qualify as earlier trade marks under section 6 of the Act. As these earlier trade marks had not been registered for more than five years at the date the application was filed, they are not subject to the proof of use provisions contained in section 6A of the Act. The opponent is, as a consequence, entitled to rely upon them in relation to all of the goods indicated without having to prove that he has made genuine use of them in relation to such goods.

12. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

Case law

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

The principles:

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

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

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

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

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

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

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

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

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

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

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

My approach to the comparison

14. In these proceedings the opponent is relying upon the two trade marks shown in paragraph 2. The 465 trade mark consists of the word “FIERCE” solus and has a broader specification than the other trade mark being relied upon. It is this trade mark which offers the opponent the best prospect of success and which I shall, as a consequence, use for the purposes of comparison. If the opponent does not succeed on the basis of this trade mark, he will be in no better position in relation to the other trade mark which also includes the device of a hashtag.

The trade marks referred to in the applicant’s counterstatement

15. In his written submissions, the opponent states:

“The applicant presents a list of trademarks and argues that “numerous trademarks including the word “FIERCE” have been granted both before and after the grant of the opponent’s marks”. Such arguments are groundless as the confusing similarity between opponent’s trademarks and the cited trademarks needs to be examined on a case by case basis. It is important to

take into account the relevant trademarks, goods/services, the existence of any co-existence agreements, and other factors...”

16. In *Zero Industry Srl v OHIM*, Case T-400/06, the General Court (“GC”) stated that:

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

17. For essentially the reasons mentioned by the opponent and by the GC in the case mentioned, the presence of a range of trade marks on the register in, inter alia, class 25 which include the word “FIERCE” do not assist the applicant.

Comparison of goods

18. The competing goods are as follows:

The opponent’s goods	The applicants’ goods
Trade mark no. 918080465 Class 25 - Clothing; Footwear; Headwear; Hats; Caps; Articles of	Class 25 - Sports clothing; Clothes for sports; Articles of sports clothing; Jackets being sports clothing; Clothing;

sports clothing; Shoes; Tee-shirts; Jackets; Pullovers; Shorts; Shirts; Trousers; Wristbands; Neckwear.	Tops [clothing]; Leisure clothing; Girls' clothing; Jerseys [clothing]; Casual clothing; Shorts [clothing].
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19. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the GC stated:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

20. Although the applicant’s specification includes a number of terms which find direct counterparts in the opponent’s specification (and are literally identical), as the opponent’s specification includes the broad term “clothing” (which would encompass all of the goods in the application), even if not literally identical, the applicant’s goods are to be regarded as such on the principles outlined in *Meric*.

The average consumer and the nature of the purchasing process

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

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

objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

22. The average consumer of the goods at issue is a member of the general public. As such a consumer will, for the most part, self-select such goods from the shelves of a bricks-and-mortar retail outlet or from the equivalent pages of a website or catalogue, visual considerations are likely to dominate the selection process. That said, as such goods may also be the subject of, for example, word-of-mouth recommendations or oral requests to sales assistants (both in person and by telephone), aural considerations must not be forgotten.


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

Comparison of trade marks

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

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

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

The opponent's trade mark	The applicant's trade mark
<p>Trade mark no. 918080465</p> <p>FIERCE</p>	

Overall impression

26. The opponent's trade mark consists of a single word presented in block capital letters. As no part of the word is highlighted or emphasised in any way, the overall impression it conveys and its distinctiveness lies in the single word of which it is composed.

27. The applicant's trade mark consists of two words i.e. "FIERCE" and "APPROACH" presented in stylised upper case letters in a heavy bold font. The words form a unit in which the first word qualifies the second (I shall return to this point below). Although the stylisation present will contribute to the overall impression conveyed, it is the words themselves which will dominate the overall impression and it is in the words themselves the vast majority of the distinctiveness lies.

Visual similarity

28. The competing trade marks coincide in the word “FIERCE”. Bearing in mind that the word “APPROACH” in the applicant’s trade mark is absent from the opponent’s trade mark and the limited degree of stylisation present in the applicant’s trade mark, it results in what I regard as a medium degree of visual similarity between the competing trade marks.

Aural similarity

29. As the words in the competing trade marks will be well-known to the average consumer how they will be pronounced is predictable. Although the applicant’s trade mark will be referred to by the two words of which it is composed, the fact that the opponent’s trade mark and the first word in the applicant’s trade mark will be verbalised in an identical manner, results in a medium degree of aural similarity.

Conceptual similarity

30. The meaning of the words in the competing trade marks will be well-known to the average consumer. Although the words have a range of meanings, the opponent’s trade mark is, in my view, most likely to be conceptualised by the average consumer as meaning aggressive, angry, intense or enthusiastic (collinsdictionary.com refers), whereas the unit created by the applicant’s trade mark is most likely to be conceptualised as meaning to undertake something in one of the ways described above. To the extent that both trade marks will evoke the meanings associated with the word “FIERCE” I have outlined, they are conceptually similar to a medium degree.

Distinctive character of the earlier trade mark

31. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade

mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

32. As these are fast track proceedings in which the opponent has filed no evidence of any use he may have made of his earlier trade mark, I have only its inherent characteristics to consider. Although a well-known word, "FIERCE" is neither descriptive of nor non-distinctive for the goods upon which the opponent relies. Considered absent use, the opponent's trade enjoys a medium degree of inherent distinctive character.

Likelihood of confusion

33. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark as the more distinctive it is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind.

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

- the competing goods are either literally identical or are to be regarded as such on the *Meric* principle;
- the average consumer is a member of the general public who, whilst not ignoring aural considerations, will select the goods at issue by predominantly visual means whilst paying a medium degree of attention during that process;
- the competing trade marks are visually, aurally and conceptually similar to a medium degree;
- the earlier trade mark enjoys a medium degree of inherent distinctive character.

35. In his written submissions, the opponent states:

“The applicant argues that the applicant’s mark will be distinguished by the use of the additional word “APPROACH”. This argument is weak as, when determining confusing similarity, the first element has more importance than the second element. The reason is that the trademark “FIERCE” may be considered by many consumers as a primary mark and the trademark “FIERCE APPROACH” as a secondary trademark. A secondary trademark is a trademark that includes the primary trademark and is usually used in relation to products which are similar to the products sold under the primary trademark...

By way of analogy, it is highly likely that many consumers will regard products bearing the trademark “FIERCE APPROACH” to be related to products bearing the trademark “FIERCE”. For example, consumers of clothes bearing the trademark “FIERCE” may regard clothes bearing the trademark “FIERCE APPROACH” to be clothes bearing the same trademark, but categorized in a different collection (i.e., a collection called “FIERCE APPROACH”).”

36. The fact that the competing goods are identical is an obvious point in the opponent’s favour. However, notwithstanding the medium degree of inherent

distinctiveness the earlier trade mark enjoys and the degree of visual, aural and conceptual similarity between the competing trade marks I have identified, an average consumer paying even a low degree of attention during the selection process (let alone the medium degree of attention I have already concluded will be appropriate) is highly unlikely to overlook the word “APPROACH” in the applicant’s trade mark. Indeed, in my view, all of the opponent’s submissions in paragraph 35 above appear to be predicated on there being a likelihood of indirect confusion. Whether I have interpreted those submissions correctly or not, there is no likelihood of direct confusion.

37. That leaves indirect confusion to be considered. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

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

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

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

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

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

“18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and

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

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

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

41. I accept that as a rule of thumb the first word in a trade mark is generally the most important for the purposes of comparison and, as the case law at paragraph 39 indicates, that those in the clothing industry use sub-brands to identify different lines. However, I have already concluded that the words in the applicant’s trade mark form a unit and the meaning of the unit created is different to the individual words of which it is composed. As the word “FIERCE” does not play an independent distinctive role in the applicant’s trade mark, I think it far more likely that the average consumer will construe the applicant’s trade mark as an integrated whole with its own meaning, rather than concluding that the words “FIERCE” and “FIERCE APPROACH” are, as the opponent suggests, primary and secondary trade marks from the same undertaking. In short, I think that the likelihood of indirect confusion is remote and,

having already concluded there will be no likelihood of direct confusion, the opposition as a whole fails.

Overall conclusion

42. The opposition has failed and, subject to any successful appeal, the application will proceed to registration.

Costs

43. As the applicant has been successful, he is entitled to an award of costs. Awards of costs in fast track opposition proceedings are governed by Tribunal Practice Notice 2 of 2015. As the applicant reviewed the Notice of opposition and prepared a defence and as he has incurred no official fees in the defence of his application, I award the applicant £200 in respect of the activities I have identified.

44. I order Nicholas Boland to pay to Lewis Livesey the sum of **£200**. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 26th day of October 2021

C J BOWEN

For the Registrar