

O/1022/22

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO. 918089895

**IN THE NAME OF
POSTUROPA**

**IN RESPECT OF THE FOLLOWING TRADE
MARK:**



SAVAGE

IN CLASSES 18 & 25

AND

**THE APPLICATION FOR INVALIDITY THEREOF
UNDER NO. 503643
BY KAVEH SAVAGE**

Background and pleadings

1. On 1 July 2019, Posturopa (the “proprietor”) applied to register the trade mark shown on the front page of this decision for the following goods in classes 18 and 25:

Class 18: Luggage, bags, wallets and other carriers.

Class 25: Clothing; Footwear; Headgear.

2. The application was registered at the European Union Intellectual Property Office (EUIPO) on 23 October 2019. On 1 January 2021, the UK left the EU. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing EUTM. As a result of the contested mark being registered as a EUTM at the end of the Implementation Period, it was automatically converted to a comparable UK trade mark. The comparable UK mark is now recorded on the UK trade mark register and has the same legal status as if it had been applied for and registered under UK law, and the original filing date remains.

3. On 10 February 2021, Kaveh Savage (the “applicant”) applied to have the contested mark declared invalid pursuant to section 47 of the Trade Marks Act 1994. The applicant relies on the following UK trade mark under section 5(2)(b):

Trade mark no.	2244426
Trade mark	SAVAGE
Filing and registration date	UK filing date: 4 September 2000 Date of entry in register: 5 October 2001
Goods relied upon	Class 18: Bags Class 25: Headgear; tops as clothing

4. By virtue of its earlier filing date, the above registration constitutes an earlier mark within the meaning of section 6 of the Act.

5. The applicant submits that there is a likelihood of confusion because the proprietor's registration is highly similar to the applicant's and the respective goods are identical or similar.

6. The proprietor filed a counterstatement denying the claims made and putting the applicant to proof of use in respect of its earlier mark.

7. The applicant is represented by Sonder & Clay whereas the proprietor is represented by Sandersons. Whilst the applicant filed evidence, the proprietor did not. Neither party requested a hearing however the applicant did file written submissions in lieu. I now make this decision after careful consideration of the papers before me.

8. 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.

Procedural History

9. In their counterstatement dated 19 April 2021, the proprietor notified the Registry that the cancellation applicant's earlier mark was subject to cancellation proceedings which would have a material effect on this decision. The Registry therefore decided to suspend these proceedings pending the outcome of the earlier cancellation proceedings.

10. A decision was implemented on the earlier proceedings on 10 March 2022 partially revoking some of the cancellation applicant's goods. As such, the cancellation applicant's specification was reduced to that in paragraph 3 above and these proceedings resumed on 30 March 2022.

EVIDENCE

11. The applicant's evidence was filed in the form of a witness statement from Kaveh Savage, the proprietor of the earlier mark, dated 23 May 2022 and with 20 accompanying exhibits. Whilst I do not intend to summarise the evidence here, I have taken it into consideration in reaching my decision and I will refer to it below where necessary.

DECISION

12. Section 5(2) of the Act has application in invalidation proceedings pursuant to section 47 of the Act. The relevant legislation is as follows:

13. Section 47 states:

“47. (1) [...]

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2ZA) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 5(6).

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if –

(a) the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with their consent in relation to the goods or services for which it is registered-

(i) within the period of 5 years ending with the date of application for the declaration, and

(ii) within the period of 5 years ending with the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application where, at that date, the five year period within which the earlier trade mark should have been put to genuine use as provided in section 46(1)(a) has expired, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) For these purposes –

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(2D)-(2DA) [Repealed]

(2E) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c)

(2G) An application for a declaration of invalidity on the basis of an earlier trade mark must be refused if it would have been refused, for any of the reasons set out in subsection (2H), had the application for the declaration been made on the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application.

(2H) The reasons referred to in subsection (2G) are-

(a) that on the date in question the earlier trade mark was liable to be declared invalid by virtue of section 3(1)(b), (c) or (d), (and had not yet acquired a distinctive character as mentioned in the words after paragraph (d) in section 3(1));

(b) that the application for a declaration of invalidity is based on section 5(2) and the earlier trade mark had not yet become sufficiently distinctive to support a finding of likelihood of confusion within the meaning of section 5(2);

(c) that the application for a declaration of invalidity is based on section 5(3)(a) and the earlier trade mark had not yet acquired a reputation within the meaning of section 5(3).

(3) [...]

(4) [...]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed.”

Section 5(2)(b)

14. 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”.

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 Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles:

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

Proof of use

16. I will begin by assessing whether there has been genuine use of the earlier mark.

17. Section 100 of the Act states that:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

18. Pursuant to section 47(2B) of the Act, there are two relevant periods for assessing whether genuine use has been made of the earlier mark. The first is the 5-year period ending with the filing date of the proprietor’s mark, so this will be 30 June 2014 - 1 July 2019. The second is the 5-year period ending with the filing date of the TM26(I) form by the applicant. This will therefore be 9 February 2016- 10 February 2021.

Relevant case law

19. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to genuine use as follows:

“114.....The Court of Justice of the European Union (“CJEU”) has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

- (1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].
- (2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].
- (3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the

goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23];

Sunrider at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

20. An assessment of genuine use is a global assessment, which includes looking at the evidential picture, not whether each individual piece of evidence shows use by itself.¹

21. As indicated in the case law cited above, use does not need to be quantitatively significant in order to be genuine. The assessment must take into account a number of factors in order to ascertain whether there has been real commercial exploitation of the mark which can be regarded as “warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark”.

Variant use

22. Before I move on to assess if the applicant has shown genuine use, I must first consider if I find the use of the mark as shown in the evidence to be use of the mark as registered. In *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, Phillip

¹ See *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

Johnson, sitting as the Appointed Person, considered the correct approach to the test under s. 46(2). He said:

“13. [...] While the law has developed since *Nirvana* [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EU*IPO*, EU:T:2020:22, [63 and 64]).

14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable variant and the following appear relevant to this case.

15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hypen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17 *M & K v EUIPO*, EU:T:2018:683, [41]. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.

16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 *Fashioneast v AM.VI. Srl*, EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no reason to disagree with it). Fourthly, the addition of descriptive or suggestive words (or it is suppose figurative elements) is unlikely to change the distinctive character of the mark: compare, T-258/13 *Arktis*, EU:T:2015:207, [27] (ARKTIS registered and use of ARKTIS LINE sufficient) and T-209/09 *Alder*, EU:T:2011:169, [58] (HALDER registered and use of HALDER I, HALDER II etc sufficient) with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).

17. It is also worth highlighting the recent case of T-615/20 *Mood Media v EUIPO*, EU:T:2022:109 where the General Court was considering whether the use of various marks amounted to the use of the registered mark MOOD MEDIA. It took the view that the omission of the word “MEDIA” would affect the distinctive character of the mark (see [61 and 62]) because MOOD and MEDIA were in combination weakly distinctive, and the word MOOD alone was less distinctive still”.

23. The applicant’s registration is for the word mark SAVAGE however, the majority of the evidence displays the mark SAVAGE LONDON in various stylised fonts, or the figurative marks shown below:



(ii)

24. In respect of the first variant, I acknowledge that where a registered mark is used as part of another mark or with additional matter, this may still constitute use of an acceptable variant of the mark as registered, where this element continues to act independently as an indicator of origin.²



² *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12

range of standard fonts. Consequently, I am of the view that this falls within normal and fair use of the mark as registered and the average consumer is still likely to perceive SAVAGE as indicative of the origin of the goods in question. The use of the additional elements does not alter the distinctive character of the registered mark, so I find the use above to be use of an acceptable variant of the applicant's mark.

25. Turning to the second variant, again for my reasons outlined above, I consider that the additional figurative and word elements do not alter the distinctive character. The elongation of the tail to the letter "g" is a modification to the original mark itself however, the word will still clearly be seen by the consumer as SAVAGE and therefore I do not find that it alters the distinctive character of the mark. I therefore find this to also be an acceptable variant of the applicant's mark.

Use of the mark

26. In his witness statement, Mr. Savage explains that he has been designing, manufacturing and selling clothing, bags and accessories under the trade mark SAVAGE since 1999.³

27. Mr. Savage goes on to state that his business has operated from a retail store located in London since 2013. Prior to this, he operated retail outlets in various locations throughout London from 1999 and in addition to the retail outlets, the applicant sells their goods via their website www.savagelondon.com which was registered on 12 October 1999.⁴

28. Turnover figures have been provided from the years 2015 to 2020 and are as follows:

Year	Total Turnover (£)
2015	45,300
2016	42,665

³ See para 2 of the witness statement of Kaveh Savage

⁴ See paras 2 and 3 of the witness statement of Kaveh Savage

2017	68,915
2018	94,400
2019	135,500
2020	83,750

29. Exhibit KS1 contains images of the applicant's current retail outlet which are said to have been taken in 2019.⁵ Goods such as tops, bags and caps can be seen on display with the word SAVAGE printed on them in a stylised font. Examples of which are shown below:



⁵ See para 5 of the witness statement of Kaveh Savage



30. Printed extracts of the applicant's website www.savagelondon.com



31. Exhibits KS4-8 contain a selection of invoices from the years 2016 to 2020 for bags and tops addressed to areas in the UK and countries within the EU. The marks as shown in paragraph 23 of this decision appear on each of the invoices.



34. Images from various magazines are shown in Exhibits KS19 such as ES Magazine (December 2000), Bliss (undated) and More! (August 1999). I note however that these examples (not including the Savage blog post dated 2016) pre-date both the relevant five-year periods during which the applicant is required to demonstrate genuine use.

Genuine Use

35. Considering the sum of the evidence, including the turnover between the years 2015 to 2020 and the use of the earlier mark shown in respect of various clothing items, on invoices and product packaging, it is my view that the applicant has made use of the mark within both relevant periods. At this point, I recognise that a number of the invoices provided are addressed to European countries however, based on the

number of UK invoices and the remainder of the evidence showing use within the UK, it is reasonable to assume that at least a reasonable portion of the use relates to UK consumers. Again, with consideration of the evidence, it is my view particularly with reference to the consistent sales figures over the last five years, the use made by the applicant does not appear to be token, solely for the purpose of preserving the rights conferred by the registration of the applicant's mark. Rather, I find the use to be for the purpose of creating and preserving a share of the market within the relevant territory for the goods for which it is registered. As such, I find that there is genuine use of this mark in relation to the goods protected by the applicant in classes 18 and 25.

Fair Specification

36. I now need to consider what constitutes a fair specification for the first earlier mark, having regard for the services upon which genuine use has been shown. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

37. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows:

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require

amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

38. The applicant's registration covers goods in classes 18 and 25 in relation to *Bags; Headgear; Tops as clothing*. I consider the use shown covers extensive evidence of sales of t-shirts, hoodies, caps and bags as shown in the invoices and sales records all dated within both relevant periods and within the relevant territory. As such, find that the use shown warrants protection for *Bags; Headgear; Tops as clothing* and I will assess the grounds under section 5(2)(b) based on that specification.

Comparison of Goods

39. 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".

40. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services;
- c) The respective trade channels through which the goods or services reach the market;
- d) 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;

e) 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.

41. The General Court (“GC”) confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, that, even if goods are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

“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”.

42. For the purposes of considering the issue of similarity of goods or services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux- Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

43. The goods to be compared are as follows:

Applicant’s Goods	Proprietor’s Goods
Class 18: Bags	Class 18: Luggage, bags, wallets and other carriers.
Class 25: Headgear; tops as clothing.	Class 25: Clothing; Footwear; Headgear.

44. In its counterstatement, the proprietor states, “In particular, the high degree of stylisation in the defendant’s mark as well as the different channels of trade and different target consumer markets, enables the relevant public to distinguish the marks and so to avoid confusion.”

45. The proprietor has applied for and gained protection for its mark in respect of goods in classes 18 and 25, including those such as ‘clothing’ generally. It has not, within the specification of goods for which it has achieved protection, limited these to goods for a particular audience or gender. It is well established that it is the goods for which the proprietors mark has been registered that I must consider within these proceedings, and not those goods which the proprietor has, to date, decided to use its mark. Similarly, any targeted marketing (gendered or otherwise) that has been carried out by the proprietor is also irrelevant to the comparison of goods (or otherwise) in these proceedings. In *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P, the Court of Justice of the European Union stated that:

“59. As regards the fact that the particular circumstances in which the goods in question were marketed were not taken into account, the Court of First Instance was fully entitled to hold that, since these may vary in time and depending on the wishes of the proprietors of the opposing marks, it is inappropriate to take those circumstances into account in the prospective analysis of the likelihood of confusion between those marks.”

46. With consideration to the above, I find that the proprietor’s comments on this subject are of no relevance to the comparison of the goods.

Class 18 Goods

47. The term *bags* appear identically in both the applicant’s and proprietor’s specification.

48. *Luggage and other carriers* in the proprietor’s specification will overlap in terms of nature, method of use, users and trade channels with the applicant’s *bags*. I also consider there may be a degree of competition and overall, I find there is a high degree of similarity between these goods.

49. I find the proprietor's *wallets* differ in terms of physical nature compared to the applicant's *bags*, however there would be an overlap in users and trade channels with the goods likely being sold by the same entities and sold next to one another in retail outlets. There is a broad overlap of purpose insofar as the respective goods are used for the purpose of storing goods however the exact purpose (storing money) differs. I do not consider there to be a degree of competition or complementarity between these goods and as such, I consider there to be no more than a medium degree of similarity between these goods.

Class 25 Goods

50. The applicant's term *tops as clothing* is encompassed by the proprietor's term *clothing*. They are therefore identical in line with *Meric*.

51. The term *headgear* is covered by both specifications and is clearly identical.

52. I now compare the proprietor's *footwear* to *tops as clothing* covered by the applicant's specification. I find that the nature of these goods differs, however the broader intended purpose, namely for wearing on the body for comfort, protection from the elements or modesty, will be shared. I also consider there will be an overlap in users to the extent that the goods are intended for the general public at large. There will also be an overlap in trade channels with the respective goods often being offered by the same entities. I am not convinced however that there will be any degree of competition between these goods. Overall, I consider there to be a medium degree of similarity.

The average consumer and the nature of the purchasing act

53. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' services. I must then determine the manner in which the services are likely to be selected by the average consumer. 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.”

54. The average consumer for the parties’ goods will be a member of the general public. The goods may vary in price, but none are likely to be prohibitively expensive and all will be purchased reasonably frequently. Even where the cost of the goods is low, various factors will be considered such as aesthetics, durability, and material. Taking all of this into consideration, I consider it likely that a medium degree of attention will be paid during the purchasing process.

55. The goods are likely to be self-selected from the shelves of a retail outlet or their online or catalogue equivalent. Visual considerations are, therefore, likely to dominate the selection process. However, given that advice may be sought from retail assistants, I do not discount an aural component to the purchase.

Comparison of marks

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

“...it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relevant 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.”

57. It would be wrong, therefore, to dissect the trade marks artificially, although it is necessary to take into account the distinctive and dominant components of the trade 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.

58. The marks to be compared are as follows:

Applicant's Mark	Proprietor's Mark
SAVAGE	 The word 'SAVAGE' is rendered in a bold, black, stylized typeface. The letters are thick and blocky, with sharp, pointed serifs. The 'S' and 'G' have particularly dramatic, angular shapes. The overall appearance is aggressive and modern.

59. The applicant's mark consists of the word SAVAGE. There are no other additional elements to contribute to the overall impression which resides in the mark as a whole.

60. The proprietor's mark consists of the word SAVAGE in a stylised typeface. I consider the wording to have a greater impact on the overall impression of the mark. Although the stylistic aspects of the mark will not be ignored, they make a smaller contribution to the overall impression.

Visual comparison

61. The marks both contain the word SAVAGE with the only point of visual difference being the proprietor's use of a stylised font. In their counterstatement the proprietor contests that the high degree of stylisation in their mark distinguishes it from that of the applicant's. I find however that through fair and notional use, the earlier mark may be used in any standard font, and therefore even if the stylisation of the contested mark falls outside of the fair and notional use, the contested mark may still be used in a bold font and so the stylisation adds only a small visual difference at best. Overall, I find the marks to be visually similar to a very high degree.

Aural comparison

62. Both marks will be given the ordinary English pronunciation of SAVAGE. There are no other additional verbal elements, rendering the marks aurally identical.

Conceptual comparison

63. The cancellation applicant submits that the term SAVAGE is defined as a noun being 'a brutal or vicious person' or as an adjective meaning fierce, violent and uncontrolled.⁶ I agree that the average consumer will perceive the word SAVAGE in line with one of these definitions submitted by the cancellation applicant and this is true of both marks. I do not find that the average consumer will attribute any meaning to the stylisation of the proprietor's mark and therefore I consider the marks to be conceptually identical.

Distinctive character of the earlier mark

64. 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

⁶ Paragraph 10 of the cancellation applicant's submissions in lieu

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. In *Lloyd Schuhfabrik*, 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).”

65. Registered trade marks possess varying 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 which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

66. I will begin by initially assessing the inherent distinctiveness of the applicant’s mark.

67. The applicant's mark consists solely of the word SAVAGE, a standard dictionary word which is neither descriptive nor allusive to the goods at issue. I find it holds a medium degree of inherent distinctiveness.

68. I now turn to consider whether the distinctiveness of the applicant's mark has been enhanced through use. When considering whether the distinctiveness of a trade mark has been enhanced through use, it is the perception of the UK consumer at the relevant dates that is key.

69. In the witness statement of Mr. Savage, it is claimed that the applicant's mark has been in use since 1999 with the earliest use of the mark shown in an excerpt from "More!" magazine dated between July and August 1999.

70. The applicant has not disclosed the UK market share held by their mark nor have they provided any figures relating to advertising expenditure. Previously however, in paragraph 27 of this decision, I outlined the applicant's turnover figures from 2015 to 2020. Whilst the figures are not insignificant, when considering these figures in relation to the scope of the fashion industry in the UK, it would be reasonable to assume that opponent holds only a minimal amount of the UK market share.

71. As outlined previously, Exhibit KS19 shows the applicant's mark being used in the publications "Bliss" (undated), "More!" (July-August 1999), "ES Magazine" (December 2000) and the applicant's own online "Savage London" blog (July 2016). It is not clear how widely these publications were circulated in the UK. The applicant has also provided printouts from their social media pages including Instagram, Facebook and Twitter.⁷ The Facebook page was created on 20 July 2009. There are 1,276 likes for the Facebook page. Some of the posts date to 2018. The Instagram account has 175 followers. The posts date between 2013 – 2018. The Twitter account created in 2009 has 888 followers. The tweets filed in evidence appear to have been made in 2018 and 2019. It is unclear however, as to what proportion of the opponent's followers and interactions are from the relevant UK public.

⁷ See Exhibits KS15-17

72. Overall, from the evidence provided by the applicant, I do not consider that the evidence provided by the applicant is sufficient to show that the distinctiveness of their earlier mark has been enhanced through use.

Likelihood of confusion

73. There is no simple formula for determining whether there is a likelihood of confusion. I must make a global assessment of the competing factors (*Sabel* at [22]), keeping in mind the interdependency between them (*Canon* at [17]) and considering the various factors from the perspective of the average consumer. In making my assessment, I must bear in mind 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 (*Lloyd Schuhfabrik* at [26]).

74. 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.

75. Earlier in my decision, I found the similarity of the respective goods to range from no more than medium to identical. I identified the average consumer to be a member of the general public with the goods being purchased predominantly by visual means, though I do not discount an aural element to the purchase. I also concluded that a medium degree of attention will be paid during the purchasing process.

76. I found the respective marks to be visually similar to a very high degree and aurally and conceptually identical. I also found the earlier mark to have a medium level of inherent distinctive character as a whole in respect of its registered goods however, the distinctiveness of the mark has not been enhanced through the use made of it.

77. The respective marks consist of the same word (SAVAGE), and I consider that the stylisation of the proprietor's mark creates only a small point of visual difference. I find the average consumer of medium attentiveness may not recall the minor difference between the marks, leading them to confuse one mark for the other. Considering the above factors and with consideration to the consumers' imperfect recollection, I conclude that given the very high similarity between the marks and the level of similarity between the respective goods, there is a likelihood of direct confusion.

78. I now go on to consider indirect confusion.

79. 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.

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.)

80. These examples are not exhaustive but provide helpful focus.

81. I note that the two marks do not appear to fall into one of the categories highlighted in *L.A. Sugar*. However, I note that these categories are not exhaustive, and so I consider again all of the factors I have found within this decision. If I am wrong on my finding of direct confusion and the average consumer notices the differences between the mark, I am of the view that they will recognise that the dominant and distinctive SAVAGE element of the applicant’s mark is wholly reproduced within the proprietor’s mark. The differences are such that reproduction of the applicant’s mark with no other additional elements apart from a stylised font is likely to result in the relevant consumer believing that the same economic undertaking is responsible for offering the goods under slightly different versions of their mark. Consequently, I consider there to be a likelihood of indirect confusion.

Conclusion

82. The application for invalidation succeeds under Section 5(2)(b) of the Act in respect of all of the goods as registered, and subject to a successful appeal, the UK mark 918089895 will be invalidated in its entirety.

COSTS

83. The applicant has been successful and is entitled to a contribution towards its costs. Awards of costs in proceedings commenced after 1 July 2016 are governed by Annex A of Tribunal Practice Notice (‘TPN’) 2 of 2016. Using that TPN as a guide, I

award the applicant the sum of £1200 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Official fee:	£200
Preparing a statement and considering the other side's statement:	£200
Preparing and filing evidence:	£500
Preparing written submissions:	£300

84. I therefore order Posturopa to pay the sum of £1200 to Kaveh Savage. 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 21st day of November 2022

Catrin Williams
For the Registrar