

O/1109/22

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION  
NO. 03578437 BY  
JAMES SALON & BARBER LTD  
TO REGISTER AS A TRADE MARK:



IN CLASSES 3 & 25

AND

OPPOSITION THERETO  
UNDER NO. 426642 BY  
UNCOMMON LIMITED

## Background & Pleadings

1. James Salon & Barber LTD (“**the applicant**”), applied to register the trade mark shown on the front page of this decision in the United Kingdom. The application was filed 13 January 2021 and was published on 4 June 2021. For the purposes of this opposition the relevant goods in the specification are:

**Class 25:** Shoes; Jackets; Jeans; Tank-tops; Bathing costumes; Camouflage jackets; Camouflage pants; Camouflage shirts; Casual clothing; Casual footwear; Casual jackets; Casual shirts; Clothing; Clothing for children.

2. Uncommon Limited (“**the opponent**”) opposes the application on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (“**the Act**”). The opponent is the proprietor of the following UK registration number 3541985 for the following series of two marks:

The image shows two instances of the 'Uncommon' trade mark. The word 'Uncommon' is written in a stylized, cursive script with a white fill and a black outline. The two instances are positioned side-by-side, with the second one slightly offset to the right and upwards from the first.

**Class 25:** Clothing, footwear and headwear in relation to Motorsport, Automotive, Team sport, Health and Fitness, and Corporate wear.

**Class 35:** Retail services in relation to clothing, footwear and headwear; wholesale services of clothing, footwear and headwear; Distribution of promotional goods namely clothing, footwear and headwear.

**Class 42:** Design of clothing, footwear, headgear.

4. Under Section 6(1) of the Act, the opponent's series of two trade marks clearly qualifies as earlier trade marks. Further, as the registration of the opponent's series of two marks was completed less than five years before the application date of the contested mark, proof of use is not relevant in these proceedings as per Section 6A of the Act.
5. The opponent, in its notice of opposition, claims that:

“The earlier mark consists of the word UNCOMMON in a basic stylisation. The opposed mark consists of the word UNCOMMON, also in a basic stylisation, with the letters J, S and B, which could be read as JSB or SJB, along with a small device element. The opposed mark, therefore, contains the earlier mark in its entirety. Furthermore, the UNCOMMON element appears at the beginning of the opposed mark, being the most prominent part, and it is the largest and most dominant element of the mark. This will be the part of the mark which is remembered by consumers and when using the mark verbally, they are likely to drop the JSB or SJB element and just refer to the mark as 'UNCOMMON', particularly as the Applicant itself often uses the mark without the JSB element. Furthermore, as UNCOMMON JSB/SJB is a bit of a mouthful and consumers can be lazy and it is likely that the UNCOMMON element that will be the part of the mark that is remembered and used.”

Further, it contends that the contested goods in Class 25 are identical to the opponent's goods in the same Class and “confusingly” similar to the opponent's services in Classes 35 and 42.

6. The applicant filed a defence stating in its counterstatement that:

“The common feature of both trademarks is the word "uncommon" There is a clear difference between the image and the stylization of the word "uncommon", Furthermore, the opposed trademark contains additional features consisting of the letters "J", "S" and "B"” .

7. Moreover, the applicant does not explicitly deny identity or similarity between the competing goods/services apart from the term “*Clothing*” in Class 25 for which it admits that it is “common” in the competing specifications. I will return to this point later in my decision.
8. None of the parties filed evidence or submissions.
9. No request for a hearing was made. Thus, this decision has been taken following a careful consideration of the papers.
10. In these proceedings, the opponent is represented by Vault IP Ltd and the applicant is a litigant-in-person.
11. Although the UK has left the EU, Section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

## **Decision**

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

12. Sections 5(2)(b) of the Act are 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”.

13. The principles, considered in this opposition, stem from the decisions of the European 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 BV* (Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (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-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):

- 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 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**

### *Clothing*

14. The applicant, in its notice of defence, admits that the term "*Clothing*" is common in the competing specifications. Given the applicant's admission, there is nothing for me to decide. In any case, I should highlight that the competing terms are identically worded, and, thus, they are identical.

Jackets; Jeans; Tank-tops; Camouflage jackets; Camouflage pants; Camouflage shirts; Casual clothing; Casual jackets; Casual shirts; Clothing for children.

15. The General Court (GC) confirmed in *Gérard Meric v OHIM*, Case T-133/05, paragraph 29, that, even if goods or services are not worded identically, they can still be considered identical if one term falls within the scope of another, or vice versa:

“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”.

16. The earlier term “*Clothing*” is a broad term to encompass the narrower terms of the applicant in the same Class. In this regard and based on the *Meric* principle, the respective goods are identical.

### **Average Consumer and the Purchasing Act**

17. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purposes of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods and services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. In *Hearst Holdings & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), at paragraph 70, Birss J (as he then was) described the average consumer in these terms:

“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 word ‘average’ denotes that the person is typical. The term ‘average’ does not denote some form of numerical mean, mode or median.”

18. The goods at issue will be purchased by members of the general public. Such goods are usually offered for sale in stores, such as retail outlets, brochures and catalogues, and online. In retail premises, the goods will be displayed on shelves and racks, where they will be viewed and self-selected by consumers. Similarly, for online stores, consumers will select the goods relying on the images displayed on the relevant web pages. Nevertheless, the selection process may involve aural considerations, as advice may be sought from a sales assistant or representative. Therefore, visual considerations will dominate the selection of the goods in question, but aural considerations will not be ignored in the assessment.<sup>1</sup> Even for those at the inexpensive end of the scale, the average consumer may examine the products to ensure that they select the correct type, size, material, quality, and aesthetic appearance of, for example, clothing items. Thus, the average consumer will pay an average degree of attention.

### **Comparison of Trade Marks**

19. 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

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<sup>1</sup> The GC highlighted this in *New Look Ltd v OHIM Cases T-117/03 to T-119/03 and T-171/03*, at paragraph 50:

“Generally, in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly, the visual aspect plays a greater role in the global assessment of the likelihood of confusion.”





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*, 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.”

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

21. The marks to be compared are:

Opponent's Series of Two Marks	Applicant's Mark
	

Overall Impression

22. The contested mark consists of the word element “UNCOMMON”, slightly stylised, in white upper case font and standard typeface with a grunge effect, i.e. a random texture with a rugged look, against a black background. On the left, there is a vertical white line separating the word “UNCOMMON” and the letters ‘S’, ‘J’, and ‘B’ (from left to right), appearing

smaller in size while sitting inside a grey 'X' device. Underneath the letter 'J', there is the figurative element of the transgender symbol in white, which will be suggestive that the goods are appropriate for any gender. I consider that the word element "UNCOMMON" will be the dominant element having the greatest weight in the overall impression due to its size and position in the mark. Given that the UK average consumer reads from left to right, the verbal elements 'S', 'J', and 'B' and the transgender symbol device, which is suggestive of the goods, will contribute to the overall impression, but less weight will be afforded to them. I do not consider that the figurative lines will play any role in the overall impression as they will be ignored by the average consumer.

23. The series of two earlier marks consists of the word element "Uncommon", appearing highly stylised in a handwritten script in white and black version. The overall impression resides in the verbal element of the marks, whilst I note that the white version has a dropped shadow outline which cannot be seen in the black version.

### Visual Comparison

24. The competing marks share the same word, 'uncommon', in a white font but in different stylisations, namely handwritten stylised script v a standard one with a grunge effect. Another point of visual difference is the presence of the additional verbal elements 'S', 'J', and 'B' and the figurative element of the transgender symbol in the contested mark. I note that these diverging elements appear smaller in size and in a position which is generally considered to have less impact due to consumers in the UK reading from left to right.<sup>2</sup> Taking into account the overall impression of the marks and the similarities and differences, I consider that the degree of visual similarity is lower than a medium degree.

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<sup>2</sup> See *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02.

### Aural Comparison

25. The competing marks share the same word element, “UHN-KOM-UHN”, with the same number of syllables. The presence of the additional verbal elements ‘S’, ‘J’, and ‘B’ in the contested mark, which have less weight in the overall impression, create an aural difference in the case where the average consumer attempts to verbalise them. However, I do not consider that the figurative elements, including the transgender symbol, in the contested mark will be articulated. Thus, I find that the marks are aurally similar to a high degree (though similar to a medium degree where the letters “‘S’, ‘J’, and ‘B’” are spoken).

### Conceptual Comparison

26. The UK average consumer will immediately understand the common and well-known word ‘uncommon’ in the competing marks, which will be perceived as something rare or unusual. In the absence of evidence, I consider that the verbal elements ‘S’, ‘J’, and ‘B’ will be perceived as such without further meaning. Further, the transgender symbol device will introduce the additional concept of gender inclusivity, which may suggest that the given goods are unisex. Despite the added concepts and considering all the factors and the points of the overall impression, I consider there to be a high degree of similarity between the competing marks on a conceptual level.

### **Distinctive Character of the Earlier Trade Mark**

27. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, paragraph 22 and 23, the CJEU stated that:

“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).

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).”

28. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.
29. The opponent did not file evidence and so I only need consider the inherent distinctiveness of the earlier mark. The earlier mark consists of the word element “Uncommon”, which is a dictionary word with the meaning that I have identified earlier in this decision. The average consumer will be familiar with this ordinary term and potentially might attribute a very mild allusive quality to the mark, that of rarity. However, the allusion is quite mild, and I still regard the inherent distinctiveness of the mark to be of a medium degree, boosted slightly by the stylisation of the word.

## Likelihood of Confusion

30. In assessing the likelihood of confusion, I must adopt the global approach set out in the case law to which I have already referred above in this decision. Such a global assessment is not a mechanical exercise. I must also have regard to the interdependency principle, that 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.<sup>3</sup> It is essential to keep in mind the distinctive character of the opponent's trade mark since the more distinctive the trade mark, the greater the likelihood of confusion. I must also keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon imperfect recollection.<sup>4</sup>
31. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. Indirect confusion is where the consumer notices the differences between the marks but concludes that the later mark is another brand of the owner of the earlier mark or a related undertaking.
32. In *L.A. Sugar Limited v Back Beat Inc*, Case BL O/375/10, Iain Purvis Q.C., sitting 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

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<sup>3</sup> See *Canon Kabushiki Kaisha*, paragraph 17.

<sup>4</sup> See *Lloyd Schuhfabrik Meyer*, paragraph 27.

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.”

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

34. Earlier in this decision I have concluded that:

- the competing goods at issue are identical;
- the average consumer for the goods at issue will be a member of the general public, and the selection process is predominantly visual without discounting aural considerations. The average consumer may examine the products to ensure that they select the correct type, quality, size and/or aesthetic appearance. The level of attention paid will be average;
- the competing marks are similar visually to a lower than medium degree, aurally to a high degree (though similar to a medium degree where the letters “S”, ‘J’, and ‘B’” are spoken), and conceptually to a high degree;
- the earlier mark has a medium degree of inherent distinctiveness, boosted slightly by the stylisation of the word.

35. Taking into account the above factors and considering the identical goods in play, there is likelihood of direct confusion. The difference in the stylisation of the competing marks is insufficient to allow the average consumer to distinguish between them. The presence/absence of the figurative and verbal elements, including the letters 'S', 'J', and 'B', in the contested mark may well be lost due to the principle of imperfect recollection because of their position at the end of the mark, which is considered less impactful. Put simply, both marks are 'uncommon' marks, and it is this that the average consumer will have in mind. When they encounter one mark for clothing goods and then encounter another 'uncommon' mark for identical goods, they will simply be mistaken that the goods originate from the same undertaking.
36. Even when the average consumer recalls that one mark has a different stylisation from the other and that it contains additional verbal and figurative elements and the other does not, I still consider that the marks would be indirectly confused for identical goods. This is because both marks contain the identically shared word element, 'uncommon', which is the dominant element in both marks with the greatest weight in the overall impression. Thus, it will not go unnoticed, with the figurative elements being imperfectly recalled and the difference in the stylisation put down to the use of a brand/sub-brand variant.

### **Outcome**

37. The opposition under Section 5(2)(b) of the Act is **successful in its entirety**. Therefore, subject to appeal, the application will be refused.

### **Costs**

38. The opponent has been successful and is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 2/2016. I award costs to the opponent as a contribution towards the cost of the proceedings on the following basis:

Preparing and filing a notice of opposition	<b>£200</b>
Opposition fee	<b>£100</b>
Total	<b>£300</b>

39. I, therefore, order James Salon & Barber LTD to pay Uncommon Limited the sum of £300. 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 15<sup>th</sup> day of December 2022**

**Dr Stylianos Alexandridis**  
**For the Registrar,**  
**The Comptroller General**