

O/0122/23

TRADE MARKS ACT 1994

**IN THE MATTER OF
TRADE MARK APPLICATION NO. UK00003684564
BY SISTERS & SEEKERS LIMITED
TO REGISTER:**

BROTHER AND KIN

**AS A TRADE MARK
IN CLASSES 25 & 35**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 429630
BY JOHN LEWIS PLC**

BACKGROUND AND PLEADINGS

1. Sisters & Seekers Limited (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK on 21 August 2021. The application was accepted and published in the Trade Marks Journal on 24 September 2021 in respect of the following goods and services:

Class 25: *Clothing, footwear and headgear.*

Class 35: *Retail services relating to clothing, footwear and headgear.*

2. On 21 December 2021, John Lewis Plc (“the opponent”) filed a notice of opposition on the basis of sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”).¹ The opposition is directed at the applicant’s mark in its entirety. The opponent relies on the following trade mark:

KIN

UK registration no. UK00002503044

Filing date 21 November 2008; date of entry in register 1 May 2009.

Relying on the following goods:

(“the opponent’s mark”)

Class 25: *footwear / clothing*

3. The opponent submits that there is a likelihood of confusion because the applicant’s mark is similar to its own mark and the respective goods and services are identical or similar. The applicant filed a defence and counterstatement denying the claims made.

4. The opponent is represented by Lewis Silkin LLP; the applicant is represented by Francis McEntegart. Neither party filed evidence or submissions. No hearing was requested. Only the opponent filed submissions in lieu of a hearing. This decision is taken following a careful perusal of the papers. I do not intend to summarise the

¹ The opponent did not file evidence in support of its 5(3) ground of opposition. As a result, on 12 July 2022, the Registry informed the opponent that its 5(3) ground will be deemed withdrawn. The decision to strike out the 5(3) ground was confirmed in an official letter dated 26 October 2022.

submissions in lieu. However, I have taken them into consideration in reaching my decision and will refer to them below, where necessary.

5. 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.

Section 5(2)(b): legislation and case law

6. Section 5(2)(b) of the Act reads as follows:

“(2) A trade mark shall not be registered if because- (a) ...

(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 or association with the earlier trade mark.”

7. Section 5A of the Act is as follows:

“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.”

8. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“(6)(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for

registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

9. Given its filing date, the opponent’s mark qualifies as an earlier trade mark under the above provisions. The opponent’s mark completed its registration process more than five years before the application date of the applicant’s mark. The condition of use, therefore, applies to the mark. However, the applicant did not request proof of use. Therefore, the opponent can rely on all the goods in its mark.

10. 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:

(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 impression created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

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

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

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

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

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

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

COMPARISON OF THE GOODS AND SERVICES

11. The goods to be compared are as follows:

The applicant's goods and services	The opponent's goods
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<u>Class 25 Clothing, footwear and headgear.</u>	<u>Class 25 footwear / clothing</u>
<u>Class 35 Retail services relating to clothing, footwear and headgear.</u>	

12. Although I note the point made by the applicant that its goods are for sportswear and clothing for the young, trendy and active customer and would not target the same customer as the opponent, this does not assist the applicant. This is because I must consider notional and fair use of the opponent's mark across all segments of the markets for the goods and services for which they are registered. This means that the particular segment of the market in which the opponent has so far chosen to trade does not deprive the opponent's mark of the normal level of protection afforded to every registered trade mark. Consequently, I must include consideration of the likelihood of confusion if both parties decide to target the same segment of the market. Therefore, the applicant's statement that it intends to target a different market to that of the opponent is irrelevant.

13. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union ("CJEU") in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

"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".

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

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

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

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

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

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

15. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05, the General Court (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 the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

16. In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the GC held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

17. In *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services v goods. He said (at paragraph 9 of his judgment) that:

“9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent’s earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are ‘similar’ to goods are not clear cut.”

18. However, on the basis of the European courts’ judgments in *Sanco SA v OHIM*, and *Assembled Investments (Proprietary) Ltd v. OHIM*, upheld on appeal in *Waterford Wedgewood Pic v. Assembled Investments (Proprietary) Ltd*, Mr Hobbs Q.C. concluded that:

- i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer’s point of view, they are unlikely to be offered by one and the same undertaking;
- ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent’s goods and then to compare the opponent’s goods with the retail services covered by the applicant’s trade mark;
- iii) It is not permissible to treat a mark registered for ‘retail services for goods X’ as though the mark was registered for goods X;
- iv) The General Court’s findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party’s trade mark was registered (or proposed to be registered).

19. “*Clothing*” and “*footwear*” appear in both parties’ specifications and, therefore, are self-evidently identical.

20. “*Headgear*” in the applicant’s specification and “*clothing*” in the opponent’s specification are similar. The goods share the same purpose as they protect, cover and adorn the human body. The goods may also share the same nature. They are often found in the same retail outlets and target the same users. The goods also share trade channels as consumers looking for headgear will expect to find clothing in the same shop. Moreover, I note that many manufacturers and designers will produce and design both goods. It is not my view that the goods are complementary nor are they in competition. Taking all of the above into account, I find the goods to be similar to a high degree.

Class 35

21. As set out in the case law reproduced above, the GC has explained that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels and, therefore, similar to a degree. It is common for producers of various types of clothing products to also retail in those goods. For example, a manufacturer of clothing may operate its own retail stores that exclusively sell its goods. In addition, those goods may be listed for sale on the manufacturer’s website directly rather than via third party retailers. In my view, the average consumer will be aware of the complementary relationship between the producer of these types of goods and the retailing of the same. For the opponent’s goods in class 25 i.e. “*clothing*”, it follows that a medium degree of similarity exists between the opponent’s goods and the services in the applicant’s class 35 specification which relates to identical goods. I, therefore, find that “*retail services relating to clothing, footwear [...]*” in the applicant’s specification are similar to a medium degree with “*footwear/clothing*” contained in the opponent’s specification.

22. I note that in *Waterford Wedgwood Plc v. Assembled Investments*, Mr Hobbs K.C. concluded that *Oakley* did not mean that goods had to be the same as the goods being retailed by the services to find similarity. Bearing this in mind and applying the

same reasoning above, I find that there is similarity between the “*retail services relating to [...] headgear*” in the applicant’s specification and the opponent’s goods. I have found above in paragraph 20 that there is a high degree of similarity between the applicant’s services and “*clothing*” in the opponent’s specification. It is customary for retailers in the clothing sector to offer clothing and headgear in their stores, therefore, the goods and services share trade channels. In these circumstances, the applicant’s services may be important for the sale of the opponent’s goods. Therefore, it is plausible that the relevant public might believe that the undertaking which sells clothing under one trade mark is the same undertaking, or a connected undertaking, that provides retail services relating to headgear under the same or similar mark. Therefore, here is a degree of complementarity. I consider the applicant’s services and the opponent’s goods to be similar to a low to medium degree.

THE AVERAGE CONSUMER AND THE PURCHASING ACT

23. As the law above indicates, it is necessary for me to determine who the average consumer is for the parties’ goods and services. I must then determine the manner in which the goods and 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 F ox 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."

24. The average consumer for the goods at issue is the general public at large. The goods are most likely to be sold through a range of clothing retailers and their online or catalogue equivalents. In physical retail premises, the goods at issue will be displayed on shelves or racks, where they will be viewed and self-selected by the customer. A similar process will apply to websites and catalogues, where the

consumer will select the goods having viewed an image displayed on a webpage or in a catalogue. This means that the mark will be seen and so the visual element of the mark will be the most significant: see *New Look Limited v OHIM*, Joined cases T-117/03 to T-119/03 and T-171/03, paragraph 50. Visual considerations, therefore, dominate the selection process, although I do not discount an aural component playing a part. The price and frequency of the purchase of the goods at issue may vary. Even where the goods are of low cost and purchased relatively frequently, a number of factors will still be considered by the average consumer during the purchasing process. When selecting the goods at issue the average consumer may consider current fashion trends, price, quality and suitability. With this in mind, I consider that the average consumer will pay a medium degree of attention during the purchasing process.

25. Turning to the services, I find that members of the general public at large will be the average consumer of retail services. In relation to retail services, these are most likely to be selected after having considered the promotional material (in hard copy and online) and the signage appearing on the high street. For all the services at issue, visual considerations will be an important part of the selection process. Such services are also likely to be the subject of word-of-mouth recommendations meaning that aural considerations will not be an insignificant feature of the selection process. When selecting all the services at issue, the average consumer is likely to consider such things as stock, price of goods offered in comparison to other retailers, delivery method and experience/knowledge of the staff. I am of the view that the average consumer is likely to pay a medium degree of attention during the selection process for the services.

COMPARISON OF THE MARKS

26. The respective trade marks are shown below:

KIN	BROTHER AND KIN
The opponent's mark	The applicant's mark

27. 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 trade marks must be assessed by reference to all the overall

impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated, at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

28. 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.

29. I note in its submissions in lieu, the opponent submits that the word ‘KIN’ in the applicant’s mark plays an independent and distinctive role in the mark ‘BROTHER AND KIN’ with the words ‘BROTHER’ and ‘KIN’ sharing an equal weight in the level of distinctiveness in the marks. The opponent submits that the word ‘AND’ does nothing but to separate the words and does nothing to qualify the word ‘KIN’. I disagree with the opponent. The applicant’s mark consists of the words ‘BROTHER AND KIN’. The applicant’s mark is presented in standard typeface and upper case. It is my view that the average consumer will perceive that the distinctive character of the mark lies in the mark as a whole and there are no other elements that contribute to the overall impression of the mark. This is on the basis that the concept of brother and kin are similar and the average consumer is likely to perceive the mark as a phrase. I will discuss the concept in more detail below.

30. The opponent’s mark consists of the word ‘KIN’. The opponent’s mark is presented in standard typeface and upper case. There are no other elements that contribute to the overall impression of the mark.

31. Visually, the marks share the word ‘KIN’. ‘KIN’ is the entirety of the opponent’s mark and is the final word in the opponent’s mark. The points of difference between

the marks are the words 'BROTHER AND' that are present at the beginning of the opponent's mark. Consequently, I consider the marks to be visually similar to a low to medium degree.

32. Aurally, the applicant's mark will be pronounced as 'KIN' and the opponent's mark will be pronounced as 'BROTH-ER AND KIN'. I note that the marks share the pronunciation of 'KIN' and differ in the pronunciation of 'BROTH-ER AND' in the opponent's mark. Consequently, I consider the marks are aurally similar to a low to medium degree.

33. Conceptually, the applicant's mark will convey the concept of brother and familial relations. It is my view that the opponent's mark will convey the concept of familial relations. Whilst the marks share the concept of familial relations, the concept of brother specifically in the applicant's mark offers a point of conceptual difference. Taking this into account, I find the marks to be conceptually similar to a high degree.

THE DISTINCTIVE CHARACTER OF THE OPPONENT'S MARK

34. In *Lloyd Sohufabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

"22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49). 23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the

public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

35. Registered trade marks possess varying degrees of inherent distinctive character through use, ranging from the very low, because they are suggestive or allusive of a characteristic of the services, to those with a high inherent distinctive character, such as invented words which have no allusive qualities.

36. The opponent has not pleaded enhanced distinctive character through use and has not filed evidence to support such a claim, therefore, I have only the inherent position to consider.

37. The average consumer will apply the ordinary dictionary definition to the mark ‘KIN’. For the average consumer, the mark is neither descriptive nor allusive in relation to the goods at issue. While I accept the word ‘KIN’ is not descriptive, it is not, from a trade mark perspective, particularly remarkable. Therefore, I find the mark enjoys a medium degree of inherent distinctive character.

LIKELIHOOD OF CONFUSION

38. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. 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 services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier marks, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between

trade marks and must instead rely upon the imperfect picture of them that s/he has retained in his/her mind.

39. I have found the marks to be visually and aurally similar to a low to medium degree and conceptually similar to a high degree. I have identified the average consumer as the general public who will purchase/select the goods and services by visual means (although I do not discount an aural component). I have concluded that a medium degree of attention will be paid during the purchasing process. I have found the opponent's mark to be inherently distinctive to a medium degree. I have found the goods and services to vary from identical to similar to a low to medium degree.

40. Taking all the above and the principle of imperfect recollection into account, I do not consider that the average consumer is likely to misremember or mistakenly recall the marks for one another. I recognise that the marks share the same common element, being the word 'KIN', which is in favour of the opponent. Whilst I bear in mind that similar ends of marks may also be capable of giving rise to a likelihood of confusion,² and that it is the beginnings of marks where the average consumer tends to focus,³ (being where the point of difference between these marks lies) I consider that the presence of 'BROTHER AND' at the beginning of the mark will be sufficient to enable the consumer to differentiate between them. This will particularly be the case given the importance of the visual component in the selection of the goods and services at issue and bearing in mind that the average consumer will be paying a medium degree of attention when selecting the goods and services. Consequently, I do not consider there to be a likelihood of direct confusion between the marks.

41. It now falls to me to consider whether there is a likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C., sitting as the Appointed Person in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10.

"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

² *Bristol Global Co Ltd v EUIPO*, T-194/14

³ *El Corte Ingles, SA v OHIM*, Cases T-183/02 and T-184/02

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.). BL O/375/10 Page 15 of 16

(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).”

42. Whilst I note that the examples set out by Mr Purvis are not exhaustive, I note the recent case of *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors*,⁴ wherein Arnold LJ referred to the comments of James Mellor QC sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he stated that a finding of a likelihood of indirect confusion is not a consolation prize and that there

⁴ [2021] EWCA Civ 1207

needs to be a reasonably special set of circumstances in order for indirect confusion to arise where there is no likelihood on direct confusion. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

43. In the present case, the marks share the common element of ‘KIN’. I do not consider that the presence of the words ‘BROTHER AND’ at the beginning of the applicant’s mark will be sufficient enough for the average consumer to consider that the mark originates from a different or unconnected undertaking to that of the opponent. This is on the basis that the concept conveyed by ‘KIN’ of familial relations will only be altered slightly by the presence of ‘BROTHER AND’ in the applicant’s mark. It is not such that the average consumer would assume that another undertaking would be relying in the same concept as a trade mark, especially on identical goods. This is particularly the case given that the shared element has no obvious connection to the goods and services at issue to the point where it would be considered coincidental.

44. I consider that the differences between the marks, being ‘BROTHER AND’ at the beginning of the applicant’s mark may be indicative of a collaboration that the opponent’s brand is undertaking with a third party, be that of another brand, for example. In these circumstances, I consider that the average consumer would view the presence of ‘BROTHER AND’ alongside the common element ‘KIN’ to be indicative of a collaboration between two brands.⁵ In my view, this points to the marks coming from the same or economically linked undertakings. Consequently, I consider that there is a likelihood of indirect confusion between the marks, particularly given the identity and similarity of the goods and services at issue. It is my view that this finding extends to the services that I have found to be similar to a low to medium degree.

⁵ I note that in *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207 Arnold LJ commented on the *L.A Sugar* examples for a finding of a likelihood of confusion. He states at paragraph 12, “This is a helpful explanation of the concept of indirect confusion, which has frequently been cited subsequently, but as Mr Purvis made clear it was not intended to be an exhaustive definition. For example, one category of indirect confusion which is not mentioned is where the sign complained of incorporates the trade mark (or a similar sign) in such a way as to lead consumers to believe that the goods or services have been co-branded and thus that there is an economic link between the proprietor of the sign and the proprietor of the trade mark (such as through merger, acquisition or licensing).”

CONCLUSION

45. The opponent's 5(2)(b) ground succeeds in full. The application will, therefore, be refused for all goods and services for which registration is sought.

COSTS

46. The opponent has been successful, it is entitled to a contribution towards its costs based upon the scale published in the Tribunal Practice Notice 2/2016. Whilst I note that the opponent paid £200 for official fees, as the opposition was initially for grounds 5(2)(b) and 5(3), the 5(3) ground was struck out due to a lack of evidence being provided by the opponent. I do not intend to compensate the opponent fully for its official fees, as it was due to the opponent's lack of evidence that the section 5(3) opposition was not addressed in this decision. The costs award below has been amended to reflect this.

47. In the circumstances, I award the opponent the sum of £500 as a contribution towards its costs. The sum is calculated as follows:

Preparing a notice of opposition and considering the counterstatement	£200
Preparing submissions in lieu	£300
Official fees	£100

48. I, therefore, order Sisters & Seekers Limited to pay John Lewis Plc the sum of £600. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 3rd day of February 2023

A KLASS

For the registrar