

BL O/0402/25

IN THE MATTER OF THE TRADE MARKS ACT 1994 and
IN THE MATTER of Application no. UK00003772212 by Relande Barrett-Gordon to
register the trade mark INNOCENT CRIMINAL in Class 25 (Respondent) and
IN THE MATTER of Opposition thereto under no. 434950 by Criminal Clothing Limited
(Appellant) and
IN THE MATTER of an Appeal to the Appointed Person against decision no BL/O/1010/23

DECISION

INTRODUCTION

1. This appeal concerns the mark:

**INNOCENT
CRIMINAL**

which the applicant (respondent) has applied to register in Class 25 for clothes, clothing and a range of other specific clothing goods (“the Mark”).

2. The opponent (appellant) opposed the mark on the basis of its earlier trade mark registration for the word mark **CRIMINAL**, filed on 14 January 2022 and registered on 22 April 2022, inter alia in Class 25 in respect of Class 25 Clothing; Footwear; Headgear. The grounds relied on were sections 5(2)(b) and 5(3) of the Trade Marks Act 1994. The section 5(3) ground was subsequently withdrawn. There was no reliance on evidence of enhanced reputation based on use of the earlier mark.
3. In a decision dated 30 October 2023, the hearing officer concluded, in summary, that the marks were visually and aurally similar “to a medium degree”; that the marks were “conceptually similar to between a low and medium degree”; that the “opponent’s mark

[was] inherently distinctive to a medium degree”. The hearing officer identified the average consumer for the goods to be “the general public, who will select the goods primarily by visual means” without discounting an aural component and concluded that a medium degree of attention would be paid during the purchasing process for the goods. The goods were treated as identical. Taking these matters into consideration, the hearing officer held that there was no likelihood of confusion and allowed the mark to proceed to registration.

4. The appellant contends that the hearing officer was wrong in this conclusion for a number of reasons, each of which focusses on the presence in the Mark of the stylised word CRIMINAL. The appellant argues that the hearing officer should have held that, notwithstanding the presence of the word INNOCENT before the word CRIMINAL, the average consumer would perceive the mark as CRIMINAL in substance, mainly because the word INNOCENT appeared struck through in a stylised way. This contention runs through all of the appellant’s arguments both on the likelihood of direct and indirect confusion. The essence of the submission was that both of the marks are essentially CRIMINAL.

PROCEDURE

5. The appellant was represented by Mr Harris, an experienced trade mark attorney and the respondent represented himself (very competently in each case). However, because Mr Harris also sits part-time as an Appointed Person, an opportunity was given to the respondent to object to Mr Harris representing the appellant, in accordance with the relevant case law and practice. The respondent confirmed, in my view correctly, that this did not give rise to any issues in this case.
6. The hearing went ahead online without difficulty. In view of the imbalance in trade mark knowledge, prior to the hearing, the appellant was reminded of the duty to bring all relevant authorities (supportive or otherwise) to the attention of the tribunal in circumstances in which the unrepresented opponent may not be aware of them and that was done. Nonetheless in such situations, given the nature (and extent) of the case law in trade mark cases including on the likelihood of confusion where there are composite marks and the approach to consideration of the average consumer, I have considered it appropriate to calibrate this decision by reference to some of the case law (including

recent summaries from the Court of Appeal) not cited by either party and which might be said to provide support for one or the other side's position, in so far as relevant. None of these additional authorities seems to me to say anything different in substance from those cited at the hearing or in the hearing officer's decision or to be inconsistent with them. I asked for further submissions on one point by reference to an authority which I considered after the hearing on the approach which should be taken to the spectrum of consumers encompassed by the concept of the average consumer and I received helpful brief further written submissions.

STANDARD OF REVIEW ON APPEAL

7. The hearing officer's conclusion that there was no likelihood of confusion involved a multi-factorial evaluation. This tribunal can only intervene if the hearing officer erred in law or in principle (see for example: *Actavis Group PTC EHF v ICOS Corp* [\[2019\] UKSC 15](#), at [78]-[81] and *Lifestyle Equities CV v Amazon UK Services Ltd* [\[2024\] UKSC 8](#), at [46]-[50]). In particular, it is not sufficient for this tribunal to consider that it might have decided the matter differently. Cases of this kind involve the exercise of judgments on which, sometimes, reasonable people can differ but where the primary decision maker's conclusions are entitled to considerable respect.

LEGAL PRINCIPLES – GENERAL

8. There was no dispute as to the legal principles relevant to the evaluation of similarity and likelihood of confusion. The standard summary, expressed in terms referable to the registration context is as follows (see for example *Lifestyle Equities CV & Ors v Royal County of Berkshire Polo Club Ltd & Ors* [2024] EWCA Civ 814 at [11]):
 - "(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, in certain circumstances, be dominated by one or more of its components;
- (f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; and
- (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."

9. The issue on this appeal requires consideration of aspects (c), (d) and (e) of this formulation of the test, which focus on the significance of a common element in an otherwise composite mark and how that would be perceived by the average consumer. That in turn requires some consideration of the average consumer for the goods in question.

Average consumer - principles

10. As to the average consumer, the hearing officer said

“I must then determine the manner in which the goods 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.”

11. That approach, which focusses on the typical consumer was, in my view correctly taken by the hearing officer, and was not criticised by the appellant. However, given the arguments on this appeal and the concentration on how the Mark may be perceived by some, the following further points should also be borne in mind summarised in *ZOHARA/ZARA (Christies Trade Mark BL O-040-20; [2020] R.P.C. 8)* derived from a number of authorities on the likelihood of confusion:

“21. First, it is clear from the summary in *Comic Enterprises* and other cases that the average consumer provides a normative benchmark (to use the language of Arnold J in *Jack Wills v. House of Fraser* [2014] EWHC 110 (Ch) at [63]). Like a standard of negligence, it relies on an evaluation of what can reasonably be expected of a consumer, which may be informed by but is not determined by the responses of any given actual consumer.

22. Second, it is equally clear that the test of likelihood of confusion does not require evaluation of whether a statistical majority of actual consumers would in fact be confused. Equally, it does not require a quantitative assessment of

particular proportions of a notional or real population which would in fact be confused.

23. Third, it is implicit in the test that, given the diversity of consumers, in appropriate cases, a tribunal should take account of classes of consumer where they form substantial subgroups of consumers as a whole. There are numerous illustrations of this in the case law (see for example *Alcon v. OHIM* C-41/05 – where patients using the products as well as medical professionals ordering or supplying them were taken into account; *Schütz v. Delta* [2011] EWHC 1712 – where end users as well as tank fillers were considered). That is appropriate where it is possible to identify particular kinds of consumers with readily identifiable common characteristics which make confusion more (or sometimes less) likely for that group. In cases of that kind, the law is really saying that because a significant class of consumers of a particular kind to which the mark is specifically directed and whose interests are therefore particularly relevant are likely to be confused, taken as a whole there is a likelihood of confusion on the part of the notional average consumer even if consumers in other classes may not be. This issue is helpfully discussed, with reference to some of the difficulties in doing so practice in as a result of inhomogenous populations and diverse responses, in: Fhima and Gangee *The Confusion Test in European Trade Mark Law*, Oxford, 2019, Chapter 6, referred to in argument at the hearing.

24. Fourth, in order to evaluate whether confusion is likely, a tribunal may properly (and in many cases must) consider a range of situations in which the mark is likely to be encountered in use. Equally, a tribunal must consider the different ways in which the respective marks (and particularly the mark under challenge) may be perceived by consumers. In such case, that is often in part an exercise of imagination as much as anything else, since in proceedings before the Registrar evidence of actual consumer responses is often unavailable.

25. However, that cannot be taken too far: consideration of the range of responses does not require a microscopic analysis of the assumed characteristics of large numbers of possible individual consumers or possible kinds of situation in which the marks might be used. Moreover, it does it follow from the fact that it is possible to envisage situations in which confusion might arise in such imagined scenarios, that this suffices for a conclusion that confusion on the part of the average consumer is likely. Consideration must be given also to how

realistic or likely such situations are as well as how typical of the normal manner in which the marks in question would be encountered. The more remote such scenarios are from a situation in which a mark would normally be perceived or presented, having regard to the nature of the goods and the nature of the trade in them, the greater the caution that must be exercised before taking such into account and concluding that the statutory test is satisfied.”

12. It is important to have regard to the whole picture in determining the “typical” average consumer and in evaluating the likelihood of confusion, a tribunal is entitled to focus more on the typical part of the “spectrum of consumers” (to use the words of Birss J in *Thomas Pink v. Victoria’s Secret* [2014] EWHC 2631) and typical purchasing or advertising situations among the range of all situations in which the marks in question might be presented. The fact that it may be possible to imagine not wholly fanciful but outlier scenarios in which consumers may perceive given marks in a way which might give rise to confusion, does mean that there is automatically a likelihood of confusion (see *New Look v. OHIM* In Joined Cases T-117/03 to T-119/03 and T-171/03) at [49]-[50]).
13. It is, however, necessary to take the full spectrum into account. ignoring the outliers. I have also had regard in this connection to the observations of Arnold LJ in *Match Group, LLC & Ors v Muzmatch Ltd & Anor* [2023] EWCA Civ 454 at [31] that in considering the test for infringement:

“The point of assessment from the perspective of the average consumer is that one excludes from consideration those who are either ignorant or have specialist knowledge and those who are either careless or excessively careful, but otherwise one takes into account the characteristics of the relevant class of consumers. Such consumers are not an undifferentiated mass, but have the spread of relevant characteristics that human beings have. Moreover, it is sufficient to establish a likelihood of confusion that a significant proportion of the relevant class of consumers is likely to be confused even if many would not be: see *Interflora Inc v Marks & Spencer plc* [\[2014\] EWCA Civ 1403](#), [\[2015\] Bus LR 492](#) at [129] (Kitchin LJ giving the judgment of the Court of Appeal).

These observations are potentially relevant to this case because one aspect underlying the appellant's argument is that the hearing officer failed to consider possible scenarios in which, even if not intended, confusion was likely because of the way in which the Mark might be perceived by some members of the public. They do not detract from the general correctness of evaluating the marks from the perspective of a typical consumer but they do not mean that all consumers can be assumed to approach the marks in question in exactly the same way. When one is dealing with marks registered or proposed to be registered for goods for which the actual spectrum of real consumers is likely to be broad, a tribunal should ensure that it has considered whether its approach reflects that full spectrum but ignoring outliers. It is equally important, as the respondent submitted in its further submissions, not to adopt so cautious an approach to the possibility of confusion by a tiny proportion that, in substance, a decision is driven by the views of those who are likely to be outliers (see for example *Interflora Inc v. Marks & Spencer plc* [2014] EWCA Civ 1403 and the reference to a "significant proportion" of consumers). The boundary between these is not always easy to determine given the inhomogenous nature of real populations. A tribunal must take account of minority perception, if within the reasonable spectrum but a decision should not be based on speculation that a small or unrepresentative minority of outliers may view a mark in a given way or might be confused if they did.

THE DECISION

14. It is convenient to deal first with how the hearing officer addressed the case and then turn to the specific criticisms of it. The key aspect of the decision for the purpose of the appeal is the hearing officer's evaluation of the Mark. The hearing officer said:

“24. The opponent's mark consists of the word CRIMINAL. There are no other elements to contribute to the overall impression which lies in the word itself.

25. The applicant's mark consists of the words INNOCENT CRIMINAL written in a stylised capitalised typeface. For reasons I will come to discuss in the conceptual comparison, I consider that the words INNOCENT and CRIMINAL together play a greater role in the overall impression of the mark, with the stylisation (the typeface and line) playing a lesser role. The words INNOCENT and CRIMINAL do not dominate over each other; they play an equally dominant role.

26. Visually, the opponent's word mark, CRIMINAL, is replicated at the end of the applicant's mark. Both marks are also presented in capital letters. This acts as a point of visual similarity. However, the applicant's mark is presented in a

stylised font and begins with the 8 letter word INNOCENT, which has a line crossed through it. These act as points of visual difference. I note that the word INNOCENT is presented on top of the word CRIMINAL in the applicant's mark. It is therefore the first word that the average consumer will see and read, and therefore I consider that the principle that the average consumer tends to pay more attention to the beginning of the marks applies. Consequently, the marks are visually similar to a medium degree.

27. Aurally, the opponent's mark is likely to be pronounced as CRIM-IN-AL. The applicant's mark is likely to be pronounced as IN-OH-SENT CRIM-IN-AL. Consequently, the beginning of the marks differ aurally. However, as they overlap in the pronunciation of CRIMINAL, they are aurally similar to a medium degree.

28. Conceptually, the opponent contends that the INNOCENT element of the applicant's mark will not be perceived as the distinctive or dominant element of the mark, especially because "the inclusion of a single line through this word [INNOCENT] would lead to the relevant consumer believing that this element is to be disregarded". I disagree that this element would be disregarded by the average consumer.

29. As noted above, the INNOCENT element, albeit crossed out, still clearly contributes visually and aurally to the applicant's mark, and I also consider that it contributes to the conceptual message. It is clearly present at the beginning of the mark, and is presented in the same size as the word CRIMINAL directly below it. As noted above, the consumer tends to pay more attention to the beginning of the mark. I also note that the line element through the word is very thin, and does not distort the word in any way. It is still visible and can be clearly read by the consumer. More importantly, I also note that all three letter N's do not have the thin line striking through them, meaning that the word is not fully crossed out. Consequently, I consider that the thin line will be seen as a purely stylistic element within the mark which is used alongside the stylised capitalised typeface.

30. The applicant submits that its mark is a term "used to describe a person who has been wrongly stereotyped as a criminal, despite being innocent". I do not consider that this exact meaning would be recognised immediately by the average consumer. However, I consider that the concept, the idea of a criminal

who is innocent, is likely to be assigned to the applicants mark by the average consumer.

31. As a whole, “INNOCENT CRIMINAL” as a phrase is unusual, as it is contradictory in nature, because to be innocent means you are not guilty of a crime and a criminal is someone who commits crimes. Therefore the word INNOCENT clearly juxtaposes the word CRIMINAL. However, I also consider that the words INNOCENT and CRIMINAL qualifies each other, and creates a new unitary meaning different than those of its individual components.

32. Therefore, taking all of the above into account, as the marks share, to some extent, the concept of CRIMINAL in both marks, they are conceptually similar to between a low and medium degree.”

GROUND OF APPEAL

Evaluation of similarity of marks and direct confusion

15. The appellant made essentially three broad arguments to the effect that the hearing officer had erred in the evaluation of confusing similarity and I will deal with them in turn. Each has a number of sub-aspects.
16. The appellant contended that the errors as to evaluation of the Mark particularly affected the conclusion on direct confusion which, it was argued, was fundamentally flawed. The focus of this ground of appeal was that the hearing officer should have regarded the claimant’s mark as, in substance, for the stylised word CRIMINAL with the INNOCENT aspect of the mark being insufficient to make the mark fundamentally different from that given its presentation.
17. The point was put in various ways in the appellant’s skeleton and orally but, in essence, the argument came down to a contention that the hearing officer should have regarded the CRIMINAL element of the mark as much more important and the INNOCENT aspect as significantly less so to the average consumer, for a range of reasons. The arguments on appeal were, more specifically, the following.
18. First, the appellant contended that the hearing officer had failed to give due or sufficient weight to the CRIMINAL element in the Mark when assessing the similarity of the respective marks and conducting the global assessment for likelihood of confusion. The

argument under this head centered on the contention that the hearing officer should have treated the mark as being perceived by the average consumer as being one in which the word INNOCENT was struck through and therefore visually and conceptually signalling to the average consumer that the Mark had a meaning of “genuinely” criminal (rather than “innocent”), especially having regard to imperfect recollection

19. Second, that this erroneous evaluation fed into the determination of whether there was a likelihood of direct confusion, rendering that determination open to challenge.

20. Third, that the hearing officer had erred in the assessment of the likelihood of indirect confusion between the respective marks, specifically in the assessment of whether the Mark would be seen as logical and consistent with a brand extension.

EVALUATION OF THE MARKS AND DIRECT CONFUSION

Evaluation of the Mark

21. The central points on the appeal in so far as it concerns direct confusion come down ultimately to a question of whether the hearing officer had a proper basis for considering that the marks taken as a whole were not confusingly similar to the average consumer, given the similarities and differences between them and the identity of the relevant goods.

22. The starting point was the evaluation of the Mark. As to that, the hearing officer considered that the words INNOCENT and CRIMINAL played a greater role in the overall impression of the mark than the stylisation and that they played an equally dominant role. The appellant submits that this was wrong but I do not think that the hearing officer can be criticised in this respect or that insufficient weight was given to the CRIMINAL element for the following reasons which deal with the sub-strands of the appellant’s arguments.

23. First, the hearing officer considered that the INNOCENT element, albeit “crossed out” contributed visually, aurally and conceptually to the Mark and that was significant, noting its presence at the beginning of the Mark and its presentation.

The appellant's overriding criticism is that this was fundamentally erroneous as an overall evaluation. I do not believe that criticism is justified. The Mark is and appears as a composite mark in that the two words appear naturally to be taken together, visually, aurally and conceptually. Indeed, the two words to some extent go together as a matter of language, albeit in a somewhat oxymoronic way. Although it is possible that a small number of individuals might perceive the Mark as one in which the words are taken separately or in which the word CRIMINAL was dominant, that would not be a natural reading or perception of the mark and would involve dissection contrary to the way in which marks are perceived.

Significance of first element

24. Second, as to visual evaluation, the appellant next contends that the hearing officer was wrong to say that there was a principle that the first part of a mark is the most important and that was only a rule of thumb. The appellant is of course right that there is no principle to this effect but what the hearing officer was getting at here was that the INNOCENT aspect of the mark was prominent in this case and the fact that it was the initial element contributed to that. That accords with the approach to this aspect of evaluation in *El Corte Ingles SA v OHIM*, Cases T-183/02 and T184/02, at 83.

The strike through of INNOCENT

25. Third, this leads to the appellant's third and most important point under this head, namely the effect of the strike through on the word INNOCENT. The appellant submits that it is "a matter of general common knowledge that a "strikethrough" or crossing out indicates that a word is included as a mistake and not to be included nor considered".
26. While that may be true of certain texts, I do not think that can be said of the Mark in this case. First, I do not consider that this mark will be viewed with that level of analysis by the average consumer. Second, although there is a strike through (and that may have been the intention) it is (at best) imperfect and light with the word INNOCENT clearly appearing – it is not conventional strike through of text and appears more as a decorative feature. I do not consider that it can appropriately be regarded as a part of the mark which is to be disregarded in considering the identity of the mark as a whole. I consider the hearing officer's points on this aspect to be correct.

Visual perception of mark in actual use

27. Fourth, the appellant contended that even if the line is not shown in the Mark on the register as passing entirely through all of the letters, especially having regard to imperfect recollection, the average consumer would see this as a strike through and would therefore place less importance on this element of the mark, given the significance of the visual element of the mark (see decision para. [20]), the purchasing process for clothing and the fact that the consumer may not notice that the line does not go all the way through INNOCENT).
28. Again, I am not persuaded by this point. The line that runs through INNOCENT in the Mark applied for is a fine one and it seems to me, if anything, more likely in a situation of this kind that the Mark in actual use may make the striking out less rather than more noticeable at a realistic distance. I do not think it would be right to proceed on the basis that the mark as registered would make the striking out more prominent. I have considered this point by reference to the more recent case law relating to the evaluation of similarity of marks by reference to how they may be seen in actual use (*Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor* [2024] EWCA Civ 29 – currently under appeal to the Supreme Court). While it is right to proceed on the basis that a mark will be used as registered, in a situation of this kind where it is known that the mark is likely to appear on particular kinds of goods and in particular positions, it may also be appropriate to have some regard to the manner in which a mark may appear to an average consumer in realistic circumstances of actual use, having regard to the way in which the mark is likely to be encountered (such as the distance away and the fact that it may be on a clothing label).
29. However, in my view, even taking that case law and approach into account, I do not think there is a realistic prospect of the INNOCENT part of the mark being treated as so struck out that it ceases to play a significant part in the evaluation of the mark as a whole.
30. I therefore do not accept the argument that the hearing officer’s approach to evaluation of visual similarity was wrong.

Aural impact of strike through of INNOCENT

31. Fifth, the appellant contends that aurally, “as a matter of common sense”, if a word is struck through, it is intended not to be pronounced and “the emphasis therefore shifts to CRIMINAL.” It is submitted that an ordinary person faced with a strikethrough in text knows to disregard that word and that, if reading a text, a struck through word would not be read out but mentally deleted.
32. That may be so in the case of a struck through word in a passage of ordinary text but it does not seem to me probable in the case of a trade mark for clothing of this kind. I think it very unlikely that anyone seeing the mark and asked to say it out loud would not say the word INNOCENT, despite the strike through.
33. So here too, I do not think the hearing officer fell into error.

Conceptual understanding

34. Sixth, as to conceptual meaning, the appellant criticises the hearing officer’s decision saying that it is at odds with what the Mark conveys as a matter of first impression.
35. The appellant contends that the hearing officer should have treated the mark as being one which conveyed the meaning of a criminal who was not innocent (as a result of the strike through) because the strike through would indicate that a mistake had been made and the innocent criminal called to mind was, in fact, not innocent. It is said that it would be more of a mental effort to arrive at this postulated “reverse meaning” than what is said to be the more obvious one and that the hearing officer arrived at this conclusion by discounting the strikethrough, and its effect on consumers who were used to interpreting text. This it is said was an error of principle. It is said that so far from any connotation of innocence, the mark as a whole reinforces the conceptual meaning of criminal.
36. The fundamental problem with this argument is that it relies on the assumption that the average consumer will regard the way in which the Mark as a whole is presented (including having regard to the strike through) as conceptually denoting a “criminal” effectively disregarding the “innocent” element.

37. I do not think an average consumer would subject the strike through to that kind of rather detailed semantic analysis. The way in which the mark is presented retains the conceptual notion of an innocent criminal even if it might be said that the strike through might, purely linguistically, call the innocence into question to some extent. But the average consumer is in my view unlikely to be viewing the Mark with a detailed semantic eye. In so far as they do, it seems to me at least as likely that the average consumer would treat the mark as connoting a person who had been treated as a criminal and the innocence (inappropriately) struck out. However, I do not think for a mark of this kind, that kind of analysis is appropriate.
38. The hearing officer considered that the words INNOCENT and CRIMINAL qualified each other, and created a new unitary meaning different than those of its individual components. In my view that was a realistic evaluation in the light of the matters referred to by the hearing officer and the overall conclusion that the marks were conceptually similar to between a low and medium degree was justifiable.
39. Again, here I do not think the conceptual analysis of the mark was wrong.

Other matters

40. Finally, although it is of course possible to treat the word INNOCENT as struck out and that accords with the evidence of the applicant's intention (in so far as relevant), I am not convinced that it is right that it would be so regarded by all actual consumers or that it is a strike through of a conventional kind which conveys a negation of that which is struck through. It is true that INNOCENT in the Mark has something which could be perceived as a line going through it which could be seen as a strike out and the negation of the concept of "criminal" (in so far as that is the right conceptual analysis). However, the word INNOCENT is generally presented in a stylised way and the line can equally be seen as a kind of decorative element.
41. Even assuming that this feature can be and would be regarded as striking out the word INNOCENT, this is far from a situation in which the applicant's mark is to be treated as not featuring the word INNOCENT at all or negating its significance in the mark as a whole in a relevant way. Indeed, partly because of the way in which that word is presented (including the line), it is a part of the mark to which the eye may be drawn.

42. Taken as a whole, I think the mark would be perceived as a whole with all of these features contributing to it. On that basis it cannot be said that the hearing officer was wrong not to have given greater weight to the CRIMINAL aspect the mark than to the INNOCENT aspect.
43. In the light of the authorities and the points made in the further submissions I have paid particular attention to whether the hearing officer had sufficient regard to the spectrum of consumers in the evaluation of the reaction of the average consumer. In my view, the points made in the decision and the conclusions were sufficiently reflective of that spectrum and, in particular, of the typical consumer and the hearing officer was right to approach the matter in that way. In my judgment, those who viewed the mark in a different way from that analysed by the hearing officer could properly be described as outliers.

Overall approach

44. Finally, I return to the appellant's overriding criticism that the hearing officer failed to approach the evaluation in the manner required by *Duebros Limited v Heirler Cenovis GmbH* BL O/547/17 at [81.2] namely not by a process of analysis or reasoning, but "an impression or instinctive reaction."
45. Again, I do not think that is a fair criticism, of the decision taken as a whole. The hearing officer inevitably had to give reasons for the conclusions. To that extent the decision had to be analytic. But I do not think those reasons lost sight of the need to consider the reaction of the average consumer which, as the appellant correctly says, may take place in a matter of seconds in a retail environment.
46. I therefore do not think that the hearing officer fed an erroneous evaluation of the marks into the analysis of likelihood of confusion to which I now turn.

The evaluation of direct confusion

47. The appellant criticises the hearing officer for feeding the incorrect analysis of the Mark into the assessment of the likelihood of confusion and conducting that incorrectly.

48. The hearing officer took the various factors referred to above into account as well as imperfect recollection (at para. [39]) and concluded that the marks are unlikely to be mistakenly recalled or misremembered as each other. The reasons given by the hearing officer were as follows:

“Taking all of the factors listed in paragraph 38 into account, and even bearing in mind the principle of imperfect recollection, I am satisfied that the marks are unlikely to be mistakenly recalled or misremembered as each other. Firstly, as highlighted above the words INNOCENT and CRIMINAL in the applicant’s mark play an equally dominant role in the overall impression of the mark. The words also qualify each other, and create a new unitary meaning, different than those of its individual components. Secondly, the beginning of the marks tend to make more of an impact than the ends. Therefore, I do not consider that the average consumer would overlook the 8 letter word INNOCENT at the beginning the applicant’s mark, which is presented in the same size, and directly above, the word CRIMINAL. The opponent has argued that the word INNOCENT has a “single line through” it, which would lead the consumer into “believing that this element is to be disregarded”. However, as highlighted above, the line element in the applicant’s mark is thin in nature and does not strike through all 3 letter N’s. Consequently, the word is not fully crossed out and the word INNOCENT is clearly visible and easy to read. The thin line will, therefore, be seen as a purely stylistic element which is used alongside the stylised typeface in the applicant’s mark. Consequently, taking all of the above into account, I do not consider there to be a likelihood of direct confusion”

49. The appellant criticises the starting point, the approach and the conclusion. As to the starting point, I have concluded above that the hearing officer had a proper basis for treating the mark as a composite with each element playing an important role. The appellant says that the conclusion relies on the average consumer noticing INNOCENT but without giving any weight or relevance to the strikethrough, whilst at the same time giving the mark so much concentration that the uncrossed “N”s are both noted and factored in to negate the indicated “disregard” as a stylistic element.

50. However, I do not think that is so or that this is what the hearing officer did. As can be seen from the analysis, the hearing officer did consider the strike through and its nature as a design element, thought it would be noticed but also that it would not diminish the significance of the word INNOCENT in the manner contended for by the appellant.
51. As to the impact of the initial element, in this case, I do not think the hearing officer was wrong to say that this would be regarded as important. In taking that approach, I consider that the hearing officer was correct. Contrary to the appellant's submission, this analysis does not go beyond that which a reasonable tribunal may adopt. Indeed, in my view it is correct.
52. As to the remainder of the hearing officer's analysis, in my judgment the hearing officer had a sufficient basis for concluding that the Mark would be perceived as one in which the word INNOCENT remained particularly prominent and significant and that the line would be likely to be viewed as a purely stylistic element which is used alongside the stylised typeface in the applicant's mark.
53. The upshot is that the hearing officer had a proper basis for concluding that the essence of the marks to be compared was on the one hand CRIMINAL and on the other INNOCENT CRIMINAL and that these were materially different visually, orally and conceptually – and sufficiently so for confusion to be unlikely.
54. Finally on this point, there was reference at the hearing to an earlier decision of the Registry in which an opposition to registration of a stylised mark in class 25 the main element of which was CRIMINAL based on section 5(2)(b) succeeded based on an earlier registration of the mark CRIMINAL DAMAGE (O-063-05). The hearing officer in that case considered that the earlier registration was most likely to be remembered and referred to as CRIMINAL DAMAGE even though it had a skull and cross bones device and an exclamation mark as well. He held that the mark applied for in that case consisting of the word CRIMINAL alone, “can only be remembered and referred to as CRIMINAL” and that being the case the marks shared a degree of oral/aural similarity. The hearing officer there concluded that the use of the word CRIMINAL either alone or in the phrase CRIMINAL DAMAGE related “either to a person who commits crime, or a particular category of crime such a person may commit”.

55. The hearing officer there said that, given the wide penumbra of protection which he considered applied to the opponent's mark in that case and "the degree of oral/aural and conceptual similarity between the respective marks, the identical/closely similar nature of the goods at issue, the traits of the average consumer when purchasing items of clothing, the manner in which such goods are marketed and allowing for imperfect recollection" he was satisfied that there was a real likelihood of confusion. The opposition was upheld. It also succeeded on the basis of a claim that there would be passing off in the light of the opponent's earlier goodwill.
56. I have considered that case with some care, including the summary of the evidence in it which was not relied on for the purposes of the decision on section 5(2)(b) but was important for passing off. At first sight, it provides some support by way of analogy for the appellant's position that marks containing the word "CRIMINAL" are remembered for that.
57. However, there are also significant differences. In particular, while it is only a rule of thumb that it matters, the word CRIMINAL was the first word in the earlier mark in that case and, more importantly, there was no connotation there of innocence which the Mark conveys in this case. Moreover, on this appeal, I need to consider whether there is a proper basis for overturning the hearing officer's evaluation in this case not by reference to other authorities about different marks.

Conclusion on evaluation of likelihood of confusion

58. The hearing officer had a sufficient basis for the evaluation that there was no likelihood of direct confusion notwithstanding the similarities identified, in the light of the significant differences between the marks.

INDIRECT CONFUSION

59. On this issue, it is convenient first to summarise the law relating to indirect confusion which was originally developed in the *LA Sugar* case and reformulated by the Court of Appeal in *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207 (05 August 2021, "*Sazerac*") as follows.

“9. ... As Kitchin LJ (with whom Sir John Thomas PQBD and Black LJ agreed) put it in *Specsavers International Healthcare Ltd v Asda Stores Ltd* [2012] EWCA Civ 24, [2012] FSR 19 at [87]:

“In my judgment the general position is now clear. In assessing the likelihood of confusion arising from the use of a sign the court must consider the matter from the perspective of the average consumer of the goods or services in question and must take into account all the circumstances of that use that are likely to operate in that average consumer’s mind in considering the sign and the impression it is likely to make on him. The sign is not to be considered stripped of its context.”

10. It is well established that there are two main kinds of confusion which trade mark law aims to protect a trade mark proprietor against (see in particular Case C-251/95 *Sabel BV v Puma AG* [1997] ECR I-6191 at [16]). The first, often described as “direct confusion”, is where consumers mistake the sign complained of for the trade mark. The second, often described as “indirect confusion”, is where the consumers do not mistake the sign for the trade mark, but believe that goods or services denoted by the sign come from the same undertaking as goods or services denoted by the trade mark or from an undertaking which is economically linked to the undertaking responsible for goods or services denoted by the trade mark.

11. In *LA Sugar Ltd v Back Beat Inc* (O/375/10) Iain Purvis QC sitting as the Appointed Person said:

“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).”

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).

13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/219/16) at [16] “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Mr Mellor went on to say that, if there is no likelihood of direct confusion, “one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion”. I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion.

14. “Likelihood of confusion” usually refers to the situations described in paragraph 10 above. As this Court held in *Comic Enterprises*, however, it also embraces situations where consumers believe that goods or services denoted by the trade mark come from the same undertaking as goods or services denoted by the sign or an economically-linked undertaking (sometimes referred to as “wrong way round confusion”).”

60. In this case, the question is whether the hearing officer was right in concluding that there was insufficient basis for a finding that there was a likelihood of indirect confusion. The hearing officer’s decision applied the law as follows:

“43. Firstly, where the common element is so strikingly distinctive that the average consumer would assume that no-one else, but the brand owner, would be using it. In this instance, I do not consider that the ordinary dictionary word, CRIMINAL, which has a recognisable meaning to the average consumer, is so strikingly distinctive that the average consumer would think that no-one else but the opponent would use it. As established above, it has a medium degree of inherent distinctiveness, which has not been enhanced. The first category is therefore not satisfied.

44. This leads to the second category from L.A Sugar, where the later mark simply adds a non-distinctive element to the earlier mark. The examples provided by Mr Purvis Q.C. for this category are separate words which are frequently used to indicate that they are sub-categories/brands. However, the word INNOCENT is not a non-distinctive element. As highlighted above, the word INNOCENT plays an equally dominant role, with the word CRIMINAL, in the overall impression of the applicant's mark. It is a dictionary word which is neither descriptive nor allusive of the parties' goods. The word INNOCENT is also not a word which is frequently used to indicate sub-brands such as 'LITE' or 'EXPRESS'. Consequently, the second category cannot be satisfied.

45. Lastly, where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension. I do not consider that the addition of the word INNOCENT at the beginning of the applicant's mark is a logical brand extension of the opponent's mark, or vice versa. As highlighted above, the words INNOCENT and CRIMINAL play an equally dominant role in the overall impression of the applicant's mark. The use of the two words together is also particularly striking because they contradict and juxtapose each other. "INNOCENT CRIMINAL" together creates a new unitary meaning (a criminal who is innocent), different than those of its individual components. I therefore consider that the applicant's mark is a step too-far removed from being a logical brand extension, or a logical sub-brand of the opponent's mark. The inherent meaning and concept of the shared element (CRIMINAL) has changed to meaning the opposite of what it should mean (a criminal being person who commits crimes vs a criminal who is innocent/not guilty of a crime). I therefore do not consider that the third category is satisfied.

46. I bear in mind that the examples above set out by Mr Purvis Q.C. are not exhaustive. However, I do not consider that there are any other logical examples of how the applicant's mark could be indirectly confused with the opponent's. I consider that having noticed that the trade marks are different, I see no reason why the average consumer would assume that they come from the same or economically linked undertakings. As highlighted above, the marks are not natural variants or brand extensions of each other. Even if the opponent's mark is brought to mind when viewing the applicant's mark, this is mere association, not confusion: see

Duebros Limited v Heirler Cenovis GmbH, BL O/547/17, paragraph 81.
Consequently, I consider there is no likelihood of indirect confusion.”

Appellant’s arguments

61. The appellant makes a number of related criticisms of the hearing officer’s decision.
62. First, the appellant contends that the hearing officer did not sufficiently heed the warning in *Duebros Limited v Heirler Cenovis GmbH* BL O/547/17 where at [81] Mr James Mellor QC (as he then was) said that caution was required in considering the authorities lest the paragraphs were applied in a manner akin to a statutory test and that it was important that “the detail of each of the sub-paragraphs does not provoke the tribunal into too detailed an analysis of what I believe should be an emulation of an instinctive reaction in the mind of the average consumer when encountering the later mark with an imperfect recollection of the earlier mark in mind”.
63. It is said that, despite the recognition that the “categories” listed by Mr Purvis were not exhaustive or closed and there is no need for an Opponent to identify a particular category as the hearing officer acknowledged at [46] she did not properly take this into account.
64. I am not persuaded by this point. Although there is a range of ways in which indirect confusion may occur as a result of common features appearing in marks, it is necessary to keep the concept of indirect confusion within reasonable bounds, lest it undermine the more general principles (not so much of law but common knowledge) that (a) composite marks are normally treated as a whole and (b) that consumers are generally alert to the fact that fairly common words may appear in a number of different marks without there being any reason for assuming a connection between the goods so marked.
65. I am also not persuaded by the related point that, in para [42] of the decision, the hearing officer was beginning to “close [their] mind” to the wider picture and the possibility of indirect confusion outside the classes identified.
66. The key point made by the appellant here is the submission that both marks are CRIMINAL marks, and the submission that it is “inevitable” that a consumer would

conclude it is another brand of the owner of the earlier mark. This, it is said, is the foundation for a failure to make the proper assessment which takes account of the common element in the context of the later mark as a whole. The primary reason given is the failure to compare the marks properly and the incorrect evaluation of the role the term INNOCENT (and its presentation including as struck out) plays in the Mark. For the reasons given extensively above, I do not think there was such an error of evaluation. It is not inevitable (or even likely) that a consumer would consider that the Mark was another brand of the owner of the earlier mark if (as I have held the decision did) the marks were each correctly evaluated as a whole.

67. Third, the appellant criticises the hearing officer for saying, on the one hand (at [43]), that CRIMINAL is not so strikingly distinctive that no-one else would use it but, on the other, saying (at para [36]) that it has no allusive or descriptive nature as regards the goods in issue. The appellant argues that this is an inconsistency and would mean that distinctive words would not be recognised as being susceptible to indirect confusion.

68. I am not convinced by this argument either. A situation in which a mark is specifically descriptive or allusive to the goods or service in question is a paradigm situation in which others would be expected to be using it for the goods without signifying a trade mark connection. However, it is not the only situation in which that reaction would be expected by the average consumer. There are words which may not be specifically or generally descriptive of or allusive to the specific goods but which are nonetheless ones that the average consumer could reasonably expect other traders to be using as part of another mark without considering it likely that the goods so marked are connected. The observations of the Arnold LJ in the Court of Appeal in *Lifestyle Equities CV & Ors v Royal County of Berkshire Polo Club Ltd & Ors* [2024] EWCA Civ 814 (emphasis added) are relevant here:

“39...For example, it is well established that, if the only similarity between the trade mark and the sign (or between the trade marks, as the case may be) is a common element which has low distinctiveness, that points against there being a likelihood of confusion: see *Whyte & Mackay Ltd v Origin Wine UK Ltd* [2015] EWHC 1271 (Ch), [2015] FSR 33 at [44]. The common element may

have low distinctiveness because it is descriptive or allusive, but that need not be the case.”

69. Even in the case of marks that are distinctive (in the sense of not descriptive or allusive), use of the same word in a different context is not always likely to be taken as indicating that there is a trade connection between the goods or services. The question posed by the appellant in argument “why would anyone else want to use it?” is likely to have a ready answer in the mind of the average consumer: “because it is a common word in the English language which can be combined with other words in the English language to mean something different from its meaning when used alone”. The key point here is that, when a word is used in combination with other words, there may be good reasons for other traders to use that word other than to denote the same trade origin. What the word denotes in one context may be different from what it denotes in another (for example as used alone compared with used with other words).
70. The approach suggested by the authorities is that the tribunal is required to take account of the extent to which the common element is descriptive of the goods or services (including, in particular, whether it is “strongly distinctive” (to use the more recent language of the High Court in *easyGroup Ltd v Easyfundraising Ltd & Ors* [2024] EWHC 2323). It must also take account of other reasons why the presence of a common element, even if not descriptive, may not be regarded as signalling a common trade origin. It is right to focus on whether there are reasons for the average consumer to consider that the presence of the common element either denoted or did not denote a common origin or connection, rather than on the degree of distinctiveness of the common element for the goods in question. The hearing officer approached the case in this way and was right to do so.
71. Third, the appellant contends that the hearing officer misunderstood the test for indirect confusion in applying it by saying that the word INNOCENT at the beginning of the mark was not a logical brand extension of the mark CRIMINAL or vice versa.
72. The appellant submits that this loses sight of the fact that the test focusses on how the mark would be perceived by the average consumer (and in that sense logical and consistent with being a brand extension). It is said that there could be illogical additions

to a mark (in the sense that they may not make sense to the mark) but which would nonetheless be taken by the average consumer to denote the goods or services of the same undertaking.

73. In my view the criticism is based on the hearing officer's slightly loose language which is in substance correct. While the language of the decision does not exactly reflect that of the statement in the case law, the way in which the hearing officer applied it demonstrates that the decision was based on a correct understanding of it. In the decision "logical brand extension" clearly meant a mark which would be taken by consumers to denote a brand extension.

74. The appellant's next point was that the hearing officer had erroneously fallen back on making a distinction between a likelihood of confusion and mere association (see para [46]). The whole passage must be seen in context. The hearing officer said:

"I bear in mind that the examples above set out by Mr Purvis Q.C. are not exhaustive. However, I do not consider that there are any other logical examples of how the applicant's mark could be indirectly confused with the opponent's. I consider that having noticed that the trade marks are different, I see no reason why the average consumer would assume that they come from the same or economically linked undertakings. As highlighted above, the marks are not natural variants or brand extensions of each other. Even if the opponent's mark is brought to mind when viewing the applicant's mark, this is mere association, not confusion: see *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, paragraph 81. Consequently, I consider there is no likelihood of indirect confusion".

75. In my view, this does not disclose any error: the hearing officer was saying no more here than that even if the opponent's mark was brought to mind, it did not follow that the average consumer would think that there was a trade connection between goods so marked and the opponents goods. The reason given was that there was insufficient basis in the Mark to lead the average consumer to think that it was a brand extension.

76. Finally, there was discussion at the hearing as to whether the Mark should be regarded as one which had the CRIMINAL element in one presentation or stylisation with the

element INNOCENT in another presentation (in particular struck through) and the fact that there was this difference might suggest to an average consumer that the Mark denoted a sub-brand of the CRIMINAL brand. That kind of argument would have some greater force merit had the term in question been descriptive (such as for example “young” in such a way as to connote a line of products suitable or intended for young people). However, taken as a whole, I do not think that the term INNOCENT (even as struck through) falls into this category. The difference in design of the two elements (even disregarding the meaning) does not suffice without more to lead the average consumer to treat the mark as a composite whole.

77. In reaching these conclusions, I have also considered the further submissions and take the view that this is a situation in which the approach taken by the hearing officer was sufficiently reflective of the views of the average consumer (having regard to the spectrum of actual consumers for the goods in question).

78. The other points developed in the appellant’s grounds of appeal, skeleton and oral argument amount in my view to different ways of putting the same arguments concerning the relative significance of the INNOCENT and CRIMINAL elements in this context. To take one example, the appellant says that the word INNOCENT is “used quite commonly in respect of the word CRIMINAL, as it is often portrayed in TV shows/films or literature that the majority of criminals believe themselves to be innocent of the crime committed. As such, the notion of an INNOCENT CRIMINAL is not as fanciful and uncommon as stated by the Registrar and therefore would fall into the category of a change which could be seen as a logical and consistent brand extension of the Appellant’s CRIMINAL brand”.

79. I am not convinced that the hearing officer was really saying that the notion of an INNOCENT CRIMINAL as such was fanciful. The decision was based on considering whether the term INNOCENT qualifying CRIMINAL would be taken as on the one hand denoting a brand extension of CRIMINAL or on the other taken as part of a new composite term INNOCENT CRIMINAL

80. The other points made along these lines are to similar effect and none of them persuade me that the hearing officer was wrong.

81. The hearing officer made a fact sensitive evaluation. Where, as in this case, the hearing officer has considered the composite mark as a whole and concluded that the common word's significance in the composite is different to the average consumer to that of the word used alone, that is a decision which the case law suggests must be respected by this tribunal unless wrong in the sense required by the authorities.

82. In my view, the hearing officer's judgment on this issue cannot be described as wrong in such a way as to warrant appellate reversal. At its highest, it falls into the category of decisions on which some may reasonably differ but that is far from sufficient to provide grounds for overturning the decision on appeal. Put simply, the hearing officer's view was that the typical consumer could reasonably be expected to distinguish the marks and would not regard them as denoting goods (and in particular clothing and related goods) which came from the same or a connected trade origin and that was a conclusion well within the range of conclusions open to the hearing officer.

OVERALL CONCLUSION

83. For these reasons the appeal must be dismissed.

COSTS

84. The respondent represented himself at the brief hearing and filed a short skeleton argument. No award of costs was made below nor any applied for by the respondent and I do not think a costs award would in any event be merited.

DANIEL ALEXANDER KC

APPOINTED PERSON

30 April 2025

Representation: Mr P Harris for the appellant; the respondent appeared in person