

O-105-10

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2510699
BY CHURAN & CO TO REGISTER A
TRADE MARK IN CLASS 25**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 99206 BY FINDEL PLC**

BACKGROUND

1. On 10 March 2009, Churan & Co (Churan) applied to register the trade mark **TG 101** for a specification of goods in class 25 which read:

“Clothing, footwear, headgear for Mens, ladies and children”.

Following examination, the application was accepted and published for opposition purposes on 17 April 2009 in Trade Marks Journal No.6781.

2. On 17 June 2009, Findel Plc (Findel) filed a notice of opposition. This consisted of a single ground based upon section 5(2)(b) of the Trade Marks Act 1994 (as amended) (the Act). In their Notice of opposition Findel indicate that the opposition is based upon the following trade marks:

Trade Mark	No.	Application Date	Registration Date	Goods (in class 25)
	2411396	18.01.2006	26.1.2007	Articles of clothing, articles of footwear, articles of headgear; bibs, slippers, socks, pyjamas, nighties, bath robes, caps, t-shirts, sweatshirts.
	2504285	8.12.2008	24.4.2009	Articles of clothing, articles of headwear, articles of footwear; underwear, hosiery.
	2504286	8.12.2008	15.5.2009	Articles of clothing, articles of headwear, articles of footwear; underwear, hosiery.
	2504287	8.12.2008	22.5.2009	Articles of clothing, articles of headwear, articles of footwear; underwear, hosiery.

3. I note that in their Notice of opposition Findel say, *inter alia*:

“The mark TG 101 is visually, phonetically and conceptually very similar to [Findel’s] TG logo. The addition of the numerals 101 adds nothing distinctive or distinguishing to the mark overall.”

4. On 24 August 2009, Churan filed a counterstatement. As this constitutes Churan’s only response to the opposition, I have reproduced it below in full. They say:

“With reference to the opposer’s objection, it appears there are four marks registered as TG. Two marks are distinct from each other by virtue of them being in different typesets (upper and lower case), the remaining two marks have the scorpion image attached. The four marks are therefore distinct from each other.

Our application is for TG 101 which is clearly different from simply TG or any fashion of the letters TG, and we have no image of a scorpion to confuse our application with that of the opposer. We have developed use of the TG 101 since 2005 and have common law rights. We would purport that TG 101 is significantly different from the marks of the opposer and request that our application is allowed.”

5. Neither party either filed evidence or asked to be heard. Findel filed written submissions which I will refer to as necessary below. After a careful consideration of all the material before me, I give this decision.

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

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

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

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

7. 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.”

8. In these proceedings Findel is relying on the registered trade marks shown in paragraph 2 above, all of which have application dates prior to that of the application for registration; as such, they all qualify as earlier trade marks under the above provisions. The application for registration was published for opposition purposes on 17 April 2009, and Findel’s earlier trade marks were registered on 26 January 2007, 24 April and 15 and 22 May 2009. As Findel’s earlier trade marks had not been registered for five years at the point at which Churan’s application was published, they are not (despite Churan’s request in box 5 of their counterstatement) subject to The Trade Marks (Proof of Use, etc) Regulations 2004.

Section 5(2)(b) – case law

9. The European Court of Justice (ECJ) has provided guidance in a number of judgments germane to this issue. The principal cases are: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Mayer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05).

It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all the relevant factors: *Sabel BV v. Puma AG*, paragraph 22;

(b) the matter must be judged through the eyes of the average consumer of the good/services in question; *Sabel BV v. Puma AG*, paragraph 23, who is deemed to be reasonably well informed and 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*, paragraph 23;

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*, paragraph 23;

(e) when considering composite marks, it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element; *Shaker di L. Laudato & Co. Sas* (C-334/05), paragraph 42;

(f) an element of a mark may play an independent distinctive role within it without necessarily constituting the dominant element; *Medion AG V Thomson multimedia Sales Germany & Austria GmbH*, paragraph 30;

(g) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17;

(h) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*, paragraph 24;

(i) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*, paragraph 26;

(j) further, 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; *Marca Mode CV v. Adidas AG + Adidas Benelux BV*, paragraph 41;

(k) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.

The average consumer and the nature of the purchasing decision

10. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods; I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. In reaching a conclusion on this point, I must proceed on the basis that the respective parties' trade marks will be used on all the goods for which they have either been applied or are registered.

11. The goods at issue in these proceedings are all items of clothing. These are the sort of goods which will be bought by the general public; they then are the average consumer for such goods.

12. The selection of the goods by the average consumer is most likely (initially at least) to consist of a visual act made on the basis of self selection in either a retail environment, from a catalogue or on-line (see the comments of the Appointed Person in *React Trade Mark* [2000] RPC 285). Whilst this is likely, in my view, to be the principal means by which the goods are selected by the average consumer, as orders may also be placed by telephone, aural considerations will also play a part in the selection process.

13. The cost of the goods at issue may vary from very small sums (for a pair of socks for example) to many thousands of pounds (for, for example, a bespoke suit). The factors the average consumer in this context would be conscious of when selecting such goods are likely to be, *inter alia*, brand, cost, design, material, size, colour, compatibility with other items of clothing and, ultimately, if the goods are suitable for their purposes. All of these factors point, in my view, to this average consumer paying a reasonably high but not the highest level of attention to their purchase. As the cost of

the goods increases so one assumes will the level of attention the average consumer is likely to pay to their selection.

Comparison of goods

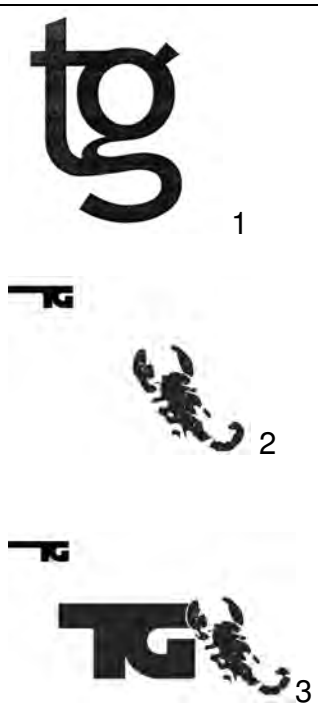
14. The goods to be compared are as follows:

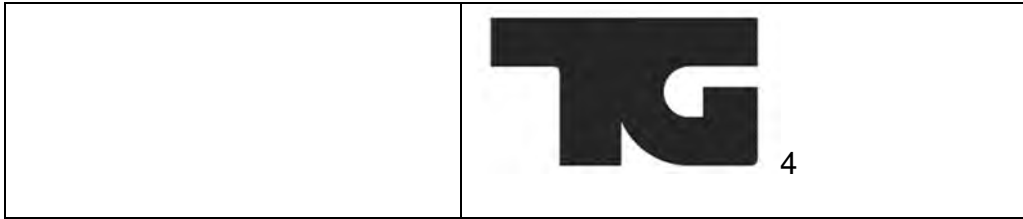
Churan's goods	Findel's goods
Clothing, footwear, headgear for Mens, ladies and children	All of the earlier trade marks include: Articles of clothing, articles of headwear (or headgear) and articles of footwear

15. As all of Churan's goods are encompassed by the goods contained in Findel's earlier trade marks, the respective goods are therefore identical.

Comparison of trade marks

16. For the sake of convenience, the trade marks to be compared are as follows (the numbers have been added for ease of reference and do not form part of the trade marks):

Churan's trade mark	Findel's trade marks
TG 101	 <p>1</p> <p>2</p> <p>3</p>



17. It is well established that the average consumer is considered to be reasonably well informed, circumspect and observant, but perceives trade marks as a whole and does not pause to analyse their various details. In addition, he/she rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he/she has kept in his or her mind. In reaching a conclusion on similarity, I must also identify what I consider to be the distinctive and dominant components of the respective trade marks.

18. In their written submissions Findel say:

“As can be seen [Findel] has protection for a number of marks which either comprise the letters TG in a stylised form with no additional matter, or the letters TG in a stylised form with the device of a scorpion..”

And:

“It is quite common for trade marks to be used in various forms, as is the case with Findel’s TG marks. It is also common for variations of such marks to include numerals added to the basic mark to signify, for example, different ranges of clothing. Hence, [Churan’s] mark TG 101 is likely to be seen by members of the public already familiar with Findel’s TG marks as being a variation of those TG marks, and as such they are likely to be confused as to the origin of the goods concerned, with that confusion including a likelihood of association of the TG 101 mark with the earlier TG marks of Findel.”

19. In these proceedings Findel are relying on the four earlier trade marks shown above. I note that trade marks 2 and 3 contain, *inter alia*, the device of a scorpion which is not to be found in trade marks 1 and 4 and (as Churan point out in their counterstatement) has no counterpart in their application for registration. It appears to me that trade marks 1 and 4 offer Findel their best prospect of success in these proceedings and I intend to conduct the comparison on the basis of these trade marks alone. If Findel’s opposition fails in relation to these two trade marks, their position will, in my view, be no better in relation to the two trade marks which remain.

20. In my view, Findel’s trade marks 1 and 4 have no distinctive and dominant element; the distinctiveness of each resides in the totality of the respective trade marks. Insofar as Churan’s trade mark is concerned, this consists of two distinct elements i.e. the letters TG and the numerals 101. I note that in their Notice of opposition Findel say that the numerals 101: “adds nothing distinctive or distinguishing to the mark overall”. In their

written submissions they add that: "It is also common for variations of such marks to include numerals added to the basic mark to signify, for example, different ranges of clothing." However, they have provided no evidence to support these bald assertions, and this is not a matter of which I am prepared to take judicial notice. While I accept that those trading in items of clothing, footwear and headgear will use numerals to indicate, for example, size, I am not (without appropriate evidence) prepared to accept that numerals of the type found in Churan's trade mark are routinely used in the clothing trade to identify different ranges and as a result of such use will not contribute to the overall distinctive character of Churan's trade mark. Consequently, as both elements of Churan's trade mark are, in my view, distinctive, both will contribute to its overall distinctive character. That said, the positioning of the letters TG as the prefix element of Churan's trade mark results, in my view, in these letters having a degree of dominance over the numerals which appear in the suffix position.

21. In reaching a conclusion on the degree of similarity between the respective trade marks, I must, as the case law dictates, compare them from the visual, aural and conceptual perspectives. However, before doing so, I note that in their counterstatement Churan say: "it appears there are four marks registered as TG". This is an important point as it reflects (realistically in my view) that all of Findel's earlier trade marks contain an element that would be interpreted as the letters TG.

Visual similarity

22. Churan's trade mark consists of the letters TG presented in upper case together with the numerals 101 separated by a space. Findel's trade mark No 1 consist of the letters tg presented in lower case as a monogram; their trade mark No 4 consists of the letters TG elided, presented in upper case in an enlarged bold font. Notwithstanding that the numerals 101 are alien to Findel's earlier trade marks, as both parties trade marks contain letters which Churan agree would be interpreted as the letters TG (albeit with different presentations), this leads, in my view, to the conclusion that when considered as totalities there is a reasonable degree of visual similarity between the respective trade marks.

Aural similarity

23. Similar considerations apply to the aural comparison. In my view, Churan's trade mark would be articulated as either Tee Gee One O One, or Tee Gee One Zero One, whereas Findel's trade marks are likely to be referred to as simply Tee Gee. When compared as totalities, this would once again, in my view, result in a reasonable degree of aural similarity between the respective trade marks.

Conceptual similarity

24. I have no evidence to suggest that Churan's trade mark, when considered as a whole, has any meaning and the combination TG 101 does not create any conceptual image in my mind. The same applies to Findel's trade marks which consist of the letters

tg and TG in different presentations. Consequently, as neither parties' trade marks convey any conceptual message, they are neither conceptually similar or dissonant.

Distinctive character of Findel's earlier trade marks

25. I must now assess the distinctive character of Findel's earlier trade marks. I note that in their written submissions Findel say:

“The various TG marks have been used by Findel plc's subsidiary, Express Gifts Limited, since at least as early as 1996.”

26. However, as Findel have not provided any evidence of the use they may have made of their trade marks, I have only their inherent characteristics to consider. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

27. I have no evidence which suggests either that the letters TG have any meaning for the goods at issue in these proceedings, or that in relation to these goods they are unlikely to be taken as an indication of origin by the average consumer. Of course Findel's earlier trade marks do not consist of the letters TG simpliciter, but of these letters presented in a particular manner. In those circumstances i.e. where the letters TG simpliciter are likely to possess a reasonable level of inherent distinctive character, I think that Findel are entitled to claim that their earlier trade marks (while still only possessing a reasonable level of inherent distinctive character overall) have a slightly higher level of inherent distinctive character than the non-stylised letters TG.

Likelihood of confusion

28. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of Findel's trade marks, as the more distinctive these trade marks are the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and 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 they have retained in their mind.

29. In summary, I have concluded that:

- (i) the respective goods at issue are identical;
- (ii) the average consumer is a member of the general public;
- (iii) given the nature of the goods at issue the visual aspect of the comparison is likely to be the most important although aural considerations will also play a part in the selection process;
- (iv) the average consumer is likely to pay a reasonably high level of attention to the selection of the goods;
- (v) both the letters TG and the numerals 101 contribute to the distinctive character of Churan's trade mark;
- (vi) the positioning of the letters TG as the prefix element in Churan's trade mark means that these letters have some dominance over the numerals 101 which appear in the trade mark in the suffix position;
- (vii) there is a reasonable degree of both visual and aural similarity between the respective trade marks;
- (viii) there is no conceptual similarity or dissonance between the respective trade marks;
- (ix) Findel's earlier trade marks are possessed of a reasonable level of inherent distinctive character.

30. I must now apply the global approach advocated to my findings to determine whether direct confusion (where one trade mark is mistaken for the other) or indirect confusion (where the goods would be assumed to come from economically linked undertakings) is likely to occur.

31. I have found that the respective goods at issue are identical and that there is a reasonable degree of both visual and aural similarity between the respective trade marks. I must also keep in mind the nature of the purchasing process, the traits of the average consumer when purchasing the goods and the reasonable level of inherent distinctive character Findel's trade marks possess. I noted above that in their submissions Findel said:

"It is quite common for trade marks to be used in various forms, as is the case with Findel's TG marks".

I agree with this comment and note that in *Zero Industry Srl v Office for Harmonisation in the Internal Market (Trade Marks & Designs)(OHIM) Case T-400/06* the General Court took a similar view when they said:

“78. Second, the Board of Appeal also pointed out in paragraph 25 of the contested decision that, as regards the conditions in which the goods in question are marketed, it is not unusual in the clothing business for the same mark to be configured in various ways according to the product it designates. It is also common, in its view, for the same clothing manufacturer to use sub-brands in order to distinguish its various lines from those of others. It therefore concluded that it is conceivable that consumers may associate zero^{rh+} and zero and regard the marks at issue as designating different ranges of products coming from the same manufacturer. “

32. The cumulative effect of these conclusions results, in my view, in a likelihood of confusion. Given the overall differences in the presentation of the respective trade marks, this confusion is more likely to be of an indirect nature i.e. where the average consumer does not mistake Churan’s trade mark for that of Findel’s but assumes that the goods provided under the respective trade marks come from the same trade source. In reaching this conclusion I have not overlooked Churan’s comments to the effect that they: “have developed use of the TG 101 since 2005 and have common law rights.” However, as no evidence has been provided by either party to these proceedings, this point is without relevance to my decision.

33. In summary, the opposition has been successful and the application is refused in its entirety.

Costs

34. As Findel have been successful they are entitled to a contribution towards their costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide, I award costs to Findel on the following basis:

Preparing a statement and considering the other side’s statement:	£200
Official fee:	£200
Written submissions:	£100
Total:	£500

35. I order Churan & Co to pay to Findel Plc the sum of £500. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 07 day of April 2010

**C J BOWEN
For the Registrar
The Comptroller-General**