

O-262-11

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2543900
BY MICHAEL ROGER MAURER
TO REGISTER A TRADE MARK IN CLASS 25**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 101002 BY HI-TEK OFFICE S.R.L.**

BACKGROUND

1. On 1 April 2010, Michael Roger Maurer applied to register **U-BOOT** as a trade mark for the following goods in class 25:

Clothing, footwear, headgear.

Following examination, the application was accepted and published for opposition purposes on 25 June 2010.

2. On 27 September 2010, Hi-Tek Office S.R.L (“Hi-Tek”) filed a notice of opposition. Following amendment this now consists of grounds based upon sections 5(1) and 5(2)(b) of the Trade Marks Act 1994 (as amended) (“the Act”) directed, I note, at all the goods contained in Mr Maurer’s application.

Hi-Tek relies upon the following trade marks:

Trade Mark	No.	Application date	Registration date	Goods relied upon
U-BOOT	E8964901	18.03.2010	Pending	25 - Clothing, footwear, headgear.
U-BOAT	E4197661	16.12.2004	10.11.2006	25 - Clothing, shoes, headgear.

3. On 29 November 2010, Mr Maurer filed a counterstatement in which the grounds of opposition are denied.

4. Neither party filed evidence or written submissions during the course of the proceedings. Mr Maurer filed written submissions in lieu of attendance at a hearing; I will refer to these submissions as necessary below.

DECISION

5. The opposition is based upon sections 5(1) and 5(2)(b) of the Act. These sections read as follows:

“5. - (1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

(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, or

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

6. 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.”

7. In these proceedings Hi-Tek is relying upon the two trade marks shown in paragraph 2 above, both of which constitute earlier trade marks under the above provisions, and neither of which is subject to proof of use, as per The Trade Marks (Proof of Use, etc) Regulations 2004).

Section 5(1) of the Act – in relation to trade mark No. E8964901 – U-BOOT

8. I turn first to the objection based upon section 5(1) of the Act. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA* [2003] FSR 34, the CJEU said in relation to what constitutes an identical trade mark:

“51 There is therefore identity between the sign and the trade mark where the former reproduces, without any modification or addition, all the elements constituting the latter.

52 However, the perception of identity between the sign and the trade mark must be assessed globally with respect to an average consumer who is deemed to be reasonably well informed, reasonably observant and circumspect. The sign produces an overall impression on such a consumer. That consumer only rarely has the chance to make a direct comparison between signs and trade marks and must place his trust in the imperfect picture of them that he has kept in his mind. Moreover, his level of attention is likely to vary according to the category of goods or services in question (see, to that effect, Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] E.C.R. I-3819 at para.[26]).

53 Since the perception of identity between the sign and the trade mark is not the result of a direct comparison of all the characteristics of the elements compared, insignificant differences between the sign and the trade mark may go unnoticed by an average consumer.

54 In those circumstances, the answer to the question referred must be that Art.5(1)(a) of the Directive must be interpreted as meaning that a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

Comparison of trade marks/goods

9. The respective trade marks at issue are for the hyphenated letter and word U-BOOT presented in upper case; they are, self evidently, identical. In addition, as both trade marks have been applied for in respect of, inter alia, “clothing, footwear, headgear”, the competing goods are also identical. Ordinarily that would be the end of the matter and Hi-Tek’s opposition to Mr Maurer’s application would succeed; however, Hi-Tek’s earlier Community trade mark 8964901 has not yet achieved registration.

10. In a letter from Mr Maurer’s professional representatives, Taylor Wessing, dated 13 June 2011, I have been told that Mr Maurer has opposed Hi-Tek’s Community trade mark application. In those circumstances, and bearing in mind the provisions of section 6(2) of the Act, my decision in relation to the ground based upon section 5(1) of the Act must be a provisional one until the final outcome of Hi-Tek’s Community trade mark is known. As the outcome under section 5(1) of the Act is uncertain, I will now go and consider the objection based upon section 5(2)(b) of the Act.

Section 5(2)(b) – in relation to trade mark No. E4197661 – U-BOAT

Case law

11. The leading authorities which guide me are from the CJEU (Court of Justice of the European Union): *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P (LIMONCELLO). It is clear from these cases that:

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

(b) the matter must be judged through the eyes of the average consumer for the goods/services in question; *Sabel BV v Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

(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*,

(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*,

(e) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

(f) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*.

(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*,

(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*,

(i) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(j) 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*,

(k) 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 and Adidas Benelux BV*,

(l) 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.*

The average consumer and the nature of the purchasing process

12. 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. The goods at issue in these proceedings are articles of clothing, footwear and headgear. These are goods which will be bought by the public at large; they then are the average consumer for such goods.

13. As to the manner in which the goods are likely to be selected by the average consumer, this is most likely 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 for example the comments of the Appointed Person in *React Trade Mark* [2000] RPC 285). In his written submissions Mr Maurer appears to agree with this conclusion when he says:

“This gives the marks a different visual appearance and visual comparison is important for the purchase of class 25 goods.”

14. As to the degree of attention the average consumer will display when selecting the goods, in his written submissions Mr Maurer says:

“These are goods where people take care in purchasing to ensure that they have bought the right brand as the trade mark is exceptionally important for consumers when buying items of clothing, footwear and headgear.”

15. In *New Look Ltd v Office for the Harmonization in the Internal Market* (Trade Marks and Designs) Joined cases T-117/03 to T-119/03 and T-171/03 the General Court considered the level of attention taken purchasing goods in the clothing sector:

“43 It should be noted in this regard that the average consumer's level of attention may vary according to the category of goods or services in question (see, by analogy, Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 26). As OHIM rightly pointed out, an applicant cannot simply assert that in a particular sector the consumer is particularly attentive to trade marks without supporting that claim with facts or evidence. As regards the clothing sector, the Court finds that it comprises goods which vary widely in quality and price. Whilst it is possible that the consumer is more attentive to the choice of mark where he or she buys a particularly expensive item of clothing, such an approach on the part of the consumer cannot be presumed without evidence with regard to all goods in that sector. It follows that that argument must be rejected.”

16. As the *New Look* case acknowledges, the cost of clothing can vary considerably. However, as neither of the competing specifications in class 25 is limited in this respect, it is goods across the whole price spectrum I must keep in mind. While I agree the average consumer’s level of attention is likely to be heightened when selecting, for example, a bespoke gown or suit, it is also, in my view, likely that the same average consumer’s level of attention will diminish when selecting, for example, an inexpensive pair of socks. While these examples demonstrate that the average consumer’s level of attention will vary considerably given the cost and nature of the article of clothing at issue, I accept that when selecting even routine items of clothing the average consumer is likely to be conscious of factors such as the size, colour, material and price of the article concerned. Overall, I think the average consumer is likely to pay at least a reasonable degree of attention to the selection of the goods at issue.

Comparison of goods

17. For the sake of convenience, the goods to be compared are as follows:

Hi-Tek’s goods	Mr Maurer’s goods
Clothing, shoes, headgear	Clothing, footwear, headgear.

18. The words “clothing” and “headgear” are common to both specifications and are identical. The “shoes” in Hi-Tek’s registration are a sub-set of the “footwear” in Mr Maurer’s application, and must, in view of the following comments of the General Court in *Gérard Meric v OHIM*, Case T-133/05, be regarded as identical:

“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 (Case T-104/01 Oberhauser v OHIM – Petit Liberto (Fifties) [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 Vedral v OHIM – France Distribution (HUBERT) [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03 Koubi v OHIM – Flabesa (CONFORFLEX) [2004] ECR II-719, paragraphs 41 and 42).”

Comparison of trade marks

19. The trade marks to be compared are:

Hi-Tek’s trade mark	Mr Maurer’s trade mark
U-BOAT	U-BOOT

20. The average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as wholes and does not pause to analyse their various details. In addition, he rarely has the chance to make direct comparisons

between trade marks and must instead rely upon the imperfect picture of them he has kept in his mind. In reaching a conclusion on similarity, I must identify what I consider to be the distinctive and dominant components of the respective trade marks and, with that conclusion in mind, I must then go on and compare the respective trade marks from the visual, aural and conceptual perspectives.

Distinctive and dominant components

21. Both parties' trade marks consist of three elements; the letter U, the hyphen and the word BOAT or BOOT. Insofar as Hi-Tek's trade mark is concerned, I note that in his written submissions (albeit in relation to conceptual similarity) Mr Maurer says:

“The Opponent's mark U-BOAT has a meaning being a type of submarine.”

22. In my view, the average consumer is likely to understand the letter and word U-BOAT as a reference to a submarine operated by Germany in the first and second world wars (I will return to this point below). The combination “hangs together”, and as such, there is, in my view, no distinctive and dominant component; the distinctiveness lies in the totality.

23. As far as I am aware (and there is no evidence nor are there any submissions to the contrary), the letter U appearing as the first element of Mr Maurer's trade mark has no meaning for the goods at issue in these proceedings. While the word BOOT is clearly descriptive of footwear, it is also likely, in my experience, to be viewed by the average consumer as being descriptive of, for example, jeans (where boot-cut is, I am aware, a term of art). However, the manner in which Mr Maurer's trade mark is presented i.e. with the letter U and the word BOOT hyphenated, suggests to me that the average consumer will see and remember Mr Maurer's trade mark as an integrated whole, where no element is dominant. I will now approach the visual, aural and conceptual comparison with those conclusions in mind.

Visual comparison

24. In his submissions Mr Maurer says:

“It has been held that differences of one letter are sufficient to distinguish short words. We would submit that this is the case in this opposition where one important letter is different, O and A.”

25. In case T-112/06, *Inter-Ikea Systems BV, established in Delft (Netherlands), v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* the GC said:

“54. As regards the visual comparison between the verbal element of the contested mark and the earlier word marks, the applicant claims that the only difference between them is the presence of the letter 'd' in the contested mark

and the letter 'k' in the earlier word marks. However, the Court has already held in Case T-185/02 Ruiz-Picasso and Others v OHIM – DaimlerChrysler(PICARO) [2004] ECR II-1739, paragraph 54) that, in the case of word marks which are relatively short, even if two marks differ by no more than a single consonant, it cannot be found that there is a high degree of visual similarity between them. “

26. I have described the competing trade marks above. Consisting as they do of five letters, presented in exactly the same manner and where only the fourth of the five letters differ, results, in my view, in a reasonable degree of visual similarity between them.

Aural similarity

27. The similarities mentioned above combined with the fact that both trade consists of two syllables, results, in my view, in a reasonably high degree of aural similarity between the competing trade marks.

Conceptual similarity

28. I set out Mr Maurer's views on this aspect of the comparison in paragraph 21 above. In addition, Mr Maurer says:

“Furthermore the marks are conceptually different...In contrast, the applicant's mark does not have any meaning to UK consumers. As was set out in the Bass/Pash case, conceptual differences can be sufficient to distinguish marks.”

29. The case referred to by Mr Maurer is case T-292/01 *Phillips-Van Heusen v OHIM – Pash Textilvertrieb und Einzelhandel* (BASS) [2003] which explains:

“Next, it must be held that the conceptual differences which distinguish the marks at issue are such as to counteract to a large extent the visual and aural similarities pointed out in paragraphs 49 and 51 above. For there to be such a counteraction, at least one of the marks at issue must have, from the point of view of the relevant public, a clear and specific meaning so that the public is capable of grasping it immediately. In this case that is the position in relation to the word mark BASS, as has just been pointed out in the previous paragraph. Contrary to the findings of the Board of Appeal in paragraph 25 of the contested decision, that view is not invalidated by the fact that that word mark does not refer to any characteristic of the goods in respect of which the registration of the marks in question has been made. That fact does not prevent the relevant public from immediately grasping the meaning of that word mark. It is also irrelevant that, since the dice game Pasch is not generally known, it is not certain that the word mark PASH has, from the point of view of the relevant public, a clear and specific meaning in the sense referred to above.

The fact that one of the marks at issue has such a meaning is sufficient –where the other mark does not have such a meaning or only a totally different meaning to counteract to a large extent the visual and aural similarities between the two marks.”

30. I have already concluded that Hi-Tek’s U-BOAT trade mark is likely to create a conceptual image in the mind of the average consumer. As far as I am aware (and once again there is no evidence or submissions to the contrary), Mr Maurer’s U-BOOT trade mark has no meaning. In short, while Hi-Tek’s trade mark will create a conceptual picture in the mind of the average consumer, Mr Maurer’s trade mark will not.

Distinctive character of Hi-Tek’s U-BOAT trade mark

31. I must now assess the distinctive character of Hi-Tek’s earlier trade mark. The distinctive character of a trade mark must be appraised first by reference to the goods in respect of which it has been registered and, second, 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. Although the combination U-BOAT has a meaning which is likely to be known to the average consumer, it is not, as far as I am aware, either descriptive of or non-distinctive for the goods for which it stands registered. Whilst not in the category of an invented word, it is, absent use, a trade mark possessed of a fairly high degree of inherent distinctive character.

Likelihood of confusion

32. In determining whether there is a likelihood of confusion, I need to bear a number of factors 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. It is also necessary for me to consider the distinctive character of Hi-Tek’s earlier trade mark, as the more distinctive this trade mark is, 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 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 he has retained in his mind. Earlier in this decision I concluded, inter alia, that: (i) the average consumer was the public at large, (ii) the goods at issue were identical, (iii) Hi-Tek’s earlier trade mark was possessed of a fairly high degree of inherent distinctive character, (iv) there was a reasonable degree of visual similarity and a reasonably high degree of aural similarity, and (v) while Hi-Tek’s trade mark was likely to create a concrete conceptual image in the mind of the average consumer, Mr Maurer’s trade mark was not.

33. Keeping all of the factors above in mind, I have come to the conclusion there will be neither direct confusion (where one trade mark is mistaken for the other) nor indirect confusion (where the average consumer will assume that the goods come from undertakings which are economically linked). I reach this conclusion because although there is undeniably a degree of visual and aural similarity between the competing trade marks, the fact that Hi-Tek's U-BOAT trade mark will create a concrete conceptual picture in the average consumer's mind whereas Mr Maurer's trade mark will not, is, as the case law explains, likely to counteract to a large extent any visual and aural similarities between the competing trade marks; that is the position here, and Hi-Tek's opposition based upon section 5(2)(b) of the Act fails accordingly.

34. Subject to successful registration in respect of relevant goods, Hi-Tek's opposition will succeed on the basis of its U-BOOT trade mark No. E8964901. In the absence of this trade mark the opposition would have failed. Consequently, a final decision cannot be given in relation to these proceedings until No. E8964901 is itself determined.

35. I direct Hi-Tek to advise me with one month of the final determination of Community trade mark No. 8964901 of the outcome of that application. On receipt of this information I will issue a supplementary decision giving a full determination of these proceedings which will include consideration of an award of costs.

Dated this 27th day of July 2011

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