

O-293-11

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2513620  
BY  
CHONG TECK CHOY  
TO REGISTER THE TRADE MARK**

**SULTANATE**

**IN CLASSES 25, 35 & 38**

**AND**

**AND IN THE MATTER OF OPPOSITION THERETO  
UNDER NO 100548  
BY  
BANCA ITALEASE S.P.A.**

**Trade Marks Act 1994**  
**IN THE MATTER OF application 2513620**  
**By Chong Teck Choy**  
**To register the trade mark**  
**SULTANATE**  
**In Class 25**  
**AND IN THE MATTER OF opposition thereto**  
**Under no. 100548**  
**By Banca Italease S.P.A.**

## **BACKGROUND**

1. On 11 April 2009, Chong Teck Choy (hereafter, the applicant) applied to register the above mark for goods and services in Classes 25, 35 and 38 of the Nice Classification System.<sup>1</sup>
2. The application was published on 26 February 2010 in the Trade Marks Journal.
3. On 21 May 2010, Banca Italease S.P.A.(hereafter ‘the opponent’) filed a notice of opposition, claiming that registration would be contrary to section 5(2)(b) of the Trade Marks Act 1994 (“the Act”).
4. The opposition is directed only at *clothing* in Class 25. The opponent relies on its earlier Community trade mark (CTM) detailed below:

<b>Mark details and relevant dates</b>	<b>Services relied upon</b>
CTM 244251 SULTANINO Date of application: 30 April 1996 Date of completion of registration procedure: 9 November 1998	Class 25 Footwear

5. The mark relied on by the opponent was registered more than five years before the date of publication of the applicant’s mark and is clearly an earlier trade mark. Consequently, the proof of use provisions<sup>2</sup> would be relevant. However, as the applicant has not put the opponent to proof of use they are entitled to rely on their goods to the extent claimed, namely, ‘*footwear*’.

<sup>1</sup> International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).

<sup>2</sup>See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations 2004: SI 2004/946) which came into force on 5<sup>th</sup> May 2004.

6. Only the opponent filed evidence and it also filed written submissions in lieu of a hearing; neither side requested a hearing, both being content for a decision to be made from the papers on file.

### **Opponent's evidence**

7. The opponent's evidence consists of a witness statement, dated 7 September 2010, in the name of Edmund Stephen Harrison, a trade mark attorney of Mewburn Ellis LLP, acting on its behalf. Exhibited at ESH1, Mr. Harrison provides a copy of the opponent's earlier mark from the OHIM database.

### **DECISION**

8. The opposition is based on section 5(2)(b) of the Trade Marks Act 1994, which states:

*“(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.”*

9. The leading authorities pertinent to this ground are from the Court of Justice of the European Union (CJEU), namely: *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) 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. (hereafter Canon)*;

(f) 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*;

(g) 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.*;

(h) 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*;

(i) 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*;

(j) but if the association between the marks causes the public to believe wrongly 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.*;

k) 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*;

l) 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: *Limoncello*

## **Comparison of goods**

10. For ease of reference the respective goods are as follows:

<b>Opponent's goods</b>	<b>Applicant's goods</b>
Footwear	Clothing

11. In comparing the respective goods, all relevant factors should be considered, as per *Canon* in which the CJEU stated at paragraph 23 of its judgment:

*“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”*

12. Other factors which may be considered include the criteria identified in *British Sugar Plc v James Robertson & Sons Limited (Treat)*<sup>3</sup> such as the respective trade channels through which the goods or services reach the market.

13. Both ‘*footwear*’ and ‘*clothing*’ have the same general intended purpose and method of use in that they are worn to cover the body, for protection and/or due to the aesthetic characteristics of the goods. The goods will be used by members of the public at large who are unlikely to substitute one of these goods for the other, meaning that they are not in competition with each other. Both may be manufactured by the same operator and are regularly sold through the same outlets resulting in a similarity between distribution channels. ‘*Footwear*’ and ‘*clothing*’ may, in some cases be made from the same or similar materials, such as leather, cotton, canvas and so on.

14. I must also consider if the respective goods are complementary. In this respect I am guided by the judgement of the GC in *Boston Scientific Ltd v OHIM (Trade marks and Designs Case)*, *Case T-325/06 at paragraph 82*:

*“It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, T-169/03 Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI) [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P Rossi v OHIM [2006] ECR I-7057; Case T-364/05 Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL) [2007] ECR II-757, paragraph 94; and Case T-443/05 El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños) [2007] ECR I-0000, paragraph 48).*

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<sup>3</sup>*British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

15. In broad terms *'footwear'* and *'clothing'* share common characteristics. They may both be purchased as fashion items and may be selected for aesthetic reasons in order to create a particular 'look'. However, it has been commented upon by the GC in *Sergio Rossi v OHIM – Sissi Rossi*<sup>4</sup> and *Oakley v OHIM – Venticinque*<sup>5</sup> that consumers may search for a range of goods with an "aesthetic harmony" and although this is a common feature of the entire fashion and clothing sector, it is too general a factor to justify a finding that all the goods concerned are complementary and, thus, similar.

16. Clothing and footwear are not indispensable or important for the use of each other. Therefore, in light of the guidance above, I am bound to conclude that the goods are not complementary. Finally, I am also mindful of the decision of the GC in *Giordano Enterprises Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*<sup>6</sup> in which the court said at paragraph 20:

*"As the Court has held in previous cases<sup>7</sup>, in view of the sufficiently close links between the respective purposes of 'clothing' and 'footwear', which are identifiable in particular by the fact that they belong to the same class, and the specific possibility that they can be produced by the same operators or sold together, it may be concluded that those goods may be linked in the mind of the relevant public."*

17. The court concluded in the same paragraph of its judgement that:

*"... 'clothing' and 'footwear' must therefore be regarded as similar within the meaning of Article 8(1)(b) Regulation No. 40/94".*

18. Taking all of these factors into account I conclude that *'clothing'* in the applicant's specification shares a high degree of similarity with *'footwear'* in the opponent's specification.

### **Average consumer and nature of the purchasing act**

19. The average consumer for *'footwear'* and *'clothing'* will be the same, namely clothing/footwear buying members of the general public. The average consumer is reasonably well informed and reasonably circumspect and observant, but with a level of attention likely to vary according to the category of goods. The attention paid is likely to vary depending on price and, to some extent, the nature of the goods and the frequency of the purchase. Clothing and footwear both consist of a wide range of goods which can include socks, which may be a fairly frequent, inexpensive purchase but also high end designer clothing, which will be a less frequent and more expensive one. In *New Look Ltd v Office for the Harmonization in the Internal*

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<sup>4</sup> T-169/03, paragraph 27

<sup>5</sup> T-116/06, paragraph 86

<sup>6</sup> T-483/08, paragraph 20

<sup>7</sup> (Case T-115/02 *AVEX v OHIM – Ahlers (a)* [2004] ECR II-2907, paragraphs 26 and 27; see also judgment of 10 September 2008 in Case T-96/06 *Tsakiris-Malla v OHIM – Late Editions(exé)*, not published in the ECR, paragraphs 29 and 30, and judgment of 8 March 2005 Case T-32/03 *Leder & Schuh v OHIM – Schuhpark Fascies(Jello Schupark)*, not published in the ECR, paragraph 50)

*Market (Trade Marks and Designs)* Joined cases T-117/03 to T-119/03 and T-171/03, at paragraph 43, the GC considered the level of attention taken in purchasing goods in the clothing sector:

*“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.”*

23. I am also mindful of the comments of Mr Simon Thorley, sitting as the Appointed Person, in *React trade mark* [2000] R.P.C. 285:

*“There is no evidence to support Ms Clark’s submission that, in the absence of any particular reputation, consumers select clothes by eye rather than by placing orders by word of mouth. Nevertheless, my own experience tells me it is true of most casual shopping. I have not overlooked the fact that catalogues and telephone orders play a significant role in this trade, but in my experience the initial selection of goods is still made by eye and subsequent order usually placed primarily by reference to a catalogue number. I am therefore prepared to accept that a majority of the public rely primarily on visual means to identify the trade origin of clothing, although I would not go so far as to say that aural means of identification are not relied upon.”<sup>8</sup>*

24. Whilst these comments concentrate on *clothing* specifically, they are equally relevant when considering the nature of the purchasing act in respect of *footwear*. *Clothing* and *footwear* need to fit and may be selected according to aesthetic characteristics or function, meaning that considerations such as fabric or colour may be a factor. Consequently, the purchasing act will involve a reasonable degree of care and attention but not at the highest level. As Mr Thorley noted, the purchasing process is primarily a visual one but I do not ignore the aural considerations that may be involved.

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<sup>8</sup> The GC has continued to identify the importance of visual comparison when considering the purchasing act in respect of clothing (see for example Joined Cases T-117/03 to T-119/03 and T-171/03 *New Look Ltd v OHIM (NLSPORT et al)* [2004] ECR II-3471 at [49]-[50] and Case T-414/05 *NHL Enterprises BV v OHIM (LA KINGS)* [2009] ECR II).

## Comparison of marks

25. The marks to be compared are:

The opponent's earlier mark	The applicant's mark
SULTANINO	SULTANATE

26. In making a comparison between the marks, I must consider the respective marks' visual, aural and conceptual similarities with reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components,<sup>9</sup> but without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

### Distinctive and dominant components

27. The opponent's mark consists, in its entirety, of the word SULTANINO. The applicant's mark consists of the word SULTANATE. Neither contains any emphasis on any part of the word, nor any stylisation or additional elements. Both marks are a single word which does not split into separate distinctive and dominant components. Both marks will be considered in their entirety.

28. However, in making this assessment I am mindful of the GC's comments in *Les Editions Albert René v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-336/03* when they stated at paragraph 75:

*"It should be noted in this regard that the attention of the consumer is usually directed to the beginning of the word (Joined Cases T-183/02 and T-184/02 El Corte Inglés v OHIM – González Cabello and Iberia Líneas Aéreas de España (MUNDICOR) [2004] ECR II-0000, paragraph 83)."*

29. There is no evidence, nor are there any submissions, before me that indicate consumer attention will be any different in the current case.

### Visual comparison

30. The respective marks both consist of a single word of nine letters in length. The obvious point of similarity is that both begin with the same six letters, namely, S-U-L-T-A-N. They differ in the last three letters, the opponent's mark ending 'INO', while the applicant's mark ends with 'ATE'. Taking these factors into account I conclude that the marks share a reasonably high degree of visual similarity.

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<sup>9</sup> *Sabel v Puma AG*, para. 23



## Aural comparison

31. Both marks begin with the six letters 'SULTAN' resulting in the first two syllables of both parties' marks being aurally identical. The opponent's mark ends with the three letters 'INO', which is likely to be pronounced as 'EE-NO'. The whole mark is four syllables in length and will be pronounced 'SUL-TAN-EE-NO'. The applicant's mark ends with 'ATE' which will be pronounced as it appears, resulting in a mark which is three syllables long and will be pronounced 'SUL-TAN-ATE'. Despite the obvious differences between the lengths of the marks, there is a strong similarity in the fact that the marks both begin with the same two syllables. Taking these factors into account I conclude the marks share a reasonably high degree of aural similarity.

## Conceptual comparison

32. For a conceptual meaning to be relevant it must be one capable of immediate grasp.<sup>10</sup> Such assessment must, of course, be made from the perspective of the average consumer. Neither the applicant's nor the opponent's mark is defined in standard English dictionaries. However, the word 'SULTANATE' is defined in the Oxford Dictionary of World History as 'A territory subject to sovereign independent Muslim rule'.<sup>11</sup>

33. The applicant submits that:

*"The marks SULTANATE and SULTANINO are different because the meaning of SULTANINO is 'small sultan' in Italian...whereas SULTANATE is the land ruled by a sultan."*

34. Neither of these words is an everyday word, nor has any evidence been provided to show how SULTANATE or SULTANINO would be commonly understood by the average consumer. It would be wrong for me to assume that the relevant consumer is familiar with the term 'SULTANATE' or that the average UK consumer would be aware that 'INO' is an Italian suffix which can be used to denote 'small'. In considering this point I have born in mind the comments of Anna Carboni sitting as the appointed person in 'CHORKEE' when she said:

*"I have no problem with the idea that judicial notice should be taken of the fact that the Cherokee Nation is a Native American tribe. This is a matter that can easily be established from an encyclopaedia or internet reference sites to which it is proper to refer. But I do not think that it is right to take judicial notice of the fact that the average consumer of clothing in the United Kingdom would be aware of this. I am far from satisfied that this is the case."*<sup>12</sup>

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<sup>10</sup>This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r. –I-643; [2006] E.T.M.R. 29.

<sup>11</sup>*A Dictionary of World History*. Oxford University Press, 2000. *Oxford Reference Online*. Oxford University Press. Intellectual Property Office. 26 July 2011 <<http://www.oxfordreference.com/views/ENTRY.html?subview=Main&entry=t48.e3528>>

<sup>12</sup> O-048-08, paragraph 37

35. In this case, though the parties have provided meanings for both marks, I am not prepared to accept that these would be commonly understood by the average consumer. Taking these factors into account, I must conclude that the average consumer will consider both SULTANATE and SULTANINO to be invented words. Nevertheless in making a conceptual comparison between these marks I am also mindful of the fact that an invented word can carry conceptual weight.<sup>13</sup>

36. In *Usinor SA v Office for Harmonisation in the Internal Market*<sup>14</sup> (GALVALLOY) the GC held that:

*“...while the average consumer normally perceives the mark as a whole and does not proceed to analyse its various details<sup>15</sup>, he will nevertheless, perceiving a verbal sign, break it down into verbal elements which, for him, suggest a concrete meaning or which resemble words known to him.<sup>16</sup>*

...

*By breaking down the signs at issue, the relevant public will therefore interpret both signs as referring to the concepts of galvanisation and alloy.”*

37. The opponent also submits:

*“The earlier trade mark consists of the word ‘SULTANINO’. This is a word that is unlikely to have a specific meaning to the average consumer of the relevant products in the UK. The mark is likely; therefore, to be viewed as a made up word, but it is highly likely that the average consumer would assume there was a reference to the English word ‘SULTAN’ which is an English transliteration of an Arabic honorific title...The marks therefore share the same conceptual significance.”*

38. Having regard for the GC’s guidance in GALVALLOY, I agree with the opponent’s submission. It is highly likely that in the case of both of the marks at issue, the average consumer, in an attempt to break down the verbal elements, will distinguish the word SULTAN at the start of the mark, even though they may not go on to attribute a meaning to the mark in its entirety. The presence of SULTAN at the beginning provides a conceptual hook which is likely to result in both being interpreted, by the relevant public, as referring to someone, or something, related to the title of SULTAN. Taking the guidance into account I find that even though there is no clear dictionary definition in respect of either mark which would provide an obvious conceptual meaning for the average consumer, the presence of a recognisable word at the beginning of the mark, which will be understood, results in the marks both referring to the concept of a sultan. As a consequence, I conclude there is a reasonably high degree of conceptual similarity between the marks.

39. I have found the marks to have a reasonably high degree of visual, aural and conceptual similarity, resulting in a reasonably high degree of similarity overall.

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<sup>13</sup> *Ontex NV v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T- 353/04, paragraph 91*

<sup>14</sup> T-189/05, paragraphs 62-68

<sup>15</sup> *Lloyd Schuhfabrik Meyer, paragraph 25*

<sup>16</sup> *Vitakraft-Werke Wührmann v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-356/02, paragraph 51*

## **Distinctive character of the earlier mark**

40. In order to make an overall global assessment of the likelihood of confusion, I must also assess the distinctive character of the opponent's mark. The distinctive character of a mark can be appraised only, first, by reference to the goods in respect of which it has been registered and, secondly, by reference to the way it is perceived by the relevant public.<sup>17</sup> In determining the distinctive character of a trade mark, it is necessary to make an overall assessment of the greater or lesser capacity of the 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.<sup>18</sup>

41. SULTANINO does not have a dictionary meaning. In relation to *footwear* the mark is neither descriptive nor allusive of the goods. As a consequence the mark enjoys a reasonably high level of inherent distinctive character. As I have already discussed above,<sup>19</sup> no evidence of use has been provided so I cannot go on to consider whether the inherent distinctive character of the earlier mark has been enhanced through the use made of it.

## **Likelihood of confusion**

42. In assessing the likelihood of confusion I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them he has in his mind.<sup>20</sup> I must also keep in mind the average consumer for the goods, the nature of the purchasing process and have regard to the interdependency principle i.e. a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective goods and vice versa.

43. I have found the respective marks to share a reasonably high degree of visual, aural and conceptual similarity resulting in a reasonably high level of similarity overall. I have also identified a reasonably high level of distinctive character in the opponent's earlier mark. In respect of the goods I have concluded that the applicant's '*clothing*' in class 25 shares a high degree of similarity with the opponent's '*footwear*'. I have identified the average consumer as clothing/footwear buying members of the general public and have concluded that the purchasing act will involve a reasonable degree of care and attention but not the highest level and will be primarily visual (though aural considerations must also be borne in mind).

44. Taking all of the above factors into account, and considering the marks as a whole, I conclude that the differences between the marks are not sufficient to outweigh the obvious similarities. It is clear from decisions such as those in joined

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<sup>17</sup> Rewe Zentral AG v OHIM (LITE) [2002] ETMR 91

<sup>18</sup> Windsurfing Chiemsee v Huber and Attenberger Joined Cases C-108/97 and C-109/97 [1999] ETMR 585

<sup>19</sup> See paragraph 5

<sup>20</sup> *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27

cases T-183/02 and T-184/02<sup>21</sup> that the first parts of words catch the attention of consumers. I have also concluded that the beginning of these marks provide the average consumer with a conceptual hook which in light of the concept of imperfect recollection means that the similarities between the marks are such that if used on goods which possess a reasonably high level of similarity, there is a likelihood that the average consumer will believe that the goods provided under one mark are provided by the same or a linked undertaking as the goods provided under the other. Accordingly, **I find that there is a likelihood of confusion and the opposition succeeds in respect of class 25**, which was the only class subject to opposition.

## **COSTS**

45. The opposition having succeeded, Banca Italease S.P.A. is entitled to a contribution towards its costs. I have taken into account that no hearing has taken place, but that written submissions were filed in lieu.

Preparing a statement and considering the other side's statement: £500  
(including opposition fee)

Written submissions: £200

**Total: £700**

46. I order Chong Teck Choy to pay Banca Italease S.P.A. the sum of £700. 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 18th day of August 2011**

**Ms Al Skilton  
For the Registrar**

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<sup>21</sup> *El Corte Inglés v OHIM – González Cabello and Iberia Líneas Aéreas de España (MUNDICOR)*  
[2004] ECR II – 965, paragraph 81