

O/057/12

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK REGISTRATION 2448653  
IN THE NAME OF CHIOMA EBILAH IN RESPECT OF THE TRADE MARK:**



**AND**

**AN APPLICATION (NO. 83770) FOR INVALIDITY BY TAMASU BUTTERFLY  
EUROPA GMBH**

## **THE BACKGROUND AND THE PLEADINGS**

1) On 6 March 2007 Ms Chioma Ebilah applied for the following mark for the following goods:



**Class 18:** Leather goods including travel bags, luggage, hand bags for fashion, school and leisure, purses, wallets and related accessories namely, umbrellas and animal coverings, also includes the aforesaid items in non leather materials.

**Class 25:** Clothing, footwear, headgear, belts.

2) The application was published in the Trade Marks Journal on 23 November 2007 and it completed its registration procedure on 29 February 2008.

3) Tamasu Butterfly Europa GmbH (“Tamasu”) applied for a declaration of invalidity in respect of the above registration. The application was received on 3 June 2010. It is claimed that the above mark was registered in breach of section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). Tamasu relies on a single earlier trade mark of which it is the proprietor, a mark which consists of the word Butterfly. The earlier mark<sup>1</sup> is relied upon in respect of the following goods for which it is protected:

**Class 18:** Sports bags.

**Class 25:** Clothing, in particular outer clothing, winter jackets, wind-resistant jackets, fleece jackets, briefs, T-shirts, sportswear, casual wear, sports shirts, sports trousers, tracksuits, jogging suits, leotards, sweatbands, headbands; knitwear, in particular, sweaters, jerseys, jumpers, jersey clothing; hosiery goods (clothing), in particular, stockings, socks, sports socks; terry cloth clothing, namely bath robes; shoes, in particular sports shoes for tennis and table tennis; headgear, in particular caps.

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<sup>1</sup> It is an international registration (No. 921807) which has designated the UK for protection.

4) The earlier mark is not subject to the requirement to prove that it has been used because it had not been registered (or the protection process completed) for more than five years before the date on which the application for invalidation was made. (Section 47(2A) of the Act refers). The earlier mark may, therefore, be taken into account for the goods for which it is protected, to the extent relied upon.

5) Ms Ebilah filed a counterstatement denying the grounds on which the application is made. Only Ms Ebilah filed evidence. The matter came to be heard before me on 2 December 2011. At the hearing Tamasu were represented by Mr Alan Fiddes of Urquhart-Dykes & Lord LLP. Ms Ebilah did not attend the hearing nor did she file written submissions in lieu of attendance.

### **THE EVIDENCE**

6) The evidence comes from Ms Ebilah herself. I do not intend to summarise it in any great detail because it either consists of submissions (which are borne in mind) or it contains factual evidence as to the nature of the actual trade the respective parties have made; this second aspect is largely not relevant because, as I will explain in more detail, it is the notional use of the trade marks in respect of the goods for which they are registered/protected which is paramount. For the record, though, I note the following from Ms Ebilah's evidence:

- Her reference to what she says are the obvious visual, aural and conceptual differences between the marks;
- A statement that BUTTERFLY is a generic term, unlike BLACKBUTTERFLY which is quite distinctive in character;
- *Google* prints showing how the parties are described (Tamasu being a table tennis brand), Ms Ebilah's brand being used for bespoke denim jeans and other fashion items;
- Evidence that Tamasu is based in Germany and is, therefore, different from Ms Ebilah's market;
- Evidence from the parties' websites showing the trade marks' distinct "use, stylization, industry, consumer geographic". The evidence shows that Ms Ebilah's mark relates to a young fashion brand, but Tamasu's mark (which often includes a butterfly to the left of the word) focuses on the table tennis market;
- A business card for BLACKBUTTERFLY which contains the strap-line "Handcrafted, limited edition, bespoke";

- Further evidence, including website material, demonstrating different end-users etc, focusing, again, on the differences between a table tennis brand and bespoke fashion goods.

## **SECTION 5(2)(b)**

### **The law**

7) Section 5(2)(b) of the Act reads:

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

(a) .....

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

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

8) In reaching my decision I have taken into account the guidance provided by the Court of Justice of the European Union (“CJEU”) in a number of judgments: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 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, *Case C-3/03 Matrazen Concord GmbH v GmbGv Office for Harmonisation in the Internal Market* [2004] ECR I-3657 *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05). In *La Chemise Lacoste SA v Baker Street Clothing Ltd* (O/330/10) Mr Geoffrey Hobbs QC, sitting as the Appointed Person, quoted with approval the following summary of the principles which are established by these cases:

"(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 great 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;

(k) if the association between the marks causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion."

### **The notional assessment**

9) Much of Ms Ebilah's evidence and argument focuses on the exact nature of the parties' use, highlighting that Tamasu's brand relates to the world of table tennis and her brand to the world of bespoke fashion goods. However, it is paramount to bear in mind in all the assessments that I come to make that I must consider the position on a notional perspective based on the respective marks as they appear on the register and the goods for which they are registered/protected. I cannot, for example, apply a *de facto* limitation to Tamasu's goods limiting in them in anyway to sporting uses let alone more specifically to table tennis. Tamasu's earlier mark is not subject to the proof of

use provisions and it is, therefore, able to be relied upon for all of the goods for which it is registered. This may be frustrating to Ms Ebilah, but that is the reality of the situation given that Tamasu have protection for its mark in respect of the goods that its registration covers. This also explains why much of the evidence filed is of little or no significance. It is against that backdrop that my subsequent assessments must be made.

### **The average consumer**

10) The case-law informs me that the average consumer is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). The degree of care and attention the average consumer uses when selecting goods or services can, however, vary depending on what is involved (see, for example, the judgment of the General Court (“GC”) in *Inter-Ikea Systems BV v OHIM* (Case T-112/06)).

11) The goods concerned are not specialist ones and will be purchased by members of the general public. They are the sorts of goods which are purchased more by the eye than by oral request. The prices of the goods will vary but are not, generally speaking, high cost. I consider the purchasing process to be a normal, reasonably considered one, with no higher or lower degree of consideration than the norm.

### **Comparison of goods**

12) In terms of the comparison to be made, all relevant factors relating to the goods in the respective specifications should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* 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.”

13) Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

- “(a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;

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

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

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

14) In relation to understanding what terms used in specifications mean/cover, the case-law informs me that “in construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of the trade”<sup>2</sup> and that I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning<sup>3</sup>. Finally, when comparing the respective goods, if a term clearly falls within the ambit of a term in the competing specification then identical goods must be considered to be in play<sup>4</sup> even if there may be other goods within the broader term that are not identical.

15) It should be noted that the class 25 specification of Tamasu’s earlier mark contains the words “namely” and “in particular”. A question arises as to whether the use of such words means that the terms in the specification are to be limited to only the goods which follow the words namely/in particular or whether protection is also afforded to the broad terms that precede them. In my view, the use of the word namely limits the goods to those that follow and, therefore, there is no protection for the broad term that precedes it. The word namely, by implication, names goods. However, the converse applies with regard to the use of the words “in particular”. Here the words indicate the particular items of interest, but not to the exclusion of all other goods that also fall within the broad term that precedes it. Therefore, when looking at the class 25 goods of the earlier mark, I would observe the following:

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<sup>2</sup> See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

<sup>3</sup> See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

<sup>4</sup> See *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)(OHIM) Case T-133/05 (“Gérard Meric”)*.

*Clothing, in particular outer clothing, winter jackets, wind-resistant jackets, fleece jackets, briefs, T-shirts, sportswear, casual wear, sports shirts, sports trousers, tracksuits, jogging suits, leotards, sweatbands, headbands*  
This term covers all forms of clothing as well as those that are subsequently identified.

*Knitwear, in particular, sweaters, jerseys, jumpers, jersey clothing*  
This term covers all forms of knitwear as well as those that are subsequently identified.

*Hosiery goods (clothing), in particular, stockings, socks, sports socks*  
This term covers all forms of hosiery as well as those that are subsequently identified.

*Terry cloth clothing, namely bath robes*  
This term covers only bath robes made from terry clothing and not terry cloth clothing at large.

Shoes, in particular sports shoes for tennis and table tennis;  
This term covers all shoes as well as those that are subsequently identified.

Headgear, in particular caps.  
This term covers all forms of headgear as well as those that are subsequently identified.

16) In relation to the class 25 goods applied for by Ms Elibah and their similarity/identity with the goods of Tamasu's mark, I make the following assessment:

Clothing is clearly identical to goods of the earlier mark given that the earlier mark has protection for clothing at large.

Footwear is also identical to the earlier marks' clothing as clothing is a broad term that covers anything which clothes the body. Identity also exists because the earlier mark covers shoes which are included within Ms Elibah's term footwear. Whilst footwear items other than shoes also fall within the applied for term, the similarity with them will still be high on account of the nature, purpose and channels of trade etc.

Headgear is clearly identical to the goods of the earlier mark given that the earlier mark has protection for headgear at large.

Belts is a term classified in class 25 as it is a form of clothing, as such it falls within the general term clothing covered by the earlier mark and, as such, is identical.



17) In relation to Ms Ebilah's class 18 goods, the use of the word "namely" also applies and the use of the word "including" is similar to the use of the words "in particular". Also, as the specified leather goods are specified as being also of non-leather, then the goods sought are:

Leather goods at large

Travel bags & luggage

Hand bags for fashion, school and leisure

Purses & wallets

Umbrellas

Animal coverings

18) I find that there is no similarity between animal coverings and the goods of the earlier mark. Indeed, I struggle to find anything particularly close to even make an assessment upon. I also find no similarity between umbrellas and the goods of the earlier mark. Umbrellas are certainly not similar to sports bags when the normal factors relevant to a goods comparison is made. Nor do I see any link between umbrellas and clothing products, the purposes of which differ as do the nature and methods of use. I see no complementary relationship in the sense described by the jurisprudence.

19) In relation to travel bags and luggage, such goods are for carrying items, as are sports bags. Although sports bags may be used to carry sporting items, they are not the type of bags that are specifically adapted for such a purpose (such goods fall in class 28 not class 18) and, as such, they may be used to carry anything. Indeed, it is my experience that a sports bag is often used as a multi-purpose bag for carry anything, including carrying items when travelling. There could therefore be an overlap in purpose and an element of competition. The nature may also be very similar, particularly as a lot of luggage nowadays is in a holdall/bag form. I consider there to be a high degree of similarity with these goods.

20) In relation to the various handbags listed, there is a degree of similarity with sports bags. Handbags would ordinarily be smaller than sports bags, but they are both for carrying things, could be made of similar materials, there could also be a degree of competition because a person may choose between a large handbag or purchasing a sports bag for carry things around (particularly in relation to the school and leisure hand bags which are listed). I consider there to be a reasonable degree of similarity. There is also a reasonable degree of similarity


between handbags and the clothing covered by the earlier mark on account of the complementary relationship between handbags and certain fashion items<sup>5</sup>.

21) In relation to purses and wallets, these are a step removed from bags as their purpose is to carry money, credit cards etc, are much smaller in nature and will differ in form. They could of course be made form the same material as sports bags, and they could be sold through similar trade channels. They do not, however, compete nor are they complementary. I consider that any similarity is of only a low degree.

22) In relation to leather goods, such goods would include sports bags within its ambit so identical goods are considered to be in play. Leather goods would, of course, include other items beyond sports bags. However, Ms Ebilah has listed particular leather goods she is interested in (which I have assessed above) so I do not consider it necessary to consider the matter any further.

**Comparison of the marks**

23) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The visual, aural and conceptual similarities of the marks must be assessed by reference to their overall impressions, bearing in mind their distinctive and dominant components. The marks to be compared are:

Tamasu's mark	Ms Ebilah's mark
<p>Butterfly</p>	

24) It should be noted that the colour in Ms Ebilah's mark cannot act as a significant point of difference with the earlier mark given that the earlier mark is not registered with regard to any particular colour<sup>6</sup>. The earlier mark could, notionally, be presented in white on a pink background. In terms of Tamasu's mark, it has only one element namely the word Butterfly, this, accordingly, represents its dominant element. In terms of Ms Ebilah's mark, it is made up,

<sup>5</sup> See *El Corte Inglés SA v OHIM* Case T-443/05

<sup>6</sup> See to that effect *Mary Quant Cosmetics Japan Ltd v. Able C&C Co Ltd*, O-246-08 and, also, the judgment of Mr Justice Mann in *Specsavers International Healthcare Limited & Others v Asda Stores Limited* [2010] EWHC 2035 (Ch)).

essentially, of the words BLACK BUTTERFLY in a stylised script superimposed above a picture of a butterfly, the butterfly also being black. I would, though, observe that the word BLACK, although it is in the same script as the word BUTTERFLY, is less legible on first glance. This in itself means that the word BUTTERFLY will be the more dominant element. Even if that were not the case then because the word black is merely indicating the colour of the butterfly then, again, the word BUTTERFLY becomes the more dominant word. That being said, it is to be remembered that the average consumer will perceive the mark as a whole so the word BLACK will not, therefore, be ignored from my analysis. In terms of the device of the butterfly, this also forms a dominant element, I consider the words and the device to make a roughly equal contribution to the overall impression of the mark.

25) In terms of the visual similarities/differences, the word Butterfly is in common, but the earlier mark also contains the word black, the device of a butterfly and the stylized script. Whilst the earlier mark may, notionally, be used in a script of its own, the script of Ms Ebilah's mark is stylized enough so that it should not be considered a potential notional form of use of the earlier mark. There are clearly some visual differences, but they do not outweigh the similarities, particularly when the dominant element of the marks is borne in mind. I consider there to be a moderate, neither high nor low, degree of visual similarity.

26) In terms of aural similarity, there are less differences. The only difference, from an aural perspective, being the word BLACK. Bearing in mind, again, what the dominant elements of the marks are, I consider that there is a reasonable degree of aural similarity.

27) In terms of conceptual similarity, for a conceptual meaning to be relevant it must be one capable of immediate grasp<sup>7</sup>. Both concepts are clear, one is of a butterfly, one is of a butterfly that is black. Although not identical concepts, there is a strong similarity as both relate to a butterfly, which is the dominant element of the marks.

### **The distinctiveness of the earlier Butterfly mark**

28) The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark (based either on inherent qualities or because of use made), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). No use of the earlier mark has been presented so I have only its inherent qualities to consider. To that extent, and considered as a trade mark used in the course of trade, I have no reason to conclude that the mark has at least an average degree of distinctive character. I note that Ms

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<sup>7</sup> This is highlighted in numerous judgments of the GC and the ECJ including *Ruiz Picasso v OHMi* [2006] e.c.r. –I-643; [2006] E.T.M.R. 29.

Ebilah stated in her evidence that Butterfly was generic, but no evidence has been presented to this effect.

### **Likelihood of confusion**

29) The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

30) I need not consider likelihood of confusion in respect of umbrellas and animal coverings. I have found that such goods are not similar to any of the goods covered by the earlier mark. The goods must be similar for the ground of opposition to bite<sup>8</sup>, as such, the ground of opposition is dismissed.

31) I next consider the goods that are either identical or highly similar (all of Ms Ebilah's class 25 goods, plus leather goods at large, travel bags and luggage). The closeness of the respective goods is important because a greater degree of similarity between the goods may offset a lesser degree of similarity between the marks. In any event, in this case, I have found there to be a moderate (neither high nor low) degree of visual similarity and a reasonable degree of aural similarity. That there is less visual similarity than aural similarity is borne in mind, as is the following comment of the General Court in *New Look v OHIM*:

“However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (*BUDMEN*, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumers choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs.

50 The applicant has not mentioned any particular conditions under which the goods are marketed. Generally in clothes shops customers can

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<sup>8</sup> See, for example, the CJEU's judgment in *Waterford Wedgwood plc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case C-398/07.

themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly the visual aspect plays a greater role in the global assessment of the likelihood of confusion.

51 Nevertheless it is common in the clothing sector for the same mark to be configured in various ways according to the type of product which it designates. It is also common for a single clothing manufacturer to use sub-brands (signs that derive from a principal mark and which share with it a common dominant element) in order to distinguish its various lines from one another (*Fifties*, paragraph 49, and *BUDMEN*, paragraph 57). In the present case the conceptual content of the marks applied for may reinforce the consumer's perception of them as sub-brands of a mark NL. Even if the consumer were faced with only one of the signs in question, the separate perception of 'NL' in bold type, first, and then of the following word, which may evoke the idea of a certain style of clothing, might lead the consumer to identify it as a sub-brand of the mark NL. Moreover, the different written form of the letter combination 'NL' in the signs applied for as compared with that of the earlier trade mark NL could be perceived as a particular configuration of that mark. Accordingly, the conclusion of the Board of Appeal that the consumer may perceive the marks applied for as special lines originating from the undertaking which is the proprietor of the earlier trade mark must be upheld"

32) Therefore, whilst visual similarity is a more important aspect than aural similarity, I must bear in mind that marks may be configured in different ways and, so, even if such reconfiguration introduces visual differences, a likelihood of confusion may still be found. I think this is a case in point. Although there are some visual differences, I believe the average consumer will put the common presence of the word Butterfly, the dominant element in both marks, down to the goods sold under the marks emanating from the same or an economically linked undertaking. This is even more likely when one bears in mind the concept of imperfect recollection because Ms Ebilah's mark is dominated by both the word and picture of a butterfly and this concept is what will lodge in the consumer's mind. **There is a likelihood of confusion in relation to the identical and highly similar goods.**

33) In relation to the various handbags, I extend the above finding. Even though the goods are not as similar to that assessed in the preceding paragraph, there is still a reasonable degree of similarity. For similar reasons to that expressed above, I believe the average consumer will believe that the undertakings responsible for the respective goods are the same or are linked. **There is a likelihood of confusion in relation to the various handbags that are listed.**

34) That leaves purses and wallets which I have found to be similar to only a low degree. The off-setting or interdependency principle I have referred to needs to be borne in mind. Here there is only a low degree of goods similarity and only a moderate degree of visual similarity. Whilst bearing in mind the conceptual and aural similarity, it is my view that the various factors do not combine to mean that the average consumer will be confused as to economic origin. **There is no likelihood of confusion in relation to purses and wallets.**

### **SUMMARY**

35) The opposition succeeds for all of the goods applied for with the exception of:

“Purses, wallets; umbrellas; animal coverings”

### **COSTS**

36) Tamasu has been largely successful and is entitled to a contribution towards its costs. I have, however, made a small discount from what I would have awarded had Tamasu been completely successful. I hereby order Ms Ebilah to pay Tamasu Butterfly Europa GmbH the sum of £900. This sum is calculated as follows:

*Preparing a statement and considering the other side's statement*  
£250

*Opposition fee*  
£200

*Considering Ms Ebilah's evidence*  
£200

*Attending the hearing*  
£250

37) The above sum should 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 10<sup>th</sup> day of February 2012**

**Oliver Morris  
For the Registrar,  
The Comptroller-General**