

O-008-13

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2583839
BY AMARJIT SINGH BIRRING
TO REGISTER**



AS A TRADE MARK

IN CLASS 25


AND:

**OPPOSITION THERETO UNDER NO. 102568
BY WILLY BOGNER GMBH & CO KGAA**

BACKGROUND

1. On 8 June 2011, Amarjit Singh Birring applied to register the trade mark shown on the cover page of this decision. The application was accepted and published for opposition purposes on 22 July 2011 for the following goods in class 25: “Clothing, footwear, headgear”.

2. On 21 October 2011, Willy Bogner GmbH & Co KGaA (“WB”) filed a notice of opposition directed against all of the goods in Mr Birring’s application. WB relies upon a single ground based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). WB relies upon the following trade mark:

Trade Mark	No.	Application Date	Registration Date	Goods relied upon
	CTM 8640948	31.10.2003	9.10.2009	Clothing, footwear and parts therefor (included in class 25), shoe soles; headgear; gloves (clothing).

3. In its notice of opposition WB said:

“The goods of [WB’s trade mark] are identical to [Mr Birring’s] goods.

The dominant element of each of the marks is the capital letter B. The letter B is meaningless in the context of the goods in question and therefore highly distinctive. As the distinctive and dominant element of the marks is identical, overall the marks are similar.”

4. On 21 December 2011, Mr Birring filed a counterstatement in which he asks WB to provide proof of use in relation to: “Winter clothes, namely ski suits and anoraks; sport suits”; I will return to this point below. In his counterstatement Mr Birring says, inter alia:

“The overall impression given by our mark as a composite logo is very different to that given by [WB’s trade mark]. Each mark has a definite and very different visual appearance and conceptual meaning so they are highly unlikely to be confused with each other in the mind of the public. The golden boot...is the dominant component and is visually striking and memorable. The letter B...is inextricably linked to the gold boot device.

Indeed, the only element in common with [WB’s] trade mark is the letter B. A search of the register shows that [WB] does not have a monopoly over the letter B in the classes in question, stylised or unstylised. There are many marks registered which co-exist with [WB’s] trade mark and which are more or equally similar to it, many of which cover overlapping goods and/or services to [WB’s] trade mark.

5. Having provided a list of 23 trade marks in support of the above, Mr Birring said:

“To object against our...application would therefore be arbitrary and groundless.”

6. Mr Birring also says:

“Visually the initial B is completely different to [WB’s] trade mark;
The mark would be incorporated in the boot;
The inside labels would be Birring clothing which will be located at the back of the neck;
There would be no confusion of the brand;
Pricing tags would also be marked as Birring clothing.”

7. While neither of the parties filed evidence or asked to be heard, WB filed submissions during the evidential rounds, and both parties filed written submissions in lieu of attendance at a hearing; I will refer to these submissions as necessary below.

DECISION

8. Section 5(2)(b) of the Act 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, or

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

9. 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.”

10. In these proceedings WB is relying upon the trade mark shown in paragraph 2 above; this qualifies as an earlier trade mark under the above provisions. While in his counterstatement Mr Birring asked WB to provide proof of use of the goods mentioned in paragraph 4, given the interplay between the date on which Mr Birring's application was published i.e. 22 July 2011 and the date on which WB's earlier trade mark completed its registration procedure i.e. 9 October 2009, WB's earlier trade mark is not subject to The Trade Marks (Proof of Use, etc) Regulations 2004, and, as a consequence, WB is entitled to rely upon all the goods in class 25 it referred to in its notice of opposition.

Section 5(2)(b) – case law

11. In his decision in *La Chemise Lacoste SA v Baker Street Clothing Ltd* -BL O/330/10 (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), the Appointed Person, Mr Geoffrey Hobbs QC, expressed the test under this section (by reference to the Court of Justice of the European Union (CJEU) cases mentioned) on the basis indicated below:

The CJEU cases

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; Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), Case T-6/01; Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH C-120/04; Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P.

The principles

“(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 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 and then to determine the manner in which these goods will be selected by the average consumer in the course of trade. In its submissions WB said:

“20. Also, the goods concerned are all everyday consumer items sold to the general public, so that it cannot be considered that the relevant market of consumers of the goods would exercise an unusually high degree of care when purchasing the goods.”

13. The goods at issue in these proceedings are clothing, footwear and headgear. Such goods will be sold in, inter alia, traditional retail outlets on the high street, through catalogues and on the Internet. The average consumer of the goods at issue is a member of the general public who is likely, in my view, to select the goods by predominantly visual means (although I think more expensive items may be the subject of some research and/or discussions with sales staff (where possible) prior to selection)). In this respect, I note that in *New Look Ltd v OHIM Cases - T-117/03 to T-119/03 and T-171/03*, the General Court (GC) said this about the selection of clothing:

“50. Generally in clothes shops customers can 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.”

14. As to the degree of care the average consumer will display when selecting clothing, in the same case the court said:

“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.”



15. While I accept that the average consumer’s level of attention is likely to be heightened when selecting, for example, a bespoke suit or gown, 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 or baseball cap. While these examples demonstrate that the average consumer’s level of attention will vary considerably depending on the cost and nature of the item at issue, I think that when selecting even routine items of clothing, footwear and headgear the average consumer is likely to be conscious of factors such as the size, colour, material and price of the item 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

16. As the terms clothing, footwear and headgear in Mr Birring's application find exact counterparts in WB's registration, the competing goods are identical.

Comparison of trade marks

17. The trade marks to be compared are as follows:

Mr Birring's trade mark	WB's trade mark
	

18. 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 identify what I consider to be the distinctive and dominant elements 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 elements

Dominant elements

19. WB's trade mark consists of a single element i.e. a slightly stylised upper case letter B. As no part of WB's trade mark is highlighted or emphasised in any way, there is no dominant element. As to Mr Birring's trade mark, this consists of a picture of what appears to me to be a conventional looking studded sporting boot (football I think) presented in gold and yellow and accompanied by an upper case letter B presented in a standard type face. Given its size within the trade mark as a whole, the picture of a sporting boot is the dominant element of Mr Birring's trade mark.

Distinctive elements

20. Turning to distinctiveness, in its submissions WB said of the letter B:

“14...The letter B is inherently distinctive for the class 25 goods in question...”

21. As far as I am aware, the letter B is not descriptive of any of the goods at issue in these proceedings. However, in his counterstatement, Mr Birring provided a list of trade marks which contain a letter B, some of which are or have been registered in class 25

(and some of which belong to WB). The relevance of this list is, I assume, to prove that in the context of the goods in class 25, I should treat the letter B as lacking distinctive character. In its submissions WB said:

“The relevance of that list is disputed. Some of the marks listed have expired. The vast majority of the remainder were registered at OHIM, so cannot stand as evidence of the practice of the UK Registry. The Registry no longer examines (and OHIM never has examined) trade mark applications *ex officio* on relative grounds. The co-existence of the marks on the European and Community Trade Mark Registers does not mean that the trade marks actually co-exist in the market place...”

22. In *British Sugar Plc v. James Robertson & Sons Ltd* [1996] RPC 281 Jacob J (as he then was) said:

“In particular the state of the register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led the registrar to put the marks concerned on the register. It has long been held under the old Act that comparison with other marks on the register is in principle irrelevant when considering a particular mark tendered for registration, see e.g. *Madame Trade Mark* and the same must be true under the 1994 Act. I disregard the state of the register.”

23. In *GfK AG v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-135/04 the General Court (GC) stated:

“68. As regards the search of the Cedex database, the mere fact that a number of trade marks relating to Class 35 contain the word „bus’ is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned. Firstly, the search in question does not provide any information on the trade marks actually used in relation to the services concerned. Secondly, it includes a number of trade marks in which the word „bus’ is used descriptively by public transport businesses.”

24. This was a view re-iterated by the GC in *Zero Industry Srl v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-400/06.) While I am aware of the judgment of Mr Daniel Alexander QC, sitting as a deputy judge of the High Court in *Digipos Store Solutions Group Ltd v Digi International Inc* [2008] RPC 24, in that case Mr Alexander was not referred to the judgment of the GC in *GfK AG*. I also note that in his judgment Mr Alexander referred to the *Madame* case being an absolute grounds case and appeared to consider this of some significance. The GC cases referred to above are relative grounds cases; clearly the GC considered that the principle of not giving weight to state-of-the-register evidence also applies in cases involving relative grounds issues.

25. For the reasons mentioned both above and by WB in its submissions, and bearing in mind the decision of the CJEU in Case C-196/11 P, *Formula One Licensing BV v OHIM, Global Sports Media Ltd*, it is not permissible for me to regard WB's earlier trade mark as having no distinctive character. That being the case, it follows that the stylised letter B in WB's trade mark is distinctive; similarly, the letter B in Mr Birring's trade mark is a distinctive but not dominant element of his trade mark.

26. Turning now to the picture of a sporting boot in Mr Birring's trade mark, in its submissions WB said:

“14...Although the opposed trade mark includes a golden football boot, it appears to have a regular, unremarkable form and is thus of limited distinctiveness, particularly in relation to footwear”.

27. The picture of a conventional sporting boot is obviously non-distinctive when considered in relation to sporting footwear such as football and rugby boots. The same would also, I think, be true of articles of sports clothing, sports footwear and sports headgear, in relation to which the average consumer is unlikely to accord a picture of a conventional sporting boot any trade mark significance. In addition, as sporting boots come in a range of different colours, the colours present in Mr Birring's trade mark are unlikely, in my view, to add much (if any) distinctiveness to the trade mark as a whole. However, when considered in the context of non-sporting clothing, non-sporting footwear and non-sporting headgear, such as, formal shirts, formal suits, gowns, trilbies etc., the photograph of a sporting boot is, in my view, likely to have a not insignificant degree of distinctive character.

Visual similarity

28. Although Mr Birring's trade mark is presented in colour, as WB's trade mark is presented in black and white this does not, for the reasons given by Mann J in *Specsavers International Healthcare Ltd v Asda Stores Ltd* (No. 2) [2011] FSR 1, assist in distinguishing the competing trade marks. The only similarity between the competing trade marks is the letter B. When considered in the context of sports clothing, sporting headgear and particularly sporting footwear (in which the picture of a conventional sporting boot will lack any distinctive character) the average consumer is, in my view, likely to focus on the letter B in Mr Birring's trade mark, resulting in a high degree of visual similarity with WB's trade mark. However, when considered in relation to the type of non-sporting clothing etc. I have identified above, the size of the letter B in comparison to the size of the picture of a sporting boot (which for such goods is likely to be distinctive), results, in my view, in the competing trade marks being visually similar to only a low degree.

Aural similarity

29. In its submissions WB said:

“13. Phonetically, the marks are identical as they have the same verbal content and would both be referred to as B marks.”

30. It is well established that where a word (and, in my view, by extension a letter) appear in a composite trade mark, the average consumer is most likely to refer to the composite trade mark by the word/letter element. As Mr Birring’s trade mark is, in my view, most likely to be referred to by the average consumer by the letter B, I agree with WB that the competing trade marks are aurally identical.

Conceptual similarity

31. In its submissions WB said:

“15. From a conceptual point of view there are both a difference and a similarity between the marks. The difference stems arises from the “boot” concept of the opposed trade mark, whilst the similarity arises from the common verbal element B. Overall, the presence of the latter in the opposed trade mark gives rise to a significant degree of conceptual similarity.”

32. The letter B in both parties’ trade marks is unlikely, in my view, to create any particular concept in the average consumer’s mind beyond that of a single letter, whereas the picture of a conventional sporting boot in Mr Birring’s trade mark is likely to evoke a sporting image in the average consumer’s mind. Overall, I think Mr Birring’s trade mark will create a definite conceptual picture in the average consumer’s mind, whereas WB’s trade mark will not.

Distinctive character of WB’s earlier trade mark

33. I must now assess the distinctive character of WB’s earlier trade mark. The distinctive character of a trade 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 – *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.

34. I have already commented on, and dismissed, Mr Birring’s argument that, on the basis of the state-of-the-register material provided, the letter B is lacking in distinctive character for the goods at issue in these proceedings. As WB has not filed any evidence of the use it may have made of its earlier trade mark, I have only the trade mark’s inherent characteristics to consider. As a slightly stylised single letter, WB’s earlier trade mark is not highly inherently distinctive. However, as I have already concluded that a

single letter B neither describes nor is non-distinctive for the goods at issue, it is, in my view, inherently distinctive to an average degree.

Likelihood of confusion

35. 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 goods and vice versa. As I mentioned above, it is also necessary for me to factor in the distinctive character of WB's 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 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 that:

- The average consumer of the goods at issue is a member of the general public who will select the goods by predominantly visual means and who will pay a reasonable degree of attention when doing so;
- The competing goods are identical;
- The distinctiveness of WB's trade mark lay in its totality;
- the picture of a conventional sporting boot is the dominant element of Mr Birring's trade mark which, in relation to some goods is non-distinctive, and which, in relation to other goods, possesses a not insignificant degree of distinctive character;
- The letter B is a distinctive but not dominant element of Mr Birring's trade mark;
- Depending on the goods at issue, the degree of visual similarity between the competing trade marks ranges from high to low;
- The competing trade marks are aurally identical;
- Mr Birring's trade mark will create a sporting image in the mind of the average consumer whereas WB's trade mark would create none;
- WB's earlier trade mark is, absent use, averagely distinctive.

36. In reaching a conclusion, I note that in *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, in which the CJEU said:

“29. In the context of consideration of the likelihood of confusion, 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. On the contrary, 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 (see *Matratzen Concord*, paragraph 32).

30. However, beyond the usual case where the average consumer perceives a mark as a whole, and notwithstanding that the overall impression may be dominated by one or more components of a composite mark, it is quite possible that in a particular case an earlier mark used by a third party in a composite sign including the name of the company of the third party still has an independent distinctive role in the composite sign, without necessarily constituting the dominant element.

31. In such a case the overall impression produced by the composite sign may lead the public to believe that the goods or services at issue derive, at the very least, from companies which are linked economically, in which case the likelihood of confusion must be held to be established.

32. The finding that there is a likelihood of confusion should not be subject to the condition that the overall impression produced by the composite sign be dominated by the part of it which is represented by the earlier mark.

33. If such a condition were imposed, the owner of the earlier mark would be deprived of the exclusive right conferred by Article 5(1) of the directive even where the mark retained an independent distinctive role in the composite sign but that role was not dominant.

34. This would be the case where, for example, the owner of a widely-known mark makes use of a composite sign juxtaposing this mark and an earlier mark which is not itself widely known. It would also be the case if the composite sign was made up of the earlier mark and a widely-known commercial name. In fact, the overall impression would be, most often, dominated by the widely-known mark or commercial name included in the composite sign.

35. Thus, contrary to the intention of the Community legislator expressed in the 10th recital in the preamble to the directive, the guarantee of the earlier mark as an indication of origin would not be assured, even though it still had an independent distinctive role in the composite sign.”

37. Having applied the guidance in *Medion*, I find that while the letter B is not the dominant element of Mr Birring’s trade mark, it plays an independent distinctive role in it. While the differences between the competing trade marks may (in some circumstances) be sufficient to avoid direct confusion (i.e. where one trade mark is mistaken for the other), the similarity which results from the use of what I have

concluded is the averagely distinctive letter B will, when used on goods which are identical lead, in my view, the average consumer to confuse the trade marks indirectly i.e. they will assume the goods of Mr Birring come from an undertaking economically linked to WB. In coming to that conclusion, I have not overlooked Mr Birring's comments to the effect that in use "the inside labels would be Birring clothing..." and "pricing tags would also be marked as Birring clothing". However, as it is necessary for me to compare the trade mark Mr Birring has actually applied for with WB's earlier trade mark, his comments as to how the trade mark may actually be used do not assist him.

Conclusion

38. Based on my conclusions above, WB's opposition succeeds in full.

Costs

39. As WB has been successful it is entitled to an award of 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 WB on the following basis:

Preparing a statement and considering Mr Birring's statement:	£300
Written submissions:	£300
Official fee:	£200
Total	£800

40. I order Amarjit Singh Birring to pay to Willy Bogner GmbH & Co KGaA the sum of **£800**. 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 8th day of January 2013

C J BOWEN
For the Registrar
The Comptroller-General