

O-127-13

**IN THE MATTER OF APPLICATION NOS 2512055 AND 2512057
BY
RIO FERDINAND LIVE THE DREAM FOUNDATION LIMITED
TO REGISTER THE TRADE MARKS**



AND

RIO FERDINAND LIVE THE DREAM

IN CLASSES 9, 16, 25, 28, 36, 41

AND

**THE OPPOSITION THERETO
UNDER NOS 99797 AND 99798
BY
KATHMANDU LIMITED**

BACKGROUND

1. On 25 March 2009, Rio Ferdinand Live The Dream Foundation Limited (the applicant) applied to register the above trade marks in classes 9, 16, 25, 28, 36 and 41 of the Nice Classification system, as follows:¹

Class 09:

Sound, video and data recordings; pre-recorded compact discs and DVDs; downloadable electronic publications; electronic instruction and teaching apparatus.

Class 16:

Stationery; paper, cardboard and goods made from these materials (not included in other classes); printed matter; instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); newsletters; notebooks; printed publications; writing materials, instruments, paper and pads.

Class 25:

Clothing, footwear, headgear; football shoes and boots; sports jerseys; sweaters.

Class 28:

Sporting articles; games and play things.

Class 36:

Charitable fund raising.

Class 41:

Education, educational services and education information and training; publication of books; entertainment, entertainment services and entertainment information; organisation of exhibitions for educational or cultural purposes; advisory services relating to entertainment; organisation of musical entertainment; vocational guidance; recreation information; organisation of sports competitions; physical education; providing online electronic publications; providing sports facilities; rental of sports equipment (except vehicles); rental of stadium facilities; sport camp services; teaching; writing of text (other than publicity text); provision of training courses for young people in preparation for careers; career advisory services; organisation, provision and production of live performances and events, including without limitation, those in relation to music, celebrity, fashion and sport; organisation and production of television, film and theatre productions for entertainment and/or educational purposes.

2. Following publication of the applications on 21 August 2009, Khatmandu Limited (the opponent) filed notice of opposition against the applications.

3. The grounds of opposition were brought under sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (the Act).

4. The oppositions based on 5(2)(b) are directed at the applicant's goods and services in classes 25, 28 and 41. The oppositions based on 5(3) grounds are directed at all of the applicant's goods and services. The opponent relies upon the two marks shown below in respect of both grounds.

¹ *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).*

Mark details and relevant dates	Goods and Services
<p>CTM: 3300928</p> <p>MARK: LIVE THE DREAM</p> <p>Filing date: 8 August 2003</p> <p>Registration date: 17 December 2004</p>	<p>Class 18: Rucksacks, haversacks and bags in this class including travel bags; umbrellas and parasols; goods made from leather and imitations of leather, and goods made of these materials and not included in other classes.</p> <p>Class 20: Furniture; bedding, mattresses, sleeping bags and outdoor furniture including furniture for camping; parts and fittings for all the aforesaid goods.</p> <p>Class 22: Camping equipment in this class including tents, awnings, tarpaulins, nets; sacks and bags in this class; parts and fittings for all the aforesaid goods including string and rope.</p> <p>Class 25: Clothing; headgear; and footwear.</p>
<p>CTM: 5127915</p> <p>MARK: LIVE THE DREAM</p> <p>Filing date: 9 June 2006</p> <p>Registration date: 31 May 2007</p>	<p>Class 35: Retailing and wholesaling of clothing, footwear, headgear and accessories for all the aforesaid, furniture including bedding, outdoor and camping furniture, sleeping bags, bag liners and sleeping sheets, packs and bags, tents, tarpaulins, nets, awnings, portable stoves and cooking apparatus, eating utensils, water purifiers, maps and other printed matter, compasses, first aid kits and components thereof, and other camping, tramping and outdoors equipment and parts and fittings therefor.</p>

5. In its statement of grounds the opponent states, in relation to section 5(3):

“Use [by the applicant] of the marks the subject of the Applications would:

1. take unfair advantage of the trade marks specified in the Oppositions because such use would benefit from the reputation attaching to such trade marks. Such use would benefit by calling to mind our client’s trade marks and thereby inciting consumer interest in the Applicant’s goods/services based on our client’s reputation in such trade marks; and/or

2. be detrimental to the trade marks specified in the Oppositions because such use would involve diminution in the value of the reputation attaching to such trade marks. Such use involves diminution in, or damage to, the value of our client’s reputation in such trade marks because such use would increase the marketability of [the applicant’s] goods/services to the detriment of our client’s goods/services and/or would prejudice the uniqueness and distinctiveness of our client’s brand.”

6. On 12 December 2011, Rio Ferdinand Live the Dream Foundation Limited (the applicant) filed a counter statement which denies the grounds of opposition and requests the opponent prove its reputation in its „LIVE THE DREAM’ marks.

7. On 30 April 2012 the applicant’s representative wrote to the opponent’s representative in the following terms:

“We write to inform you that Rio Ferdinand Live the Dream Foundation Limited has been dissolved and we are no longer instructed on behalf of the Foundation.”

8. The Registry wrote to the Treasury Solicitor’s Office² who confirmed in a letter dated 15 October 2012:

“...the Treasury Solicitor has jurisdiction to deal with the assets of the above company [the applicant company]. These assets include the above registered trademarks 2512055 & 2512057.”³

9. In this decision, references to the applicant should be taken to refer to the Rio Ferdinand Live the Dream Foundation Limited until its dissolution and the Treasury Solicitor thereafter.

10. The opponent’s marks are earlier marks not subject to proof of use because, at the date of publication of the applications, neither of them had been registered for five years.⁴

11. Only the opponent filed evidence; neither party asked to be heard or filed written submissions in lieu of attendance at a hearing.

EVIDENCE

The opponent’s evidence

12. The opponent’s evidence consists of a witness statement from Mark Todd, dated 19 March 2012, accompanied by 1 exhibit.

13. Mr Todd is the Director of Kathmandu UK Limited and is also the Finance Director, Chief Financial Officer and Company Secretary of the opponent’s holding company Kathmandu Holdings Limited. He states:

“1. I am duly authorised to make this witness statement on my own behalf and for and on behalf of the Opponent in relation to the oppositions...”

14. Key facts emerging from Mr Todd’s statement are as follows:

The Kathmandu Group opened its first store in 1987 in New Zealand.

In 2003/04 Kathmandu ‘commenced its UK initiative’.

² When a company is dissolved on or after 1 October 2009, its beneficial property and rights which are situated in England and Wales pass to the Crown, *bona vacantia* pursuant to s.1012 of the Companies Act 2006. The Treasury Solicitor is the Crown nominee for dealing with such assets.

³ The trade marks referred to are applications subject to opposition and are not yet registered.

⁴ 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 5th May 2004.

As of 31 July 2011, Kathmandu has 110 stores: 65 in Australia, 39 in New Zealand and 6 in the UK.

15. With regard to the opponent's stores, Mr Todd states:

"9. The Opponent, through [Kathmandu UK], offers for purchase through its United Kingdom stores and the Website an extensive product range, covering outdoor and travel clothing and equipment. The Opponent's product portfolio has been designed to suit a range of customer needs from the experienced adventurer to the entry-level explorer."

16. Accompanying Mr Todd's witness statement is one exhibit which consists of 103 pages. The exhibit is made up of multiple documents which, for ease of reference, I have split according to each document's corresponding page numbers. Examples of the earlier „LIVE THE DREAM' marks are presented in lower case throughout the evidence, and in lower case and block capitals in the accompanying documents relied on by the opponent. None of the forms of use shown differ in any material way from the marks as registered. For ease of reference I have referred to the marks as „LIVE THE DREAM' in plain block capitals throughout.

17. Throughout the exhibit two examples of Kathmandu marks are shown as follows:



I will refer to the mark on the left as the first Kathmandu mark and the mark on the right as the second Kathmandu mark.

18. Two examples of Kathmandu Summit Club marks are shown as follows:



I will refer to the mark on the left as the first Summit Club mark and the mark on the right as the second Summit Club mark.

18. Pages 1-3 are prints from the opponent company's website www.kathmandu.co.uk, printed on 20 March 2012. Page 1 is titled „About Us'. The second Kathmandu logo is shown at the top left corner of the page. The words „LIVE THE DREAM' are shown at the bottom left corner.

19. Page 2 is titled „Our Origins'. The second Kathmandu logo is shown at the top left corner of the page. The words „LIVE THE DREAM' are shown in the bottom left corner.

20. Page 3 is titled „Careers'. The second Kathmandu logo is shown at the top left corner of the page.

21. Pages 4-12 are a sale brochure. It is not dated but the front page states, „Sale starts Monday 19th March 2012’. The second Kathmandu logo is shown on the bottom right corner of the front page. The words „LIVE THE DREAM’ are presented below it. The following pages show the second Kathmandu logo in the top left of each page.
22. Pages 13 - 20 are a catalogue titled „Packs & Luggage’. The second Kathmandu logo is shown in the top right corner of the front page. The words „LIVE THE DREAM’ are shown in the bottom left corner. Of the remaining pages, 16 and 18 are not branded and the rest feature the second Kathmandu logo. The exhibit is not dated.
23. Pages 21-28 are a catalogue titled „Camping Gear’. The first Kathmandu logo is shown on the top right corner of the front page. The words „LIVE THE DREAM’ are presented below it. This is repeated on the back page. Pages 23, 25 and 27 feature the first Summit Club mark. The exhibit is not dated.
24. Pages 29 - 36 are a catalogue titled „All-Weather Layering Guide’. The second Kathmandu logo is shown in the top right corner of the front page (repeated at the bottom of the back page). The words „LIVE THE DREAM’ are shown in the bottom left corner. Of the remaining pages, 30, 32 and 35 are not branded, the rest feature the second Summit Club mark. The exhibit is not dated.
25. Pages 37 and 38 are washing and care instructions for synthetic and down sleeping bags. Both have the first Kathmandu logo in the bottom left corner and the words „LIVE THE DREAM’ presented below. Neither is dated.
26. Pages 39 - 43 are pitching instructions for a number of tents. Each page features the first Kathmandu logo with the words „LIVE THE DREAM’ presented below. The pages are not dated.
27. The following pages 44-55 are not dated. It is not clear where these pages can be accessed nor is it clear to whom they are made available.
28. Page 44 is an outdoor checklist. It features the first Kathmandu logo in the bottom right corner with „LIVE THE DREAM’ presented below.
29. Page 45 is a business travel checklist. It features the first Kathmandu logo in the bottom right corner with „LIVE THE DREAM’ presented below.
30. Pages 46-47 are a camping checklist. It features the first Kathmandu logo in the bottom right corner, of the second page, with „LIVE THE DREAM’ presented below. Above that is the first Summit Club mark.
31. Page 48 is a cycling checklist. It features the first Kathmandu logo in the bottom right corner with „LIVE THE DREAM’ presented below. Above that is the first Summit Club mark.
32. Page 49 is a day walk checklist. It features the first Kathmandu logo in the bottom right corner with „LIVE THE DREAM’ presented below. Above that is the first Summit Club mark.
33. Pages 50-51 are a „Duke of Edinburgh’ checklist. It features the first Kathmandu logo in the bottom right corner, of both pages, with „LIVE THE DREAM’ presented below. Above that is the first Summit Club mark.

34. Pages 52-53 are a hiking checklist. It features the first Kathmandu logo in the bottom right corner, of the second page, with „LIVE THE DREAM’ presented below. Above that is the first Summit Club mark

35. Pages 54-55 are a travel checklist. It features the first Kathmandu logo in the bottom right corner, of the second page, with „LIVE THE DREAM’ presented below. Above that is the first Summit Club mark.

36. Page 56 is a product return form. It features the second Kathmandu logo in the top right corner of the page with „LIVE THE DREAM’ presented below. The page is not dated.

37. Page 57 is a mail order purchase form. It features the first Kathmandu logo in the top left corner of the page with „LIVE THE DREAM’ presented below. The page is not dated.

38. Pages 58-64 are the slides for a presentation titled „Kathmandu - December Market Update’. The date is shown as 22 December 2011. No sales figures are provided in the presentation. The only reference to UK sales is on page 60, which states:

“UK same store sales continue to decrease.”

39. The second Kathmandu logo is shown in the top right corner of the title slide. The words „LIVE THE DREAM’ can be seen in the bottom right corner of that same slide. It is not clear who the audience was for this presentation, though it looks to be an „in-house’ update of company performance.

40. Pages 65-78 are the slides for a presentation titled „Kathmandu - Annual General Meeting’. The date is shown as 18 November 2011. Figures provided in the Chairman’s address on page 68 are in NZ dollars and relate to sales in New Zealand. The only reference to sales in the UK is on page 76 which states:

“UK same store sales continued to show a small decrease”.

41. The second Kathmandu logo is shown in the top right corner of the title slide. The words „LIVE THE DREAM’ can be seen in the bottom right corner of that same slide. It is not clear who the audience was for this presentation, though it looks to be an „in-house’ meeting.

42. Pages 79 - 83 are the Kathmandu Annual Report for 2011. The front page shows the second Kathmandu logo in the top right corner with the words „LIVE THE DREAM’ presented below. The Chairman’s introduction to the report states that since Kathmandu’s listing on the Australian and New Zealand stock exchanges, Kathmandu Holdings Limited has had a successful year. The remainder of the report focuses on the company’s performance in these two countries. No figures are provided for the UK business. Under the heading „UK BUSINESS’ the report states:

“The period of economic uncertainty in the UK may be prolonged, and this reinforces our decision not to make further investment in the UK retail network at this time. Although no new stores are planned, a step up in online activity will occur to fully leverage the new website capability we intend to launch during FY2012.”

43. That concludes my summary of the evidence.

DECISION

44. First I will deal with the opposition based upon section 5(2)(b) of the Act which reads as follows:

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

Section 5(2)(b) case law

45. 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 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 act

46. In accordance with the above cited case law, I must determine who the average consumer is and also identify the nature of the purchasing process. 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.

47. The average consumer of the goods at issue, and the opponent's services in class 35, will be a member of the general public. The purchase is likely to be primarily visual as it is likely to be made from a website or directly from a shelf. The goods cover a range of products which vary in price and frequency of purchase. Consequently, the level of attention is likely to vary: a large tent will be a fairly expensive, infrequent purchase which will demand a higher level of attention to be paid than, for example, buying a t-shirt.

48. In addition, in respect of the goods in class 25, in considering the level of attention that will be paid to such a purchase and the nature of the purchasing act, I am mindful of the decision of the General Court (GC) 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, in which it commented:

"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.

...

53. 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."

49. The average consumer for the applicant's services in class 41 may be a member of the general public or a professional or organisation. A member of the general public may make use of, inter alia, training, books and entertainment services while it is more likely that an organisation or professional will make use of stadium rental services. The level of attention paid by the average consumer will vary accordingly. The nature of all of these purchases is primarily visual, though I do not discount the fact that there may be an aural element.

Comparison of goods and services

50. The goods and services to be compared are as follows:

Opponent's goods and services	Applicant's goods and services
<p>Class 18: Rucksacks, haversacks and bags in this class including travel bags; umbrellas and parasols; goods made from leather and imitations of leather, and goods made of these materials and not included in other classes.</p> <p>Class 20: Furniture; bedding, mattresses, sleeping bags and outdoor furniture including furniture for camping; parts and fittings for all the aforesaid goods.</p> <p>Class 22: Camping equipment in this class including tents, awnings, tarpaulins, nets; sacks and bags in this class; parts and fittings for all the aforesaid goods including string and rope.</p>	

<p>Class 25: Clothing; headgear; and footwear.</p>	<p>Class 25: Clothing, footwear, headgear; football shoes and boots; sports jerseys; sweaters.</p>
	<p>Class 28: Sporting articles; games and play things.</p>
<p>Class 35: Retailing and wholesaling of clothing, footwear, headgear and accessories for all the aforesaid, furniture including bedding, outdoor and camping furniture, sleeping bags, bag liners and sleeping sheets, packs and bags, tents, tarpaulins, nets, awnings, portable stoves and cooking apparatus, eating utensils, water purifiers, maps and other printed matter, compasses, first aid kits and components thereof, and other camping, tramping and outdoors equipment and parts and fittings therefor.</p>	
	<p>Class 41: Education, educational services and education information and training; publication of books; entertainment, entertainment services and entertainment information; organisation of exhibitions for educational or cultural purposes; advisory services relating to entertainment; organisation of musical entertainment; vocational guidance; recreation information; organisation of sports competitions; physical education; providing online electronic publications; providing sports facilities; rental of sports equipment (except vehicles); rental of stadium facilities; sport camp services; teaching; writing of text (other than publicity text); provision of training courses for young people in preparation for careers; career advisory services; organisation, provision and production of live performances and events, including without limitation, those in relation to music, celebrity, fashion and sport; organisation and production of television, film and theatre productions for entertainment and/or educational purposes.</p>

51. In comparing the goods, I bear in mind the following guidance provided by the General Court (GC) in *Gérard Meric v OHIM*, Case T-133/05:

“29. ...goods can be considered identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

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

“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.”

53. Other factors which may be considered include the criteria identified in *British Sugar Plc v James Robertson & Sons Limited (Treat)* [1996] R.P.C. 281 (hereafter *Treat*) for assessing similarity between goods and services:

- (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 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, taking into account how goods/services are classified in trade.

54. I also bear in mind the decision in *El Corte Inglés v OHIM* Case T-420/03, in which the court commented:

“96...goods or services which are complementary are those where 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 the production of those goods or provision of those services lies with the same undertaking (Case T-169/03 *Sergio Rossi v OHIM-Sissi Rossi* [2005] ECR II-685)”

Class 25

55. Both parties' specifications include clothing, footwear and headgear in class 25. The applicant's also includes „football shoes and boots; sports jerseys; sweaters' which are

clearly included in the broad terms clothing, footwear and headgear. Consequently, I find the parties' goods in this class to be identical.

The applicant's goods in class 28 and services in class 41

56. Other than providing a bald statement that they are similar, the opponent has provided no indication of why it considers the applicant's goods and services in classes 28 and 41 to be similar to any of its goods and services for which either of its earlier marks are registered. In its witness statement the opponent states:


"17. In the instances where the goods and services for which the Earlier Trade Marks are registered are not similar to the goods or services for which the Opposed Marks are applied, the Opposed Marks applied for in the Applications would take unfair advantage of and/or be detrimental to the distinctive character or repute of the Earlier Trade Marks."

57. While the respective users of the competing goods and services may be the same, this superficial degree of similarity tells one little. In the absence of any submissions from the opponent to explain why it considers the applicant's goods in class 28 or its services in class 41 to be similar to its own goods and services; and having considered the nature of the goods/services, their intended purpose, their method of use and whether they are in competition with each other or are complementary, I can find no meaningful areas in which the competing goods and services coincide. As a consequence, the applicant's goods in class 28 and services in class 41 are not, in my view, similar to any of opponent's goods and services.

58. In the case of goods and services which are dissimilar, I need not go on to consider the similarity of the marks, since the test for assessing whether or not there is a likelihood of confusion is a cumulative one.⁵ The remainder of this decision in respect of the section 5(2)(b) ground is made in relation to the goods in class 25 which I have found to be identical and relate to the opponent's earlier community trade mark 3300928, which is registered for class 25.

Comparison of marks

59. The marks to be compared are as follows:

The Opponent's mark	The Applicant's marks
<p>LIVE THE DREAM</p>	 <p>RIO FERDINAND LIVE THE DREAM</p>

⁵ *Vedial SA v Office for Harmonisation in the Internal Market (OHIM) C-106/03*

60. 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,⁶ 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. In addition, s/he rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them s/he has kept in his or her mind.

Dominant and distinctive components

61. The opponent's mark consists of the three words „LIVE', „THE' and „DREAM'. The words are presented in block capitals with no additional stylisation. None of the three words which make up the mark can be considered a distinctive or dominant element. The words hang together to form a complete phrase.

62. The first of the applicant's marks consists of text presented in such a way that the overall shape is that of a rectangle. The word „RIO', which is the largest word in the mark, makes up the top third of the mark. It is presented above the word „FERDINAND'. Below these two words are the words „LIVE THE', on one line and „DREAM' presented below that. The last word in the mark is the word „FOUNDATION' which makes up the bottom line of text and is considerably smaller than the other words in the mark.

63. The words „RIO', „FERDINAND' and „FOUNDATION' are presented in mid grey. The words „LIVE THE' and „DREAM' are shown in a black font. The text of all of the letters which make up the mark is slightly faded at the edges and gives the effect of a slightly less dense print. This and the very minimal stylisation to the letters which have a slight „stencil' effect, is likely to go unnoticed by the average consumer.

64. Due to the type colour, size and nature of presentation of the words, the mark splits into three parts: „RIO FERDINAND', „LIVE THE DREAM' and „FOUNDATION'. With regard to the „RIO FERDINAND' element of the mark, the opponent comments that the applicant's marks *'of course include the name of a famous person'*. I will deal with this point in more detail below. For the purposes of reaching a conclusion on the issue of dominant and distinctive elements it is sufficient for me to acknowledge that the two words RIO and FERDINAND hang together as they create the name of a person. The „LIVE THE DREAM' element hangs together as an inspirational phrase, which is further emphasised by its tone (being presented in black) and position within the mark as a whole. The word „FOUNDATION' stands alone and is unlikely to be afforded any trade mark significance by the average consumer as it simply indicates the nature of an organisation. „RIO FERDINAND' and „LIVE THE DREAM' are distinctive within the mark, but neither is dominant.

65. The second of the applicant's marks consists of five words, „RIO', „FERDINAND', „LIVE', „THE' and „DREAM'. All are presented in block capitals and have no additional stylisation. The mark splits into two parts: „RIO FERDINAND' (due to the fact that the two words form the name of a person) and „LIVE THE DREAM' which hangs together as a phrase for the reasons I have outlined above. Both of these elements are distinctive within the mark but neither is dominant.

⁶ *Sabel v Puma AG, para. 23.*

Visual and aural similarities

66. The opponent asserts throughout its witness statement that the applicant's marks are similar to its own, but goes no further in assessing the similarity of the parties' respective marks.

67. Taking into account the construction of the respective marks and the inclusion, in both marks, of the words „LIVE THE DREAM' dominant, there is a degree of similarity from both a visual and aural perspective.

RIO FERDINAND LIVE THE DREAM FOUNDATION – The stylised mark

68. Any similarity between the marks rests in the words „LIVE THE DREAM', the middle component of the applicant's mark, which reproduces the opponent's mark in its entirety. The word „FOUNDATION' in the applicant's mark is considerably smaller than the rest of the wording and is unlikely to be afforded any trade mark significance because it is likely to be seen as a description of a type of organisation. The difference in tone between „RIO FERDINAND' and „FOUNDATION' which are presented in mid grey and „LIVE THE DREAM', which is shown in black type, means that the „LIVE THE DREAM' element stands as a separate element within the mark (though does not dominate that mark).

69. Taking all of these factors into account I find there to be a moderate degree of visual and aural similarity between the parties' marks.

RIO FERDINAND LIVE THE DREAM

70. The second of the applicant's marks is presented in plain block type. Any similarity between the marks rests in the words „LIVE THE DREAM', the second component of the applicant's mark, which reproduces the opponent's mark in its entirety. In addition to these words the applicant's mark also includes „RIO FERDINAND' before the words „LIVE THE DREAM'.

71. Taking these factors into account, including the distinctive common element „LIVE THE DREAM', I find there to be a moderate degree of visual and aural similarity between these marks.

Conceptual similarities

72. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.⁷ The assessment must be made from the point of view of the average consumer. In its witness statement the opponent says:

“22. The Opposed Marks of course include the name of a famous person which is applied by the Applicant as a mere description of the subject matter of the Applicant's goods and services.”

73. The average consumer cannot be assumed to know the meaning of everything. In the *Chorkee* case (BL O-048-08), Anna Carboni, sitting as the Appointed Person, stated in relation to the word CHEROKEE:

⁷ 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.

“36.By accepting this as fact, without evidence, the Hearing Officer was effectively taking judicial notice of the position. Judicial notice may be taken of facts that are too notorious to be the subject of serious dispute. But care has to be taken not to assume that one’s own personal experience, knowledge and assumptions are more widespread than they are.

37. 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. No doubt, some people are aware that CHEROKEE is the name of a native American tribe (the Hearing Officer and myself included), but that is not sufficient to impute such knowledge to the average consumer of clothing (or casual clothing in the case of UK TM no. 1270418). The Cherokee Nation is not a common subject of news items; it is not, as far as I am aware, a common topic of study in schools in the United Kingdom; and I would need evidence to convince me, contrary to my own experience, that films and television shows about native Americans (which would have to mention the Cherokee by name to be relevant) have been the staple diet of either children or adults during the last couple of decades.”

74. Similarly in this case, I am aware that Rio Ferdinand is a successful footballer. I can establish the fact very quickly, however, in the absence of any evidence from the parties, I am not able to take judicial notice of the fact that the average consumer for, inter alia, clothing, would know that. However, I conclude that the average consumer will consider the words RIO FERDINAND to be the name of a person, whether or not they know that to be the name of a famous footballer.

75. The words „LVE THE DREAM’ which are the common element of both parties’ marks, are three words which hang together to create an inspirational phrase which encourages the average consumer to make their dreams a reality. The addition of the words RIO FERDINAND do not alter or remove this impression which is present in both of the applicant’s marks and that of the opponent. The addition of the word „foundation’ to the first of the applicant’s mark does not remove or alter this impression.

76. Taking all of these factors into account I find there to be a moderate degree of conceptual similarity between the applicant’s marks and the opponent’s earlier mark.

Distinctive character of the earlier mark

77. I must now assess the distinctive character of the opponent’s earlier trade mark. 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 used as coming from a particular undertaking and thus to distinguish those goods and services from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

78. The opponent's mark consists of the words „LIVE THE DREAM'. It does not serve to describe the goods at issue, nor is it non-distinctive in that context. Consequently, the mark in its totality possesses a average level of inherent distinctive character.

79. I must now consider whether the evidence filed by the opponent is sufficient to enhance the distinctive character of the opponent's mark through the use made of it. In its evidence the opponent has provided a considerable number of documents which are undated. Those that are dated relate to a period some two and half years later than the publication of the applicant's mark. No evidence has been provided which shows the size of the relevant market in the UK or what the opponent's share of that market may be. The Annual Report for 2011 contains no reference to sales figures in the UK. All of the turnover figures relate to New Zealand and Australia. The only reference to UK sales is provided in the presentation which shows a decline in retail store sales (though since there are no figures I cannot conclude what the figures were or what they were at the relevant date). The Annual Report contains a paragraph which states that due to the economic climate in the UK no further investment will be made in the UK store retail market, though investment will continue to be made in the website. Neither the witness statement nor any of the documents which make up the exhibit provide any figures which relate to the opponent's UK sales either through its 6 UK stores or through purchases made on its website. In the absence of such evidence I am unable to conclude that use of the mark has enhanced its distinctive character.

Likelihood of confusion

80. 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 kept in his mind.⁸ I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and have regard to 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 services and vice versa.

81. I have found that the marks share a moderate degree of visual, aural and conceptual similarity. I have found an average level of inherent distinctive character in the earlier mark which has not been enhanced through the use made of it. I have found the applicant's goods to be identical to those of the opponent in class 25 and have found the remaining goods and services to be dissimilar, in the absence of any submissions from the parties. I have identified the average consumer, namely a member of the general public and have concluded that a reasonable degree of attention will be paid to the purchase of such goods and that the purchase will be a primarily visual one.

82. In reaching a decision on the likelihood of confusion I am mindful of the guidance on how to approach issues of similarity involving composite signs which can be found in the ECJ's judgment in *Medion AG v Thomson multimedia Sales Germany & Austria GmbH*, Case C-120/04 where it was held that:

“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

⁸ *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27

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.”

83. I have found the „LIVE THE DREAM’ element of the applicant’s composite marks to be a distinctive but not dominant element of both marks in their totality. *Medion* makes clear that a finding of a likelihood of confusion should not depend upon the overall impression of the composite mark being dominated by the part which is identical to the earlier mark. *Medion* recognises that the overall impression in a case such as this may lead the public to believe that the goods and services derive, at the very least, from companies which are economically linked. In my view that is the case here.

84. I find that there is a likelihood of indirect confusion in relation to the application insofar as it seeks to be registered in respect of goods in class 25 on the basis that the common element „LIVE THE DREAM’ will lead the average consumer to believe that the goods originate from economically linked undertakings.

Conclusion

85. The opposition succeeds on the 5(2)(b) ground in respect of class 25.

86. The opposition fails on the 5(2)(b) ground in respect of classes 28 and 41.

The opposition under s.5(3) of the Act

87. The opponent has stated at paragraph 17 of its witness statement that:

“17. In the instances where the goods and services for which the Earlier Trade Marks are registered are not similar to the goods or services for which the Opposed Marks are applied, the Opposed Marks applied for in the Applications would take

unfair advantage of and/or be detrimental to the distinctive character or repute of the Earlier Trade Marks.”

88. The opponent has provided evidence of use which does not include a single document which is dated prior to two and half years after the publication of the application. I have no turnover figures for the UK and no indication of the size of the relevant market or the opponent's share of it. I have found that the evidence provided by the opponent is not sufficient to establish enhanced distinctive character through the use made of it. Consequently, it is clear that the evidence is certainly not enough to establish a reputation of the kind envisaged by the CJEU in *General Motors Corp v Yplon SA*. Consequently, the opponent cannot hope to succeed under this ground and I decline to deal with it further.

CONCLUSION

89. The opposition succeeds on the 5(2)(b) ground in respect of class 25.

The opposition under s.5(3) fails.

COSTS

90. Both parties have achieved a measure of success. Consequently, I decline to make an award of costs in this case as it is appropriate that the parties bear their own costs.

Dated this 18th day of March 2013

**Ms Al Skilton
For the Registrar,
The Comptroller General**