

0-419-13

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2588037
IN THE NAME OF ETISE SAMPSON FOR THE TRADE MARK:



AND

OPPOSITION THERETO UNDER NO 102940
BY STREET ONE GMBH

Background

1. Application 2588037 seeks registration of the trade mark shown on the front page of this decision. It has a filing date of 15 July 2011, stands in the name of Etise Sampson (“the applicant”) and seeks registration in respect of the following goods and services:

Class 9

Apparatus for recording, transmission or reproduction of sound or images; Magnetic data carriers, recording discs; DVDs, CDs.

Class 16

Paper, cardboard and goods made from these materials, not included in other classes; Printed matter; Photographs; Stationery; instructional manuals; books; journals; periodicals; magazines.

Class 25

Clothing, footwear, headgear.

Class 28

Sporting equipment; Games and playthings; gymnastic and sporting articles not included in other classes.

Class 35


Retail services including retail services conducted from physical premises and via the Internet or mail order catalogues connected with CD's, DVD's and other apparatus for the recording of sound or images, paper products, printed matter, photographs, instruction manuals, books, journals, periodicals and magazines, clothing, footwear and headgear, sporting and gymnastic equipment, games and playthings; advertising; business management; business administration; office functions; organization, operation and supervision of loyalty and incentive schemes; advertising services provided via the Internet; production of television and radio advertisements; provision of business information.

Class 41

The provision of entertainment and cultural events and activities; production of music videos, audio-visual recordings, films, television programmes; production, staging and provision of theatrical and dance productions; production, staging and provision of festivals; production, staging and provision of fashion and design expositions and shows; services relating to the finding of locations for filming, staging and performing events, theatre, dance productions, films, festivals, concerts, television programmes, videos and commercials; services relating to the finding of locations for photographic shoots; set design services including set design services for events, theatre, dance productions, films, festivals, concerts, television programmes, videos, commercials and photographic shoots; photographic services, including the staging, preparing models, taking, developing, selecting and arranging of photographs; workshops relating to dance, visual arts, music and drama; provision of corporate events and team building exercises including themed corporate events and team building exercises; provision of dance troupes and other entertainers including for corporate and other events; meet & greet services including hospitality, registration, reception

and ushering; casting services for film, television, theatre, dance and video productions; model scouting services; provision of lighting and camera crews; music composition services; provision of music and musicians for the provision of incidental music for film, television, theatre, dance and video production; creation of artwork for animated films; education; providing of training; entertainment; sporting and cultural activities; educational services relating to sport; personal training services; provision of seminars in relation to sports and physical fitness; providing of training; entertainment; sporting and cultural activities; sport coaching services; fitness coaching; physical fitness coaching; health club services; promotion, provision and organisation of sporting events; promotion, provision and organisation of physical exercise and education classes, workshops and seminars; physical fitness classes; physical education classes; promotion, provision and organisation of sports camps; sporting and teaching information services; advisory services relating to the promotion, provision and organisation of sporting events; promotion, provision and organisation of sporting competitions; hire or rental of sports equipment; information services relating to sport; instruction courses relating to sport; refereeing, umpiring or officiating at sporting events; production of sporting events for film, radio or television; promotion and provision of sports facilities and sports clubs; ticket information for sporting events.

2. Following publication of the application in the *Trade Marks Journal* on 28 October 2011, notice of opposition against it was filed by Street One GmbH (“the opponent”) insofar as registration is sought for those goods and services set out in bold text above. The grounds of opposition are founded on sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”). The opponent relies on the following community trade mark (“CTM”) insofar as it is registered for the following goods:

Mark	Filing/registration date	Specification of goods
CTM 34439 	1 April 1996/ 13 November 1998	Class 18 Bags, pouches, rucksacks, leather and imitations of leather, and goods made from these materials, namely containers not specifically designed for the object being carried; small leather goods, in particular purses, pocket wallets, key wallets, trunks and travelling bags; travelling sets; umbrellas, parasols and walking sticks. Class 25 Clothing, footwear, headgear; clothing accessories, namely belts, expanding bands for holding sleeves, kerchiefs, gloves, belt buckles, buttons, braces, scarves, stockings, socks, headbands.

3. The applicant filed a counterstatement in which he requests the opponent to prove use of its mark under the provisions of section 6A of the Act. He accepts that the respective goods in class 25 are similar but otherwise denies the grounds of opposition.

4. Only the opponent filed evidence.

5. Originally set down for a hearing, the parties later confirmed that they were content for a decision to be made from the papers. I therefore give this decision after a careful review of all the papers before me which includes written submissions from both parties in lieu of attendance at a hearing.

The evidence

6. The opponent's evidence consists of a witness statement from Mr Thomas Kromik, managing director of the opponent company which was incorporated on 10 October 2005. Mr Kromik states that:

- STREET ONE has been used by his company in Germany since 1983 (I note that this is over twenty years earlier than the date he states his company was incorporated).
- Exhibit 2 consists of copies of pages said to be from the opponent's website. Whilst there are a small number of pages which appear to have been printed on 8 April 2009, the majority are dated 25 June 2012. The earlier pages included in the exhibit have been downloaded from www.street-one.com and describe the history of the company. These make clear that the company originated in Germany (and indeed opened its first stores there). The latter pages are taken from the www.street-one.de website showing the range of products sold under the STREET ONE trade mark. It is noted that this is a German website.
- Exhibit 3 shows examples of products contained in collections by STREET ONE. These are undated.
- According to Mr Kromik, the opponent has established a strong reputation in connection with the STREET ONE trade mark over many years through use of the mark within Europe.
- In 2007, the opponent achieved a total turnover of €4,000,000 and, under its (unnamed) parent company, it has an international presence of more than 2,250 stores and shops under the STREET ONE trade mark and STREET ONE clothing products are sold through more than 2000 multi label retailers.
- Approximate annual sales in euros of clothing items under the STREET ONE trade mark over the last five years are provided. The figures are as follows:

Country	2007	2008	2009	2010	2011
Lux'brg	1,417,969.19	1,415,286.41	1,400,000.00	1,300,000.00	1,400,000.00
Norway	3,113,596.38	3,420,580.52	2,900,000.00	2,900,000.00	3,500,000.00
France	623,132.48	1,125,536.99	3,700,000.00	4,500,000.00	6,000,000.00
Belgium	18,355,588.64	20,853,102.97	23,900,000.00	20,600,000.00	19,600,000.00
N'lands	22,281,674.97	24,989,992.80	36,800,000.00	31,900,000.00	29,600,000.00
Germany	228,418,081.31	248,513,794.62	252,000,000.00	253,900,000.00	245,200,000.00
Italy	1,642,995.00	2,165,618.37	2,600,000.00	2,800,000.00	3,100,000.00
Sweden	5,432,411.62	6,429,166.91	2,700,000.00	3,300,000.00	3,800,000.00
Hungary	11,852.45	924,516.14	2,000,000.00	2,300,000.00	2,600,000.00
Switzerland	20,518,485.00	22,775,683.73	33,100,100.00	36,400,000.00	37,500,000.00
Austria	22,411,624.18	23,916,899.02	22,700,000.00	21,100,000.00	20,300,000.00
Ireland	0	532,641.69	700,000.00	1,100,000.00	1,300,000.00
Slovenia	1,068,924.36	986,605.23	700,000.00	900,000.00	700,000.00
Bosnia	92,331.22	77,727.57	100,000.00	100,000.00	-
Denmark	2,335,724.41	2,636,195.15	4,000,000.00	3,300,000.00	2,700,000.00
Spain	673,951.77	1,592,185.25	2,000,000.00	1,700,000.00	2,200,000.00
Czech Republic	40,609.19	69,154.24	500,000.00	900,000.00	1,100,000.00
Slovakia	0	0	500,000.00	500,000.00	600,000.00

7. Based on the figures set out above in respect of sales made in 2009, Mr Kromik states that the market share of his company's main European Markets were:

Country	Market share %
Germany	4.6
Austria	2.4
The Netherlands	2.6
Belgium	2.9
Luxembourg	1.7
Switzerland	2.9
Denmark	0.8
Norway	0.6
Sweden	0.3

8. Mr Kromik states the "current" market share in the EU region (his witness statement is dated 9 July 2012) is 2.6%.

9. That concludes my summary of the evidence filed in these proceedings.

DECISION

The objection under section 5(2)(b) of the Act

10. I turn first to the ground of opposition based on section 5(2)(b) of the Act which 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.”

11. An “earlier trade mark” is defined in section 6, the relevant part of which states:

“6.-(1) In this Act an “earlier trade mark” means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark 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.”

12. The opponent relies on its CTM 34439. This is an earlier trade mark within the meaning of section 6(1) of the Act. The applicant has requested the opponent prove use of its mark and, given the interplay between the date of registration of this earlier mark and the date the application was published, the provisions of section 6A of the Act are relevant.

13. Section 6A of the Act reads:

“(1) This section applies where –

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes –

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(7) Nothing in this section affects –

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4)(relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

14. Under Section 100 of the Act the onus is upon the proprietor of the earlier trade mark(s) to show genuine use:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

15. In reaching a conclusion on this point, I must apply the same factors as I would if I were determining an application for revocation of a trade mark registration based on grounds of non-use; the relevant period for present purposes is the five year period ending with the date of publication of the application for registration i.e. 29 October 2006 to 28 October 2011.

16. In *Stichting BDO and others v BDO Unibank, Inc and others* [2013] EWHC 418 (Ch) Arnold J commented on the case law of the Court of Justice of the European Union (“CJEU”) in relation to genuine use of a trade mark:

“In *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] Anna Carboni sitting as the Appointed Person set out the following helpful summary of the jurisprudence of the CJEU in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159 and Case C-495/07 *Silberquelle GmbH v*

Maselli Strickmode GmbH [2009] ECR I-2759 (to which I have added references to Case C-416/04 P *Sunrider v OHIM* [2006] ECR I-4237):

"(1) Genuine use means actual use of the mark by the proprietor or a third party with authority to use the mark: *Ansul*, [35] and [37].

(2) The use must be more than merely 'token', which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Sunrider*, [70]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22]-[23]; *Sunrider*, [70]-[71].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no *de minimis* rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25]; *Sunrider*, [72]""

17. I must also keep in mind the guidance in *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32, in relation to determining what constitutes a fair specification, namely:

“Pumfrey J in *Decon* suggested that the court’s task was to arrive at a fair specification of goods having regard to the use made. I agree, but the court still has the difficult task of deciding what is fair. In my view the task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use”.

18. In *Animal Trade Mark* [2004] FSR 19, Jacob J held:

“The reason for bringing the public perception in this way is because it is the public which uses and relies upon trade marks. I do not think there is anything technical about this: the consumer is not expected to think in a pernicky way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. Thus, for instance, if there has only been use for three-holed razor blades imported from Venezuela (Mr T.A. Blanco White’s brilliant and memorable example of a narrow specification) “three-holed razor blades imported from Venezuela” is an accurate description of the goods. But it is not one which an average consumer would pick for trade mark purposes. He would surely say “razor blades” or just “razors”. Thus the “fair description” is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection (“the umbra”) for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods (“the penumbra”). A lot depends on the nature of the goods—are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made.”

19. Also of relevance are the comments of the General Court in *Reckitt Benckiser (España) SL v OHIM*, Case T-126/03 where it said:

“45 It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or sub-categories to which the goods or services for which the trade mark has actually been used belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of 'part of the goods or services' cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories."

20. Finally, in *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited* BL O/345/10 Mr Geoffrey Hobbs Q.C., sitting as the appointed person, stated:

"However, that does not appear to me to alter the basic nature of the required approach. As to that, I adhere to the view that I have expressed in a number of previous decisions. In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned."

21. Mr Kromik makes no claim that the earlier mark has been used on any of the goods for which it is registered in class 18 and none of the exhibits show any use in respect of such goods. That being the case, the opponent has failed to show use of its earlier mark in relation to these goods. It is not, therefore, entitled to rely on its earlier mark in respect of the goods for which it is registered in class 18.

22. As to the goods for which the earlier mark is registered in class 25, Mr Kromik states that "trendy, easily combinable clothing for fashion conscious consumers" is sold under the mark. He states that "As well as the complete fashion range –from socks to trousers, tee-shirts to outdoor jackets, knit pullovers and caps, STREET ONE products include a body wear range, consisting of underwear and leisure wear as well as night wear and sports wear products" which is a statement taken almost word for word from the company's webpage shown at page 5 of exhibit 2 which dates from within the relevant period but refers to its clothing being only for women. Other pages within the exhibit, whilst dating from after the relevant date, show only women's clothing being offered for sale. Mr Kromik has provided sales figures covering the period 2007 to 2011. Whilst a proportion of the sales for 2011 are likely to date from after it, sales figures for many European countries are shown from within the relevant period. None of these figures are broken down in a way which allows me to attribute them to sales of specific articles and the exhibits do not assist me in showing examples of each of the goods as registered being offered for sale within the relevant period, however, the figures have not been challenged and I am prepared to accept that the opponent has used its mark in the relevant period on a wide range of clothing. The extracts from the website exhibited at Exhibit 2 show a

wide range of clothing items being offered for sale, however, the only items shown are intended for women. This corresponds with other material from the same exhibit taken from its own website and in which the opponent describes itself as being in the “the Women’s Young Fashion sector” and offering “trendy, easily combinable brand clothing for fashion-conscious women”.

23. The earlier mark relied upon is a CTM and, whilst the evidence has a number of flaws, sales under the mark are shown to have been made across a large number of European countries. Those sales differ markedly dependant on the country concerned but are of some size in each and have been consistent over a number of years and are sufficient to show genuine use of the mark in accordance with the guidance in *Leno Merken BV v Hagelkruis Beheer BV* Case C-149/11. The evidence does not show use on every possible type of item that falls within the specification of goods. Despite this, I am prepared to accept that use of the mark has been shown in relation to a sufficiently wide range of goods to justify retention in respect of all of them, however, I note that the evidence shows use only in respect of such goods for women. This is a particular category of goods which the average consumer will recognise and refer to. I therefore consider that a fair description of the use made of the mark, and the specification I shall take into account when making the relevant comparison, is:

“Clothing, footwear, headgear; clothing accessories, namely belts, expanding bands for holding sleeves, kerchiefs, gloves, belt buckles, buttons, braces, scarves, stockings, socks, headbands; all for women.”

The objection under section 5(2)(b) of the Act

24. In considering the objection under section 5(2)(b) and the likelihood of confusion between the respective marks, I take into account the guidance from the settled case law provided by the CJEU in *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 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P (LIMONCELLO). In the recent case of *La Chemise Lacoste SA v Baker Street Clothing Ltd* [ALLIGATOR O/333/10] Mr Hobbs Q.C., acting as the Appointed Person, set out the test shown below which was endorsed by Arnold J. in *Och-Ziff Management Europe Ltd and Oz Management Lp v Och Capital LLP; Union Investment Management Ltd & Ochocki*, [2010] EWCH 2599 (Ch).

(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/ 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; 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;

(e) 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 in that mark;

(f) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa;

(g) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it;

(h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient;

(i) 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;

(j) 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.

Comparison of the respective goods and services

25. In view of my findings above, the goods and services to be compared are as follows:

Opponent's goods	Applicant's goods and services
Class 25: Clothing, footwear, headgear; clothing accessories, namely belts, expanding bands for holding sleeves, kerchiefs, gloves, belt buckles, buttons, braces, scarves, stockings, socks, headbands; all for women.	Class 25: Clothing, footwear, headgear Class 28: Sporting equipment; Games and playthings; gymnastic and sporting articles not included in other classes

	<p>Class 35: Retail services including retail services conducted from physical premises and via the Internet or mail order catalogues connected with clothing, footwear and headgear, sporting and gymnastic equipment.</p>
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26. In assessing the similarity of goods and services it is necessary to take into account, inter alia, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc Case C-39/97*.

27. In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, Jacob J gave guidance as to how similarity should be assessed. He considered that the following should be taken into account when assessing the similarity of goods and/or 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 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.”

He went on to say:

“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 trade”.

28. I also take note of the comments of the General Court in *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05 where it stated:

“29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application

are included in a more general category designated by the earlier mark (Case T-104/01 Oberhauser v OHIM – Petit Liberto (Fifties) [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 Vedral v OHIM – France Distribution (HUBERT) [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03 Koubi v OHIM – Flabesa (CONFORFLEX) [2004] ECR II-719, paragraphs 41 and 42).”

29. With the above in mind, I go on to carry out the comparison of the respective goods and services:

The applicant’s goods in class 25

Given that the opponent’s goods are included within the more general category designated by the applicant’s specification in class 25, these respective goods are identical.

The applicant’s goods in class 28

The opponent contends that the applicant’s goods in class 28 are similar to its goods in class 25. It submits that:

“In some cases “clothing, footwear and headgear” are all manufactured by undertakings that also manufacture sporting and gymnastic articles, games and playthings, sporting equipment and the distributions channels can be the same. Therefore, these goods may be held to be similar when sports clothing, footwear and headgear are compared to sporting and gymnastic articles. Furthermore, certain sporting clothing may incorporate weights, monitors and so forth and so the clothing amounts to both a garment and an item of sporting equipment.”

The applicant rejects the claim. It submits that:

“Class 28 goods are quite different in kind from women’s high street fashion clothing...”

I can see nothing that would lead to there being any similarity between the opponent’s goods and the *games and playthings* included within the application. The remainder of the applicant’s goods are equipment and articles used in various forms of physical and sporting activity. The applicant’s specification could include items which will be worn, e.g. boxing gloves. I do not consider them to be similar goods to e.g. gloves being articles of clothing as would be included in class 25 despite there being some commonality in that e.g. both boxing gloves and ordinary gloves are both worn on the hands and each may provide a degree of protection as, in my view, despite these potential overlaps, the natures of these respective goods, the users, uses and, most likely, the channels of trade all differ and one is not a substitute for or complementary to the other. Nevertheless, the fact that the opponent’s specification includes clothing, footwear and headgear in general (albeit one that has been restricted, for the purposes of this comparison, to such goods for women), means that it would include clothing and footwear being sportswear which could include e.g. shorts and trainers for boxing. This would lead to there being a moderate degree of

similarity with sporting equipment as is included within the applicant's specification as the users, uses and the trade channels through which such goods are sold would coincide.

The applicant's services in class 35

In *Oakley, Inc v OHIM*, Case T-116/06, the court considered a retail services specification, part of which was unrestricted: "Retail and wholesale services, including on-line retail store services". The court said:

"59 In the second place, with regard to the comparison of 'retail and wholesale services, including on-line retail store services' with the goods in question, it must be recalled that the Court held, in paragraph 50 of *Praktiker Bau- und Heimwerkermärkte*, paragraph 17 above, that the applicant for the Community trade mark must be required to specify the goods or types of goods to which those services relate.

60 In that regard, it must be pointed out that the applicant has, as correctly stated by the Board of Appeal in paragraph 32 of the contested decision, failed to provide any specification whatsoever of the goods or types of goods to which the 'retail and wholesale services, including on-line retail store services' relate.

61 Thus, it must be held that 'retail and wholesale services, including on-line retail store services', on account of the very general wording, can include all goods, including those covered by the earlier trade mark. Therefore, it must be held that 'retail and wholesale services, including on-line retail store services', display similarities to the goods concerned.

62 It follows from all of the foregoing that the Board of Appeal was right to consider that services consisting of 'retail and wholesale of clothing, headwear, footwear, athletic bags, backpacks and knapsacks and wallets', and 'retail and wholesale services, including on-line retail store services', are similar to the goods covered by the earlier trade mark."

As the applicant's specification includes retail services connected with clothing, footwear and headgear which are goods within the relevant specification of the opponent's earlier mark, I find they are similar to them.

The average consumer and the nature of the purchasing process

30. The goods and services to be considered are, broadly speaking, clothing, footwear and headgear and, in the case of the application, retail services in respect of them. The goods will be sold in a variety of ways including in traditional retail outlets on the high street, through catalogues and by way of the Internet. The average consumer of the goods and services at issue is a member of the general public who is likely to select the goods mainly by visual means though I accept that more expensive items may be researched or discussed with a member of staff. 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 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.”



31. In the same case the GC also commented upon the degree of care the average consumer will take when selecting clothing. It 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 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.”

32. Clearly, the average consumer’s level of attention will vary considerably depending on the cost and nature of the item concerned, however, even when selecting routine and relatively inexpensive items of clothing such as socks, I consider the average consumer will pay attention to considerations such as size, colour, style, material and cost. Overall, the average consumer is likely to pay a reasonable degree of attention to the selection of items of clothing, footwear or headgear. The same is likely to apply as regards the provision of the services.

Comparison of the respective marks

33. For ease of reference, the marks to be compared are as follows:

Opponent’s mark	Applicant’s mark
	

34. It is well established that the average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as wholes and does not pause to analyse their various details. In addition, he rarely has the chance to make direct comparisons between trade marks and must instead rely upon the

imperfect picture of them he has kept in his mind. In reaching a conclusion on similarity, I must compare the respective trade marks from the visual, aural and conceptual perspectives identifying, where appropriate, what I consider to be their distinctive and dominant elements.

35. The opponent submits:

“The term STREET is common within both marks and is the first word in each mark. It is well established that more attention is paid to the first element of a mark (Tripp Castroid [1925] 42 RPC 264. Therefore, the respective marks are identical in their first verbal element. The second element in each mark consists of a less important word. The later mark STREET FIT, includes the term “FIT” which is not highly distinctive for the opposed goods and services....which may be used in relation to sporting or fitness purposes....The public is likely to perceive “FIT” as a non-distinctive matter identifying the purpose of the goods i.e. fitness or goods that “fit”. Furthermore, in ordinary speech, more emphasis is placed on the first part of a term, with the second word tending to be spoken more quietly. The overall marks are therefore very similar phonetically.

Furthermore, the marks are visually very similar with the “STREET” word in each case being in a (sic) presented in a very similar fashion.

Conceptually, the first element of the respective marks is identical. It is submitted that the public will conceptually link the marks because the first word creates such a conceptual link and because the overall marks have no real meaning capable of generating a conceptual distinction. Whilst the applicant’s mark contains a heart device, we submit that this may refer to the descriptive “FIT” element of the later mark and as such does not help to distinguish it from the earlier mark. The consumer is likely to draw upon the conceptual equivalence of the first part of the marks, placing greatest reliance on the first strong element. We do not accept, as referred to by the Applicant on their Counterstatement, that the device of a heart is the most dominant part of the mark.

The Opponent submits that the respective marks are visually and phonetically extremely close to the extent that the strong visual similarities outweigh any phonetical difference...”

36. For its part, the applicant submits:

“...visually the marks are very different. The distinctive bleeding heart device...has no counterpart in [the earlier mark], which is comprised of the words STREET ONE in white on a simple rectangular black background. The two marks are clearly different and would be seen as such by consumers.

Conceptually, the respective marks are also quite different marks. The Application Mark clearly refers to fitness, specifically fitness relating to that carried on in the streets, i.e. urban fitness, free running and dance carried out by youths on the streets, e.g. breakdancing.”

It continues:

“The bleeding heart ties to the “FIT” element and adds emphasis to the fitness aspect of the Applicant’s offering. By contrast, the CTM mark has no similar conceptual references. The mark “STREET ONE” is an unusual combination of words which if anything, calls to mind a postal address. It certainly does not carry any suggestions of fitness, dance, music or any of the other urban connotations of the Application Mark.

Orally, the respective marks are similar to the extent that they begin with the mark “STREET” but that is where things end because the marks FIT and ONE are so very different that native English speakers, or even anyone in Europe, would not be confused by these respective references. The Applicant submits that it is artificial to compare only the verbal elements of the respective marks (the correct comparison being a global one) but even when a comparison of just the verbal elements is carried out, the marks are seen as quite different. In this regard, the Applicant submits that the Opponent has no separate rights in relation to the verbal elements of the CTM Mark and that the Opponent also has no separate rights in relation to the mark “STREET” and that it would be wrong to use the CTM mark, which is a stylised mark, in a way which proposes or treats the Opponent as if it had any such separate rights.

The correct comparison, of course, is a global one and when the two marks are compared on that basis, they are clearly very different and distinct.”

37. The opponent’s earlier mark consists of the two separate words Street and One, in title case, the whole presented on an unremarkable, plain, black, rectangular background. Both words are ordinary dictionary words. The word Street has a number of meanings including relating to modern urban culture or counterculture as in e.g. he’s so street or street style (see e.g. *Chambers 21st Century Dictionary* and *Collins English Dictionary*). It is not a particularly distinctive word in relation to fashion items. The word One has an obvious meaning and is often used to designate a characteristic of goods such as a size and is also not particularly distinctive. The two words in combination, however, hang together and have a reasonable degree of distinctiveness (see *Case C-363/99 Koninklijke KPN Nederland NV v Benelux Merkenbureau* [2004] E.T.M.R. 57, ECJ, *Case C-329/02P SAT.1 Satelliten Fernsehen GmbH v OHIM* [2005] E.T.M.R. 20, ECJ, *Case C-37/03P BioID AG v OHIM* [2005] E.T.M.R. CN5, ECJ and *Case T-439/04 Eurohypo AG v OHIM*).

38. The applicant’s mark consists of the two separate words Street and Fit, again in title case with the word Street presented in black. The word Fit is presented in white and contained within a heart-shape which acts as a background to the word. The heart-shape is slightly off centre and tilted to the right and has something dripping from its right hand edge. The applicant describes it as a bleeding heart device. Whilst the heart device is distinctive, I do not consider that it is a dominant element of the mark given its positioning, the fact that it acts as a background to the word Fit and bearing in mind the general principle that words “speak louder” than devices. I have set out above my view of the word STREET. The word Fit has a number of meanings including healthy, appropriate or of the right size or shape and is a word

often used in relation to clothing of a particular cut or style and thus is not distinctive. In my view, the dominant element of the mark is the word combination STREET FIT which hangs together as a whole. Whilst the heart device is not the dominant element within it, I consider it has a reasonable level of visual impact within the mark.

39. The first word of both marks is the word STREET which leads to an obvious point of visual similarity between them but there are also clear visual differences between them both because of the inclusion of the bleeding heart element in the application which is absent from the opponent's earlier mark and the presence in each of the words One and Fit respectively. Whilst the word STREET is common to both marks and is the first word within them, this does not mean the remainders of the marks will be ignored or are negligible. They have to be considered as wholes. The respective marks are visually similar to a very low degree. The bleeding heart element within the applicant's mark is unlikely to be articulated and thus, from an aural perspective the only point of similarity is the presence in both marks of the word STREET. The respective marks are aurally similar to a low degree.

40. The opponent's earlier mark is made up of two ordinary dictionary words. If it brings anything to mind, it is likely to be seen as a reference to some sort of location i.e, a thoroughfare of that number. The applicant's mark also consists of two ordinary dictionary words along with the heart device which is somewhat reminiscent of graffiti and, if it brings anything to mind at all, is likely to bring to mind something that is fit for the street. Whilst both marks bring to mind something to do with a street, I do not think either will bring an immediate and clear message to mind and thus the conceptual position is neutral.

Distinctive character of the earlier mark

41. The distinctive character of a trade mark can be appraised only, first, by reference to the goods or services for which it is 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 or services 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.

42. I set out above the evidence of use filed by the opponent. Whilst the evidence is not without its flaws, I have accepted that use has been made of it across a number of European countries though such use does not include the UK. The market share in each of the opponent's main markets varies and ranges from a low of 0.3% to a high of 4.6%. Whilst the volume of sales under the mark in some of these countries is not insignificant, it represents a very small share of the relevant markets. There is no evidence of customer activity, no invoices, no advertising or promotional material nor any evidence from the trade. Taken as a whole, I am not satisfied that the evidence shows the mark to have a reputation or that the distinctive character of the mark will have been enhanced to any material extent. Even if I am wrong, then any reputation the mark is found to have would not be a relevant reputation given that the

likelihood of confusion in respect of these proceedings is to be judged from the perspective of the average consumer in the UK. There is no evidence to suggest that the mark is known or has been brought to the attention of the average UK consumer. As I indicated above, I consider the mark has a reasonable level of inherent distinctive character.

Likelihood of confusion

43. In determining whether there is a likelihood of confusion, a number of factors have to be borne in mind. The first is the interdependency principle whereby a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. I also have to factor in the distinctive character of the earlier mark, as the more distinctive it is the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely on the imperfect picture of them he has retained in his mind.

44. Earlier in this decision I found that:

- the average consumer is a member of the general public;
- the average consumer is likely to select the goods and services primarily by visual means;
- the average consumer will pay a reasonable degree of attention to the selection of goods and services;
- there is a very low degree of visual similarity and a low degree of aural similarity between the respective marks with the conceptual position being neutral;
- the opponent's goods in class 25 are identical to the applicant's goods in class 25 and have a degree of similarity with some of the applicant's goods and services in classes 28 and 35;
- the earlier mark is possessed of a reasonable degree of inherent distinctive character that has not been shown to have been enhanced to any material degree through its use.

45. Taking all matters into account I find that the clear differences in the respective marks will not be overlooked and, even where imperfect recollection is considered, will not lead to there being any direct confusion between them. I also have to take into account the likelihood of indirect confusion, i.e. where the average consumer assumes that the goods and services come from undertakings which are economically linked. The only point of similarity between the two marks is the presence in both of the word STREET. In my view, having regard to the construction of each mark, this commonality is not sufficient, when considered in the context of the meaning of that word in relation to the goods and services, to result in a likelihood of indirect confusion. The differences between the two marks far outweigh any similarities. The ground of opposition founded on section 5(2)(b) of the Act fails.

The objection under Section 5(3) of the Act

46. Section 5(3) of the Act states:

“5.(3) A trade mark which –

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC), in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

47. In my consideration of the objection under section 5(2)(b) above, I commented that the evidence filed by the opponent was insufficient to find that the earlier mark is possessed of a reputation. As I indicated earlier, even if I am wrong and it is found that the earlier mark does have a reputation, that reputation is outside the UK. Consequently, no link will be made (and none of the heads of damage shown) from the perspective of the average consumer in the UK. That being the case, the objection founded on section 5(3) of the Act fails.

Summary

48. The opposition fails on each of the grounds on which it was brought.

Costs

49. The opposition having failed, the applicant is entitled to a contribution towards the costs of defending his application. I take into account that only the opponent filed evidence, that evidence being minimal and unlikely to have taken much time to review. Whilst the matter was originally set down for a hearing, the parties indicated in the days leading up to it that they were content for a decision to be made from the papers with both parties filing written submissions in lieu of attendance at a hearing. I make the award on the following basis:

For filing a statement and reviewing the other side's statement:	£300
For considering evidence:	£300
For the preparation of written submissions:	£300
Total:	£900

50. I order Street One GmbH to pay Etise Sampson the sum of £900 as a contribution towards his costs. This sum is to be paid within seven days of the expiry of the period for appeal against this decision or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 23rd day of October 2013

**Ann Corbett
For the Registrar
The Comptroller-General**