

O-418-14

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 2647804**

**BY**

**ALDI STORES LIMITED**

**TO REGISTER THE TRADE MARK**

**AVENUE**

**IN CLASS 25**

**AND**

**THE OPPOSITION THERETO**

**UNDER NO 400443**

**BY**

**DEICHMANN SE**

## BACKGROUND

1. On 8 January 2013, Aldi Stores Limited (the applicant) applied to register the above trade mark in class 25 of the Nice Classification system,<sup>1</sup> as follows:

### **Class 25**

Footwear

2. The application was published on 22 March 2013 and was subsequently opposed by Deichmann SE (the opponent).

3. The opposition was originally based on sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 (the Act), however, in its written submissions in reply dated 22 May 2014, the opponent stated:

*“1. The Opponent hereby requests that Section 5(4)(a) of Trade Marks Act 1994 (hereinafter referred to as “the Act”) be deleted as a ground of Opposition. The Opponent no longer intends to rely on the law of passing off in these proceedings.”*

4. The opponent relies upon Community Trade Mark (CTM) no. 2416113:

<b>Mark details and relevant dates</b>	<b>Goods relied upon</b>
<b>Mark:</b>  5 <sup>th</sup> Avenue  <b>Filed:</b> 18 October 2001 <b>Registered:</b> 19 July 2004	<b>Class 25</b> Footwear

5. The opponent states:

*“We submit that the marks “AVENUE” (the mark applied for) and “5<sup>th</sup> AVENUE” (the earlier registration) are visually, aurally and conceptually highly similar. The dominant and only feature of the mark applied for is the word “AVENUE”, which is identical to a dominant feature of the earlier word mark “5<sup>th</sup> AVENUE”. We submit, in line with UK case law on the issue, that the identity of the dominant parts of the marks results in the marks in question being highly similar.*

*The mark applied for covers “footwear” which is identical to “footwear” covered by the Opponent’s earlier registration.*

*Taking all the relevant factors into account, such as the identity of the goods and the high level of similarity between the marks, we submit that there is a likelihood of confusion on the part of the average consumer who perceives marks as a whole and does not analyse various details. We further submit that*

---

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

*the slight difference between the marks in question is offset by the identity of the goods in question (the interdependency principle) and therefore there is an increased likelihood of confusion on the part of the average consumer.”*

6. The applicant filed a counterstatement on 16 August 2013, in which it requested the opponent prove use of its mark. With regard to the opposition under section 5(2)(b) the applicant states:

*“14...The Applicant’s mark differs visually from the 5<sup>th</sup> Avenue mark as it does not consist of a 5<sup>th</sup> pre-fix, and the word avenue consists of an upper case letter ‘A’ and lower case ‘venue’ letters. The marks also differ aurally when the pre-fix 5<sup>th</sup> is taken into account when comparing the entire marks.*

*Moreover, from a conceptual viewpoint, the Applicant submits that the Opponent’s mark would strongly evoke in the mind of the average consumer the allure of the world-famous 5<sup>th</sup> Avenue in the borough of Manhattan in New York State, USA, which has been described as “the most expensive street in the world” and is lined with prestigious shops, including many well-known brands...By contrast, the applicant’s mark “AVENUE” has no such connotation and therefore would serve to distinguish the respective marks.”*

7. Both parties filed evidence and the opponent filed submissions in reply. A hearing took place on 7 August 2014, by video conference. The applicant’s representative, Franks & Co. Limited, opted to file written submissions in lieu of attendance at the hearing. The opponent was represented by Ms Amanda Michaels of Counsel, instructed by Reddie & Grose LLP.

## **EVIDENCE**

### **The opponent’s evidence**

8. In these proceedings the opponent is relying upon the trade mark shown in paragraph 4 which constitutes an earlier trade mark under these provisions. The application was published on 22 March 2013. The opponent's earlier mark completed its registration procedure on 19 July 2004. Consequently, the opponent's registration is subject to proof of use, as per The Trade Marks (Proof of Use, etc) Regulations 2004 and the applicant has requested the opponent to prove its use.

9. The relevant period is the five year period ending on the date of publication of the application, namely 23 March 2008 to 22 March 2013. The onus is on the opponent, under section 100 of the Act, to show genuine use of its mark during this period in respect of those goods relied on or, alternatively, to show that there are proper reasons for non-use of the mark during this period.

10. The opponent’s evidence comprises a witness statement of Christopher Holden, the Finance Director of Deichmann-Shoes UK. 14 exhibits are attached to the statement which is dated 15 January 2014. For the most part the evidence has been filed with a view to showing use of the opponent’s mark. In its written submissions dated 31 July 2014, filed in lieu of attendance at the hearing, the applicant states:

*“(2) The Applicant reiterates that it accepts that the Opponent has filed sufficient proof to show that its CTM Registration No 2416113 **5th Avenue** has been put*

*to genuine use for the relevant goods ‘footwear’ within the stipulated five (5) year period.”*

Given that the applicant has accepted that use has been shown, I need not summarise the evidence in detail. However, since the opponent claims enhanced distinctive character through use of its mark the following details are relevant:

11. Sales figures for footwear sold under the 5<sup>th</sup> Avenue mark in the UK are provided as follows:

	2008	2009	2010	2011	2012	2013
5TH Avenue	£129,182.46	£228,586.46	£306,551.39	£519,635.27	£225,207.16	£1,338,998.74
5TH Avenue by Halle Berry				£119.96	£1,073,362.55	£1,142,213.22
<b>Total</b>	<b>£129,182.46</b>	<b>£228,586.46</b>	<b>£306,551.39</b>	<b>£519,755.23</b>	<b>£1,298,569.71</b>	<b>£2,481,211.96</b>

12. In addition, Mr Holden states:

*“Annual sales of footwear under the mark ‘5<sup>th</sup> Avenue’ in Germany exceeded €50,000,000 in 2011, 2012 and 2013. In Austria, the annual sales figures exceeded €7,000,000 in 2012.”*

13. With regard to advertising and marketing, Mr Holden states that a series of television advertisements were aired in the UK between March 2012 and June 2013. They were endorsed by Halle Berry and all featured the ‘5<sup>th</sup> Avenue’ by Halle Berry brand. The cost of these campaigns was £1,845,547.

14. At paragraph 23 of his witness statement Mr Holden states:

*“Deichmann spends considerable amounts of money on advertising for its ‘5<sup>th</sup> Avenue’ trade mark. Deichmann advertises its ‘5<sup>th</sup> Avenue’ footwear brand in a range of mediums such as print, including printed advertisements, banners, flyers, brochures, press releases and media publications; via TV commercials; on the internet; and through social media sites such as Facebook.”*

15. Throughout the evidence the mark is shown in the following forms:



## **The applicant's evidence**

### Witness statement of Susan Morey with exhibits SM1 to SM8

16. Given the content of this evidence I will not itemise it here but will refer to it later in the decision as necessary.

17. I give this decision following a review of all of the material before me.

## **DECISION**

18. Section 5(2)(b) of the Act states:

“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.”

19. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

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

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

## **The average consumer and the nature of the purchasing act**

20. 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.

21. In its written submissions, dated 31 July 2014, the applicant states:

*“The Applicant acknowledges that the evidence filed by both parties shows that on the evidence, the goods being sold by both parties are not expensive items but items of everyday footwear.*

*However, the Applicant submits that it does not necessarily follow that the average consumer would be less attentive when selecting everyday footwear before making a purchase. Footwear, after all, is not chosen by the average*

*consumer as he would a bag of sweets. It is submitted that the average consumer would still take time to assess the suitability of the footwear before purchase from a range of utilitarian factors such as size, material, comfort, suitability for the occasion and climate, and whether the colour matches the outfit, usually after trying on footwear to assess its comfort and suitability. The average consumer would therefore take careful note of the trade mark before making a selection for purchase”.*

22. In its skeleton argument dated 4 August 2014 the opponent states:

*“8. Both parties’ specifications are for footwear, so the average consumer will be any member of the UK public. In its submissions dated 31 July 2014, Aldi suggests that footwear is bought with a fair degree of care, but at page 3 of the submissions describes only the care taken by consumers as to the look and fit of the product, which is irrelevant to the mark under which the shoes are sold. Like many other consumer products which may be bought on a regular basis, and at potentially modest cost, the Opponent submits that footwear will be bought with an average level of care and attention.”*

23. The parties agree that the footwear being sold by both sides are not expensive items. The opponent concludes that this means that consumers would, “not exercise more than normal attentiveness when making a purchase”. The applicant maintains that the consumer would still be attentive to factors such as, inter alia, size, materials, comfort.

24. The average consumer of the goods at issue will be a member of the general public. The parties’ specifications are not limited by price and must be held to include all goods within the term ‘footwear’. Whilst I accept that some can be purchased relatively cheaply, e.g a pair of flip flops for the beach, it is also true that there is a wide variation in the price of footwear with some e.g. a pair of bespoke shoes, likely to cost many hundreds of pounds. Expensive items of footwear would naturally attract a higher level of attention to be paid. That said, footwear bought for a particular occasion, or for a particular purpose, whether expensive or not, is likely to afford a higher degree of attention than a pair of slippers.

25. With regard to the nature of the purchase 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)*<sup>2</sup>, which concerns clothing but is analogous to footwear. 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 trademarks 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."*

...

---

<sup>2</sup> *Joined cases T-117/03 to T-119/03 and T-171/03*

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."

26. The nature of the purchase of footwear is primarily visual, though I do not discount the fact that there may be an aural element. The goods may be purchased on the high street, online or by mail order; the consumer will pay the attention necessary to obtain, inter alia, the correct, size, colour and technical specification but the level of attention paid will be no more than average.

### Comparison of goods

27. The application is made in respect of 'footwear' in class 25. The opponent is relying on 'footwear' in its class 25 specification. The goods are identical.

### Comparison of marks

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

Opponent's mark	Applicant's mark
5 <sup>th</sup> Avenue	AVENUE

29. 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 them, bearing in mind their distinctive and dominant components<sup>3</sup>, but without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

30. The applicant's mark consists of the single word AVENUE in block capitals. No part of the word is stylised or emphasised in any way. Consequently, the distinctiveness lies in the mark as a whole.

31. With regard to the dominant and distinctive elements of the opponent's mark, the applicant states:

*"...the distinctiveness of the Opponent's mark resides in the combination of 5<sup>th</sup> and Avenue which is greater than the sum of its parts and that 5<sup>th</sup> Avenue would be called to mind in its totality by the average consumer, who would readily distinguish between 5<sup>th</sup> Avenue and AVENUE."*

32. The opponent's mark consists of the ordinal number '5<sup>th</sup>', followed by the six letter word 'Avenue'. The nature of the numeric element, bearing in mind its position within the mark,

<sup>3</sup> *Sabel v Puma AG, para.23*

is that of a descriptor. Consequently, while both parts of the mark are noticeable elements, they hang together so that the distinctiveness of the mark rests in its totality.

### Visual similarities

33. With regard to the visual similarity between the marks, the applicant states:

*“5. ...the fact the letters –venue appear in lower case in the Opponent’s mark 5<sup>th</sup> Avenue is an element, albeit a minor one, which enables the average consumer to distinguish it from the letter –VENUE in the Applicant’s mark AVENUE.*

...

*6. ...The Applicant maintains that purely visually, the average consumer would readily distinguish between 5<sup>th</sup> Avenue and AVENUE, taking due account the notion of imperfect recollection.*

34. The opponent states:

*“18. The test is not whether there are any differences between the marks, but whether despite such differences, the marks are similar. There is a high level of visual similarity here, as the STM includes the whole of the mark applied for. The inclusion of “5<sup>th</sup>” in the CTM of course means that the two marks are not identical, and the difference would not be altogether overlooked by the consumer, but the Opponent submits that this does not prevent there being a high level of visual similarity.”*

35. It is well established that normal and fair use of the applicant’s mark would include use of the mark in normal typefaces and presentation in upper or lower case<sup>4</sup> and therefore the fact that the word ‘avenue’ appears in one mark in title case and in the other in block capitals cannot serve to distinguish between them. The applicant’s mark is the word ‘AVENUE’ solus, the opponent’s mark comprises ‘5<sup>th</sup>’ followed by the word ‘Avenue’. The marks are visually similar to a high degree.

### Aural similarities

36. The opponent submits:

*“20. Very much the same points may be made in relation to aural similarity, with 3 out of 4 syllables of the CTM being identical to the whole of the mark applied for. The opponent submits that the level of aural similarity is high”.*

37. The elements of these marks, ‘5<sup>th</sup>’ and ‘Avenue’ are commonly understood. The first element of the opponent’s mark, ‘5<sup>th</sup>’, provides the only point of aural difference between the marks. These marks are aurally similar to a high degree.

### Conceptual similarities

38. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer<sup>5</sup> and the assessment must be made from their point of view.

---

<sup>4</sup> See *Sadas SA v OHIM, T-346/04* and *Peek & Cloppenburg v OHIM, T-386/07*

<sup>5</sup> This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM [2006] e.c.r.-I-643; [2006] E.T.M.R. 29.*



39. The applicant submits:

*“7...the distinctiveness of the Opponent’s mark resides in the combination of 5<sup>th</sup> and Avenue and when considered conceptually, the Opponent’s mark 5<sup>th</sup> Avenue would immediately conjure up in the mind of the average consumer the well-known major thoroughfare of Fifth Avenue in the borough of Manhattan in New York, USA, which is renowned throughout the world for its shopping. By contrast the Applicant’s mark AVENUE does not evoke the same immediate association with the famous thoroughfare in New York and this conceptual difference between the two marks would preclude any likelihood of confusion. We refer again to the judgment of the [CJEU] in Mülhens GmbH & Co KG v OHIM<sup>6</sup>, which held that conceptual differences between marks may counteract the visual and phonetic similarities when one mark has a sufficiently clear and specific meaning that the public is capable of grasping immediately.*

*We submit that since the Opponent’s mark 5<sup>th</sup> Avenue would be considered as a whole because it ‘hangs together’ to immediately evoke 5<sup>th</sup> Avenue in New York, USA, this conceptual meaning would counteract any visual and phonetic similarities and preclude a likelihood of confusion.”*

40. The opponent submits:

*“As to the conceptual similarity, the Opponent submits that the marks are clearly conceptually similar, in that both of them convey the meaning of the word “Avenue” which is a word which has no descriptive meaning in respect of footwear.”*

41. 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:

*“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 encyclopedia 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

---

<sup>6</sup> C-206/04

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.”

Whilst I am aware that 5<sup>th</sup> Avenue is a shopping destination in the Manhattan district of New York, I am unable to take judicial notice of this. In my view, however, the average consumer will know that 5<sup>th</sup> Avenue is the name of a street in that city. Consequently, a distinction will be made between ‘Avenue’, a common English word which describes a tree lined street; and 5<sup>th</sup> Avenue, a specific, famous, street in New York.

42. Taking all of these factors into account I find the marks to be conceptually distinct.

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

43. 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 from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger Joined Cases C-108/97 and C-109/97* [1999] ETMR 585.

44. To the average consumer who is aware that 5<sup>th</sup> Avenue is a New York Street famous for prestigious stores the mark may allude to quality. But with regard to footwear, the mark does not describe or allude to the goods in question. The mark has an average degree of inherent distinctive character of the kind possessed by a normal trade mark.

45. Although the earlier mark has been used, I do not have before me any indication of the size of the market for footwear which is no doubt considerable, nor do I have any indication of the respective share of that market held by the opponent. Consequently, I am unable to conclude that the use of the opponent’s earlier mark has enhanced its distinctive character to any material extent.

### **Likelihood of confusion**

46. 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.<sup>7</sup> I must also keep in mind the average consumer for the goods, the nature of the purchasing process and have regard to the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa.

47. I have found the parties’ marks to be highly similar visually and aurally. I have found the marks to be conceptually distinct. I have found the earlier mark to have an average degree of inherent distinctive character, of the kind possessed by a normal trademark. The goods are identical and will be purchased by members of the general public. The purchase is likely to be primarily visual and the degree of attention paid is likely to vary according to, inter alia, the size, colour and technical specification but will be no more than average.

---

<sup>7</sup> *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27

48. In its submissions dated 14 March 2014 the applicant states:

*“3(b)...the mark AVENUE has been in continuous use by the Applicant in the United Kingdom in the period between 2008 and 2013 on various items of footwear, including: slippers, wellingtons, shoes, boots and sandals for men, women and children.*

*Figures showing units sold of various items of the Applicant’s clothing under the AVENUE brand in the period between 2008 and 2013 are set out as Exhibit 1 of the Witness Statement of Susan Morey. For the sake of convenience, the annual units sold are set out in paragraph 13 of Ms Morey’s Witness Statement.<sup>8</sup>*

*On comparing the Opponent’s number of units of footwear sold and the overall sales figures with those of the Applicant, the Applicant shows stronger figures than the Opponent. The only year that Applicant’s unit sales did not exceed the Opponent’s was 2013. Throughout this period 2008 to 2013, no evidence has come to the Applicant’s attention of any confusion between the Opponent’s mark **5<sup>th</sup> Avenue** and the Applicant’s mark **AVENUE**.*

*This strongly suggests that the two marks have co-existed side by side and can continue to do so in the future. We should also add that any likelihood of confusion and any actual confusion would be avoided since the Applicant’s goods are only ever sold through its own chain of retail outlets, never through other retail outlets and so the Applicant’s footwear under the **AVENUE** brand would never be exposed for sale side by side with the Opponent’s goods. ”*

49. On the issue of reliance on the absence of confusion in the marketplace, TPN<sup>9</sup> 4/2009 states:

*“6. Parties are also reminded that claims as to a lack of confusion in the market place will seldom have an effect on the outcome of a case under section 5(2) of the Act.*

*7. In *Compass Publishing BV v Compass Logistics Ltd [2004] RPC 41* Laddie J held:*

*‘22. It is frequently said by trade mark lawyers that when the proprietor's mark and the defendant's sign have been used in the market place but no confusion has been caused, then there cannot exist a likelihood of confusion under Article 9.1(b) or the equivalent provision in the Trade Marks Act 1994 ("the 1994 Act"), that is to say s. 10(2). So, no confusion in the market place means no infringement of the registered trade mark. This is, however, no more than a rule of thumb. It must be borne in mind that the provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to be a finding of infringement. Similarly, even when the proprietor of a registered mark uses it, he may well not use it throughout*

---

<sup>8</sup> They are actually provided at paragraph 15

<sup>9</sup> Tribunal Practice Notice

the whole width of the registration or he may use it on a scale which is very small compared with the sector of trade in which the mark is registered and the alleged infringer's use may be very limited also. In the former situation, the court must consider notional use extended to the full width of the classification of goods or services. In the latter it must consider notional use on a scale where direct competition between the proprietor and the alleged infringer could take place.'

8. (*In Rousselon Freres et Cie v Horwood Homewares Limited [2008] EWHC 881 (Ch)*) Warren J commented:

'99. There is a dispute between Mr Arnold and Mr Vanhegan whether the question of a likelihood of confusion is an abstract question rather than whether anyone has been confused in practice. Mr Vanhegan relies on what was said by Laddie J in *Compass Publishing BV v Compass Logistics Ltd [2004] RPC 41* at paragraphs 22 to 26, especially paragraph 23. Mr Arnold says that that cannot any longer be regarded as a correct statement of the law in the light of *O2 Holdings Ltd v Hutchison 3G Ltd [2007] RPC 16*. For my part, I do not see any reason to doubt what Laddie J says...')

9. In *The European Limited v The Economist Newspaper Ltd [1998] FSR 283* Millett LJ stated:

'Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff's registered trade mark.'

50. The Applicant's evidence and submissions state that it has used the trade mark the subject of the application since 2008. Unit sales of items of footwear sold under the applicant's mark between 21 February 2008 and 24 February are shown as 423,248. The evidence shows only two examples of the mark, namely exhibit SM7 (a photograph of a pair of ladies' shoes) and SM8 (a photograph of a pair of slippers), neither of which is dated. I have turnover figures for the period 2008 to 2013 amounting to £2,980,365 for "*footwear including: slippers, wellington boots, shoes, boots and sandals for men, woman [sic] and children*" but it is not clear how the mark is used for these goods, especially as all of the references to advertising<sup>10</sup> in respect of footwear show a catalogue style page with numerous items presented. In each case, where footwear is shown, the Applicant's mark cannot be seen either in the product description or affixed to the goods. I do not have any indication of the amount spent on marketing and advertising in respect of the mark applied for. I have nothing before me to show that the parties' goods are available in the same outlets, in fact the Applicant's submissions in the extract I have provided at paragraph 48 above state that they are not.

51. Consequently, the evidence falls a long way short of allowing me to conclude that by the date of the application for registration, the average consumer had become exposed to the competing trade marks to such an extent that s/he is able to distinguish between them.

52. With regard to the likelihood of confusion the opponent states:

*"[The applicant] claims that the dominant elements of the marks differ, but that is not correct. Alternatively, if the dominant element of "5<sup>th</sup> Avenue" is the whole*

---

<sup>10</sup> Exhibits SM2 to SM6

*mark, that would not prevent “Avenue” from having an independent distinctive role in the CTM. Any such analysis could not, therefore, preclude these marks from being highly similar, nor preclude a likelihood of confusion arising.”*

53. In support of this view the opponent relies upon *Bimbo SA v OHIM*<sup>11</sup> in which the Attorney General stated:

*“...the important factor is not so much the role within the later sign of the element which reproduces the earlier trade mark as the likelihood that that element will be independently perceived and remembered by the public in the context of that sign.”*

54. Whilst I fully accept that the word ‘Avenue’ **may** play an independent distinctive role within the mark ‘5th Avenue’, in my view, in this case it does not. The construction of the mark is such that the ordinal number ‘5<sup>th</sup>’ is informed by the following word ‘Avenue’. The average consumer will recognize the combination as referring to a geographic moniker for a street in New York, whether or not they are aware of the particular nature of that street.

55. In *The Picasso Estate v OHIM*, Case C-361/04 P, the Court of Justice of the European Union found that:

*“20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law.”*

56. That is the case here. Despite the similarity between the marks in terms of their visual and aural features, a likelihood of confusion does not arise. The opponent’s mark will be seen as a New York street and will be distinguished from the word avenue.

## **CONCLUSION**

**57. The opposition under section 5(2)(b) fails.**

---

<sup>11</sup> C-591/12, [2014] ETMR 41 at [AG 25]

## **COSTS**

58. The opposition having failed for all of the goods, the applicant is entitled to a contribution towards its costs. I make the award on the following basis:

Preparing a statement and considering the other side's statement:	£300
Preparing evidence and considering/commenting on the other side's evidence	£500
Preparation submissions in lieu of attendance at the hearing:	£300
Total	£1100

59. I order Deichmann SE to pay Aldi Stores Limited the sum of £1100. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 1st day of October 2014**

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