

O-052-15

**TRADE MARKS ACT 1994  
IN THE MATTER OF TRADE MARK REGISTRATION NO. 3021952  
IN THE NAME OF ZAYN AL ABIDIN  
IN RESPECT OF THE TRADE MARK:**

**UIKO**

**AND  
AN APPLICATION FOR A DECLARATION OF INVALIDITY THERETO  
UNDER NO 500303 BY KIKO S.R.L.**

## BACKGROUND

1) Trade mark No. 3021952, shown on the cover page of this decision, stands registered in the name of Zayn Al Abidin ('the proprietor'). It was applied for on 13 September 2013 and completed its registration procedure on 06 December 2013. It is registered in respect of "All clothing, All footwear, Headgear" in class 25.

2) On 14 February 2014, Kiko S.r.l. ('the applicant') filed an application to have this trade mark declared invalid under the provisions of sections 47(2)(a) and section 5(2)(b) of the Trade Marks Act 1994 ('the Act') which state:

"47(2) The registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, ...

(b)...

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration."

And:

"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."

3) The application for a declaration of invalidity is directed against all of the goods in the trade mark registration. The applicant relies upon the community trade mark ('CTM') shown in the following table:

CTM details	Goods relied upon
<b>CTM No: 005736351</b>  <b>KIKO</b>  <b>Filing date: 22 February 2007</b> <b>Date of entry in the register: 17 May 2013</b>	<b>Class 25: Underwear, bathing suits, beachwear, clothing for teenagers, T-shirts, scarves, gloves, belts.</b>

4) 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.”

5) The applicant’s mark is an earlier trade mark under the above provisions and, as it completed its registration procedure on 17 May 2013, being less than five years before the date on which the application for invalidity was filed (14 February 2014), it is not necessary, as per section 47(2)(A)(a) of the Act, for the applicant to show that it has put its mark to genuine use in relation to the goods upon which it relies. The effect of this is that the applicant is entitled to rely on the full breadth of its specification of goods, as registered.

6) The proprietor filed a counterstatement in which it denies the grounds relied upon by the applicant.

7) Both parties filed submissions during the evidential rounds. Only the proprietor filed evidence. That evidence is extremely brief and does not require summary here; rather, I will refer to it, as necessary, in the decision which follows. Neither party requested to be heard on the substantive matters nor did they file written submissions in lieu of a hearing. I now make this decision on the basis of the papers before me.

## **DECISION**

### **Section 5(2)(b)**

8) This section 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,

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

9) The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

### **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 be dominated by one or more of its components;

(f) however, it is also 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 creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### Comparison of goods

10) The respective goods to be compared are:

Applicant's goods	Proprietor's goods
<b>Class 25:</b> Underwear, bathing suits, beachwear, clothing for teenagers, T-shirts, scarves, gloves, belts.	<b>Class 25:</b> All clothing, All footwear, Headgear.

11) The leading authorities as regards determining similarity between goods and services are considered to be *British Sugar Plc v James Robertson & Sons Ltd* [1996] R.P.C. 281 ('*Treat*') and *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117. In the latter case, the Court of Justice of the European Union ('CJEU') accepted that all relevant factors should be taken into account including 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. The criteria identified in the *Treat* case were:

- (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.

12) Further, in *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05 ('*Meric*'), the General Court ('GC') held:

"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 *Vedial 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).”

13) The proprietor’s ‘All clothing’ encapsulates the applicant’s ‘Underwear, bathing suits, beachwear, clothing for teenagers, T-shirts’. The respective goods are identical in accordance with *Meric*.

14) The proprietor’s ‘All footwear’ and ‘Headgear’ and all of the applicant’s goods are in the nature of items intended to be worn on the person. The trade channels are likely to be the same or, at least converge significantly, and the users will likely be the same. The respective goods are highly similar.

### **Average consumer and the purchasing process**

15) It is necessary to determine who the average consumer is for the respective goods and the manner in which they are likely to be selected. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

16) The average consumer for the goods at issue in this case is the general public. 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 the GC stated:

“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.”

17) As stated by the GC, items of clothing will vary greatly in price and therefore the purchase may not always be particularly considered. The same can be said of items of footwear and headgear. Nevertheless, as the consumer may wish try on the goods or to ensure that they are of a certain colour, size or material (for example) it

is likely that at least a reasonable degree of attention is still likely to be afforded, even for those goods which bear a more inexpensive price tag. The purchasing act will be primarily visual as the goods in question are commonly bought based on their appearance; they are likely to be selected after perusal of racks/shelves in retail establishments, or from photographs on Internet websites or in catalogues. However, I do not discount aural considerations which may also play a part.

**Comparison of marks**

18) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“...it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

It would therefore be wrong to artificially dissect the marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

19) I note that, in his witness statement, Mr Abidin refers to his mark and “full complete logo” and provides an image of the same. He further stresses that “the logo and designs for the brand KIKO and... UIKO are very different”. In *L’Oreal SA v Bellure NV* [2008] R.P.C. 9, the Court of Appeal stated:

“The test is, and must be, founded on the mark as registered, not material which forms no part of that. There is simply no warrant in the Directive for taking more than the registered mark into account. The global appreciation test does not amount to the proposition that once a registered mark is used in marketing, anything, extraneous to the mark used in marketing, comes in too—as though it formed part of the registered mark.”

It is clear from the above case law that I am required to make my assessment on the basis of the respective marks as they appear on the register. Accordingly, the comparison must be made between the marks set out in the table below.

Applicant’s mark	Proprietor’s mark
<b>KIKO</b>	<b>UIKO</b>

20) Neither mark lends itself to deconstruction into separate components; their respective overall impressions are based solely on the single word of which they consist.

21) In *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02 [81] - [83], the GC noted that the beginnings of words tend to have more visual and aural impact than their endings. Whilst this is only a general rule of thumb and each case must be considered on its own merits, I see no reason why the general rule is not applicable in this case. I find that, whilst the second, third and fourth letters ('IKO') are identical, the visual difference between the initial letters 'K' and 'U', in words which are fairly short in length, results in no more than a moderate degree of visual similarity overall. As for the manner in which the marks will be vocalised, the applicant's mark will likely be pronounced as KEE-KOH. The proprietor's mark is likely to be pronounced as either OO-EE-KOH or, perhaps, WEE-KOH (although I think the former is the more likely). Either way, the last syllable of the words will be the same. However, the difference between the beginnings of the marks results in a low degree of aural similarity overall.

22) As regards the concept each mark is likely to portray, the applicant's mark will be perceived as an invented word with no meaning. The proprietor contends that its mark is a Japanese word meaning 'strength'. The applicant states that this is irrelevant since the normal consumer in the UK is unlikely to understand or speak Japanese. I agree with the applicant.<sup>1</sup> The word 'UIKO' is not one with which the average UK consumer is likely to be familiar; it too is likely to be seen as an invented word with no meaning. It follows that, as neither mark will evoke any meaning, the marks are neither similar nor dissimilar. The conceptual position is neutral.

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

23) I must consider the distinctive character of the earlier mark. This must be assessed by reference to the goods or services for which the mark is registered and by reference to the way it is perceived by the relevant public (*Rewe Zentral AG v OHIM (LITE)* Case T-79/00 [2002] ETMR 91).

24) Although the applicant asserts that it has used its mark in the UK for many years such that the "KIKO brand is well-established in the UK", there is no supporting evidence of this. It follows that I can only take into account the inherent qualities of the mark.

25) I have already concluded earlier in this decision that the applicant's mark is likely to be perceived as an invented word. As such, it neither describes nor alludes to the goods covered by its registration in any way and I find it to be possessed of a high degree of inherent distinctive character.

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<sup>1</sup> As Ms Amanda Michaels stated, sitting as the Appointed Person in *Toppo Trademarks Limited v Cofra Holding AG*, BL O/092/11: "25. .... What the Hearing Officer had to consider was how the mark would be perceived by the average UK consumer. Whilst of course there are many persons whose mother tongue is not English who live and work in the UK, such persons are not the average UK consumer for the purposes of considering the pronunciation or meaning of a word."



## Likelihood of confusion

26) The proprietor makes reference to the current marketing activities of the applicant, submitting that the latter “solely focuses on selling cosmetic products” whereas it is the proprietor’s intention to trade only in clothing. It also submits that the applicant sells its goods through stores in London which are aimed at women whereas it is the proprietor’s intention to sell products on-line only for men. As the applicant states, these submissions are irrelevant to the matter before me. Firstly, as the applicant’s mark is not subject to the proof of use requirements, it is entitled to rely on the full breadth of its specification in class 25 (which covers clothing for both men and women). Secondly, it has been held by the courts on a number of occasions that the commercial activities/intentions of trade mark proprietors, whether carried out or not, have no bearing on issues surrounding the likelihood of confusion.<sup>2</sup> I must assess the matter notionally and objectively on the basis of the goods listed before me, not on the actual current or intended marketing activities of the parties.

27) I must now feed all of my earlier findings into the global assessment of the likelihood of confusion and, when conducting that assessment, I must also keep in mind the following established principles: i) the interdependency principle, whereby a lesser degree of similarity between the goods or services may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*); ii) the factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*), and; iii) the principle that the more distinctive the earlier mark is, the greater is the likelihood of confusion (*Sabel BV v Puma AG*).

28) I have found that the respective goods at issue are identical or highly similar; this is important because this may be offset by a lower degree of similarity between the marks. The earlier mark also has a high degree of inherent distinctiveness; another factor weighing in the applicant’s favour. Further, as neither mark will evoke any concept, this factor points towards imperfect recollection being more likely since there will be no conceptual hook to assist the consumer in packing away the mark in their mind. Of course, pulling against this, in the proprietor’s favour, is the degree of attention likely to be afforded by the average consumer during the purchase of the goods at issue, which I have found is likely to be of, at least, a reasonable level. This level of attention means that the consumer may recall the marks with a greater degree of precision, thus lessening the impact of imperfect recollection. A further significant factor is the degree of visual similarity between the marks which I have found to be no more than moderate; as the purchase is likely to be mainly visual this is of particular importance in the global assessment<sup>3</sup>. There is also the factor of the

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<sup>2</sup> By way of example, see *Oakley, Inc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-116/06*, paragraph [76] and *Devinlec Développement Innovation Leclerc SA v OHIM, Case C-171/06P* [59].

<sup>3</sup> In *New Look Ltd v OHIM* Joined cases T-117/03 to T-119/03 and T-171/03, the GC stated: “49 However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (*BUDMEN*, paragraph 57). The extent of the similarity or difference between the signs may depend, in

marks being only low in aural similarity which, although not of as much importance as the visual aspect in this particular case, must still form part of my considerations. Having carefully considered all of these factors and weighed them against each other, I come to the view that, the level of attention that is likely to be paid during the mainly visual purchase and the no more than moderate degree of visual similarity between the marks, in particular, means that there is no likelihood of direct confusion (where one mark is mistaken for the other). Nor do I see any reason to conclude that there is a likelihood of indirect confusion (where the average consumer believes that the respective goods come from the same or a economically linked undertaking(s)).

**The application to invalidate the trade mark registration fails.**

**COSTS**

29) As the proprietor has been successful, it is entitled to an award of costs. In approaching the award, I bear in mind that, although the proprietor filed evidence, it was extremely brief and none of it has assisted me or had any bearing on my decision. Taking account of the guidance provided in Tribunal Practice Notice 4/2007, but keeping in mind that the proprietor has not incurred the expense of legal representation, I award costs to the same on the following basis:

Considering the Form TM26(I) and filing the counterstatement	£100
Written Submissions	£100
<b>Total:</b>	<b>£200</b>

30) I order Kiko S.r.l. to pay Zayn Al Abidin the sum of **£200**. 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 3rd day of February 2015**

**Beverley Hedley  
For the Registrar,  
the Comptroller-General**

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particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumer choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs.”