

O-054-15

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3036059

BY

KATRINA MARTIN-ANDERSEN

TO REGISTER THE TRADE MARK

BABYLON

IN CLASS 25

AND

THE OPPOSITION THERETO

UNDER NO 402036

BY

MARTIN PUIGDEMASA CALVET

BACKGROUND


1. On 23 December 2013, Katrina Martin-Andersen (the applicant) applied to register the above trade mark in class 25 of the Nice Classification system,¹ as follows:

Class 25

Clothing, footwear, headwear.

2. The application was published on 21 February 2014 and was subsequently opposed by Martin Puigdemasa Calvet (the opponent).

3. The opposition is based on section 5(2)(b) of the Trade Marks Act 1994 (the Act). The opponent relies upon Community Trade Mark (CTM) no. 12169314 in respect of the following goods:

Mark details and relevant dates	Goods relied upon
<p>Mark:</p>  <p>Filed: 25 September 2013 Date of entry in register: 19 February 2014</p>	<p>Class 25 Clothing, footwear, headgear.</p>

4. The opponent states that the respective marks are similar:

“In particular, the verbal elements Babybol and BABYLON are phonetically and visually similar.”

5. The applicant filed a counterstatement on 30 June 2014 in which it denies the marks are similar either visually, phonetically or conceptually.

6. Neither side filed evidence nor asked to be heard. The opponent filed written submissions in lieu of a hearing.

DECISION

7. Section 5(2)(b) of the Act reads as follows:

“5. - (2) A trade mark shall not be registered if because –

...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is

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

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

8. 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.”

9. The opponent's mark is an earlier mark, which is not subject to proof of use because, at the date of publication of the application, it had not been registered for five years.²

Section 5(2)(b) case law

10. 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;

² See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations 2004: SI 2004/946) which came into force on 5 May 2004

(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.

The average consumer and the nature of the purchasing act

11. In accordance with the above cited case law, I must determine who the average consumer is for the goods at issue and also identify the manner in which those goods will be selected in the course of trade. 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.”

12. The average consumer of the goods at issue will be a member of the general public. In respect of the goods in class 25, in considering the level of attention that will be paid to such a purchase and the nature of the purchasing act, I am mindful of the decision of the General Court (GC) in *New Look Ltd v Office for the Harmonization in the Internal Market (Trade Marks and Designs)* Joined cases T-117/03 to T-119/03 and T-171/03, in which it commented:

"43 It should be noted in this regard that the average consumer's level of attention may vary according to the category of goods or services in question (see, by analogy, *Case C-342/97 Lloyd Schuhfabrik Meyer* [1999] ECR I-

3819, paragraph 26). As OHIM rightly pointed out, an applicant cannot simply assert that in a particular sector the consumer is particularly attentive to trade marks without supporting that claim with facts or evidence. As regards the clothing sector, the Court finds that it comprises goods which vary widely in quality and price. Whilst it is possible that the consumer is more attentive to the choice of mark where he or she buys a particularly expensive item of clothing, such an approach on the part of the consumer cannot be presumed without evidence with regard to all goods in that sector. It follows that that argument must be rejected.

...

53. Generally in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly the visual aspect plays a greater role in the global assessment of the likelihood of confusion."

13. The selection process for each of the goods is primarily visual, though I do not discount the fact that there may be an aural element given that some articles may be selected with the assistance of a member of staff. The goods may be purchased on the high street, online or by mail order and the level of attention paid will be reasonable the consumer paying the attention necessary to obtain, inter alia, the correct size, colour and fit.

Comparison of goods

14. The application is made in respect of clothing, footwear and headwear. The earlier mark is registered in respect of clothing, footwear and headgear. These are clearly identical goods.


Comparison of marks

15. 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 Court of Justice of the European Union 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."

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

17. The respective trade marks are shown below:

Opponent's mark	Applicant's mark
	<p data-bbox="874 398 1177 454">BABYLON</p>

18. With regard to the overall impression of the marks the opponent states in its submissions, dated 12 January 2015, that:

“The dominant and distinctive element of the Opponent’s mark is the verbal element Babybol (which contrary to the Applicant’s assertion in its counterstatement would be pronounced as one word, there being no gap between the first two syllables and the final syllable and the second letter ‘b’ being in lower case) as that is how the mark would be remembered by the majority of consumers. In relation to clothing (and particularly clothing for infants which is implicitly covered by the opposed Application), the “baby face” has low natural distinctiveness as it merely indicates the intended user of the goods. One cannot of course simply compare BABYLON and the element Babybol but as that latter element is the dominant and distinctive element, the comparison between the respective marks must therefore be weighted towards the verbal element as [the] dominant element in the earlier mark.”

19. In its counterstatement the applicant submits:

“[The opponent’s mark] contains the device of the laughing head of a baby and the letters of the word element of the mark are stylised with “Bol” appearing in lighter shading to “Baby”. This serves to effectively separate the mark into two words “Baby” and “Bol”. Although the marks share the same first four letters “baby”, these letters form a word which is non-distinctive for the relevant goods. The word “baby” is clearly the least dominant element of [the opponent’s mark] and as such, we do not consider that the mark BABYLON is similar to that mark by virtue of including this element only.”

20. The applicant’s mark consists of a single element, the word BABYLON, in block capitals with no form of stylisation. Consequently, the overall impression of the mark is based solely on that word.

21. The overall impression of the opponent’s mark is made up of a figurative element, a cartoon face of a baby, which is presented above the word ‘Babybol’. The first four letters of the word are black with the remaining three being presented in dark grey. The difference in shading is minimal and is unlikely to be given any trade mark significance by the average consumer.

22. The opponent contends that a baby face simply indicates the intended user for the goods, while the applicant states that the word ‘baby’ is not distinctive for the relevant

goods. Both marks are registered in respect of clothing, footwear and headgear/wear at large and are not limited to any specific types of clothing. Consequently, whilst these elements may lack a degree of distinctiveness in respect of clothing, footwear and headgear for babies, there are many other goods for which these elements are distinctive, for example, men's shirts.

23. The figurative element plays a significant role within the mark, being presented above the word and making up approximately half of the total mark, though it is the invented word which is more dominant in terms of the overall impression.

Visual similarities

24. The word element of the earlier mark and the applicant's mark are seven letters in length and begin with the four letters 'BABY'. The remaining letters are 'BOL' and 'LON' respectively. In addition the opponent's mark contains a prominent device of the head of a baby. These marks are visually similar to a low degree.

Aural similarities

25. With regard to the pronunciation of the respective marks the opponent submits:

"As regards the phonetic comparison, it should also be borne in mind that many consumers in Scotland and northern England (therefore a very substantial percentage of the UK population) pronounce the word 'baby' as 'babby' or would at least be familiar with the alternative pronunciation. For those consumers, the phonetic comparison between BABYLON (assuming that mark is pronounced as in the eponymous city) and Babybol would be self-evidently much closer."

26. The applicant states that the opponent's mark will be pronounced as two words, 'baby' and 'bol', whereas its own application is the single word 'BABYLON' and that is how it will be pronounced.

27. In my view, the most likely pronunciation of the opponent's mark is BAY-BEE-BOL (BOL to rhyme with DOLL). The applicant's mark is most likely to be pronounced BAB (as in BABBLE) -EE (as in EEL) – LON (as in PYLON). Other than the common sounds created by the initial and third letters, 'B', the remainder of the words are pronounced differently. These marks are phonetically similar to a low degree.

Conceptual similarities

28. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer³ and the assessment must be made from their point of view.

29. The opponent's mark consists of single invented word. It is possible within it to discern the known English word 'Baby', which is reinforced by the figurative element of the head of a baby. However, the presentation of the mark is such that in my view, the average consumer will, even where they recognise a particular element of the mark to be a known word, consider it to be an invented word. Consequently, it has no conceptual meaning beyond evoking a reference to a baby.

³ 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.

Both sides state that the applicant's mark refers to (or may refer to) the city, Babylon. The assessment must be made from the point of view of the average consumer who cannot be assumed to know the meaning of everything.⁴

30. Babylon was an ancient city of Mesopotamia and now lies in Iraq. However, this is not a notorious fact of the kind which would allow me to take judicial notice of the point. In my view whilst Babylon's exact location or historic significance may not be known to the average UK consumer it would be considered to refer to a geographic location, whether it is considered to be a city or a region.

31. Taking all of these factors into account, I find the marks to be conceptually dissimilar.

Distinctive character of the earlier mark

32. In determining the distinctive character of a trade mark it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify its goods 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.

33. The opponent's mark, 'Babybol' is an invented word which is neither descriptive nor allusive of the goods at issue. Whilst the word 'baby' is included within the mark as a whole, it provides, as I have concluded above, no more than an allusive quality within the mark as a whole. Consequently, even when used in respect of clothing for babies or children (both of which would be included within the opponent's specification) the mark in its totality has a good level of inherent distinctive character.

Likelihood of confusion

34. 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.⁵ 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.

35. I have found the parties' marks to be visually and aurally similar to a low degree. I have found the marks to be conceptually dissimilar and have found the earlier mark to have a good degree of inherent distinctive character. 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 be reasonable.

36. The differences between the parties' respective marks are such that, even where the goods are identical, the marks in their totality are sufficiently different that there is no likelihood of confusion, whether direct (where one mark is mistaken for the other) or indirect (where the average consumer believes the respective goods originate from the same or a linked undertaking).

⁴ See the comments of Anna Carboni sitting as the Appointed Person in the Chorkee case, BL O-048-08

⁵ *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27

Conclusion

37. The opposition fails.

COSTS

38. The opposition having failed, the applicant is entitled to a contribution towards its costs. I have taken into account that no hearing has taken place and that no written submissions were filed by the applicant. I make the award on the following basis:

Preparing a statement and considering the other side's statement: £300

Total: £300

39. I order Martin Puigdemasa Calvet to pay Katrina Martin-Andersen the sum of £300. 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 4th day of February 2015

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