

**O-160-15**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3029108 BY  
TRIANGLE PROJECT**

**TO REGISTER:**

**Triangle Project**

**AS A TRADE MARK  
IN, INTER ALIA, CLASSES 14, 18 & 25**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 401969 BY  
s.OLIVER BERND FREIER GMBH & CO. KG**

## BACKGROUND & PLEADINGS

1. On 5 November 2013, Triangle Project (“the applicant”) applied to register the words **Triangle Project** as a trade mark in classes: 9, 14, 16, 18, 25, 35, 36, 41, 42 and 45. The application was published for opposition purposes on 7 February 2014.

2. The application is opposed by s. Oliver Bernd Freier GmbH & Co. KG (“the opponent”). The opposition, which is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), is directed against the following goods in the application:

**Class 14** - Jewellery; lapel pins made from precious metals and/or their alloys or coated with precious metals and/or their alloys; ornamental pins; badges; brooches; pendants; horological and chronometric apparatus and instruments; key rings; key fobs; cufflinks; tie clips; tiepins; medals; lapel pins; parts and fittings for all of the aforesaid goods.

**Class 18** - Handbags, briefcases, wallets, purses, card cases, key cases and bags made from leather; umbrellas; luggage; and bags.

**Class 25** - Clothing, footwear, headgear; and wristbands to wear.

The opponent relies upon the goods shown below in the following Community Trade Mark registrations (“CTM”). CTM no. 2719060 for the trade mark: **TRIANGLE**; applied for on 28 May 2002 and for which the registration procedure was completed on 8 August 2003:

**Class 18** - Fashion accessoires, namely bags, belts, hats, caps, gloves, hoisery, ties, suspensors.

**Class 25** - Clothing for men, women and children; boots, shoes, slippers; woven and knitted clothing.

CTM no. 9818543 for the trade mark: **Triangle**; applied for on 17 March 2011 and for which the registration procedure was completed on 21 February 2012:

**Class 14** - Precious metals and their alloys and goods in precious metals or coated therewith, Namely cans of precious metal, Cases, Figurines and statuettes of precious metals, Medals, Coins.

**Class 18** - Leather and imitations of leather and goods made therefrom, And namely bags, And in particular handbags, Sports bags, Tote bags, Toiletry kits, Rucksacks, Purses, Wallets, Key wallets; Trunks and travelling bags; Umbrellas, parasols and walking sticks.

**Class 25** - Clothing, footwear, headgear.

In relation to their second CTM, the opponent states:

“The application in suit comprises the words “Triangle Project”...The word PROJECT lacks distinctive character. Thus the dominant and distinctive

element of the trade mark applied for is the word TRIANGLE. That element, moreover, is the first element of the trade mark and so will be the element that the average consumer will pay most attention to. As a result, the respective trade marks must be considered highly similar and almost identical to one another.

The application covers goods in classes 14, 18 and 25, amongst others. The opponent's registration covers goods in classes 14, 18 and 25. The class 18 and 25 goods of the opponent's registration are identical to the classes 18 and 25 goods of the application in suit. We submit that the class 14 goods should be considered similar, if, not identical, to the class 14 goods of the application in suit."

3. The applicant filed a counterstatement in which the basis of the opposition is denied. Having explained that it is "a charity which has been created as a joint venture between two well known established charities, namely St Francis Children's Society and Family Society", the applicant states:

"5.1.10 There are a number of other trade marks registered in the UK in classes 14, 18 and 25 in which the word "Triangle" is also used, specifically, "Bermuda Triangle", "Triangle Circle" and "Triangle Clothing" which have obviously not been considered to be confusing to either the Opponent's mark or the Applicant's mark."

In addition, the applicant admits that some of the goods in its application are "either identical or similar to the goods specified in the opponent's mark". I will return to both of these points later in this decision.

4. Both parties filed evidence and written submission during the course of the evidence rounds. Whilst neither party asked to be heard, both filed written submissions in lieu of attendance at a hearing. I will keep all of these written submissions in mind and refer to them, as necessary, below.

## **EVIDENCE**

### **The opponent's evidence-in-chief**

5. This consists of a witness statement (accompanied by nine exhibits) from Thomas Steinhart, the opponent's Managing Director. Ordinarily, I would provide a summary of this evidence here, however, in his statement, Mr Steinhart explains:

"2. The trade mark TRIANGLE was acquired by the opponent in June 2010. In 2012 the opponent launched the trade mark in Germany and the trade mark has been in continuous use by the opponent since that date.

4. As of the beginning of the year 2014 goods sold under the trade mark TRIANGLE are sold not only in Germany but also in Austria, Luxembourg, Czech Republic, Finland, France, Greece, Netherlands, Italy and Spain and Belgium.

11...are copies of pages from....the opponent's magazine/catalogue...The magazine/catalogue was mainly distributed in Germany. Each had a print run of 4.2 million copies. 3 million were distributed via the magazines Stern, Focus, Gala and Brigitte. 470,000 were enclosed to packages. 400,000 were sent via post to customers and 230,000 were distributed via s.Oliver retail stores. 100,000 copies were distributed in countries of European Union other than Germany.

12...are copies of invoices issued to distributors of the opponent in Austria, Belgium, Netherlands and Finland...

16...is a copy of a leporello...and has been distributed via the opponent's showroom in Germany where the retail customers, also from countries other than Germany, order goods..."

6. I have reviewed the opponent's evidence with the above statements in mind. With the odd exception, the exhibits provided are in the German language. Whilst certain comments in Mr Steinhart's evidence are open to interpretation, references to sales/promotion of goods "in the European Union" for example, there is nothing concrete in his evidence to indicate that any goods have been sold by the opponent in the United Kingdom under the trade mark upon which it relies. Whilst I accept that in these proceedings the opponent relies upon the two CTMs mentioned above (one of which is, in principle, subject to proof of use), in its counterstatement, the applicant did not request proof of use. In those circumstances, Mr Steinhart's evidence would only have served any useful purpose if it established that the opponent's trade mark had acquired an enhanced reputation by virtue of the use made of it in the United Kingdom; clearly it does not. I will, as a consequence, treat the opponent's trade mark as unused, and will return to Mr Steinhart's evidence when I consider the matter of costs later in this decision.

### **The applicant's evidence-in-chief**

7. This consists of a witness statement, dated 27 November 2014, from Benjamin James, a Director and Trustee of the applicant. Mr James explains that the applicant is a fostering and adoption charity which was established in 2014. Having explained how the applicant intends to use its trade mark, Mr James states:

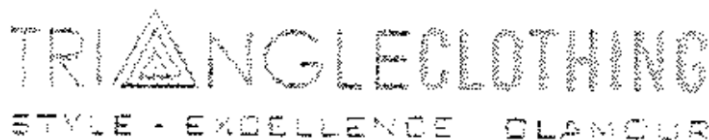
"3.2 Considering that there are a number of other trade marks, both registered and un-registered which include the word "Triangle" with an additional word, the arguments put forward by the opponent do not appear to be credible..."

Mr James points to the existence of two trade marks registered in class 25 (in different ownership) which include the word Triangle and another word i.e. TRIANGLE CIRCLE and:



8. Mr James provides three exhibits. Exhibit TP1 consists of what he describes as a “Google search in relation to the word “Triangle” and clothing” and which, in his view, “shows a wide range of uses of the word Triangle in relation to clothing, both product ranges available in the UK using the name “Triangle” and also clothing products which contain a wide range of triangle designs.” The Google search provided is, as far as I can tell undated but I infer is contemporaneous with Mr James’ statement. Although none of the eleven hits have been expanded, it is possible to discern that nine of the hits relate to the United Kingdom. There are a number of hits for “Triangle Clothing”, a hit for “Love Triangle Top” (which, given the reference to \$48, I take to be a website directed at the market in the United States), a hit for “Triangle Silver Leggings” which includes the following; “Are they silver triangles on a black background...”, a hit for “Blue Triangle Clothing” (an undertaking based in the United Kingdom), a hit for “1 Pack of 10 Copper Coloured Clothing Studs” and a hit for “Triangle T-shirt” (the last two hits are both from amazon.co.uk). As far as I can tell, the final hit, obtained from helpforheroes.org.uk, does not contain the word TRIANGLE. Finally, there are six images provided, two of which, insofar as I can tell, appear to show images of triangles upon articles of clothing.

9. Exhibit TP2 consists of what Mr James describes as “a print out from eBay showing the products available from the “Triangle Clothing” brand.” Although it appears the pages provided are undated, I make the same inference mentioned above. Although the pages provided contain images of primarily fancy dress clothing and accessories (the prices of which are shown in £), under the heading “Shop Categories” there appears a number of entries which relate to more conventional items of clothing, for example, “jackets and coats”, “tracksuits”, “blazers” etc. The image shown below appears on a number of the pages provided:



10. Exhibit TP3 consists of what Mr James describes as “a print out from the Victoria Secret’s website showing its “Triangle” range, a range of triangle bikinis”; the pages are, once again, undated. The inclusion of, for example, prices in \$, indicates a website directed at the market in the United States. The pages provided contain, for example, references to “Beach Sexy The Classic Triangle Top” and “New! Very Sexy Push Up Triangle Top”. All the images relate to bikini tops.

### **Opponent’s evidence-in-reply**

11. This consists of a witness statement from Helene Whelbourn, a trade mark attorney at Novagraaf UK, the opponent’s professional representatives. Ms Whelbourn explains that on 9 January 2015, she conducted an exact word search of the database of the United Kingdom Intellectual Property Office (“IPO”) for the word PROJECT in classes 14, 18 and 25. Exhibit HW1 consists of the results of that search, with Ms Whelbourn noting that only two registered trade marks were retrieved.

12. That concludes my summary of the evidence filed to the extent I consider it necessary.

## DECISION

13. The opposition is based upon section 5(2)(b) of the Act, which 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 protected,

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

14. 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.”

15. In these proceedings, the opponent is relying upon the two trade marks shown in paragraph 2 above, both of which qualify as earlier trade marks under the above provisions and which consist of the word TRIANGLE/Triangle presented in upper and title case respectively. Although CTM no. 2719060 (TRIANGLE) is subject to the proof of use provisions contained in section 6A of the Act, as I mentioned above, in its counterstatement the applicant indicated that it did not require the opponent to provide proof of use. As a consequence, the opponent is, as it claims, entitled to rely upon all the goods for which this trade mark is registered. However, as CTM no. 9818543 (Triangle) is not subject to proof of use and contains goods in classes 14 (as well as goods in classes 18 and 25), it is this trade mark upon which I will base my comparison. If the opponent does not succeed in relation to this trade mark, it will be in no better position in relation to CTM no. 2719060.

### Section 5(2)(b) – case law

16. 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

17. The competing goods are as follows:

Opponent's goods	Applicant's goods
<p><b>Class 14</b> - Precious metals and their alloys and goods in precious metals or coated therewith, Namely cans of precious metal, Cases, Figurines and statuettes of precious metals, Medals, Coins.</p> <p><b>Class 18</b> - Leather and imitations of leather and goods made therefrom, And namely bags, And in particular handbags, Sports bags, Tote bags, Toiletry kits, Rucksacks, Purses, Wallets, Key wallets; Trunks and travelling bags; Umbrellas, parasols and walking sticks.</p> <p><b>Class 25</b> - Clothing, footwear, headgear.</p>	<p><b>Class 14</b> - Jewellery; lapel pins made from precious metals and/or their alloys or coated with precious metals and/or their alloys; ornamental pins; badges; brooches; pendants; horological and chronometric apparatus and instruments; key rings; key fobs; cufflinks; tie clips; tiepins; medals; lapel pins; parts and fittings for all of the aforesaid goods.</p> <p><b>Class 18</b> - Handbags, briefcases, wallets, purses, card cases, key cases and bags made from leather; umbrellas; luggage; and bags.</p> <p><b>Class 25</b> - Clothing, footwear, headgear; and wristbands to wear.</p>

18. The opponent uses the word “namely” in its specification in class 14 and the word “namely” and the formulation “in particular” in its specification in class 18. The word “namely” must be approached, as indicated in the Trade Mark Registry’s classification guidance on the basis shown below:

“Note that specifications including “namely” should be interpreted as only covering the named Goods, that is, the specification is limited to those goods. Thus, in the above “dairy products namely cheese and butter” would only be interpreted as meaning “cheese and butter” and not “dairy products” at large. This is consistent with the definitions provided in Collins English Dictionary which states “namely” to mean “that is to say” and the Cambridge International Dictionary of English which states “which is or are”. ”

The use of the formulation “in particular” has no such limiting effect.

### The correct approach to the comparison of goods

19. In its counterstatement, the applicant states:

“5.2.1 It is acknowledged that some of the goods specified in classes 14...18...and 25...are either identical or similar to the goods specified in the opponent’s mark.

5.2.3...Of particular relevance in this case are the different sectors of the organizations and the different purposes for which the goods will be applied.



5.2.5 The goods will never be traded through similar channels and will not find themselves in the same retail outlets...

5.2.6 The goods whilst similar in some respects are not competitive as in the case of the applicant they are to support its fundraising activities and in the case of the opponent, they are part of a commercial operation.”

In its submissions, the opponent states:

“3. ...The opponent (sic) attempts to argue that the identity/similarity is irrelevant since the applicant’s actual commercial activities are different. However, that is not reflected in the application in suit...”

20. Fundraising activities may also be part of a commercial activity, however, for the reasons the opponent points out, the applicant’s approach is incorrect. As the applicant’s specifications are not limited in any way, and as the opponent’s earlier trade mark upon which the comparison is based is not subject to proof of use, what I am required to do is make a notional comparison of the opposed goods in the application with the goods in the earlier trade mark upon which the opponent relies.

### **The case law relating to similarity of goods**

21. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services;
- c) The respective trade channels through which the goods or services reach the market;
- d) 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;
- e) 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.

22. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

“I should add that I see no reason to give the word “cosmetics” and “toilet preparations”... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context.”

23. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

24. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court ("GC") stated that "complementary" means:

"...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking".

In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as 'complementary' and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

"It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes."

Whilst on the other hand:

".....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.

25. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05, the GC 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).”

26. For the sake of convenience, I will consider the matter on a class-by-class basis.

#### **Class 14**

27. I have already commented on the use of the word “namely” above. The use of this word limits the opponent’s specification in this class to:

Cans of precious metal, Cases, Figurines and statuettes of precious metals, Medals, Coins.

28. As “medals” appear in both parties’ specifications, these goods are clearly identical. Insofar as the goods which remain in the application are concerned, these fall into a number of categories i.e. (i) jewellery/pendants (ii) lapel pins/ornamental pins/badges, brooches, (iii) horological and chronometric apparatus and instruments, (iv) key rings and key fobs, (v) cufflinks, (vi) tie clips and tiepins and (vii) parts and fittings for these goods. Whilst I accept that there may be an overlap in the users of the competing goods (i.e. the general public), the physical nature of the competing goods (silver or gold for example) and some of the trade channels through which the goods may pass (retailed by jewellers for example), that degree of generality does not, in my view, assist the enquiry greatly. Having given the terms in the competing specifications their natural meanings, having considered the intended purpose, method of use and whether there exists a complementary or competitive relationship between the competing goods, and in the absence of evidence or submissions from the opponent to explain why they should be regarded as similar, I have concluded that there is no meaningful similarity between the opponent’s goods in class 14 and the applicant’s goods in class 14 with the exception of medals. As to the parts and fittings in the applicant’s specification, these are either identical/not similar on the same basis as the goods to which they relate.

29. In its Notice of opposition the opponent, by reference to the first trade mark shown in paragraph 2, stated:

“We submit that the class 14 goods should be considered similar to the class 18 and 25 goods since, amongst other things, they have the same purpose (fashion) and channels of trade (fashion shops).”

In *Oakley, Inc v OHIM*, Case T-116/06 the GC held that:

“The intervener’s argument that eyewear, jewellery and watches could be similar or complementary to items of clothing cannot succeed, since, as

correctly pointed out by OHIM, the relationship between those goods is too indirect to be regarded as conclusive. It must be borne in mind that the search for a certain aesthetic harmony in clothing is a common feature in the entire fashion and clothing sector and is too general a factor to justify, by itself, a finding that all the goods concerned are complementary and, thus, similar (SISSI ROSSI, paragraph 49 above, paragraph 62).

30. Although the above judgment only considers the degree of similarity between goods in classes 9, 14 and 25, the conclusion that this is too “general a factor” to lead to a finding that the competing goods are complementary (and thus similar), indicates that there is no similarity between the opponent’s goods in class 25 and, by parity of reasoning, the vast majority of the opponent’s goods in class 18. I say vast majority, because having considered, inter alia, the intended purpose, method of use and trade channels of “key rings” and “key fobs” (and parts and fittings for these goods) in the application and “key wallets” in the opponent’s specification in class 18, I have concluded that there is at least a reasonable degree of similarity between these competing goods.

### **Class 18**

31. My comments upon the use of the word “namely” and the formulation “in particular” in the opponent’s specification in this class apply here. With those comments in mind, the opponent’s specification should, in my view, be interpreted as follows:

Bags made from leather and imitations of leather and in particular handbags, Sports bags, Tote bags, Toiletry kits, Rucksacks, Purses, Wallets, Key wallets; Trunks and travelling bags; Umbrellas, parasols and walking sticks.

32. Approached on that basis, the “handbags”, “wallets”, “purses”, “bags made from leather”, “umbrellas” and “bags” in the applicant’s specification are clearly identical to the corresponding terms in the opponent’s specification in this class. As “key cases” and “luggage” in the application are simply alternative ways of describing “key wallets” and “trunks and travelling bags” in the opponent’s specification, they too are identical. The goods which remain in the applicant’s specification are “briefcases” and “card cases”. If, these goods are not identical to “bags” and “purses” and “wallets” respectively in the opponent’s specification in this class, given the coincidence in (at least) the nature, intended purpose, method of use and trade channels, they are, in my view, similar to the highest degree.

### **Class 25**

33. As the competing specifications in class 25 include the words “Clothing, footwear, headgear” and as the “wristbands for wear” in the applicant’s specification would be encompassed by the term “clothing” in the opponent’s specification, the competing goods are either literally identical or identical on the principles outlined in *Meric*.

## The average consumer and the nature of the purchasing process

34. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods; I must then determine the manner in which these goods are likely to be selected by the average consumer 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.”

35. As I mentioned earlier, the average consumer for all of the goods at issue is a member of the general public. As to the manner in which such an average consumer will select these goods, 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 considered the level of attention paid to and the manner in which clothing is selected. It 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.

50. The applicant has not mentioned any particular conditions under which the goods are marketed. 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.”

36. As all of the goods at issue are, like items of clothing, most likely to be the subject of self selection from traditional retail outlets on the high street, catalogues and websites, visual considerations are likely to dominate the selection process,

though not to the extent that aural considerations can be ignored. The cost of the goods at issue can vary considerably. Nevertheless, as factors such as material, size, colour, cost and compatibility with other items may all come into play, the average consumer will, in my experience, pay a reasonable level of attention when making their selection. This level of attention will, in my experience, increase as the cost and importance of the item increases.

### **Comparison of trade marks**

37. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union (“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.”

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

39. The trade marks to be compared are as follows: **Triangle v Triangle Project**. Although much of the competing submissions are directed at this issue, I do not intend to summarise them here. For the avoidance of doubt, however, I have considered all of the competing submissions in reaching the conclusions which follow.

40. The opponent’s trade mark consists of the word Triangle presented in title case; it has no distinctive or dominant components. The overall impression it creates will be of a single word the meaning of which will be well known to the average consumer.

41. The applicant’s trade mark consists of the words Triangle and Project presented in title case; the meanings of both words, once again, will be well known to the average consumer. Although the word Triangle appears as the first word in the trade mark, the word Project is certainly not negligible and I agree with the applicant that both words are likely to make an equal contribution to the overall impression the trade mark creates. As to the distinctiveness of these elements, the applicant has filed evidence to demonstrate that trade marks which include the word Triangle have been registered for clothing and that the word Triangle is used by other undertakings in relation to clothing. As I mentioned above, the hits provided as exhibit TP1 have

not been expanded and appear to be from after the date of the application for registration. Making what I can of the exhibit in those circumstances, it appears to show the use of the word Triangle by a number of undertakings (the majority of which are in the United Kingdom) in what appears to be either a trade mark sense (as per exhibit TP2) or in a descriptive sense (as per exhibit TP3). However, notwithstanding its own evidence, in its written submissions the applicant concludes:

“3.3 Generally there appear to be only a moderate level of distinctiveness inherent in the word Triangle in relation to the goods in class 25...

3.4 Taking the information included in the witness statement into account and the information provided by the opponent, it is clear that Triangle only has a moderate level of distinctiveness as a brand name...”

42. As the opponent points out in its submissions, the applicant’s evidence only relates to goods in class 25. In relation to those goods, the applicant concludes that the word Triangle has a “moderate level of [inherent] distinctiveness.” That, in my view, seems to be a sensible position to adopt, as notwithstanding what appears to be the use of the word Triangle in a descriptive context in relation to clothing, the evidence also appears to show that the word can operate equally well as a badge of origin. Although the applicant has not provided any evidence in relation to classes 14 and 18, it would be unsurprising if a similar situation did not prevail in those classes as well. As a consequence, I intend to proceed on the basis that the word Triangle also has a moderate level of inherent distinctiveness in relation to those goods. As to the word Project, in its submissions, the applicant states (without providing evidence) that “there are currently 23 trade marks registered or pending consisting of solely the word “Project.” In its evidence in reply, the opponent provides the results of a search which shows that there are only two trade marks consisting of this word registered in classes 14, 18 and 25. Regardless of these competing positions, in the context in which the word appears in the applicant’s trade mark, I agree with the opponent that it will be seen as a word meaning “plan, scheme or undertaking” and serves to qualify the word Triangle rather than as a distinctive element in its own right.

43. Moving on to the comparison of the competing trade marks, when considered from the visual and aural perspectives, the fact that they consist either exclusively of, or contain the word Triangle as the first word in the trade mark, inevitably leads to a reasonable degree of visual and aural similarity between them, notwithstanding the inclusion of the word Project in the applicant’s trade mark. Insofar as conceptual considerations are concerned, as I mentioned above, in my view, the word Project simply qualifies the word Triangle. As the inclusion in the applicant’s trade mark of the word Project will not, in my view, materially affect the conceptual message conveyed by the word Triangle, the competing trade marks are, in my view, conceptually similar to a reasonably high degree.

### **Distinctive character of the opponents’ Triangle trade mark**

44. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought 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 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. The applicant admits that the word Triangle has a moderate degree of inherent distinctiveness. As the opponent's evidence does not set out any specific details of any trade under the earlier mark in the United Kingdom, it fails to show that the distinctiveness of its trade mark has been enhanced through use in the United Kingdom.

### **Likelihood of confusion**

45. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is 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. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponents' trade mark as the more distinctive this trade mark 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 upon the imperfect picture of them he has retained in his mind.

46. Earlier in this decision I concluded that:

- “Medals and parts and fittings for the aforesaid goods” in the application in class 14 are identical to “medals” in the opponent's specification in class 14, and “key rings, key fobs and parts and fittings for the aforesaid goods” in the application in class 14 are at least reasonably similar to “key wallets” in the opponent's specification in class 18;
- The opponent's remaining goods in classes 14, 18 and 25, are not similar to any of the other goods in the application in class 14;
- The competing goods in class 18 are either identical or similar to a high degree;
- The competing goods in class 25 are identical;
- The average consumer is a member of the general public who will select the goods predominantly by visual means and who will pay at least a reasonable level of attention when doing so;
- The overall impression created by the opponent's trade mark will be of a single word the meaning of which will be well known;
- Both words in the applicant's trade mark will make an equal contribution to the overall impression it creates;



- The competing trade marks are visually and aurally similar to a reasonable degree and conceptually similar to a reasonably high degree;
- The opponent's earlier trade mark is possessed of a moderate degree of inherent distinctive character which, on the basis of the evidence provided, has not been enhanced by any use made of it in the United Kingdom.

47. As per the comments of the CJEU in *Waterford Wedgwood plc v OHIM* Case C-398/07, there must be some similarity in the competing goods to engage the test for the likelihood of confusion. Earlier in this decision, I concluded that there was no meaningful similarity between the opponent's goods and the following goods in the application:

**Class 14** - Jewellery; lapel pins made from precious metals and/or their alloys or coated with precious metals and/or their alloys; ornamental pins; badges; brooches; pendants; horological and chronometric apparatus and instruments; cufflinks; tie clips; tiepins; lapel pins; parts and fittings for all of the aforesaid goods.

48. Where there is no similarity in the competing goods there can be no likelihood of confusion and the opposition against the goods shown above fails accordingly. In relation to those goods I have found to be identical, highly similar or reasonably similar, the inclusion of the word Project in the applicant's trade mark is, in my view, sufficient to avoid a likelihood of direct confusion i.e. where one trade mark is mistaken for another. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, Mr Iain Purvis Q.C. as the Appointed Person noted that:

"16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: "The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ("26 RED TESCO" would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

49. Notwithstanding my conclusion in relation to direct confusion, the degree of similarity in the competing trade marks I have identified above is, in relation to those goods which I have found to be identical, highly similar or reasonably similar sufficient, in my view, to lead to a likelihood of indirect confusion. In reaching the above conclusion, I have not overlooked the fact that the word Project has been registered in its own right in a number of classes, however, in the context in which it appears in the applicant’s trade mark it will, as I explained above, be seen as qualifying the word Triangle and not as a distinctive element in its own right.

50. Finally, I need comment only briefly upon the applicant’s points regarding (i) the existence of other trade marks which are registered in relation to clothing and contain the word Triangle and another element, and (ii) the absence of evidence of confusion. In relation to the former, in its submissions, the opponent points to the following well known quotation from *British Sugar Plc v. James Robertson & Sons Ltd* [1996] RPC 281 when Jacob J (as he then was) stated:

“In particular the state of the register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led the registrar to put the marks concerned on the register. It has long been held under the old Act that comparison with other marks on the register is in principle irrelevant when considering a particular mark tendered for registration, see e.g. MADAME Trade Mark and the same must be true under the 1994 Act. I disregard the state of the register evidence.”

51. In relation to the latter, in *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283 Millett L.J. stated that:

"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.”

### **Overall conclusion**

52. The application may proceed to registration in respect of the unopposed goods i.e. classes: 9, 16, 35, 36, 41, 42 and 45. Subject to any successful appeal, the application will also be allowed to proceed to registration in respect of the following goods in class 14:

Jewellery; lapel pins made from precious metals and/or their alloys or coated with precious metals and/or their alloys; ornamental pins; badges; brooches;

pendants; horological and chronometric apparatus and instruments; cufflinks; tie clips; tiepins; lapel pins; parts and fittings for all of the aforesaid goods,

but will be refused in respect of the following goods:

**Class 14** – Medals, key rings, key fobs and parts and fittings for the aforesaid goods;

**Class 18** - Handbags, briefcases, wallets, purses, card cases, key cases and bags made from leather; umbrellas; luggage; and bags.

**Class 25** - Clothing, footwear, headgear; and wristbands to wear.

### **Costs**

53. The opponent has been wholly successful in relation to two of the three classes it opposed and partially successful in relation to a number of items in class 14. As a consequence, the opponent is entitled to a contribution towards its costs, albeit reduced to reflect the measure of the applicant's success in relation to the goods in class 14 of its application. In addition, whilst the opponent's evidence-in-chief was irrelevant and played no part in these proceedings, it would still have been necessary for the applicant to consider it. I have not, therefore, made any award to the opponent in respect of any of its evidence. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide, but bearing in mind my comments above, I award costs to the opponent on the following basis:

Preparing a statement and considering the applicant's statement:	£200
Opposition fee:	£100
Written submissions:	£300
<b>Total:</b>	<b>£600</b>

54. I order Triangle Project to pay to s.Oliver Bernd Freier GmbH & Co KG the sum of **£600**. 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 10th day of April 2015**

**C J BOWEN**  
**For the Registrar**  
**The Comptroller-General**