

O/065/16

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3111737
BY JAXKS LTD**

TO REGISTER:

JAXKS
&
Jaxks

AS A SERIES OF TWO TRADE MARKS IN CLASS 25

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 404896 BY PEEK & CLOPPENBURG KG**

BACKGROUND

1. On 3 June 2015, Jaxks Ltd (“the applicant”) applied to register **JAXKS** and **Jaxks** as a series of two trade marks for the following goods in class 25:

Clothing, footwear and headgear.

The application was published for opposition purposes on 26 June 2015.

2. The application is opposed by Peek & Cloppenburg KG (“the opponent”). The opposition, which is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), is directed against all of the goods in the application. The opponent relies upon the goods (shown below) in Community Trade Mark (“CTM”) registration no. 3587326 for the trade mark: **Jake*s** which was applied for on 17 December 2003 and for which the registration procedure was completed on 19 May 2005:

Class 25 – Clothing, footwear, headgear.

3. The applicant filed a counterstatement in which it denies the basis of the opposition and puts the opponent to proof of use of the trade mark and goods upon which it relies. The applicant states:

“3. The applicant admits that the class 25 goods are similar but denies that this has any material effect on the likelihood of confusion due to the significant differences in the respective marks.”

4. Only the opponent filed evidence; it also filed written submissions during the course of the evidence rounds. Whilst neither party asked to be heard, the applicant filed written submissions in lieu of attendance at a hearing. I will bear all of these submissions in mind and refer to them, as necessary, below.

The opponent’s evidence

5. This consists of a witness statement (accompanied by ten exhibits) from Christopher Morris, a trade mark attorney at Burgess Salmon, the opponent’s professional representatives. I will return to Mr Morris’ evidence later in this decision.

DECISION

6. 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.”

7. 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.”

8. In these proceedings, the opponent is relying upon the trade mark shown in paragraph 2 above, which qualifies as an earlier trade mark under the above provisions. As this trade mark completed its registration process more than 5 years before the publication date of the application in suit, it is subject to proof of use, as per section 6A of the Act. In its Notice of Opposition, the opponent indicated that it has used its trade mark upon all of the goods in class 25 for which it is registered and upon which it relies, and, in its counterstatement, the applicant asked the opponent to make good this claim.

9. It is at this point in my decision that I would normally reach conclusions on whether the opponent’s earlier trade mark had been used in the five year period prior to the publication date of the application in suit, and if so, in relation to which goods use had been demonstrated and what constituted a fair specification. However, for reasons which will shortly become obvious, I intend to proceed on the basis that the opponent is entitled to rely upon all of the goods for which its earlier trade mark is registered.

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;
- (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 greater 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

11. Proceeding on the basis indicated in paragraph 9 above, the competing specifications are identical consisting as they do of the phrase clothing, footwear and headgear.

The average consumer and the nature of the purchasing act

12. 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.”

13. The average consumer for 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 General Court (“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.”

14. As items of clothing, footwear and headgear are, 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 an average degree of attention when making their selection. This level of attention, once again in my experience, is likely to increase as the cost and importance of the item increases.

Comparison of trade marks

15. 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.”

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

Opponent’s trade mark	Applicant’s trade marks
Jake*s	JAXKS/Jaxks

The approach to the comparison

17. The application is for a series of two trade marks presented in upper and title case respectively, whereas the opponent’s trade mark is presented in title case. However, as fair and notional use of both parties’ trade marks would include use in, for example, upper, title and lower case, it matters not upon which trade mark I base my comparison.

For the sake of convenience, however, I will compare the opponent's trade mark with the applicant's trade mark presented in title case.

18. The opponent's trade mark consists of the word "Jake" presented in title case, followed by an asterisk and the letter "s" in lower case. In its submissions, the opponent describes its trade mark as:

"11...the word Jake's, with an asterisk replacing the apostrophe."

19. That accords with my own view of the matter and represents the overall impression the opponent's trade mark will convey. As to the applicant's trade mark, it consists of the word Jaxks in which no part is highlighted or emphasised in any way; the overall impression it creates stems from the word itself.

20. Considered from a visual perspective, the competing trade marks consist of five and six characters respectively. Both trade marks begin with the letters "J-a", contain a letter "k" in the third and fourth letter positions respectively and end with a letter "s". They differ to the extent that the applicant's trade mark contains a letter "x" as the third letter and the opponent's trade mark contains an "*" as the fifth character. Weighing the similarities and differences, in particular the fact that the letter combination "xk" is very unusual in English, I consider there to be a medium degree of visual similarity between the competing trade marks.

21. In relation to the aural comparison, the opponent states:

"15. Aurally, the earlier trade mark will be verbalised as its letters are written: JAKES. The asterisk will no more be pronounced than would an apostrophe be and it plays no role in the pronunciation of the sign."

22. I agree with the opponent's assessment in this regard.

23. In relation to the applicant's trade mark, the opponent states:

"16. The opposed mark will inevitably be verbalised as JACKS. The letter combination XK does not form a sound which can be pronounced in the English language. As they appear in the middle of a word, the consumer will not pronounce the combination as "ex-kay", as it would if they appeared by themselves. Instead they will be amalgamated into the word, with JACKS the natural and obvious pronunciation."

24. In its submissions, the applicant states that its mark will be pronounced as:

"4...Jax-s. The "k" in the applicant's mark is silent and will not be pronounced."

25. As both parties' trade mark consist of one syllable words and as both parties appear to agree that the applicant's trade mark will be pronounced as JACKS/Jax-s, I agree with the opponent that there is a medium degree of aural similarity between them.

26. Finally, in relation to conceptual similarity, the opponent states:

"19. The earlier trade mark comprises the very well-known boy's name Jake, in the plural or possessive.

20. The opposed mark is a contrived word but...is most likely to be perceived and verbalised as Jacks also a well-known boy's name pluralised.

21. The respective signs therefore share a medium level of conceptual similarity. The level of similarity may even be higher, since both Jack and Jake arguably derive from the same name Jacob. The opponent accepts, however, that such a conclusion may not form part of the thought process of the average consumer.

22. If a strict conceptual comparison is made (ignoring the effects of the aural comparison) then the opposed mark is purely a contrived word, with no meaning to the average consumer.

23. On that analysis, there is no conceptual comparison to be made between the signs...visual and phonetic similarities will only be counteracted by conceptual ones if "at least one of the marks [has] a clear and specific meaning, so that the public is capable of grasping it immediately."

27. In its submissions, the applicant states:

"4...The applicant's mark is an invented word and is highly distinctive. It has no meaning. Jake on the other is commonly understood to be a boy's first name and would be interpreted by the average consumer as that. Conceptually, the marks are completely different."

28. Considered firstly from the perspective of what the opponent describes as a "strict conceptual comparison", the parties agree that the applicant's trade mark has no meaning whereas the opponent's trade mark consists of a well-known male forename pluralised. In those circumstances, the opponent's trade mark would send a concrete conceptual message to the average consumer whereas the applicant's trade mark would send none. However, if on seeing the applicant's trade mark the average consumer (for whom it may not be necessary, given the predominantly visual selection process, to even consider how the applicant's trade mark should be verbalised) nonetheless construes it as the word JACKS, then I accept the competing trade marks MAY be conceptually similar to the limited extent that they both evoke the concept of a male forename, albeit quite different male forenames.

Distinctive character of the earlier trade mark

29. 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. As I mentioned earlier, the opponent provided evidence to comply with the applicant's request for it to prove use of its earlier trade mark. In its submissions, the opponent states:

“35. Jake's has no inherent concept or link to any of the goods for which the earlier trade mark is registered. It is neither descriptive nor non-distinctive and should, therefore, be considered a trade mark with at least a normal level of distinctiveness.”

30. At no point does the opponent make any claim that the distinctive character of its earlier trade mark has been enhanced by virtue of the use made of it. Given that the opponent's evidence discloses no use of its earlier trade mark in the United Kingdom, that is, in my view, a sensible position for it to adopt. Insofar as the inherent distinctive character of the opponent's trade mark is concerned, I agree that it is neither descriptive of nor non-distinctive for goods in class 25. However, as a very well-known male forename it is, absent use, possessed of no more than a normal level of inherent distinctive character.

Likelihood of confusion

31. 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 opponent's 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. Having indicated that I intend to proceed on the basis that the competing goods are identical, I have concluded that:

- The average consumer is a member of the general public who will pay an average degree of attention during the selection process; a process which is likely to be dominated by visual considerations, although not to the extent that aural considerations can be ignored;

- The competing trade marks are visually and aurally similar to a medium degree;
- Insofar as conceptual similarity is concerned, the high point of the opponent's case is that both trade marks will evoke the concept of a male forename;
- The opponent's trade mark is possessed of no more than a normal level of inherent distinctive character.

32. In *The Picasso Estate v OHIM*, Case C-361/04 P, the CJEU found that:

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

33. In reaching a conclusion, I am also mindful of the comments of the GC in *Nokia Oyj v OHIM*, Case T-460/07, in which it stated:

“Furthermore, it must be recalled that, in this case, although there is a real conceptual difference between the signs, it cannot be regarded as making it possible to neutralise the visual and aural similarities previously established (see, to that effect, Case C-16/06 P *Éditions Albert René* [2008] ECR I-0000, paragraph 98).”

34. I begin by reminding myself that the opponent agrees that the selection process for the identical goods at issue is primarily visual. That being the case, I see no reason why the average consumer encountering the applicant's trade mark and who will acquire the goods at issue predominantly by self-selection would pause to consider how it would be verbalised. Much more likely, in my view, is that it would simply be treated as an invented word with no meaning. In those circumstances, the very clear conceptual message sent by the opponent's trade mark is likely to fix itself in the average consumer's mind and in so doing will assist the average consumer's recall, thus making them less prone to the effects of imperfect recollection. The clear conceptual message sent by the opponent's trade mark is, in my view, more than sufficient to neutralise the medium degree of visual and aural similarity between the competing trade marks. However, even if the opponent is correct and the average consumer perceives the applicant's trade mark as the word Jacks, the mere fact that both trade marks convey the concept of a male forename, given that Jake and Jack are both very well-known and different male forenames, is still insufficient to create a likelihood of either direct or indirect confusion. By parity of reasoning, the same conclusion would apply to the position if the goods were to be selected by oral means.

35. Although I have reached the above conclusions in the context of, inter alia, an average consumer who will pay an average degree of attention during the selection process, I should make it clear, for the avoidance of doubt, that I would have reached the same conclusions even if I had characterised the degree of attention paid as low and the degree of visual and aural similarity between the competing trade marks as high.

Conclusion

36. The opposition has failed, and subject to any successful appeal, the application will proceed to registration.

Costs

37. As the applicant has been successful it is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice 4 of 2007. Using that TPN as a guide, I award costs to the applicant on the following basis

Preparing a statement and considering the other side's statement:	£200
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Written submissions:	£200
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Total:	£400
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38. I order Peek & Cloppenburg KG to pay to Jaxks Ltd the sum of **£400**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 8th day of February 2016

C J BOWEN
For the Registrar
The Comptroller-General