

**O-239-16**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION NO 3 095 493 BY RAHIM &  
SONS LTD TO REGISTER THE TRADE MARK 365 IN CLASS 25**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER NO 404 520 BY COCONA  
INC**

## Background and pleadings

1. Rahim & Sons Ltd (the applicant) applied to register the trade mark 365 under the number 3 095 493 in the UK on 20 February 2015. It was accepted and published in the Trade Marks Journal on 13 March 2015 in respect of the following goods in Class 25:

Clothing; headwear; footwear; outer clothing; under clothing; aprons being clothing; tabards; workwear; high visibility clothing; reflective clothing; luminous clothing; jackets, polo shirts, vests and bodywarmers with reflective, high visibility or luminous elements; clothing having reflective, high visibility or luminous elements; nurses trousers; nurses dresses; nurses jackets; nurses tunics; fleece jackets; fleece jackets with zips; full zip fleece jackets; half zip fleece jackets; quarter zip fleece jackets; caps; shirts; shorts; trousers; school uniforms; clothing for children; polo shirts; sweatshirts; T-shirts; waterproof and water resistant outer garments; waterproof and water resistant outer clothes; long sleeved T-shirts, short sleeved T-shirts, T-shirts with graphics printed on them; men's T-shirts, women's T-shirts, children's T-shirts, T-shirts for babies; sports clothing; knitwear being clothing; clothing of cotton, silk, linen, wool; clothing made from man-made fibres; socks, stockings and hosiery; mittens; pullovers; scarves; ski hats; sports jerseys; swimwear; gilets, overcoats, coats, jerseys, jumpers, tops, sweaters, cardigans, pullovers, ponchos, corsetry, scarves, shawls, mufflers, pashminas, wraparounds, wraps, gloves, socks, swimming costumes, one piece swimming costumes, bikini swimming costumes, tankinis, tops, thongs, pants, bras, bodyshapers, beachwear, sarongs, leisure wear, blouses, dresses; jeans, denim jackets, denim trousers, neckties, bow ties, ties, lounge suits, waist coats; articles of lingerie; articles of underwear, pyjamas, night wear, dressing gowns, bath robes; beach robes, articles of beachwear, beach clothing, beach dresses, beach shorts, beach wraps; rain coats; sou'westers; cagoules; sportswear, boxer's shorts and vests, sports bras, sports panties, sports briefs, and jockstraps, sports pants; sports shorts, sports T-shirts, sports crop-tops, sports vests; trackpants, track suits, jogging suits, warm-up suits, running shorts, running vests, running tops, running pants; bicycling shorts; soccer shirts, soccer shorts, soccer socks; football strips; football kits; football shirts, football boots, studs for football boots; football boots for use on synthetic turf surfaces, football shorts and football socks, rugby shirts, rugby shorts and rugby socks, hooded tops; swimming suits being wetsuits, wet suits for surface water-sports, wetsuits for surfing; wet suits for water-skiing; wet suits for windsurfing; dry suits; headgear, hats, woolly hats, bobble hats, ski hats, baseball caps, cricket hats, sunhats, sun-visors, swimming caps; boxer shorts; camisoles; caps being headwear; hats; headgear for wear; jackets; footwear uppers, heel pieces and tips for footwear; studs, spikes and metal fittings for footwear; welts for boots and shoes; heels for boots and shoes; tips for foot-wear; soles, inner soles, non-slipping devices for footwear; protective and safety footwear other than for protection against injury or accident; waterproof and

water resistant clothing, headwear, footwear; slippers; bath sandals and bath slippers; dance shoes; ladies shoes; leather shoes; high heeled shoes; shoes with stiletto heels; ladies shoes with heels; dancewear including footwear; beachwear including footwear; shoes, boots, trainers, flip-flops, sandals mules, slip on shoes; slip on boots; moccasin; loafers; deck shoes; plimsolls; Wellington boots, beach shoes, shoes for windsurfing and water sports; parts and fittings for all the aforesaid goods; Ankle socks; Anti-perspirant socks; Japanese style socks (tabi covers); Men's socks; Socks and stockings; Woollen socks; Japanese style socks (tabi); Bed socks; Inner socks for footwear; Sports socks; Tennis socks; Jackets and socks; Socks; Bermuda shorts; Boxer shorts; Fleece shorts; Rugby shorts; Shorts; Sweat shorts; Panties, shorts and briefs; Cycling shorts; Gym shorts; Shorts [clothing]; Tennis shorts; Trousers shorts; Boxer briefs; Bib shorts; Gloves; Gloves including those made of skin, hide or fur; Gloves for cyclists; Riding gloves; Gloves as clothing; Gloves for apparel; Knitted gloves; Motorcycle gloves; Gloves [clothing]; Ski gloves; Knitted underwear; Ladies' underwear; Women's underwear; Jockstraps [underwear]; Thermal underwear; Sweat-absorbent underclothing [underwear]; Underwear (Anti-sweat - ); Underwear; Sweat-absorbent underwear.

2. Cocona Inc (the opponent) oppose the trade mark on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (the Act). This is on the basis of its earlier International trade mark (designating the EU) No 117 4805 : 37.5. The following goods are relied upon in this opposition:

**Class 24**

Jeans fabric; knitted fabric; nylon fabric; polyester fabric; textile fabric for home and commercial interiors; textile fabrics for lingerie; textile fabric for the manufacture of clothing.

**Class 25**

Footwear; foundation garments; pants; short-sleeved or long-sleeved t-shirts; sweat pants; t-shirts; under garments; sports shirts; polo shirts; pullovers; dress shirts.

3. The opponent argues that the respective goods are identical or similar and that the marks are similar with only one number difference.
4. The applicant filed a counterstatement denying the claims made.
5. Both sides filed evidence. This will be summarised to the extent that it is considered appropriate.
6. A Hearing took place on Wednesday 23 March 2016, with the opponent represented by Jeffrey Parker, for Jeffrey Parker & Company and the applicant by Lee Curtis of HGF Limited.

## **Evidence**

### **The Opponent's Evidence**

7. This is a witness statement from Jeffrey Parker, a Trade Mark attorney representing the opponent in these proceedings. He introduces a number of exhibits all illustrating how the earlier trade mark is presented and/or marketed to the consumer. It is noted that the earlier trade mark always appears as 37.5 with much being made of the fact the products sold under the trade mark enables the wearer to maintain a comfortable body temperature. The remainder of the statement is comprised of submissions which will not be summarised here, but have been fully taken into account.

### **The applicant's evidence**

8. This is a witness statement from Ms Rachel Cockin, a Trainee Trade Mark Attorney with HGF Limited, the representative of the applicant in these proceedings. Ms Cockin introduces a number of exhibits which, according to her, confirm that 365 will be widely understood as referring to the number of days in a typical calendar year. There are also two exhibits from Wikipedia and the results of a Google search engine search which indicates that 37.5 is a normal body temperature for a human.

## **DECISION**

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

Sections 5(2)(b) of the Act is 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, or there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

### **Comparison of goods**

9. Some of the contested goods, i.e. clothing are identical to the goods on which the opposition is based (which are specific items of clothing). For reasons of procedural economy, the Tribunal will not undertake a full comparison of the goods listed above. The examination of the opposition will proceed on the basis that the contested goods are identical to those covered by the earlier trade mark. If the opposition fails, even where the goods are identical, it follows that the opposition will also fail where the goods are only similar.

## Comparison of marks

10. 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.”

11. 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.

12. The respective trade marks are shown below:

37.5	365
Earlier trade mark	Contested trade mark

13. Visually, each of the marks are comprised of a combination of numbers, differing in respect of the middle number: 7 in the earlier trade mark and 6 in the later trade mark. The earlier trade mark also contains a full stop after the second letter which has a visual impact. They are visually similar to a low degree. In reaching this view, I bear in mind the guidance of the General Court decision in *Inter-Ikea Systems BV v OHIM*, where the court said:

“54 As regards the visual comparison between the verbal element of the contested mark and the earlier word marks, the applicant claims that the only difference between them is the presence of the letter “d” in the contested mark and the letter “k” in the earlier word marks. However, the Court has

already held in Case T-185/02 *Ruiz –Picasso and Others v OHIM – DaimlerChrysler (PICARO)* [2004] ECR II-1739, paragraph 54 that, in the case of word marks which are relatively short, even if two marks differ by no more than a single consonant, it cannot be found that there is a high degree of visual similarity between them.

55 Accordingly, the degree of visual similarity of the earlier word marks and the verbal element of the contested mark must be described as low.”

14. Aurally, the earlier trade mark is most likely to be articulated as “thirty seven point five” and the later trade mark as “three hundred and sixty five”. It is accepted that the later mark may also be “three six five”. In either scenario there is significant aural difference between them and so the overall degree of similarity is considered to be low.
15. Conceptually, the earlier trade mark may be understood as referring to an ideal body temperature, though how widespread this understanding would be amongst the general public is uncertain. It is considered that the later trade mark is overwhelmingly likely to be understood as referring to the number of days in a calendar year. Indeed it is considered highly unlikely that this would not be immediately understood. So if both are seen as having their own meanings as already described, there is a clear conceptual difference between them and indeed the conceptual gap is at its maximum impact. If only the later trade mark is seen as having a meaning, this is immediately clear and the effect of this would be a conceptual gap between the signs.

## **Average consumer and the purchasing act**

16. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.
17. 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.”

18. In relation to general items of clothing, the case law<sup>1</sup> informs me that it is the visual impression of the marks that is the most important bearing in mind the manner in which such goods will normally be purchased. This would normally be from a clothes rail, a catalogue or a web site rather than by oral request. The average consumer will be the public at large, who in my view will display a medium degree of attention during the purchasing process and is said to be reasonably well informed and reasonably observant and circumspect.

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

19. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

20. There has been no claim that the earlier trade mark enjoys an enhanced degree of protection as a result of the use made of it. Its degree of distinctiveness must therefore be assessed on a prima facie basis. It is possible that for at least a proportion of the relevant public, the earlier trade mark conveys that the clothing provided under the trade mark utilises particular fabrics and/or technology to ensure that the clothing is comfortable to wear and maintains a steady body temperature by ensuring the wearer does not become too hot or indeed too cold whilst wearing the items. This is clearly meaningful and so the distinctive character can be regarded as being relatively weaker than average for those consumers who understand the

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<sup>1</sup> <sup>2</sup> See, for example, *Société provençale d'achat and de gestion (SPAG) SA v OHIM* Case T-57/03 and *React Trade Mark* [2000] RPC 285.

message being conveyed. For those who do not understand, the earlier trade mark will have no immediate meaning and so is averagely distinctive.

## **GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.**

21. 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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

22. In *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03, the General Court stated that:

“49. However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (*BUDMEN*, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumer choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs.”

And

“50..... 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.”

23. In *Quelle AG v OHIM*, Case T-88/05, the General Court found that visual similarity (and difference) is most important in the case of goods that are self-selected or where the consumer sees the mark when purchasing the goods. The Court stated that:

“68..... If the goods covered by the marks in question are usually sold in self-service stores where consumers choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any phonetic similarity between the signs (*NLSPORT*, *NLJEANS*, *NLACTIVE* and *NLCollection*, paragraph 53 supra, paragraph 49).

69. Likewise, the degree of phonetic similarity between two marks is of less importance in the case of goods which are marketed in such a way that, when making a purchase, the relevant public usually perceives visually the mark designating those goods (*BASS*, paragraph 56 supra, paragraph 55, and Case T-301/03 *Canali Ireland v OHIM – Canal Jean (CANAL JEAN CO. NEW YORK)* [2005] ECR II-2479, paragraph 55). That is the case with respect to the goods at issue here. Although the applicant states that it is a mail order company, it does not submit that its goods are sold outside normal distribution channels for clothing and shoes (shops) or without a visual assessment of them by the relevant consumer. Moreover, while oral communication in respect of the product and the trade mark is not excluded, the choice of an item of clothing or a pair of shoes 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 (*NLSPORT*, *NLJEANS*, *NLACTIVE* and *NLCollection*, paragraph 53 supra, paragraph 50). The same is true of catalogue selling, which involves as much as does shop selling a visual assessment of the item purchased by the consumer, whether clothing or shoes, and does not generally allow him to obtain the help of a sales assistant. Where a sales discussion by telephone is possible, it takes place usually only after the consumer has consulted the catalogue and seen the goods. The fact that those products may, in some circumstances, be the subject of discussion between consumers is therefore irrelevant, since, at the time of purchase, the goods in question and, therefore, the marks which are affixed to them are visually perceived by consumers.”

24. It is accepted that the visual comparison therefore has more relevant weight in respect of such goods. However that does not mean that the aural and conceptual comparison can be ignored. Indeed, all have an impact. In any case, it has already been found that the degree of visual similarity is low.

Likewise is the degree of aural similarity. It is true that the goods are identical and so the interdependency principle is in full effect. Further, for at least some consumers, the earlier trade mark is of average distinctiveness. However, there is a clear conceptual difference here. The impact of this difference is at its most powerful when both 37.5 and 365 are understood by the relevant public, who is the public at large. However, even if 37.5 is not immediately understood, the impact of 365 and its meaning remains significant. It is also true that the relevant consumer will pay a medium degree of attention during the purchasing process which negates against the impact of imperfect recollection. All of these factors leads me to the conclusion that even in respect of identical goods, consumers will not mistake one trade mark for the other.

24. However this is not the end of the matter as the aforesaid only considers the issue of direct confusion. As regards indirect confusion, I bear in mind the following:

25. 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).”

26. It is true that each of the marks contain the numbers 3 and 5. However, in the context of the particular numerical combinations, their meanings are quite different. Further, there is no evident numerical pattern, such as for example: 364 or 366 or 37.6 or 38.5. The result being that there is no true common element which has the effect of a consumer viewing the later mark as a brand extension of the earlier mark. It is considered highly unlikely that any indirect confusion would occur.

27. The opposition therefore fails in its entirety.

## **COSTS**

28. The applicant has been successful and is entitled to a contribution towards its costs. In the circumstances I award the applicant the sum of £1450 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Considering notice of opposition - £200

Preparing and filing evidence and considering evidence - £750

Preparation for and attendance at a Hearing - £500

29. I therefore order Cocona Inc. to pay Rahim & Sons Ltd the sum of £1450. The above sum should 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 16th day of May 2016**

**Louise White  
For the Registrar,  
The Comptroller-General**