

O-285-16

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3130544 BY
DANNI FREEK**

TO REGISTER:

DRTY

AS A TRADE MARK

IN CLASS 25

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 60000375 BY
SHERIDAN HENRY**

BACKGROUND & PLEADINGS

1. On 8 October 2015, Danni Freek (“the applicant”) applied to register the trade mark **DRTY** for the following goods in class 25:

Articles of clothing; footwear; boots; shoes; slippers; sandals; trainers; socks and hosiery; headgear; hats; caps; berets; scarves; gloves; mittens; belts (being articles of clothing); shirts; blouses; casual shirts; T-shirts; vests; camisoles; bodysuits; polo shirts; sports shirts; football and rugby shirts; trousers; jeans; shorts; sports shorts; swimwear; underwear; lingerie; tracksuits; articles of outerwear; coats; jackets; ski jackets; casual jackets; waterproof and weatherproof jackets and coats; parkas; body warmers; ski wear; suits; dresses; skirts; culottes; jumpsuits; playsuits; sweatshirts; jumpers; shrugs and cardigans; knitwear; leggings; neckties; pyjamas; waistcoats; headbands and wristbands; legwarmers; menswear; womenswear; childrenswear.

The application was published for opposition purposes on 23 October 2015.

2. The application is opposed in full by Sheridan Henry (“the opponent”) under the fast track opposition procedure. The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The trade mark and goods relied upon are shown below:

United Kingdom trade mark no. 2580640 for the trade mark:



which was applied for on 9 May 2011 and which was entered in the register on 9 September 2011:

Class 25 – Clothing, footwear, headgear.

3. In his Notice of Opposition, the opponent stated:

“The likelihood of there being confusion is quite high, as to begin with the name DIRTY – DRTY when pronounced sound identical and grammatically the only difference is the “I”...”

4. The applicant filed a counterstatement in which the basis of the opposition is denied.

5. Rule 6 of the Trade Marks (Fast Track Opposition)(Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

6. The net effect of these changes is to require parties to seek leave in order to file evidence in fast track oppositions. No leave was sought in respect of these proceedings.

7. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise written arguments will be taken. A hearing was neither requested nor considered necessary; the opponent filed written submissions which I will refer to, as necessary, below.

DECISION

8. 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.”

9. 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.”

10. The trade mark upon which the opponent relies qualifies as an earlier trade mark under the above provisions. As this earlier trade mark is not subject to proof of use, the opponent is entitled to rely upon all of the goods he has identified.

Section 5(2)(b) – case law

11. 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

12. The competing goods are as follows:

Opponent's goods	Applicant's goods
<p>Class 25 – Clothing, footwear, headgear.</p>	<p>Class 25 - Articles of clothing; footwear; boots; shoes; slippers; sandals; trainers; socks and hosiery; headgear; hats; caps; berets; scarves; gloves; mittens; belts (being articles of clothing); shirts; blouses; casual shirts; T-shirts; vests; camisoles; bodysuits; polo shirts; sports shirts; football and rugby shirts; trousers; jeans; shorts; sports shorts; swimwear; underwear; lingerie; tracksuits; articles of outerwear; coats; jackets; ski jackets; casual jackets; waterproof and weatherproof jackets and coats; parkas; body warmers; ski wear; suits; dresses; skirts; culottes; jumpsuits; playsuits; sweatshirts; jumpers; shrugs and cardigans; knitwear; leggings; neckties; pyjamas; waistcoats; headbands and wristbands; legwarmers; menswear; womenswear; childrenswear.</p>

13. In its counterstatement, the applicant admits that “the goods in question are similar or identical”. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) stated that:

“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 trade mark application (Case T-388/00 Institut fur Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

14. As all of the applicant's goods would, at the very least, be encompassed by the terms “clothing, footwear, headgear” which comprise the opponent's specification, the competing goods are to be regarded as identical on the principle outlined in *Meric*.

The average consumer and the nature of the purchasing act

15. As the case law above indicates, it is necessary for me to determine who the average consumer is for the goods at issue; 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.”

16. 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 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.”


17. 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 (for example, when orders are placed by telephone or during interactions with sales assistants). 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 is, also in my experience, likely to increase as the cost and importance of the item increases.

Comparison of trade marks

18. 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.”

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

Opponent's trade mark	Applicant's trade mark
	DRTY

20. The opponent's trade mark consists of the well-known English language word “DIRTY” presented in white in upper case against a black, substantially rectangular background, in which a part of the bottom right-hand corner is missing. Below this there appears in much smaller white upper case letters the word “CLOTHING” presented against a red rectangular background. As the word “CLOTHING” is purely descriptive and as the black and red rectangles merely serve as backgrounds, these elements have little distinctive character and will, as a consequence, have little weight in the overall impression the opponent's trade mark conveys. Rather it is the word “DIRTY” which is the distinctive component of the opponent's trade mark, and it is this word that will dominate the overall impression the trade mark conveys.

21. The applicant's trade mark consists exclusively of the letters “DRTY” presented in upper case. As no part of this trade mark is highlighted or emphasised in any way, its distinctiveness and overall impression stems from these letters which, in my view, are highly suggestive of the word “DIRTY”.

22. Before I go on to consider the competing trade marks from the visual, aural and conceptual perspectives, I should say a little more about the colours in which the opponent's trade mark is presented. In short, as notional and fair use of the applicant's trade mark would include use in exactly the same colours as those in the

opponent's trade mark, for example, white on a black background, the fact that the opponent's trade mark is shown in colour is not a factor that assists the applicant in these proceedings.

Visual comparison

23. In its submissions, the applicant states:

“On a visual comparison, the only common element shared by the respective signs is the letters D, R, T, Y...As such, there is no, or at best very low, visual similarity between the marks.”

24. I have already concluded that the dominant and distinctive element of the opponent's trade mark is the word “DIRTY”. Bearing that conclusion in mind, but not forgetting the presence of the other elements present in the trade mark, results in a relatively high (but not the highest) degree of visual similarity between them.

Aural comparison

25. In its submissions, the applicant states:

“On an aural comparison, there is nothing in the presentation of the mark to suggest that the registration should be announced anything other than its ordinary English expression DIRTY CLOTHING. However, the application in suit has a missing vowel and therefore the average consumer has the choice to pronounce the mark as each consonant D-R-T-Y or pronounce the word without the vowel which results in an emphasis being placed on the R. As such, there is only medium to low similarity between the marks on an aural basis.”

26. I think it most unlikely that the average consumer will pronounce the applicant's trade mark as letters i.e. D-R-T-Y. Much more likely, in my view, is that the degree of visual similarity between the well-known word “DIRTY” and the applicant's trade mark will, notwithstanding the missing letter “I”, prompt the average consumer to pronounce the applicant's trade mark as “DIRTY”. Considered on that basis and if, as I consider it likely, the average consumer will not verbalise the word “CLOTHING” in the opponent's trade mark, the competing trade marks are aurally identical. However, even if I am wrong in that conclusion and the average consumer does verbalise the word “CLOTHING”, as the word “DIRTY” (which I have concluded is the dominant and distinctive component of the trade mark) would be verbalised first, the competing trade marks would still be aurally similar to a high degree.

Conceptual comparison

27. In its submissions, the applicant states:

“With regard to conceptual similarities, both marks rely on a play of words in relation to soiled or dirty clothing, nevertheless the deliberate misspelling of the application is a distinctive and striking difference which is the dominant characteristic of the mark. Given the heavy stylisation of the registration, the

colours used, and the arrangement of the words, there is low conceptual similarity between the marks.”

28. The fact that the applicant submits that “both marks rely on a play of words in relation to soiled or dirty clothing...” can only be interpreted as an admission that its trade mark will (as I concluded earlier) be construed as the word “DIRTY”. As the word “CLOTHING” in the opponent’s trade mark does nothing to modify the meaning conveyed by the word “DIRTY”, the competing trade marks are, in my view, conceptually identical.

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.

30. These are fast track opposition proceedings in which it was not necessary for the opponent to provide evidence of the use he may have made of his earlier trade mark. Notwithstanding the manner in which the opponent’s trade mark is configured and the colours in which it is presented, it is the word “DIRTY” that will be perceived by the average consumer as the distinctive and dominant element. Although the meaning of this word will be well-known, there is no evidence or submissions to suggest that in relation to the goods at issue, it is descriptive, non-distinctive or even allusive. It is, as a consequence, possessed of an average degree 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. Earlier in this decision I concluded that:

- the competing goods are identical;
- the average consumer is a member of the general public who will select the goods by predominantly visual means and who will pay an average degree of attention during that process;
- the competing trade marks are visually similar to a relatively high degree, aurally similar to at least a high degree and conceptually identical;
- the opponent's earlier trade mark is possessed of an average degree of inherent distinctive character.

32. Notwithstanding the average degree of attention that will be paid by the average consumer during the selection process, I am satisfied that, inter alia, the identity in the goods combined with the degree of similarity in the competing trade marks I have identified, will, given the potential for imperfect recollection, result in a likelihood of direct confusion i.e. the applicant's trade mark will be mistaken for that of the opponent. For the avoidance of doubt, I would have reached the same conclusion even if I had characterised the level of distinctiveness of the earlier trade mark as low (rather than average) and the level of attention paid during the selection process as high (rather than average), both of which are, of course, factors that would weigh in the applicant's favour.

Overall conclusion

33. The opposition succeeds in full and, subject to any successful appeal, the application will be refused.

Costs

34. As the opponent has been successful, he is entitled to a contribution towards his costs. Awards of costs in fast track opposition proceedings filed after 1 October 2015 are governed by Tribunal Practice Notice ("TPN") 2 of 2015. Using that TPN as a guide but bearing in mind that the opponent has not been professionally represented, I award costs to him on the following basis:

Official fee:	£100
Preparing a statement and considering the applicant's statement:	£100
Written submissions:	£50
Total:	£250

35. I order Danni Freek to pay to Sheridan Henry the sum of **£250**. 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 13th day of June 2016

C J BOWEN
For the Registrar