

O-509-16

**TRADE MARKS ACT 1994
IN THE MATTER OF
APPLICATION NO 3108129
BY PRINCE MACLEAN ET AL
TO REGISTER THE TRADE MARK**

DICHINO

IN CLASS 25

AND

OPPOSITION THERETO (UNDER NO. 404997)

BY

MICHAEL KÜHN

BACKGROUND

1) On 12 May 2015, Prince Maclean, Diev Songolo, Daniel Allan Alarcon, Paul Maclean-Aidoo and Richard Boateng, ('the applicants') applied to register the word **DICHINO** as a trade mark for Clothing, footwear, headgear; Casual clothing; Bodywarmers [clothing] in class 25.

2) The application was published on 05 June 2015 in the Trade Marks Journal and notice of opposition was subsequently filed by Michael Kühn ('the opponent').

3) The opponent claims that the application offends under Section 5(2)(b) of the Trade Marks Act 1994 ('the Act'). It relies upon the European Union Trade Mark ('EUTM') shown in the table below:

EUTM details	Goods relied upon
<p>EUTM No: 10255801</p> <p>SHINO</p> <p>Filing date: 25 August 2011</p> <p>Date of entry in the register: 21 December 2011</p>	<p>Class 25: Clothing, included in class 25.</p>

4) The opponent's trade mark is an earlier mark, in accordance with section 6 of the Act and, as it had not been registered for five years or more before the publication date of the applicants mark, it is not subject to the proof of use requirements, as per as per section 6A of the Act.

5) The applicants filed a comprehensive counterstatement explaining why, in its view, there is no likelihood of confusion.

6) Both parties filed written submissions during the evidential rounds; only the applicants filed evidence. Neither party requested to be heard. Only the opponent filed written submissions in lieu. I now make this decision on the basis of the papers before me.

7) Rather than summarise the applicants' evidence here, I will refer to it, when it is appropriate to do so, in the decision which follows.

DECISION

8) Section 5(2)(b) of the Act states:

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

(a)

(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) The leading authorities which guide me are from the Court of Justice of the European Union ('CJEU'): *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

10) The relevant goods are set out in the following table:

Opponent's goods	Applicants' goods
Class 25: Clothing, included in class 25.	Class 25: Clothing, footwear, headgear; Casual clothing; Bodywarmers [clothing].

11) The applicants submit that the respective goods are neither identical nor similar for the following reasons:

- i) goods may not be regarded as identical or similar merely because they fall within the same class; and
- ii) the applicants have filed evidence showing the nature, users, trade channels etc. of its goods but the opponent has not and so it is not possible to compare the parties' goods.

As regards point i), the applicants are, of course, correct to say that goods cannot be deemed to be identical or similar merely because they fall within the same class. The opponent does not, in any event, claim identity on that basis. The opponent claims identity between the respective goods (at least insofar as the applicants' 'clothing', 'casual clothing' and 'body warmers' are concerned) on the basis that the applicants' goods are also clothing or "sub-species" of clothing. Alternatively, it claims similarity,

(insofar as 'footwear; headgear' are concerned) on the basis that the respective goods are similar in nature and purpose and will be sold through the same trade channels.

12) Turning to point ii), as I stated earlier, the earlier mark is not subject to the proof of use provisions. The consequence of this is that the opponent is entitled to rely upon the full breadth of its specification, as registered. Furthermore, I am required to assess the matter on the basis of normal and fair use of the respective trade marks. That is to say, it is simply a question of looking at the respective terms within the parties' specifications, exactly as they appear before me, and deciding from a notional and objective perspective whether they are identical or similar. The reason for this approach is that marketing strategies are temporal and may change with the passage of time. Further, as a trade mark registration is a form of property, it could potentially be sold to a third party at some point in the future who may use it in a different way to that of the current applicants. In *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P, the CJEU stated:

“59. As regards the fact that the particular circumstances in which the goods in question were marketed were not taken into account, the Court of First Instance was fully entitled to hold that, since these may vary in time and depending on the wishes of the proprietors of the opposing marks, it is inappropriate to take those circumstances into account in the prospective analysis of the likelihood of confusion between those marks.”

13) It follows that the applicants' 'clothing' is, from a notional and objective standpoint, identical to the opponent's 'clothing'.

14) The applicants' 'casual clothing; bodywarmers [clothing]' are also identical to the opponent's 'clothing' given that the former goods fall within the scope of the latter as per the decision of the General Court ('GC') in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05 ('*Meric*'), where it 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 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”.

15) Insofar as the applicants’ ‘footwear; headgear’ are concerned, I bear in mind that the leading authorities as regards determining similarity between goods and services are considered to be *British Sugar Plc v James Robertson & Sons Ltd* (‘*Treat*’) [1996] R.P.C. 281 and *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117 (‘*Canon*’). In the latter case, the CJEU accepted that all relevant factors should be taken into account including the nature of the goods/services, their intended purpose, their method of use and whether they are in competition with each other or are complementary. The criteria identified in the *Treat* case were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) 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;
- (f) The extent to which the respective goods or services are competitive.

16) Further, in *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criteria capable of being the sole basis for the existence of similarity between goods and in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the 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”.

17) I also note that in *Giordano Enterprises Ltd v OHIM* (case T-483/08) the GC stated:

“20 As regards the goods in Class 25 for which the applicant seeks registration of its trade mark, it challenges the Board of Appeal’s finding that ‘clothing’ and ‘headgear’ are similar to ‘footwear’ for which the earlier trade mark is registered. As the Court has held in previous cases, in view of the sufficiently close links between the respective purposes of ‘clothing’ and ‘footwear’, which are identifiable in particular by the fact that they belong to the same class, and the specific possibility that they can be produced by the same operators or sold together, it may be concluded that those goods may be linked in the mind of the relevant public (Case T-115/02 *AVEX v OHIM – Ahlers (a)* [2004] ECR II-2907, paragraphs 26 and 27; see also judgment of 10 September 2008 in Case T-96/06 *Tsakiris-Malla v OHIM – Late Editions(exé)*, not published in the ECR, paragraphs 29 and 30, and judgment of 8 March 2005 Case T-32/03 *Leder & Schuh v OHIM – Schuhpark Fascies(Jello Schuhpark)*, not published in the ECR, paragraph 50). That reasoning may be applied by analogy to ‘headgear’ and ‘footwear’ since ‘headgear’ also has the same basic nature and purpose as ‘footwear’, albeit in respect of a different part of the human body.”

18) The applicants’ ‘footwear; headgear’ will coincide with the opponent’s ‘clothing’ in terms of users and trade channels. The respective nature, intended purpose and method of use is also very similar as the goods may be made of the same or similar materials and will be worn on the person. There may also be a degree of complementarity given that the respective goods may be coordinated as part of an outfit or overall ‘look’. I find there to be a good degree of similarity between the applicants’ ‘footwear; headgear’ and the opponent’s ‘clothing’.

Average consumer and the purchasing process

19) It is necessary to determine who the average consumer is for the respective goods and the manner in which they are likely to be selected. 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.”

20) For similar reasons to those given in paragraph 12 above, the applicants’ evidence as to the “typical” purchaser of its goods does not assist it and the lack of evidence from the opponent on this point is not detrimental to its position. Notionally speaking, the average consumer of the parties’ goods is the same i.e. the general public. 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 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.

...

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

As stated by the GC, items of clothing will vary greatly in price. The same applies to footwear and headgear. Generally speaking, I would expect a normal level of attention to be paid by the consumer when selecting such goods. The purchasing act will be mainly visual on account of the goods being commonly purchased based on their aesthetic appeal; they are likely to be selected after perusal of racks/shelves in retail establishments, or from photographs on Internet websites or in catalogues. However, I do not discount aural considerations which may also play a part.

Comparison of marks

21) 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 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.”

It would therefore be wrong to artificially dissect the 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 marks.

22) The marks to be compared are:

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23) The opponent's mark, consisting of the single word SHINO presented in plain block capitals, is not readily divisible into separate components; its overall impression is based solely on that word.

24) Turning to the applicants' mark, the opponent submits:

“...the Applicants have admitted that DI- is a recognised word prefix in the English language. Thus, a substantial proportion of the relevant purchasing public will be familiar with the concept that compound words commencing with the letters DI- are to be ascribed a meaning in which the prefix DI- qualifies the stem. Given the common nature of such prefixes, the element DI- must be regarded as possessing a relatively low distinctive weight in its own right, and attention will inevitably be drawn to the mark stem (in this case –CHINO).”

The applicants responded to this submission, as follows:

“Whilst the counterstatement accepts that “di” can be a prefix indicating doubling or division this is entirely dependent on the word to which that prefix is applied”.

In the counterstatement, the applicants had pointed out that DI- would have no meaning in a word such as “dingy”.

25) As the applicants submit, whilst DI- can be used as a prefix to indicate doubling/division, whether it is perceived as such or recognised as a separate element within a word is entirely dependent on the context in which it is used. The applicants' mark has the appearance of a single invented word. I do not consider that the average consumer will break it down into the two elements DI- and –CHINO; to do so would be to artificially dissect the mark. Rather they will instantly perceive it as a unified whole upon which the overall impression is based.

26) Visually, the opponent argues that there is a degree of similarity owing, in particular, to both marks ending in –HINO. The applicants submit that the marks have “a low to (at most) average degree of [visual] similarity”. It later describes the degree of visual similarity as “limited”. I agree with the opponent that there is clearly some degree of visual similarity owing to the presence of the letters ‘-HINO’ in both marks. However, in the applicants' mark, those letters are preceded by the letters ‘DIC-’ whereas, in the opponent's mark, they are preceded by the single letter ‘S’. As the applicants point out, the beginnings of words will tend to have the greatest impact on the consumer's perception¹. Of course, this is a general rule rather than an immutable one; each case must be assessed on its own merits. However, I consider the rule is applicable here. In the instant case, the difference in the appearance of the letters at the beginning of the marks, which are the first to hit the eye, creates a notable and striking point of visual contrast. I agree with the applicants that, when the marks are viewed as a whole, there is a limited degree of visual similarity between them.

27) I should add that in reaching the above conclusion, I have not overlooked the opponent's contention that normal and fair use may include the applicants' goods (such as the t-shirts and sweatshirts bearing DICHINO on the front shown in the applicants' evidence) being folded in such a way on a retail shelf so as to partially obscure the word DICHINO rendering it more visually similar to SHINO. Suffice to say, I am far from persuaded by this argument. Normal and fair use includes examples of how the mark, as a whole, may be presented; it does not mean taking into account parts of the mark being potentially obscured when the goods are on

¹ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02 [81] - [83],

display. Such an approach would mean that any number of otherwise visually dissimilar marks could be found to have some degree of visual similarity.

28) The opponent submits that its mark will be pronounced SHEE-NO; I agree. As regards the applicants' mark, it argues that this will be pronounced as DUH-SHEE-NO resulting in a high degree of aural similarity. I am not persuaded that the second syllable of the applicants' mark is likely to be pronounced as 'SHEE'; rather it will be pronounced as 'CHEE' (as in 'cheese') with the entire word being vocalised as DI-CHEE-NO (with 'DI' as in 'ditch') or perhaps, as the opponent argues, as DUH-CHEE-NO. The opponent further contends that if its mark were referred to as "the SHINO brand", where the 'th' is pronounced sloppily so as to sound like the letter 'd', this would sound the same as the pronunciation of "DICHINO brand". This argument does not assist the opponent. I must only take into account the actual marks before me. Those marks are SHINO and DICHINO; they are not 'the SHINO brand' and 'DICHINO brand'. I find there to be a medium degree of aural similarity between SHEE-NO and DI-CHEE-NO/DUH-CHEE-NO.

29) The parties agree that both marks will be perceived as invented words. Accordingly, there is neither conceptual similarity nor dissimilarity; the conceptual position is neutral.

Distinctive character of the earlier mark

30) The distinctive character of the earlier mark must be considered. The more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). 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)."

As the opponent has not filed any evidence of use, I can only take into account the inherent qualities of its mark. SHINO is an invented word. It neither describes nor alludes to the relevant goods in any way. I find it to be possessed of a high degree of distinctive character.

Likelihood of confusion

31) I must now feed all of my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors: i) the interdependency principle, whereby a lesser degree of similarity between the goods may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*); ii) the principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*), and; iii) the factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*).

32) The respective goods are identical or similar to a good degree and the earlier mark has a high degree of inherent distinctive character. These are important factors weighing in the opponent's favour. Further, as the conceptual position is neutral, this

means that there is no conceptual hook to assist the consumer in packing the mark away in their mind. However, weighing against these factors is my finding that the respective marks share only a limited degree of visual similarity. This latter factor is particularly important (more so than the medium degree of aural similarity) in the global assessment since the purchasing act is likely to be primarily visual². Having carefully considered all of these factors, I find that, even allowing for imperfect recollection and having due regard for the interdependency principle, the consumer is unlikely to mistake one mark for the other. There is no likelihood of direct confusion. I also cannot see any basis for concluding that the consumer is likely to believe that the respective goods emanate from the same or linked undertaking(s). There is no likelihood of indirect confusion. **The opposition fails.**

COSTS

33) As the applicants have been successful, they are entitled to a contribution towards their costs. In approaching the award, I bear in mind that the applicants' evidence was of no relevance to the matters before me; I will make no award in respect of it. Using the guidance in Tribunal Practice Notice 4/2007, I award the applicant costs on the following basis:

Preparing a statement and considering the opponent's statement	£200
Preparing written submissions	£300
Total:	£500

² In *New Look Ltd v OHIM* Joined cases T-117/03 to T-119/03 and T-171/03, the GC stated: "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."

34) I order Michael Kühn to pay Prince Maclean, Diev Songolo, Daniel Allan Alarcon, Paul Maclean-Aidoo and Richard Boateng the sum of **£500**. 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 31st day of October 2016

**Beverley Hedley
For the Registrar,
the Comptroller-General**