

O-582-16

TRADE MARKS ACT 1994

**IN THE MATTER OF THE APPLICATION BY
SLYDES SUPPLY COMPANY LTD
UNDER NO 3134996 FOR THE TRADE MARK**

SLYDESTM

AND

**IN THE MATTER OF OPPOSITION NO. 405916 THERETO BY
STYLINE STUDIOS INTERNATIONAL LIMITED**

THE BACKGROUND AND THE PLEADINGS

1) On 6 November 2015 Slydes Supply Company Ltd (“the Applicant”) filed application no. 3134996 to register the following trade mark:

SLYDES™

The goods for which registration was sought were goods in class 25, and during the course of these proceedings the Applicant revised its specification as follows:

Class 25: *Ladies' footwear; casual footwear; leisure footwear; esparto shoes; rubber shoes; beach shoes; slip-on shoes; sandals; flipflops.*

The application was published for opposition purposes on 27 November 2015.

2) On grounds under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) Styleline Studios International Limited (“the Opponent”) opposes the registration of the Applicant’s mark for all the goods for which the Applicant seeks registration.

3) For the purposes of its claims the Opponent relies on the UK trade mark no. 3104508, filed on 17 April 2015 and registered on 17 July 2015, and the European Union trade mark no. 14629943, filed on 29 September 2015 and registered on 14 January 2016. Both are registered for *footwear* in Class 25, which is relied on in these proceedings, and both consist of the following mark:

J/SLIDES

4) The significance of the above dates is that (1) both marks relied on by the Opponent constitute “earlier marks” for the purposes of section 5(2)(b) of the Act,

and (2) the proof of use provisions in section 6A of the Act do not apply in respect of either of them.

5) The Opponent claims that because of the similarity between the opposed mark and goods and those of the Opponent there exists a likelihood of confusion. The Applicant filed a notice of defence and counterstatement, denying the grounds of opposition. Neither party filed evidence. Both parties filed written submissions in the evidence rounds and the Opponent filed further written submissions in lieu of a hearing. The Applicant is represented by Brand Protect. The Opponent is represented by Sanderson & Co. Neither side requested a hearing. I therefore give this decision after a careful review of all the papers before me.

DECISION

The law

6) Section 5(2)(b) of the Act 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) I have taken into account the guidance provided by the Court of Justice of the European Union (“CJEU”) in a number of judgments. The following principles are gleaned from the decisions 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:

(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 the goods and services

8) In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

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

a) The respective users of the respective goods or services;

b) The physical nature of the goods or acts of services

- c) The respective trade channels through which the goods or services reach the market
- d) In the case of self serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- e) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

9) In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, (“*Meric*”) the General Court (“the 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 the trade mark application (Case T-388/00 *Institut für 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”.

10) The Applicant submits that the term *footwear* in the Opponent’s specifications is “overbearingly wide”, since it embraces goods which, by virtue of differing uses, users, channels of trade, and lack of competition or complementarity, are unlikely to be confused, and that an analogy can be drawn with Floyd J’s decision in *Galileo International Technology, LLC v European Union (formerly European Community)* [2011] EWHC 35. This is misconceived. The issue considered by the court in that case was the satisfactory determination of a subset of goods for which use had been proved. In the present proceedings no proof of use is required for either of the earlier marks and the Opponent is entitled to rely on the full breadth of the term *footwear*, which identifies the goods for which protection is sought with sufficient

clarity and precision to enable the competent authorities and other traders, on that basis alone, to determine the extent of the protection conferred by the registration.

11) Each of the items listed in the opposed trade mark application – namely, *ladies' footwear; casual footwear; leisure footwear; esparto shoes; rubber shoes; beach shoes; slip-on shoes; sandals; flipflops* – clearly fall within the ambit of the term *footwear* designated by the earlier marks. Accordingly, the competing goods are identical under the guidance in *Meric*.

The average consumer and the purchasing process

12) 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*. 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) In the case of footwear the average consumer will be a member of the public at large. The purchase of footwear is unlikely to be a highly considered process since it is purchased relatively frequently and, although cost can vary, it is not, generally speaking, a highly expensive purchase. That said, the goods may be tried on and are likely to be inspected for colour, size, style etc., all of which will increase the potential exposure to the trade mark. The purchasing process is, therefore, a

normal, reasonably considered one, no higher or lower than the norm. Footwear is sold through traditional retail outlets on the high street, through catalogues and on the Internet. Accordingly, the average consumer of the goods is likely to select them by predominantly visual means. It has been held by the General Court (see, for example, *New Look Ltd v OHIM* – Joined cases T-117/03 to T-119/03 and T-171/03) that the purchase of clothing is predominantly a visual act, although aural similarity should not be ignored completely. These observations also hold for footwear. Telephone orders for these goods, for example, would normally be given on the basis of visual selection from a catalogue.

The distinctiveness of the earlier marks

14) The degree of distinctiveness of the earlier marks must be assessed. This is because the more distinctive the earlier mark (on the basis either of inherent qualities or because of use made), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). 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 *WindsurfingChiemsee 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).”

15) The distinctive character of a trade mark must be assessed by reference to the goods or services in respect of which registration is sought and by reference to the way it is perceived by the relevant public (see *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91).

16) The Applicant’s counterstatement contains the following submission: *“Conceptually, “slides” describes a type of footwear. A “slide” is descriptive of an open toe sandal usually used in wet places (such as swimming pools), because such footwear is so easy to slide on and off the foot. Thus the only distinctive part of the earlier trade marks is the letter “J” and the symbol “/”.* I have never come across the word “slides” used in this sense. Judicial notice may be taken of facts that are too notorious to be the subject of serious dispute, but that is clearly not the case here. In the absence of evidence to support this contention, therefore, I am unable to accord it any weight.

17) In the absence of any evidence of use I have only the inherent distinctive character of the earlier marks to consider. Neither of the parties has suggested that the letter “J” followed by the oblique stroke in the earlier marks will be seen by the average consumer as bearing any particular meaning. The word SLIDES might, at most, have some tenuous allusiveness in relation to footwear, insofar as it might tend to evoke faintly in the minds of some consumers the idea of feet “sliding” into shoes – i.e. of footwear easily slipped on and off. However, it is not descriptive of the goods. Overall, the earlier marks have a normal degree of distinctiveness.

Comparison of the marks

18) 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 be wrong, therefore, to dissect the trade marks artificially, 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.

19) The marks to be compared are shown below:

The opposed mark	The earlier marks
<i>SLYDES</i> TM	J/SLIDES

20) The Applicant’s mark consists of the word SLYDES in a bold italic (albeit somewhat laterally compressed) font, followed at its lower right-hand corner by the very small letters “TM”, which are clearly intended to represent the TM symbol; the latter will not be seen by the average consumer as having any distinctive significance

in itself, but simply as standard way of indicating to the public that the Applicant is using the sign as a trade mark with the aim of distinguishing its products from those of other companies¹. The graphical presentation is not particularly striking or unusual; its contribution to the overall impression is limited. The opposed mark's dominant and distinctive feature consists of the word SLYDES itself.

21) In its written submissions the Applicant draws my attention to Case T-781/13 *Red Bull GmbH v Office for Harmonisation in the Internal Market*, in which the General Court noted that that “*the consumer will generally pay greater attention to the beginning of a word sign than to the end. The first part of a trade mark tends normally to have a greater visual and phonetic impact than the final part.*” This is a rule of thumb which does not hold in all cases. Each case must be considered on its merits. My assessment must take account of the overall impression created by the marks². According to the settled case law, when perceiving a word sign, a consumer will break it down into elements which, for him, suggest a concrete meaning, or which resemble words known to him³.

22) In this case, although the mark will be perceived as a whole, the oblique stroke after the initial “J” clearly assists the eye in resolving the mark into constituent elements. The positioning of the initial “J” at the beginning of the earlier marks, separated off from the rest of the mark in this way, ensures that this first part of the marks receives the attention of the consumer. However, this initial element consists of only 2 out the total of 8 characters in the marks. By virtue of the fact that it consists of a familiar word, and takes up by far the greater part of the earlier marks spatially, the word “SLIDES” will tend to impress itself strongly on the attention. Both the “J/” and the “SLIDES” elements each make a substantial contribution to the

¹ See *BioID AG v OHIM*, Case T-91/01 at paragraph 40

² *Spa Monopole, compagnie fermière de Spa SA/NV v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-438/07:

“23 Admittedly, the consumer normally attaches more importance to the first part of words (Joined Cases T-183/02 and T-184/02 *El Corte Inglés v OHIM – González Cabello and Iberia Líneas Aéreas de España (MUNDICOR)* [2004] ECR II-965, paragraph 81). However, that argument cannot hold in all cases (see judgment of 16 May 2007 in Case T-158/05 *Trek Bicycle v OHIM – Audi (ALL TREK)*, not published in the ECR, paragraph 70 and the case-law cited) and does not, in any event, cast doubt on the principle that the assessment of the similarity of marks must take account of the overall impression created by them.”

³ See *Sherwin-Williams Sweden AB v OHIM*, T-12/13, at paragraph 69, and the case law cited there.

overall impression of the earlier marks, though I consider that “SLIDES” preponderates.

23) I bear in mind that since the earlier marks are word marks, registered in block capitals, notional and fair use of them would include use in differing ordinary typefaces, including ones similar to that of the contested mark; so the typographical presentation of the opposed mark does not play an appreciable role. The earlier marks have eight characters, making them visually a little longer than the opposed mark with its six characters. The initial “J” and oblique stroke of the earlier marks are further points of difference. The remaining six letters of the earlier marks differ by only one letter from those of the opposed mark. Overall, there is a medium degree of visual similarity between the competing marks.

24) In its written submissions the Applicant suggests that the “TM” symbol in the opposed mark and the oblique stroke in the earlier marks would be pronounced when the marks are used orally. I cannot agree. I have already observed that the TM symbol will not itself be regarded by the consumer as part of the trade mark; it will not be articulated when the mark is used orally. Nor is punctuation normally pronounced when text is spoken. The obvious exception is dictation. When a web address is read out to be noted and used by the listener, for example, it is customary for oblique strokes to be indicated by the words “forward slash”. The earlier marks clearly do not represent a web address, however, nor is there any other evident reason why the oblique stroke should be articulated.

25) The initial “J”, appearing as an individual letter separated from the remaining word element of the earlier marks, will be articulated simply as the name of the letter (“JAY”). It represents a differing sound and a further syllable compared with the monosyllable of the opposed mark, and therefore contributes an element of aural difference. SLIDES in the earlier marks is a simple, common English word, which will be recognised and pronounced in the normal way. There is a strong phonetic correlation between the letters “I” and “Y”. When followed by a concluding “E” or “ES”, the preceding “I” will be pronounced as in the words “bides”, “rides”, “tides” or “chides”. This also holds true for the letter “Y”. The obvious way for an English-speaker to pronounce the “Y” in SLYDES is as in the familiar names “Clyde”, “Hyde”

or “Tyne”, or the words “tyres”, “lyres” or “bytes”. Overall, there is a medium degree of aural similarity between the competing marks.

26) Neither of the parties has suggested that the letter “J” followed by the oblique stroke in the earlier marks will be seen by the average consumer as bearing any particular meaning. SLIDES is a common English word, the meaning of which, either as a verb or as a noun, will be immediately apparent to the consumer. It describes either the action of gliding smoothly along or within a surface, or something which slides (e.g a slide rule) or which is slid upon or within (e.g. a children’s play slide). Examples of such uses can be found in the *Oxford Dictionary of English*, 3rd ed, 2015.

27) The average consumer is used to encountering misspellings of familiar words in trade marks. I have already referred to the strong phonetic correlation between the letters “I” and “Y”. I consider that many consumers will see the opposed mark as consisting of a modified version of the word SLIDES. It will certainly at least call that word to mind for most consumers. Overall, there is a medium degree of conceptual similarity between the marks.

Likelihood of confusion

28) The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

29) The competing goods are identical. I have found a medium degree of visual, aural and conceptual similarity between the competing marks. I have also found the earlier mark to have a normal degree of inherent distinctive character. Keeping in mind my findings on the average consumer and the purchasing process, I consider it on balance unlikely that the presence of the initial “J/” in the earlier marks, positioned right at the front and visually separated off from the rest of the mark by the oblique

stroke, will be overlooked by the average consumer. This being so, the competing marks will not be directly confused, even where the competing goods are identical.

30) That leaves the question of indirect confusion to be considered. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. considered the impact of the CJEU's judgment in *Bimbo*, Case C-591/12P, on the court's earlier judgment in *Medion v Thomson*. The judge said:

“18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

31) In the present case it is the earlier marks which consist of a composite mark containing an element which is similar to the mark for which registration is sought, rather than vice versa, but the same considerations are in play in determining the likelihood of indirect confusion. I have found that the purchasing process will be a normal, reasonably considered one; but I must also bear in mind that the consumer 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, leaving scope for imperfect recollection. I have pointed out that the consumer is used to seeing familiar words misspelt in trade marks, and I have noted the strong phonetic correlation between the letters “I” and “Y”. I also bear in mind the point made by Richard Arnold QC, sitting as the Appointed Person in *MOBIS* (O/020/07 – at paragraph 20), that the human eye has a tendency to see what it expects to see. I consider that, taking all this into account, together with the principle of imperfect recollection, the average consumer will be apt to confuse the preponderant SLIDES element of the earlier marks with the Applicant’s SLYDES.

32) In *Nike International Ltd v OHIM*, Case T-233/10, the General Court observed (at paragraph 57) that in the clothing and footwear sector it is not uncommon for the same mark to be configured in various ways according to the products it designates and also common for a single clothing manufacturer to use sub-brands (signs that derive from a principal mark and which share with it a common dominant element) in order to distinguish its various lines from one another. I have already noted that, although both the “J/” and the “SLIDES” elements of the earlier marks are distinctive and contribute to the overall impression of those marks, I consider that “SLIDES” preponderates by virtue of the fact that it consists of a recognisable word, and takes up by far the greater part of the earlier marks spatially. This being so, in my judgment a consumer who comes across the opposed mark, having first encountered the earlier marks used for identical goods, or vice versa, and being

liable to confuse the respective SLYDES/SLIDES elements of the competing marks, will be apt to infer that the “J/” of the earlier marks represents a sub-brand of the opposed mark, indicating a particular product line or lines of the same, or an economically related, undertaking. **There will be a likelihood of indirect confusion.**

OUTCOME

33) The opposition succeeds in its entirety.

COSTS

34) Styleline Studios International Limited has been successful and is entitled to a contribution towards its costs. I hereby order Slydes Supply Company Ltd to pay Styleline Studios International Limited the sum of £900. This sum is calculated as follows (I have taken into account that the Opponent filed written submissions in lieu of a hearing in addition to the written submissions filed in the evidence rounds):

<i>Opposition fee</i>	£100
<i>Preparing a statement and considering the other side's statement</i>	£300
<i>Written submissions</i>	£500

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 9th day of December 2016



Martin Boyle
For the Registrar,
The Comptroller-General