

O-333-17

**TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK APPLICATION NO 3156712
BY PEPPERFRUIT LIMITED
TO REGISTER**

PEPPERFRUIT

**AS A TRADE MARK
IN CLASSES 25 & 35
AND OPPOSITION THERETO (UNDER NO. 407398)
BY
FRUIT OF THE LOOM INC**

BACKGROUND AND PLEADINGS

1. Pepperfruit Limited ('the applicant') applied to register the trade mark **PEPPERFRUIT** on 26 March 2016. It was accepted and published in the Trade Mark Journal on 17 June 2016 in respect of the following goods and services:

Class 25: Clothing, footwear and headgear; belts; underwear; coats.

Class 35: Retail services connected with the sale of clothing, footwear and headgear; fashion shows.

2. Fruit of the Loom Inc ('the opponent') opposed the trade mark under Section 5(2) (b) of the Trade Marks Act 1994 ('the Act') against all of the goods and services in the application on the basis of its earlier European Trade Mark set out below:

Opponent's trade mark details	Opponent's goods and services
EU011627577 FRUIT Filing date: 5 March 2013 Registration date: 17 July 2013	Class 25: Clothing, headgear, footwear. Class 35: Retail services (including online retail services) in relation to clothing, headgear, footwear; advertising services; information and advisory services relating to the aforesaid services.

3. The applicant filed a counterstatement admitting that its class 25 goods and class 35 services are similar to the opponent's goods and services in those classes. In addition they accept both marks share a common element, i.e. FRUIT but deny any similarity between the two marks when compared as a whole.

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

5. Both parties filed written submissions. No hearing was requested so this decision is taken from consideration of the papers before me.

DECISION

6. Section 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, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

7. 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 & SERVICES

8. The applicant has conceded that the respective goods and services in classes 25 and 35 are similar. I would go further and say that some are identical given that both contain **clothing, footwear, headgear** in class 25 and **retail services connected with the sale of clothing, footwear, headgear** in class 35.

9. Furthermore 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 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”.

On this basis the term 'clothing, headgear and footwear' in the opponent's specification will include the remaining goods in the application's specification namely 'belts, underwear and coats'.

10. Turning to the remaining term, 'fashion shows', in the applicant's class 35 specification, I note that the applicant has conceded that these are similar services to those provided by the opponent. However, I still need to decide on the level of similarity.

11. In the judgment of the Court of Justice of the European Union 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.

12. Fashion shows would be for promotional or commercial purposes when classified in class 35 (as opposed to for the purpose of entertainment which would be proper to class 41). The users of this service could be the general public or specialist buyers in the fashion industry so there may be some overlap with the opponent's advertising

services in terms of users and trade channels since both may be used to promote goods (clothing in this case) to the public to gain custom. I find there is at least a reasonable level of similarity between the applicant's 'fashion shows' and the opponent's 'advertising services'.

AVERAGE CONSUMER AND THE PURCHASING ACT

13. I must now consider the role of the average consumer and how the goods and services are purchased. 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*.

14. 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."

15. The contested goods and services here include clothing and retail of clothing. The average consumer will be a member of 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 General Court ('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.”

16. As stated by the General Court, items of clothing vary in price and quality. The same can be said of footwear and headgear. Ordinarily 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 as the goods are commonly purchased on the basis of their aesthetic appeal. It is likely they will be selected after viewing of racks/shelves in retail establishments, or from photographs on Internet websites or in catalogues. However, I do not discount any aural considerations which may also play a part. Similar reasoning will apply to retail services. The average consumer will pay a normal level of attention when choosing a particular retailer usually on the basis of signage, window dressing and other visual factors. With regard to ‘fashion shows’, these are evidently visual by the very nature of being a show or display of the goods available and I would expect a normal level of attention to be paid.

COMPARISON OF THE MARKS

17. The marks to be compared are:

Opponent's mark	Applicant's mark
FRUIT	PEPPERFRUIT

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 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.”

19. 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.

20. The opponent's trade mark consists of a single word **FRUIT** in plain block capital letters. The overall impression of the mark and its distinctiveness rests solely on that word.

21. The applicant's trade mark consists of a single word **PEPPERFRUIT** in plain block capital letters.

22. The opponent submits that the contested mark will be broken down into the two well-known English words, PEPPER and FRUIT. Furthermore they submit that:

“PEPPER will be seen as an adjective of the noun FRUIT, and as such will have secondary importance, compared to the dominant noun FRUIT”.

23. I acknowledge that the contested mark is likely to be seen as a conjoining of the two words PEPPER and FRUIT. However I do not consider that either word dominates the other. Elsewhere in its submissions, the opponent also appears to contend that FRUIT forms an independently distinctive element of the mark. I disagree. In my view, the two words combine to form a conceptual unit whereby the distinctiveness resides in the mark as a whole.

24. With regard to a visual comparison of the marks, the opponents have referred to a number of EU IPO and General Court decisions to support their contention that the marks are visually similar at least to an average degree. The referenced cases are CTM Opp No B1726705 FRUIT vs Jackfruit, T62/13 METABIOMAX vs BIOMAX and T1/13 GLAMOUR vs TUDOR GLAMOUR. The referenced decisions consider the issue of where the emphasis is placed in marks with more than one element. I have noted these decisions in the consideration of the case before me. However I do not consider them to be on 'all fours' with the current matter and I must reiterate the principle that each case must be decided on its own merits. The contested marks share a common word FRUIT which is the only element of the opponent's mark and the last five letters of the applicant's mark. However I consider the first six letters PEPPER in the applicant's mark to create a notable and strong point of visual contrast such that the marks overall are visually similar to only a low degree.

25. In respect of the aural comparison, the opponent again refers to previous decisions of the EU IPO and General Court. They furthermore submit that there is at least an average degree of aural similarity because of the outcomes of said EU IPO and GC decisions. As I have previously found above, these decisions do not assist

as the marks at issue here are not the same. I further note that in those referenced cases, at least half of the syllables of the respective marks were identical. That is not the case here where PEPPERFRUIT has three syllables and shares only one syllable with the word FRUIT. The word PEPPER is at the beginning of the mark and takes up two out of three syllables of the mark as a whole. As such it has greater impact on the ear than the single syllable FRUIT at the end of the mark. Overall, I disagree with the opponent that there is at least an average degree of similarity. In my view it is low overall.

26. In a conceptual comparison, the opponent's mark will be seen as a non-specific edible product of a tree or bush, whereas the applicant's mark will be seen as a specific type or variety of such edible produce. I agree with the opponent that this results in at least an average degree of conceptual similarity between the two marks.

DISTINCTIVE CHARACTER OF THE EARLIER TRADE MARK

27. 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).”

28. The opponent did not file any evidence in support of their mark so I can only consider the inherent distinctiveness of the earlier mark.

29. The earlier mark consists of an ordinary English dictionary word which does not describe or allude to the goods and services for which it is registered. I find the earlier mark to have an average level of distinctiveness.

LIKELIHOOD OF CONFUSION

30. I must now draw together my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors:

- a) The interdependency principle, whereby a lesser degree of similarity between the goods and services may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc*).
- b) The principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*).
- c) 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 BV*).

31. So far I have found that the goods and services in so far as they relate to clothing and the retail of clothing are identical and similar to at least a reasonable degree in relation to ‘fashion shows’. In addition I have found that the average consumer is a member of the general public or specialist in the fashion industry who will select the goods and services by primarily visual means whilst paying a normal degree of attention during the purchasing process. I also found that the overall impression and distinctiveness of the opponent’s mark lies in the single word FRUIT.

Whereas the overall impression and distinctiveness of the applicant's mark lies in the overall-unit created by the conjoining of the two words PEPPERFRUIT, where neither of those words dominates the other and where FRUIT does not have independent distinctive significance. In terms of the comparison of the marks, I found that they are visually and aurally similar only to a low degree. I found the concept of both marks to be at least similar to an average degree. In terms of the distinctiveness of the earlier mark, I concluded this to be average.

32. Having weighed all of the relevant factors, I conclude that whilst some of the respective goods and services are identical and others ('fashion shows') are similar to at least a reasonable degree, and there is at least an average degree of conceptual similarity between the marks, this is outweighed by my finding that the visual (in particular) and aural similarity between the respective marks is low. I have said "in particular" in relation to the level of visual similarity because the purchase of the goods and services at issue is likely to be mainly visual, and so the level of visual similarity is of particular importance¹. Taking these factors into account, together with the average level of distinctiveness of the earlier mark, I do not consider there to be a likelihood of direct confusion between the applicant's mark and the opponent's mark, on the part of an average consumer paying a normal level of attention. I also do not consider that the average consumer is likely to believe that the respective goods and services come from the same or linked undertakings. The common element, FRUIT, is not "so strikingly distinctive"², the applicant's mark does not "simply add a non-distinctive element to the earlier mark"³, the applicant's mark does not strike me as being "entirely logical and consistent with a brand extension"⁴ of the

¹ 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."

² *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, [16].

³ *ibid*

⁴ *ibid*

opponent's FRUIT mark and I cannot see any other reason why the marks are likely to be indirectly confused.

COSTS

33. As the applicant has been successful, it is entitled to a contribution of the costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 2/2016. Bearing in mind the guidance given in TPN 2/2016, I award costs to the applicant as follows:

£200 for consideration of the Notice of Opposition and filing a counterstatement.
£200 written submissions.

34. I order Fruit of the Loom Inc to pay Pepperfruit Limited the sum of £400. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 17th day of July 2017

June Ralph

For the Registrar

The Comptroller-General