

O-368-17

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3168328

BY RELIABLE EXPRESS LIMITED

TO REGISTER:



AS A TRADE MARK IN CLASS 25

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 407227 BY CKL HOLDINGS N.V.

BACKGROUND & PLEADINGS

1. On 7 June 2016, Reliable Express Limited (“the applicant”) applied to register the trade mark shown on the cover page of this decision for the goods shown in paragraph 10 below. The application was published for opposition purposes on 24 June 2016.

2. On 23 August 2016, the application was opposed in full by CKL Holdings N.V. (“the opponent”) under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent is the owner of the following United Kingdom trade mark:

No. 3181739 for the trade mark: **Peter** which was applied for on 23 August 2016 (claiming an International Convention priority date of 1 March 2016 from an earlier filing in France) and which was entered in the register on 27 January 2017. The opponent relies upon all the goods for which the trade mark is registered and which are shown in paragraph 10 below.

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

4. In these proceedings, the opponent is represented by Trademarkers Merkenbureau C.V; the applicant represents itself. Although neither party filed evidence, the opponent filed written submissions during the course of the evidence rounds. Neither party asked to be heard nor did they elect to file written submissions in lieu of attendance.

DECISION

5. 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.”

6. An earlier trade mark is defined in section 6 of the Act, which states:

“6. - (1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK), 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.”

7. In these proceedings, the opponent is relying upon the trade mark shown in paragraph 2 above. Although it has a later filing date than the application for registration, it claims an International Convention priority date of 1 March 2016 from an earlier filing in France. As a consequence, it qualifies as an earlier trade mark under the provisions of section 6(1)(a) of the Act. Attached to the Notice of opposition as Exhibit A is a copy of an extract (in French) obtained from the inpi website, indicating that the opponent is the owner of the earlier French trade mark upon which priority is based. Also provided is a translation of this document into English. Although the provenance of this translation is not explained, a rudimentary review of the terms appearing in the French version of the opponent’s specification in class 25 i.e. “Vêtements; chaussures;

chapellerie; chemises; vêtements en cuir; ceintures (habillement); fourrures (vêtements); gants (habillement); foulards; cravates; bonneterie; chaussettes; chaussons; chaussures de plage; chaussures de ski; chaussures de sport; sous-vêtements”, confirms that the specification shown in paragraph 10 fairly reflects that in the French trade mark.

8. As the trade mark upon which the opponent relies had not been registered for more than five years at the date when the application was published, it is not subject to proof of use, as per section 6A of the Act.

Section 5(2)(b) – case law

9. The following principles are gleaned from the decisions of the courts of the European Union 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 greater 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 competing goods are as follows:

The opponent's goods	The applicant's goods
Class 25 - Clothing; shoes; headgear; shirts; leather clothing; belts (clothing); furs (clothing); gloves (clothing); scarves; ties; hosiery; socks; slippers; beach shoes; ski boots; sport shoes ; underwear.	Class 25 - Athletics footwear; Athletics wear; Babies' clothing; Casual clothing; Casual shirts; Casualwear; Children's footwear; Clothing for children; Clothing for gymnastics; Coats; Coats for men; Coats for women; Coats (Top); Fancy dress costumes; Football shoes; Footless socks; Footwear; Jackets and socks; Knit jackets; Knitted gloves; Knitwear; Long jackets; Men's and women's jackets, coats, trousers, vests; Menswear; Work clothes.

11. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) 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”.

12. Although the goods in the applicant’s specification may fall into one or more categories of the goods in the opponent’s specification (and vice versa), what follows is my analysis of the most obvious areas of overlap.

13. The opponent’s specification includes the term “clothing” which is broad enough to include the following goods in the application: “athletics wear; babies' clothing; casual clothing; casual shirts; casualwear; clothing for children; clothing for gymnastics; coats; coats for men; coats for women; coats (Top); fancy dress costumes; jackets; knit jackets; knitted gloves; knitwear; long jackets; men's and women's jackets, coats, trousers; menswear; work clothes”; the competing goods are, as a consequence, identical on the *Meric* principle.

14. As (i) “sport shoes” in the opponent’s specification would include “athletics footwear” and “football shoes” in the application, (ii) “shoes” in the opponent’s specification would include “children's footwear” in the application and (iii) as “footwear” in the application would include “shoes”, “slippers”, “beach shoes”, “ski boots” and “sports shoes” in the opponent’s specification, such goods are, once again, identical on the *Meric* principle.

15. Finally, as (i) “socks” in the opponent’s specification is identical to “socks” in the application and would include “footless socks” in the application and (ii) as “vests” in the application would be included in the term “underwear” in the opponent’s specification, the competing goods are either literally identical or, once again, identical on the principles outlined in *Meric*.

The average consumer and the nature of the purchasing act

16. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods; 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.”

17. In its decision in *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03, the GC stated:

“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.”

18. The average consumer of the goods at issue is a member of the general public. As such goods will, for the most part, be obtained by self-selection i.e. from the shelves of


a bricks and mortar retail outlet or from the equivalent pages of a website or catalogue, visual considerations are likely to dominate the selection process. That said, as such goods may also be the subject of, for example, word-of-mouth recommendations or oral requests to sales assistants, aural considerations must not be forgotten. As to the degree of care the average consumer will display when selecting such goods, I am aware that the cost of the goods can vary considerably. However, as the average consumer will be alive to factors such as cost, size, colour, material and compatibility with other items of clothing, they will, in my view, pay at least a normal degree of attention to their selection.

Comparison of trade marks

19. 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 them, 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.”

20. 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 they create. The trade marks to be compared are:

Opponent's trade mark	Applicant's trade mark
Peter	

21. The opponent's trade mark consists of a single word presented in title case; that is the overall impression it conveys and where its distinctiveness lies.

22. In my view, the applicant's trade mark consists of two components. The first, is a device consisting of a thick "wavy" line presented in bold. Given its size and positioning in the context of the trade mark as a whole, it will make a not insignificant contribution to the overall impression it conveys. Although in paragraph 7 of its submissions the opponent describes this device as "a banal line above the word element", I disagree. In my view, the positioning, size and shape of the device element combined with the fact that it clearly forms a letter "W" to, I assume, mirror the letter "W" in the word "WHITE", means that not only will it make a not insignificant contribution to the overall impression conveyed but also to the trade mark's distinctiveness. The second component consists of the words "PETER" and "WHITE" presented in bold in block capital letters.

Notwithstanding that the word "PETER" appears first (a point to which the opponent attributes great importance), in my view, the words "PETER WHITE" form a "unit", with the "unit" having a different meaning to the separate words of which it is composed (I shall return to this point below). Despite its relative size in the context of the trade mark as a whole, this unit will, in my view, make a more significant contribution to the overall impression the applicant's trade mark conveys and its distinctiveness.

23. When considered from the visual and aural standpoints, the fact that the competing trade marks either consist exclusively of the word "Peter" or contain this word (which, as the applicant's trade mark will most likely be referred to by the words "PETER WHITE",

will be articulated first), leads to at least a medium degree of visual and aural similarity between them. As to conceptual similarity, the opponent's trade mark consists of a word which will be very well-known to the average consumer as a very common male forename, whereas the applicant's trade mark will be understood as consisting of that same forename and, in my experience, a very common surname i.e. "WHITE"; considered overall, it will be understood as a full name referring to a specific individual i.e. "PETER WHITE." The competing trade marks are conceptually similar only to the extent that they both contain the very common male forename "Peter"/"PETER".

Distinctive character of the earlier trade mark

24. 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.

25. As the opponent has not filed any evidence of any use it may have made of its earlier trade mark, I have only its inherent characteristics to consider. As I mentioned earlier, the opponent's trade mark will be understood as a very common male forename. In my experience, it is very common for those engaged in the trade concerned to use, inter alia, male forenames as indicators of origin. Considered on that basis and absent use, the earlier trade mark is possessed of a low degree of inherent distinctive character.

Likelihood of confusion

26. 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 it 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 at issue by predominately visual means, displaying a normal degree of attention during the selection process;
- the overall impression conveyed by the opponent's trade mark and its distinctiveness lie in the word of which it is composed;
- while the device component will make a not insignificant contribution to the distinctiveness of the applicant's trade mark and the overall impression it conveys, it is the unit created by the words "PETER WHITE" which will make the most significant contribution in this regard;
- the competing trade marks are visually and aurally similar to at least a medium degree and conceptually similar to the extent that they both contain the very common male forename "Peter"/"PETER";

- absent use, the opponent's earlier trade mark is possessed of a low degree of inherent distinctive character.

27. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks/goods down to the responsible undertakings being the same or related.

28. 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*. He stated:

“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.”

29. The competing trade marks consist of or contain the word “Peter” or “PETER”, leading to at least a medium degree of visual and aural similarity between them. However, the word “Peter” is a very common male forename in this country and, as a consequence, has a low degree of inherent distinctive character. As the opponent has filed no evidence to indicate that its trade mark enjoys an enhanced level of protection and as the word “PETER” in the applicant’s trade mark does not have a distinctive significance independent of the whole, its mere presence in the “unit” the applicant’s trade mark creates, would not, in my view, lead to a likelihood of either direct or indirect confusion. As a consequence of those conclusions, the opposition fails and is dismissed accordingly.

Overall conclusion

30. The opposition has failed and, subject to any successful appeal, the application will proceed to registration.

Costs

31. The applicant has been successful and is entitled to a contribution towards its costs. Awards of costs in proceedings commenced after 1 July 2016 are governed by Annex A of Tribunal Practice Notice (“TPN”) 2 of 2016. As the applicant is unrepresented, at the conclusion of the evidence rounds the tribunal invited it to indicate whether it intended to make a request for an award of costs, and if so, to complete a pro-forma indicating a breakdown of its actual costs, including providing accurate estimates of the number of hours spent on a range of given activities relating to the prosecution of the opposition; it was made clear to the applicant that if the pro-forma was not completed “no costs, other than official fees arising from the action and paid by the successful party...will be awarded”. As the applicant did not respond to that invitation within the timescale allowed (nor has any response been received from the applicant prior to the date of the issuing of this decision), and as the applicant has not incurred any official fees in defending its application, I make no order as to costs.

Dated this 7th day of August 2017

C J BOWEN

For the Registrar