

O-508-17

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3199777 BY
FLORA INTERNATIONAL LTD**

TO REGISTER:

FLORA

AS A TRADE MARK IN CLASSES 14, 25, 26 & 38

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 60000647 BY
XINGMAO YE, YI YE & KNT TRADING LIMITED**

Background & pleadings

1. On 1 December 2016, Flora International Ltd (“the applicant”) applied to register the trade mark **FLORA** for goods and services in classes 14, 25, 26 and 38. The application was published for opposition purposes on 10 February 2017.

2. On 9 May 2017, the application was opposed under the fast track opposition procedure by Xingmao YE, Yi Ye and KNT Trading Limited (“the opponents”). The opposition, which is only directed against the goods in class 25 of the application (shown in paragraph 12 below), is based upon section 5(2)(a) of the Trade Marks Act 1994 (“the Act”). The opponents rely upon UK trade mark registration no. 3027727 for the trade mark **Flora** which has an application date of 23 October 2013 and registration date of 7 February 2014. The opponents rely upon all the goods for which their trade mark is registered (shown in paragraph 12 below):

3. The applicant filed a counterstatement in which it acknowledges that:

“17...the earlier marks (sic) and the [trade mark the subject of the application] are visually, phonetically and conceptually identical.”

It does not, however, agree there is a likelihood of confusion.

4. In these proceedings both parties have represented themselves.

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

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

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

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

DECISION

8. The opposition is based upon section 5(2)(a) of the Act, which reads as follows:

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

(a) It is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected,

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

9. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

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

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

10. The registration upon which the opponents rely qualifies as an earlier trade mark under the above provisions. As this earlier trade mark is not subject to proof of use, the opponents are entitled to rely upon it for each of the goods they have identified.

Comparison of trade marks

11. As mentioned above, the applicant admits the competing trade marks are identical.

Comparison of goods

12. The competing goods are as follows:

The opponents' goods	The applicant's goods in class 25
Petticoats; Veils; Boleros; Shawls; Wraps [clothing]; Bridal gowns; Bridal wear; Bridesmaid dresses; Bridesmaids wear; Capes; Crinolines; Garters; Gloves; Underskirts; Christening gowns; Clothing for children; Ballet suits; Costumes; Headdresses [veils]; Headwear; Stoles; all for sale via the internet only.	Clothing; footwear; headgear; swimwear; sportswear; leisurewear

13. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05, the General Court 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 the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359,

paragraphs 32 and 33; Case T-110/01 Vedral v OHIM – France Distribution (HUBERT) [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03 Koubi v OHIM – Flabesa (CONFORFLEX) [2004] ECR II-719, paragraphs 41 and 42).”

14. In its counterstatement, the applicant states:

“15...The goods of the contesting marks have entirely different distribution channels. The goods of the earlier mark are sold and made available to the public via the internet only. Whereas the goods of the subject mark can be purchased and distributed in stores other than the internet.

16...swimwear, sportswear, leisurewear and footwear [in the application] are not encompassed by any of the goods in the earlier mark in class 25”.

15. The term “Clothing” in the applicant’s specification includes many of the goods in the opponents’ specification; as a consequence, the competing goods are identical on the principle outlined in *Meric*. The term “headgear” in the applicant’s specification is an alternative way of describing “Headwear” in the opponents’ specification; such goods are literally identical. “Clothing for children” in the opponents’ specification is broad enough to include “swimwear”, “sportswear” and “leisurewear” (for children) in the application and would also include goods such as socks which would be encompassed by the term “footwear” in the application. Such goods are, once again, to be regarded as identical on the *Meric* principle.

16. The applicant’s submission regarding what it considers to be the differing distribution channels, misses the point. As its specification is not limited in any way, it includes goods made available to the public via the internet as well as by other means.

The average consumer and the distinctiveness of the earlier trade mark

17. It is at this point in my decision that I would normally consider who the average consumer is for the goods at issue and their purchasing traits and then go on to

consider the distinctiveness of the earlier trade mark. However, as both the competing goods and trade marks are identical, it matters not how, or how carefully the goods may be selected, or how distinctive the earlier trade mark might be. There is simply nothing that would allow the average consumer to distinguish between the competing trade marks/goods.

Likelihood of confusion

18. Having concluded that the competing trade marks and goods are identical, it is inevitable that direct confusion will result and the opposition to the goods in class 25 of the application succeeds accordingly.

19. In reaching the above conclusion, I have not overlooked the fact that the opposition is based upon section 5(2)(a) of the Act, which requires identity in the competing trade marks and similarity in the goods. Strictly speaking, the opponents ought to have opposed the application in class 25 under section 5(1) of the Act (which deals with identical trade marks and identical goods/services). However, perhaps in an abundance of caution, it elected to rely only upon the goods being “closely related”. As the applicant has admitted the competing trade marks are identical and as I have concluded that the competing goods in class 25 are identical (as opposed to just being similar), it would, in my view, be perverse for the opposition to the goods in class 25 to fail simply because the competing goods are actually more similar (i.e. identical) than the opponents originally contemplated.

Overall conclusion

20. The opposition to the goods in class 25 of the application has succeeded in full and, subject to any successful appeal, the application will be refused in class 25. The unopposed goods and services in classes 14, 26 and 38 may, in due course, proceed to registration.

Costs

21. Awards of costs in fast track opposition proceedings filed after 1 October 2015 are governed by Tribunal Practice Notice (“TPN”) 2 of 2015. Using that TPN as a guide, I award costs to the opponents on the following basis:

Preparing a statement and considering the applicant’s statement:	£200
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Opposition fee:	£100
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Total:	£300
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22. I order Flora International Ltd to pay to Xingmao YE, Yi Ye and KNT Trading Limited (jointly) the sum of £300. 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 11th day of October 2017

C J BOWEN
For the Registrar