

O-537-17


**TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No. 3163833
BY OXYGEN INTERNATIONAL LIMITED
TO REGISTER THE TRADE MARK
OXYGEN
IN CLASS 25**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER No. 407829 BY
GRIMALDI INDUSTRI AB**

BACKGROUND

- 1) On 11 May 2016, Oxygen International Limited (hereinafter the applicant) applied to register the trade mark “Oxygen” in respect of the following goods in Class 25: Clothing; footwear; headgear; swimwear; sportswear; leisurewear.
- 2) The application was examined and accepted, and subsequently published for opposition purposes on 5 August 2016 in Trade Marks Journal No.2016/032.
- 3) On 7 November 2016 Grimaldi Industri AB (hereinafter the opponent) filed a notice of opposition. The opponent is the proprietor of the following trade mark:

Mark	Number	Dates of filing & registration	Class	Specification relied upon
 Colours Claimed: Black, white, green.	EU 12443289	18.12.13 05.08.14	9	Helmets, cycling helmets;
			25	Clothing, footwear, headgear, including clothing for cyclists.
			35	Retailing in relation to helmets, bicycle helmets, clothing, footwear, headgear, including clothing for cyclists.

- a) The opponent contends that its mark and the mark applied for are very similar and that the goods applied for are similar to the goods and services for which the earlier mark is registered. As such the mark in suit offends against Section 5(2)(b) of the Act.
- 4) On 10 January 2017 the applicant filed a counterstatement, basically denying that the marks and goods / services are similar.
 - 5) Neither party filed evidence. Both parties seek an award of costs in their favour. Neither side wished to be heard. Both parties provided written submissions which I shall refer to as and when necessary in my decision.

DECISION

6) The only ground of opposition is under section 5(2)(b) which reads:

“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.”

7) An “earlier trade mark” is defined in section 6, the relevant part of which states:

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

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

8) The opponent is relying upon its trade mark listed in paragraph 3 above which is clearly an earlier trade mark. Given the interplay between the date that the opponent’s mark was registered (5 August 2014) and the date that the applicant’s mark was published (5 August 2016), the proof of use requirements do not bite.

9) When considering the issue under section 5(2)(b) I take into account the following principles which are gleaned from the decisions of the EU courts 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*

Klijisen 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 goods and services

10) In the judgment of the Court of Justice of the European Union (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”.

11) 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) I also note that in *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM Case T-133/05) (*'Meric'*), the General Court ('GC') held:

“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 Vedial 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).”

13) The opponent’s strongest case is clearly under its class 25 goods. The Class 25 goods of the two parties are:

Applicant’s goods	Opponent’s goods
Clothing; footwear; headgear; swimwear; sportswear; leisurewear.	Clothing, footwear, headgear, including clothing for cyclists.

14) The applicant contends:

“15. The opponent claims that the applicant’s goods in Class 25 are identical to its goods in the same class. The applicant accepts that there are some similarities between the respective classifications. However, it is important to note that the mere fact that a particular good is a part of another does not suffice in itself to prove that the goods provided to the public are similar. In

particular, their nature, intended purpose and the consumers, may be completely different although the entities belong to and compete fairly in the same marketplace (reference is made to the judgment of the ECJ of 27 October 2005 Case no: T-336/03 –MOBILIX v OBELIX). Simply because a mark is seeking protection for an extremely broad specification of goods available, i.e. “clothing”, cannot imply per se that any other trade mark protected for a narrower specification should be able to deny its registration. This would result in a clear trespassing of the UK legislator’s intent and go beyond the scope of the Act.

The additional goods of the subject mark, such as “leisurewear” and “swimwear” clearly differentiate the subject mark. As a result, it appears that the nature and purpose of the goods of the opponent’s marks are different from the goods of the subject mark, besides importantly differing further with regard to their intended use. Accordingly, the aforementioned additional goods specified under class 25 of the respective marks would almost certainly be offered for sale in different outlets. These goods would likely be sold in specialist stores, whereas the goods of the earlier mark are intended to be sold in general clothing stores. Even in larger stores the goods would be sold in separate, distinct areas.”

15) The case relied upon by the applicant is not on all fours with the instant case. In the instant case the earlier mark has a wide ranging specification which has terms which are identical to the later mark. Both parties marks have the words “Clothing; footwear; headgear;” in them and these must be regarded as identical. To my mind, the terms “leisurewear” and “sportswear” in the applicant’s specification are very wide ranging and would include items of clothing such as jeans, T-shirts, football and rugby jerseys which are worn as everyday clothing and are encompassed in the term “clothing”. Such items would be purchased by the same user, have similar physical characteristics, would be found on the same racks/shelves in a store and be sold alongside other items of clothing. They must be regarded as identical to the term “clothing” in the opponent’s specification. Lastly, I turn to the term “swimwear” in the applicant’s specification. This term covers a wide range of goods from bikinis, ladies one piece swimsuits, men’s “speedo” type trunks and shorts to swimming burkas. It could also include items of clothing to wear when one comes out of the water such as sarongs etc. As such these items would be encompassed by the term “clothing”. The specifications of both parties are identical.

The average consumer and the nature of the purchasing decision

16) As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then determine the manner in which these goods and services 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) The application is in respect of, “clothing; footwear; headgear; swimwear; sportswear; leisurewear”. Such goods will be sold in, inter alia, traditional retail outlets on the high street, through catalogues and on the Internet. The specifications of both parties are unlimited, and so I must keep all of these trade channels in mind. The average consumer of the goods at issue is a member of the general public who is likely, in my opinion, to select the goods mainly by visual means. I accept that more expensive items may be researched or discussed with a member of staff. In this respect I note that in *New Look Ltd v OHIM Cases- T-117/03 to T-119/03 and T-171/03*, the General Court (GC) said this about the selection of clothing:

“50. 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) In the same case the Court also commented upon the degree of care the average consumer will take when selecting clothing. It said:

“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 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.”

19) Clearly, the average consumer’s level of attention will vary considerably depending on the cost and nature of the item at issue. However, to my mind even when selecting routine inexpensive items of clothing such as socks, the average consumer will pay attention to considerations such as size, colour, fabric and cost. Overall the average consumer is likely to pay a medium degree of attention to the selection of such items of clothing. I extend this finding to the other categories of goods “footwear and headgear”.

Comparison of trade marks

20) 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 them, 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.”

21) 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 created by them. The trade marks to be compared are:

Opponents' trade mark	Applicant's trade mark
	Oxygen

22) Both parties agree that the term “VELO” would be commonly understood to refer to bicycles, due to its use in terms such as velodrome. Clearly there are visual and aural differences in that the opponent’s mark begins with the words “velo” and “&” neither of which appear in the mark in suit. The obvious similarity visually and aurally is that they share the word Oxygen. Conceptually, the word “velo” if used upon clothing, footwear or headgear for cyclists would be seen as descriptive of its intended use. On all other clothing, footwear and headgear neither “velo” nor “oxygen” would be seen as having any particular meaning other than referring to bicycles and the well-known gas.

23) The applicant referred me to the *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, where the General Court noted that the beginnings of word tend to have more visual and aural impact than the ends. However, I also take into account the views of the same court in *Bristol Global Co Ltd v EUIPO*, T-194/14, where the GC held that there was a likelihood of confusion between AEROSTONE (slightly stylised) and STONE if both marks were used by different undertakings in relation to identical goods (land vehicles and automobile tyres). This was despite the fact that the beginnings of the marks were different. The common element – STONE – was sufficient to create the necessary degree of similarity between the marks as wholes for the opposition before the EUIPO to succeed. To my mind, **overall, the marks are similar to a medium degree.**

Distinctive character of the earlier trade mark

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 *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).”

25) In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.’

40. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask ‘in what does the distinctive character of the

earlier mark lie?’ Only after that has been done can a proper assessment of the likelihood of confusion be carried out”.

26) The opponent’s mark consists of mark “VELO & OXYGEN”. The term “VELO” as stated earlier will be seen as an allusion to bicycles/cycling and if used on cycling clothing, footwear or headgear would be seen as descriptive. However, for clothing, footwear or headgear not connected to cycling the word has no meaning and so would be seen as distinctive. The word “Oxygen” is a well-known English word for the gas that is required for human life. To my mind, neither word is the dominant element of the mark, both are distinctive (with the exception of cycling items). When used in combination with an ampersand they do not form a different meaning from the individual elements. **The mark is inherently distinctive to a medium degree. The opponent has not shown use of its mark and so it cannot benefit from enhanced distinctiveness.**

Likelihood of confusion

27) 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 services 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 this trade mark 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 average consumer for the goods is the general public who will select the goods by predominantly visual means, although I do not discount aural considerations, and that the degree of care and attention they pay will vary depending upon the cost of said goods. They are, however, likely to pay a medium degree of attention to the selection of such goods.
- the marks of the two parties are similar to a medium degree.

- the opponent's mark has a medium level of inherent distinctiveness and cannot benefit from an enhanced distinctiveness through use.
- the class 25 goods of the two parties are identical.

28) In view of the above, and allowing for the concept of imperfect recollection, there is a likelihood of consumers being confused into believing that the goods applied for under the mark in suit and provided by the applicant are those of the opponent or provided by some undertaking linked to it. **The opposition under Section 5(2) (b) therefore succeeds in full.**

CONCLUSION

29) The opposition in relation to all the goods applied for has been successful under section 5(2)(b).

COSTS

30) As the opponent has been successful it is entitled to a contribution towards its costs.

Expenses	£100
Preparing a statement and considering the other side's statement	£300
Filing written submissions	£300
TOTAL	£700

31) I order Oxygen International Limited to pay Grimaldi Industri AB the sum of £700. This sum 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 24th day of October 2017

George W Salthouse
For the Registrar,
the Comptroller-General

