

O-178-18

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3202665
BY KING TEMPLE OPARA TO REGISTER:**



AS A TRADE MARK IN CLASS 25

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 408870 BY OPERA PARTNERS LTD.**

BACKGROUND & PLEADINGS

1. On 16 December 2016, King Temple Opara (“the applicant”) applied to register the trade mark shown on the cover page of this decision for “Clothes” in class 25. The application was published for opposition purposes on 23 December 2016.
2. The application is opposed by Opera Partners Ltd. (“the opponent”). The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), in relation to which the opponent relies upon United Kingdom trade mark application No. 3199514 for the trade mark **OPERA**, which was applied for on 30 November 2016 and which is currently shown as status “Opposed”. The opponent indicates that it relies upon the goods in class 25 of its application, shown in paragraph 9 below:
3. The applicant filed a counterstatement in which the basis of the opposition is denied.
4. In these proceedings, both parties represent themselves. Although neither party filed evidence or submissions during the course of the evidence rounds, the opponent elected to file written submissions in lieu of attendance at a hearing. I shall, if necessary, refer to these submissions later in this decision.

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 UK trade mark shown in paragraph 2 above. Although currently status opposed, as the application date of this trade mark is earlier than that of the applicant’s trade mark, it qualifies as an earlier trade mark under the provisions of Section 6(2) of the Act. Should I find in the opponent’s favour, my decision will be an interim one and the proceedings will be suspended to await the outcome of the opponent’s application.

Section 5(2)(b) – case law

8. 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

9. The applicant's specification is for "Clothes", whereas the opponent's specification in class 25 reads: "Clothing; footwear; headgear; swimwear; sportswear; leisurewear." "Clothes" in the application is an alternative way of describing "Clothing" in the opponent's specification. The competing goods are, as a consequence, identical.

The average consumer and the nature of the purchasing act

10. As the case law above indicates, it is necessary for me to determine who the average consumer is for the goods at issue. 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.”

11. In *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03 the General Court (“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.”

12. The average consumer of the goods at issue is a member of the general public. As a member of the general public will, for the most part, self-select the goods 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.

13. As to the degree of care the average consumer will display when selecting such goods, 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, a member of the public will pay at least a normal degree of attention to their selection.

Comparison of trade marks

14. 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.”

15. 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
OPERA	

16. The opponent's trade mark consists exclusively of the well-known word OPERA presented in block capital letters. That is the overall impression it will convey and where its distinctiveness lies.

17. The applicant's trade mark consists of two components. Although the first, presented in gold, actually consists of the devices of five forks placed above an element I am unable to identify, the average consumer is, in my view, more likely than not to view the device as a stylised crown. The second component, also presented in gold, appears below the device and consists of the word OPARA presented in an unremarkable script. Both components play an independent and distinctive role in the applicant's trade mark and although the device component is much larger than the word which appears below it, both components will, in my view, make a roughly equal contribution to the overall impression the trade mark conveys.

18. I will now compare the competing trade marks with those conclusions in mind. The trade marks at issue either consist of or contain a word component consisting of five letters in which the first, second, fourth and fifth letters are identical. The fact that notional and fair use of the opponent's trade mark would, inter alia, include its presentation in the colour gold, means that the colour and presentation of the word OPARA in the applicant's trade mark is not a distinguishing feature. Of course, the applicant's trade mark also includes the stylised crown device I mentioned above which, I concluded, makes a roughly equal contribution to the overall impression conveyed. Balancing the similarities and differences results, in my view, in a medium degree of visual similarity between the competing trade marks.

19. As the word of which the opponent's trade mark is comprised will be well known to the average consumer, the manner in which it will be verbalised is predictable. As for the applicant's trade mark, it is well established that when a trade mark consists of a combination of words and figurative components, it is by the word component that it is most likely to be referred. Proceeding on that basis and as both words consists of three

syllables i.e. OP-ER-A and OP-AR-A and as the first and last syllables are identical, the competing trade marks are aurally similar to a high degree.

20. Finally, the conceptual comparison. The opponent submits:

“Although the verbal element of the subject mark is not a word existing in the English language, it will be perceived as a misspelling of OPERA...”

Whereas, the applicant submits:

“...OPARA means first born son...”

21. However, as there is no evidence in support of either of these bald assertions, I must reach my own conclusion. Firstly, the presence of the device of a stylised crown in the applicant’s trade mark is, broadly speaking, likely to evoke the concept of royalty in the mind of the average consumer; a concept completely alien to the opponent’s trade mark. Secondly, as I mentioned earlier, the word OPERA will be well known to the average consumer as will its meaning i.e. “a play with music in which all the words are sung” (collinsdictionary.com refers). While it is possible that the average consumer may, for example, treat the word OPARA as a foreign language word or a name of foreign origin, it is equally possible (and more likely in my view) they will treat it as an invented word conveying no concept. While the opponent’s trade mark will create a concrete conceptual message in the mind of the average consumer, the word OPARA in the applicant’s trade mark will either convey no concept or a different concept to that conveyed by the opponent’s trade mark.

Distinctive character of the earlier trade mark

22. 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.

23. As the opponent has filed no evidence of any use it may have made of its earlier trade mark, I have only its inherent characteristics to consider. Although the word OPERA will be well known to the average consumer, I am not aware and there is no evidence or submissions to the effect that it is either descriptive of, or non-distinctive for, the goods in class 25 upon which the opponent relies. However, as a well known word in its own right, the opponent's trade mark is, as a consequence, possessed of only a normal/average degree of inherent distinctive character.

Likelihood of confusion

24. 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.

25. 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 and goods down to the responsible undertakings being the same or related.

26. 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* and 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.”

27. Earlier in this decision, I concluded that the competing goods are identical (that is a point in the opponent’s favour). Whilst not ignoring aural considerations, I found that the average consumer is most likely to select the goods at issue by predominantly visual means, paying at least a normal degree of attention during that process. Having found that the stylised device of a crown and the word OPARA both played an independent and distinctive role in the applicant’s trade mark, I went on to assess the trade marks at issue as visually similar to a medium degree, aurally highly similar and while the opponent’s trade mark conveys a concrete conceptual message, the applicant’s trade mark may either create no concept (beyond that of royalty) or, alternatively, the presence of the word OPARA may create an additional concept i.e. of a foreign language word or name. Finally, I held that the opponent’s trade mark enjoyed a normal/average degree of inherent distinctive character.

28. In *The Picasso Estate v OHIM*, Case C-361/04 P, the CJEU found that:

“20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law.”

29. However, in *Nokia Oyj v OHIM*, Case T-460/07, the GC stated:

“Furthermore, it must be recalled that, in this case, although there is a real conceptual difference between the signs, it cannot be regarded as making it possible to neutralise the visual and aural similarities previously established (see, to that effect, Case C-16/06 P *Éditions Albert René* [2008] ECR I-0000, paragraph 98).”

30. Notwithstanding the identity in the goods and the word OPARA playing an independent and distinctive role in the applicant’s trade mark, I am satisfied that the very clear conceptual message that will be conveyed by the opponent’s trade mark (a concept which will fix itself in the average consumer’s mind and act as a hook to prompt its recall), is sufficient, when considered from the perspective of an average consumer paying even a normal degree of attention during the selection process, to counteract the visual and aural similarities between the trade marks. The clear conceptual message conveyed by the crown device and the potential conceptual messages the word OPARA may convey to the average consumer are, in my view, further factors pointing to the same conclusion. For the avoidance of doubt, I should say that the same conclusion applies even if, as I suspect, the average consumer treats OPARA in the applicant’s trade mark as an invented word conveying no concept. It follows that there is, in my view no likelihood of either direct or indirect confusion; the opposition to the application fails and is dismissed accordingly.

Overall conclusion

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

Costs

32. As neither of the parties to these proceedings is professionally represented, at the conclusion of the evidence rounds the Tribunal invited them, inter alia, to indicate whether they intended to make a request for an award of costs. If so, they were asked to complete a pro-forma indicating a breakdown of their 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 parties 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”. Neither party elected to respond to that invitation.

33. Although the applicant has been successful, as it has not incurred any official fees in the defence of its application, I make no order as to costs.

Dated this 20th day of March 2018

C J BOWEN
For the Registrar