

O-290-18

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO 3 181 037: DUKES BY
BRITISH CRICKET BALLS LIMITED

AND

IN THE MATTER OF OPPOSITION THERETO BY AVINASH BASSI AND
SUBHASH KUMAR

Background and pleadings

1. British Cricket Balls Limited (the applicant) applied to register the trade mark DUKES in the UK on 18th August 2016. It was accepted and published in the Trade Marks Journal on 18th November 2016 in respect of the following goods:

Class 25:

Cricket clothing, cricket footwear and cricket headgear¹.

Class 28:

Cricket Balls; cricket bats; cricket batting and wicket-keeping gloves; cricket protective pads; cricket bags; cricket wickets and bails; cricket equipment and articles.

2. Avinash Bassi and Subhash Kumar (the opponent) partially oppose the trade mark on the basis of, amongst other grounds, Section 5(2)(b) of the Trade Marks Act 1994 (the Act). This is on the basis of its earlier UK Trade Marks, details of which are:

UK Trade Mark Number 1 407 041 (series of two):

DUKE



Class 25:

Articles of outer clothing; all included in Class 25.

¹ This specification as described was limited by the applicant upon the filing of the counterstatement.

UK Trade Mark Number 2 495 478:



Class 18:

Belts.

Class 25:

Articles of clothing; not including undervests, shorts (other than denim shorts) and gloves; denim jeans, denim jackets, denim skirts; denim shirts; sweat shirts; t-shirts; denim shorts; articles of footwear.

3. The opponent argues that the respective goods are identical or similar and that the marks are similar. The opposition is in respect of the Class 25 goods of the application only.
4. The applicant filed a counterstatement denying the claims made (and requesting that the opponent provides proof of use of its earlier trade marks relied upon). The relevant date in these proceedings is 18th August 2016. The evidence of use filed will therefore be judged according to the five year period prior to this date.
5. Only the opponent filed evidence in these proceedings. This will be summarised to the extent that it is considered necessary.

6. A Hearing took place on 11th April 2018, with the opponent represented by Mr Aaron Wood of Wood IP Limited. The applicant did not attend, nor did it file written submissions in lieu. Indeed, the only contact made by the applicant in these proceedings is the counterstatement. Within this, the applicant merely denied that the respective trade marks are identical and/or similar, denied that the goods were similar and requested that the opponent provide proof of use of the earlier trade marks upon which it relies.

Proof of use

7. Relevant statutory provision: Section 6A:

“Raising of relative grounds in opposition proceedings in case of non-use

6A. - (1) This section applies where -

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if -

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in

the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

8. Section 100 of the Act states that:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

9. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. summarised the case law on genuine use of trade marks. He said:

“217. *The law with respect to genuine use* . In *Stichting BDO v BDO Unibank Inc* [2013] EWHC 418 (Ch), [2013] FSR 35 I set out at [51] a helpful summary by Anna Carboni sitting as the Appointed Person in *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] of the jurisprudence of the CJEU in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439 , Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159 and Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759 (to which I added references to Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237). I also referred at [52] to the judgment of the CJEU in Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16 on the question of the territorial extent of the use. Since then the CJEU has issued a reasoned Order in Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and that Order has been persuasively analysed by Professor Ruth Annand sitting as the Appointed Person in *SdS InvestCorp AG v Memory Opticians Ltd* (O/528/15).

218. An important preliminary point to which Prof Annand draws attention in her decision is that, whereas the English versions of Articles 10(1) and 12(1) of the Directive and Articles 15(1) and 51(1)(a) of the Regulation use the word “genuine”, other language versions use words which convey a somewhat different connotation: for example, “ernsthaft” (German), “efectivo” (Spanish), “sérieux” (French), “effettivo” (Italian), “normaal” (Dutch) and “sério/séria” (Portuguese). As the Court of Justice noted in *Ansul* at [35], there is a similar difference in language in what is now recital (9) of the Directive.

219. I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v*

Centrotherm Clean Solutions GmbH & Co KG [EU:C:2013:592], [2014] ETMR 7, as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector

concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

Evidence filed

10. This is in the form of two witness statements. The first is dated 2nd August 2017 from Mr Subhash Kumar Bassi, the Director of Bassi Fashions Limited. Of note in this witness statement is confirmation from Mr Bassi that though the earlier trade marks are co-owned personally by him and his brother (Mr Avinash Bassi), the company Bassi Fashions Limited has, at all times, had permission to use the aforementioned earlier trade marks. Mr Bassi also confirms that the company has used the trade mark DUKE for over 25 years and continues to make extensive use of it and the logo formats of the DUKE mark (including in the form DUKE LONDON). This use is, according to Mr

Bassi across the full range of clothing, footwear and headgear, including underwear, leisurewear, outerwear, formalwear, shoes, hats and caps.

11. The second witness statement, dated 3rd August 2017, is from Mr Rohan Bassi, the Creative Director of Bassi Fashions Limited. It should be noted that certain parts of the witness statement are subject to a confidentiality order. As such, particular details will be described only in general terms. Further, some information provided is particularly pertinent to the issue of whether the earlier trade marks have been used. As such, the summary which follows focusses upon the information considered to be decisive on the issues relevant to these proceedings:

- Bassi Fashion Limited (BFL) is a wholesaler of clothing and footwear which takes two forms. Firstly, clothing is produced under the DUKE clothing brand which is sold to the public under that brand or one of its sub-brands. Secondly, clothing is produced as private label, i.e. clothing where the customer wants their own brand used.
- Alongside the traditional range of clothing and footwear, BFL has established a niche for the bigger/taller customer.
- Exhibit RB2 contains screen shots from brochures from future seasons (Autumn/Winter 2018). It is noted that there is use of DUKE, alone and within “The DUKE clothing company”. Exhibit RB3 contains a small selection of emails from clients ordering stock for Spring/Summer 2018. It is noted that the emails are headed “The DUKE Clothing Company”.
- Details are provided regarding attendance at trade shows and conferences from 2010 onwards. Photographs of the stands displayed are contained within Exhibit RB4. It is noted that both earlier trade marks are displayed (alongside other variations).
- Turnover figures are provided in respect of DUKE branded clothing. These are confidential. These are not enormous bearing in mind the size of the clothing industry. But they are not insignificant either.

- In respect of the DUKE London logo mark, Exhibits RB14 and 15 provide examples of said logo applied to numerous items of clothing. These are dated from 2011 onwards. It is noted that numerous trade marks are in evidence throughout, including DUKE, DUKE LONDON (minus the lion graphic), The DUKE Clothing company. It is also noted that a wide range of clothing is on offer including trousers, tops, shoes and hats. In terms of style, some of the clothing illustrates the potential for overlap between so-called “sports” clothing and “regular” clothing. I will return to this point further below.
- Exhibit RB15 is in respect of brand books dated around the relevant date in these proceedings, which is August 2016. They are dated Spring/Summer 2016 and Autumn/Winter 2016. Mr Bassi confirms that the content and product range reflect earlier brand books.
- Exhibit RB27 contains a news story, dated September 2016, from The Nottingham Post, regarding BFL and its history. This is after the relevant date in these proceedings. However, its content is worth noting, particularly as it contains historical information regarding BFL and provides details regarding its success. The focus of the article is The Duke Clothing Company (trading name of BFL) which produces three million garments each year. It also reports a 24% growth from the previous year. Exhibit RB28, contains three examples, one dated 2010 and the others, 2015, regarding “cricket” jumpers as a fashion trend. I will return to this exhibit further below.

Conclusions on the evidence

12. I have already acknowledged that there are several trade marks of the opponent’s displayed throughout the evidence, including D555 and Rockport. However this does not dilute the presence of the earlier trade marks upon which the opposition relies. These are clear from the documents filed as they are each displayed on numerous occasions and in respect of various items of clothing. It is true that they are sometimes used in an alternative form, for

example the DUKE LONDON logo mark appears minus the lion graphic on occasion. However, nothing turns on this point, as the opponent has also provided numerous examples of them being used as registered. The evidence also provides details of turnover, which is not insignificant and is helpfully focussed upon DUKE branded items (as well as providing additional context for the business as a whole, which has different limbs). There are details of marketing activities and expenditure. There is also an independent news article regarding The Duke Clothing Company, which consolidates its position as a successful business providing clothing. Finally, there are numerous invoices regarding DUKE clothing together with brochures and brand books displaying the range of clothing sold under the earlier trade marks. It is noted that these include trousers, tops, outer clothing such as jackets and coats, shoes, hats and jumpers.

13. Bearing in the mind the entirety of the evidence filed, I have little hesitation in concluding that both of the earlier trade marks have been used across the full range of goods for which they are registered and so satisfy the proof of use provisions.

DECISION

Section 5(2)(b)

14. 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”.

Comparison of goods and services

15. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, 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”.

16. 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 uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) 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;
- (f) 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.

17. I also take into account the following guidance: in *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

18. I also take into account: *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, where the General Court 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 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".

19. The earlier goods are:

UK Trade Mark Number 1 407 041 (series of two):

Class 25:

Articles of outer clothing; all included in Class 25.

UK Trade Mark Number 2 495 478:

Class 25:

Articles of clothing; not including undervests, shorts (other than denim shorts) and gloves; denim jeans, denim jackets, denim skirts; denim shirts; sweat shirts; t-shirts; denim shorts; articles of footwear.

20. In respect of earlier trade mark '478, it is noted that it includes clothing and footwear at large. The applied for term has been limited to "cricket" clothing, footwear and headgear. The applicant has not provided any further illumination on this and in particular, why this would avoid a finding of similarity. The earlier specification includes clothing and footwear at large and so, even on paper, I find that the later cricket clothing and cricket footwear are identical. This finding is supported in real terms by some of the evidence filed by the opponent. I note two important points from this: firstly, cricket jumpers can be a known fashion style and secondly, there are other items in the evidence which clearly illustrate the overlap which can occur between "sports" clothing and regular clothing. For example, there are polo shirts, blazers, trilby style hats and loafers, all of which could potentially be used for playing cricket.
21. In respect of cricket headgear, it is noted that this term appears in Class 25 rather than Class 9 which covers protective headgear for sports so this is interpreted as meaning casual baseball style caps and the like rather than protective cricket helmets. Such caps are used to cover the body (as is clothing) and is also a fashion item. They are considered similar to a medium degree to the earlier articles of clothing.
22. In respect of earlier trade mark '041, it is noted that the term is "outer clothing". Bearing in mind the guidance outlined above, it is considered that to limit this term to meaning only coats and jackets would result in an overly restrictive interpretation. Establishments selling outer clothing routinely offer for sale other items of "outdoor" clothing such as fleeces and showerproof

jackets. They also offer hats, walking shoes and other items such as trousers and shorts with particular qualities such as the ability to dry more quickly. In comparing these goods with those applied for, this interpretation of the earlier term will be borne in mind particularly as it can include items of clothing, the nature of which is already described. Bearing in mind the aforesaid analysis, it is considered that the earlier outer clothing will include similar items to the later terms, irrespective of their exact use. They are similar, to a medium to high degree.


Comparison of marks

23. 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 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.”

24. It would be wrong, therefore, to dissect the trade marks artificially, 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.

25. The respective trade marks are shown below:

	
Earlier trade marks	Contested trade mark

26. It is noted that in respect of the earlier trade mark (a series of two), that it is comprised entirely of DUKE, albeit with a slightly stylised typeface in the case of one of the marks. The impact of this stylisation has no impact on the overall distinctiveness of DUKE. The later trade mark is DUKES. In comparing the two, it is noted that the later trade mark includes the additional letter S. This has the effect of making it a plural version of the earlier trade mark. It is considered that it is still highly similar both visually and aurally.

27. Conceptually, Duke is a royal title and is likely to be understood as such. The same is true of the later trade mark, albeit it is a plural. I do not discount that each of the trade marks will be understood as a surname. In either scenario, the additional S will not create a conceptual gap and so it is considered that the marks are highly similar conceptually.

28. In respect of the remaining earlier trade mark, it is a complex mark. However, the element DUKE appears centrally and in larger font and so is clearly

visually dominant. It is also a distinctive element. Visually, there is considered to be a low to moderate degree of similarity.

29. Aurally, the earlier trade mark will be articulated as DUKE LONDON as opposed to DUKES in the later trade mark. There is a medium degree of aural similarity.

30. Conceptually, the addition of London in the earlier trade mark has some impact but does not detract from the meaning of Duke. Arguably the royal feel is reinforced by the presence of the lion device (and indeed the inclusion of LONDON) but nothing turns on this point. They are highly similar conceptually.

Average consumer and the purchasing act

31. 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 & Co. GmbH v Klijsen Handel BV*, Case C-342/97.

32. 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.”

33. The average consumer of the earlier goods is the public at large. The same is true of the later goods, bearing in mind the seeping of “sports” clothing into general fashion as already commented on. The case law² tells me that visual considerations are important in clothing purchases, although aural considerations will not be ignored. During the purchasing process, the relevant consumer is likely to display a moderate degree of attention as choosing the correct style and size will be important.

Distinctive character of the earlier trade mark

34. In *Lloyd Schuhfabrik Meyer & Co.* 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

² *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03

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).”

35. The opponent provided evidence of use of its earlier trade marks. This has satisfied the threshold for proof of use, but falls short of establishing that the trade marks enjoy an enhanced distinctive character as it is impossible even to gauge the knowledge of the trade marks in respect of the public at large. I therefore have the prima facie position to consider. In respect of the series of two DUKE, it is noted that the word is meaningless for the goods in question. Indeed it is somewhat fanciful. It is considered to have an average degree of distinctive character. In respect of the earlier DUKE London logo trade mark, this includes the additional distinctive feature of a lion device, as additional colour and a stylised letter D. It also includes LONDON. These additional features do have an impact, but it is considered they do not bestow a notably greater degree of distinctiveness overall. It is also distinctive to an average degree.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.

36. The following principles 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 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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

37. The position as regards the earlier word (series of two) trade mark will be considered first. It has been found that the later trade mark is highly similar. This is important as it means the interdependency principle (referred to above) is in full operation here. Whilst it is true that the relevant consumer will pay a moderate degree of attention, it must also be borne in mind that consumers rarely view trade marks side by side. Rather, they rely upon an imperfect picture of them. The earlier trade mark also enjoys an average degree of distinctiveness. The high degree of similarity between the trade marks when attached to goods found to be similar to a medium and/or high degree leads to the inevitable confusion that the relevant public is likely to mistake one trade mark for the other. The case for direct confusion is therefore made out.

38. The opposition therefore succeeds.

39. Strictly speaking, I do not need to consider the position as regards the earlier DUKE LONDON logo mark. However, I will do so for the sake of completeness. Here, it is the goods that are identical, with the exception of the later headgear which is in any case, similar. The earlier trade mark is a complex mark. However, DUKE is its core central component visually, which is highly similar to the later DUKES. It is also distinctive to an average degree. Bearing in mind all of these factors, together with imperfect recollection, it is considered that direct confusion (i.e. the public mistaking one trade mark for

the other) is unlikely to occur as the differences between the marks are such that they are likely to be noticed. However, this is not the end of the matter. In this regard, I bear in mind the following guidance:

40. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

41. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

42. It is considered that though the earlier trade mark is a complex mark, it is DUKE which is dominant and distinctive and will provide the conceptual hook in the mind of the relevant consumer. The later DUKES coincides as a concept. As such, it is considered that the later trade mark is likely to be viewed as another brand of the opponent's. There is a likelihood of indirect confusion and the opposition also succeeds on this basis.

Conclusion

43. The opposition is only against Class 25 and succeeds in its entirety. The remaining (unopposed) class of the application, namely Class 28, may proceed to registration.

COSTS

44. The opponent has been successful and is entitled to a contribution towards its costs. In the circumstances I award the opponent the sum of £2250 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Notice of opposition plus official fee - £500

Preparing and filing evidence - £1000

Preparation for and attendance at Hearing - £750

TOTAL - £2250

45. I therefore order British Cricket Balls Limited to pay Avinash Bassi and Subhash Kumar the sum of £2250. The above sum should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

Dated this 15th day of May 2018

Louise White
For the Registrar