

**O-584-18**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3203816  
BY BENJAMIN AMANNA LTD TO REGISTER:**

**AND STILL**

**AS A TRADE MARK IN CLASS 25**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 408968 BY SOPHIE WHITTAM**

## BACKGROUND & PLEADINGS

1. On 22 December 2016, BENJAMIN AMANNA LTD (“the applicant”) applied to register the above trade mark for the following goods:

**Class 25:** T-shirts; hoodies; tracksuits; hats; gloves; scarfs; bottoms; shirts; headgear; footwear; sweatshirts; vests; underwear; socks; coats.

The application was published for opposition purposes on 6 January 2017.

2. On 6 April 2017, the application was opposed in full by Sophie Whittam (“the opponent”). The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”)<sup>1</sup>, in relation to which the opponent relies upon the following trade mark:

United Kingdom Trade Mark (“UKTM”) 3194516:

**AND THE  
NEW**

Filing date: 2 November 2016

Registration date: 20 January 2017

Ms Whittam indicates that she relies upon all goods for which her mark is registered, namely:

**Class 25:** T-shirts; sweatshirts; hoodies; caps; hats; tracksuits; scarves; socks; underwear; vests; jackets; coats.

3. The applicant filed a counterstatement in which it denies the basis of the opposition.

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<sup>1</sup> Section 5(3) was struck from the opposition due to the opponent’s failure to provide the required clarification regarding her pleadings. It follows that none of the comments provided by the opponent in respect of s.5(3) will be considered for the purpose of these proceedings.

4. The applicant in these proceedings is represented by Vault IP and the opponent is unrepresented. Neither party filed evidence or submissions during the evidence rounds and neither party requested to be heard. Only the applicant filed written submissions in lieu of a hearing. This decision is taken following a careful reading of all the papers which I will refer to, as necessary.

## **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. With a filing date of 2 November 2016, the opponent's mark qualifies as an earlier trade mark under the provisions outlined above. In accordance with section 6A of the Act, as the mark had not been registered for five years or more at the publication date of the application, it is not subject to the proof of use requirements.

### **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 Office for Harmonisation in the Internal Market (Trade Mark and Designs) ("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.

### **The opponent's comments regarding a target market**

9. In her Notice of Opposition, the opponent says of the competing goods:

“They are both targeting the same market and customer base of boxing.”

10. In *Oakley v OHIM*, Case T-116/06, it is made clear that consideration of likelihood of confusion is prospective and not to be restricted to the current marketing or trading patterns of the parties:

“...since the particular circumstances in which the goods covered by the marks are marketed may vary in time, and depending on the wishes of the proprietors of the trade marks, the prospective analysis of the likelihood of confusion between the two marks, ...cannot be dependent on the commercial intentions, whether carried out or not – and which are naturally subjective – of the trade mark proprietors...”

11. Further, marketing strategies are temporal and may change with the passage of time. See for instance, *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P, where the CJEU stated:

“59. As regards the fact that the particular circumstances in which the goods in question were marketed were not taken into account, the Court of First Instance was fully entitled to hold that, since these may vary in time and depending on the wishes of the proprietors of the opposing marks, it is inappropriate to take those circumstances into account in the prospective analysis of the likelihood of confusion between those marks.”

12. In light of the above and given that neither party has provided evidence pertaining to the respective target markets, it follows that I am required to make the assessment of the likelihood of confusion notionally and objectively solely on the basis of the goods (and marks) as they appear on the register. The *actual* part of the market they may target is irrelevant to that assessment. That said, I will return to the opponent’s submission later in the decision.

### **Comparison of goods**

13. The competing goods are as follows:

Opponent's goods	Applicant's goods
<p><u>Class 25</u>: T-shirts; sweatshirts; hoodies; caps; hats; tracksuits; scarves; socks; underwear; vests; jackets; coats.</p>	<p><u>Class 25</u>: T-shirts; hoodies; tracksuits; hats; gloves; scarfs; bottoms; shirts; headgear; footwear; sweatshirts; vests; underwear; socks; coats.</p>

14. In her Notice of Opposition, the opponent states that:

“The phrases will be used in the same goods – tees, sweaters, caps, jackets, etc”.

15. In its submissions, the applicant admits that there is some identity and similarity between the goods, though it has not indicated where it considers the identity or similarity to lie or to what degree this is accepted.

16. The following goods are present in both the applicant's and the opponent's specification and are, therefore, self-evidently identical:

*T-shirts; hoodies; tracksuits; hats; scarfs/scarves; sweatshirts; vests; underwear; socks; coats.*

17. Having made this finding, in the interest of procedural economy, I will, at least initially, continue my assessment on the basis of the competing goods that are identical. Only if necessary shall I return to consider the applicant's remaining goods.

**The average consumer and the nature of the purchasing act**

18. 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.”

19. In *New Look Ltd v Office for the Harmonization in the Internal Market (Trade Marks and Designs)*, joined cases T-117/03 to T-119/03 and T-171/03, the GC said in relation to the selection of clothing:

“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.”

20. The average consumer for the goods at issue in these proceedings is a member of the general public, with the goods most likely to be the subject of self-selection from traditional high street retail outlets, catalogues and websites. For this reason, and as the case law above indicates, visual considerations are likely to play a larger role in the selection process. I do not discount aural considerations as, in my experience, it would not be unusual for orders to be made via telephone or for sales assistants to provide oral recommendations, for example.

21. The goods in dispute are available in a relatively broad range of prices, from very expensive designer goods to those sold by budget brands. Irrespective of cost, when selecting articles of clothing, consumers may consider factors including size, material,




compatibility and so on. This suggests that the average consumer will pay at least an average degree of attention when making their selection.

### Comparison of trade marks

22. 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 CJEU stated at paragraph 34 of its judgment in *Bimbo SA v OHIM*, Case C-591/12P, 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.”

23. It would be wrong, therefore, to artificially 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
	AND STILL

24. The opponent's mark consists of three dictionary words presented in black block capitals, using a fairly standard, bold font. The word 'NEW' is notably the largest of the words and sits underneath 'AND THE'. The two lines of text created as a result span

the same width, providing the mark a sense of structure by creating an impression of a box-like shape absent of any outline. Despite appearing on two separate lines, the words will be read as if appearing on only one<sup>2</sup>. The mark's overall impression lies, in my view, in the unit which is formed by the combination of the three individual words, although the presentation and the greater relative size of the word NEW still plays a role in the overall impression.

25. The applicant's mark is presented in block capitals and comprises two dictionary words, namely 'AND STILL'. Its overall impression rests in its totality, with neither word materially dominating the other.

### **Visual comparison**

26. The opponent's mark possesses a very small degree of stylisation, to the extent described above. The applicant's is entirely devoid of stylisation. The words in the opponent's mark are divided across two tiers; the applicant's only one. Notwithstanding these differences and the discrepancy in the number of words each mark comprises, both begin identically with the word 'AND' which creates some similarity. On balance, I find the marks to be visually similar to a low degree.

### **Aural comparison**

27. Both marks consist of common English language words which the average consumer will be familiar with and accustomed to the pronunciation of. The opponent's mark is likely to be articulated in a total of three syllables, whereas the applicant's mark is likely to be articulated in only two. The first syllable of each is identical which presents, again, some similarity. As I am unable to identify any further likeness between the marks' remaining syllables, I find the degree of aural similarity to reside at a low level.

### **Conceptual comparison**

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<sup>2</sup> *Ella Valley Vineyards (Adulam) Ltd v OHIM*, Case T-32/10

28. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R 29. The assessment must, therefore, be made from the point of view of the average consumer.

29. Of the competing marks' conceptual indications, the applicant states the following:

“... “AND THE NEW” essentially means recently created, or something different from that which existed before, whereas “AND STILL” means to remain the same.”<sup>3</sup>

30. The opponent has not commented upon the conceptual significance of either mark.

31. I find the applicant's above submission to be a fair representation of the concepts which may be evoked by each mark. Their functions differ in the sense that 'AND THE NEW' serves, self-sufficiently, to introduce a recently created entity or individual, whereas 'AND STILL' often precedes a revelation of something which remains or continues. In my view, the average consumer will immediately recognise that the respective concepts are not similar and are, in fact, when approached in this way, almost contradictory.

32. Notwithstanding the above, there is, in my view, a possibility that the average consumer could struggle to attach a definitive concept to either mark. As neither reveals a specific subject, consumers may instead be left wondering what either actually relates to. Consequently, both marks may be viewed as incomplete, and therefore ambiguous, combinations of well-known words. In this instance, I find the marks to be conceptually neutral. The net effect of my finding is that for some average consumers there is conceptual neutrality, but for others, they may see specific, but contradictory (and thus conceptually different), messages.

33. Returning briefly to the applicant's mark, I acknowledge that 'STILL' can also refer to a physical attribute meaning unmoving. This would, again, separate the marks

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<sup>3</sup> See written submissions; page 3; lines 9 to 11

conceptually. However, in my view, beginning with the word 'AND' changes the dynamic of the mark in such a way that it is unlikely, in its entirety, to be interpreted conceptually as a physical description in the mind of the average consumer.

### **Distinctive character of the earlier trade mark**

34. 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. 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).”

35. Without evidence to aid my assessment of the distinctive character of the opponent's earlier trade mark, I have only its inherent characteristics to consider. It is widely accepted, although just a rule of thumb, that words which are invented often

possess the highest degree of distinctive character, whilst words which are allusive or suggestive of the goods and/or services relied upon generally possess the lowest.

36. I begin by reminding myself that the mark's overall impression lies in its entirety and that it comprises three well known dictionary words. When viewed in the context of the relevant goods, reference to something 'NEW', though not restricted to use in relation to clothing, may be considered allusive of the goods' nature insofar as it informs the consumer that the article is not second hand or, perhaps, that it represents an original or innovative range. While none of the words within the mark are particularly distinctive when assessed independently, in my view, the positioning of the word 'AND', i.e. at the beginning of the mark, contributes to the mark's distinctiveness, acting unusually in an introductory capacity (instead of occupying its traditional role as a connector). On balance, I find the opponent's mark to possess an average degree of distinctiveness.

### **Likelihood of confusion**

37. 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.

38. 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.”

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.

39. 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.

40. I take note of the comments made by Mr Iain Purvis Q.C., as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, where he 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. Earlier in this decision I reached the following conclusions:

- Some of the competing goods are identical;
- The average consumer is a member of the general public who will select the goods predominantly by visual means. I do not discount an aural element;
- At least a normal degree of attention will be paid to the selection of goods to the extent necessary to obtain, for example, size, material, compatibility and so on;
- The competing trade marks are visually and aurally similar to a low degree;
- The competing trade marks are either conceptually dissimilar or conceptually neutral;
- The opponent's trade mark possesses an average degree of inherent distinctive character.

43. To properly assess the likelihood of confusion, I must adopt the global approach advocated by the case law and take account of each of the above conclusions. I 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 chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them retained in their mind. In doing so, I am satisfied that the contrasting overall impressions of the respective marks, combined with their visual differences, are sufficient to preclude a likelihood of direct confusion. In my view, the marks simply do not have enough in common for consumers to likely mistake one for the other.

44. This leaves indirect confusion to consider. The common element between the competing marks is their shared beginning; the word 'AND' which, while I have suggested is unusually positioned, is by no means an independent or defining component of either mark, nor is it so 'strikingly distinctive' that the average consumer

is likely to erroneously assume that an economic connection exists between them. I imagine, instead, that consumers would find the shared presence (and location) of 'AND' purely coincidental. When it comes to the marks' remaining elements, I find it extremely unlikely that an exchange of 'THE NEW' for 'STILL' would be viewed, under any circumstance, as a probable brand extension. In light of these findings and given the marks' neutral or contradictory conceptual indications, I am of the view that consumers are likely to conclude, correctly so, that they originate from separate undertakings. In short, there will be no indirect confusion. Having made this finding in respect of identical goods, it follows that there can be no confusion for goods with a lower level of similarity. Consequently, considering the degree(s) of similarity attributable to the applicant's remaining goods would have no bearing on the outcome of the opposition.

45. Finally, I return to the opponent's assertion that both trade marks target the same market and customer base of boxing, which presumably comprises participants and spectators alike. I do so because those familiar with the sport are still average consumers of the goods. Therefore, for the sake of completeness, I will briefly approach the likelihood of confusion with this in mind. In doing so, I remain satisfied that the visual differences between the marks are sufficient to mitigate against a likelihood of direct confusion. Furthermore, I find it unlikely that even consumers who are familiar with boxing will immediately identify a relationship (if one does indeed exist) between the respective marks, with some still failing to attribute a relevance or concept to either. Of the consumers who may, as a matter of fact, be aware that both phrases could be used in boxing to precede the announcement of a new or existing champion, it would in my view represent an overly analytical and artificial approach to assume that they would identify that aspect of similarity between the marks and then, in the unlikely event that they did, go on to make an assumption of economic origin. There is no indirect confusion. The outcome of the decision remains unaltered.

### **Overall conclusion**

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



## **Costs**

47. As the applicant has been successful, it is entitled to a contribution toward its costs. Awards of costs in proceedings are governed by Annex A of Tribunal Practice Notice (“TPN”) 2 of 2016. Applying the guidance in that TPN, I award costs to the opponent on the following basis:

Preparing a counterstatement: £200

Written submissions: £200

**Total: £400**

**48. I order Sophie Whittam to pay BENJAMIN AMANNA LTD the sum of £400. 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 24<sup>th</sup> day of September 2018**

**Laura Stephens  
For the Registrar**