

BL O/631/18

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION 3259047

BY

ELEVEN ELEVEN CLOTHING LIMITED

TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 25:



AND

OPPOSITION THERETO (NO. 411030)

BY

Eleven teamsports GMBH

Background and pleadings

1. Eleven Eleven Clothing Limited (the applicant) applied to register the trade mark:



in the UK on 25 September 2017. It was accepted and published in the Trade Marks Journal on 13 October 2017, in respect of:

Class 25: Tee-shirts.

2. eleven teamsports GMBH (the opponent) oppose the trade mark on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (the Act). This is on the basis of two earlier European (EU) Trade Marks, namely:
3. EU TM 011244266, filed on 05 October 2012 and registered on 17 May 2013, for the mark:



4. EU TM 013449384, filed on 07 November 2014 and registered on 17 March 2015, for the mark:

11running

5. Both earlier marks are registered in a number of classes, however for the purposes of this opposition, the opponent relies only on the class 25 element in each of its EU TMs. The following goods are relied upon in this opposition:

EU TM 011244266

Class 25: Clothing, footwear, headgear; Heels; Heelpieces for footwear; Suits; Babies' pants [clothing]; Layettees [clothing]; Swimsuits; Bathing trunks; Bath robes; Bathing caps; Bath sandals; Bath slippers; Bandanas [neckerchiefs]; Berets; Leg warmers; Clothing of imitations of leather; Motorists' clothing; Clothing; Paper clothing; Boas [necklets]; Teddies [undergarments]; Brassieres; Chasubles; Dresses; Shower caps; Inner soles; Pocket squares; Masquerade costumes; Mittens; Fishing vests; Football boots; Footmuffs, not electrically heated; Gabardines [clothing]; Galoshes; Spats; Money belts [clothing]; Non-slipping devices for footwear; Belts [clothing]; Clothing for gymnastics; Gymnastic shoes; Half-boots; Scarfs; Gloves [clothing]; Slips [undergarments]; Shirt yokes; Shirts; Shirt fronts; Wooden shoes; Trousers; Gaiter straps; Suspenders; Girdles; Hats; Hat frames [skeletons]; Jackets [clothing]; Jerseys [clothing]; Stuff jackets [clothing]; Bodices [lingerie]; Skull caps; Hoods [clothing]; Ready-made linings [parts of clothing]; Pockets for clothing; Ready-made clothing; Headgear for wear; Camisoles; Corsets [underclothing]; Shoulder wraps; Detachable collars; Neckties; Ascots; Short-sleeve shirts; Bibs, not of paper; Clothing of leather; Leggings [trousers]; Underwear; Liveries; Maniples; Cuffs; Coats; Pelisses; Mantillas; Corselets; Miters [hats]; Dressing gowns; Muffs [clothing]; Caps [headwear]; Cap peaks; Outerclothing; Ear muffs [clothing]; Combinations [clothing]; Slippers; Paper hats [clothing]; Parkas; Pelerines; Furs [clothing]; Petticoats; Ponchos; Pullovers; Pyjamas; Cyclists' clothing; Welts for footwear; Waterproof clothing; Skirts; Sandals; Saris; Sarongs; Collar protectors; Sashes for wear; Sleep masks; Veils [clothing]; Wimples; Breeches for wear; Lace boots; Fittings of metal for footwear; Shoes; Soles for footwear; Footwear uppers; Tips for footwear; Footwear; Smocks; Aprons [clothing]; Dress shields; Ski gloves; Ski boots; Skorts; Underpants; Socks; Sock suspenders; Boots for sports; Sports shoes; Boots; Boot uppers; Headbands [clothing]; Esparto shoes or sandals; Shawls; Fur stoles; Studs for football boots; Beach clothes; Beach shoes; Garters; Stockings; Stockings (Sweat-absorbent -); Heelpieces for stockings; Stocking suspenders; Tights; Sweaters; Tee-

shirts; Togas; Jumper dresses; Knitwear [clothing]; Singlets; Turbans; Topcoats; Uniforms; Underwear (Anti-sweat -); Pants; Wet suits for water-skiing; Vests; Hosiery; Top hats.

EU TM 013449384

Class 25: Clothing; Footwear; Headgear; Heelpieces for footwear; Heelpieces for footwear; Suits; Babies' pants [clothing]; Layettes [clothing]; Swimming costumes; Bathing trunks; Bath robes; Swimming caps; Bath sandals; Bath shoes; Bandanas [neckerchiefs]; Leg warmers; Clothing of imitations of leather; Tights; Brassieres; Shower caps; Soles for footwear; Pocket squares; Mittens; Fishing vests; Football boots; Gabardines [clothing]; Belts (Money -) [clothing]; Non-slipping devices for footwear; Belts [clothing]; Clothing for gymnastics; Gymnastic shoes; Ankle boots; Scarves; Gloves; Slips [undergarments]; Shirt yokes; Shirts; Shirt fronts; Pants (Am); Trouser straps; Garters; Girdles; Headgear; Frames (Hat -) [skeletons]; Jackets [clothing]; Jumpers; Skull caps; Hoods [clothing]; Clothing for children; Linings (Ready-made -) [parts of clothing]; Pockets for clothing; Compression clothing; Ready-to-wear clothing; Headgear; Corsets; Shoulder wraps; Short-sleeve shirts; Clothing of running; Running shoes; Clothing of leather; Leggings [trousers]; Underwear; Light-reflecting clothing; Light-reflecting footwear; Cuffs; Jackets; Corsets; Muffs (clothing); Caps [headwear]; Cap peaks; Outerwear; Ear muffs [clothing]; Combinations [clothing]; Parkas; Ponchos; Pullovers; Cyclists' clothing; Welts for footwear; Mackintoshes; Collar protectors; waistwraps; Lace boots; Footwear; Soles for footwear; Footwear uppers; Tips for footwear; Footwear; Overalls; Sweatbands; Dress shields; Shirts; Ski gloves; Ski boots; Skorts; Pants (Am); Socks; Sock suspenders; Sportswear; Sports jackets; Sports socks; Sports caps; Sports shoes; Athletics vests; Boots; Footwear uppers; Headbands [clothing]; Espadrilles; Shawls; Beachwear; Beach shoes; Stockings; Stockings (Sweat-absorbent -); Garters; Tights; Pullovers; Tee-shirts; Kerchiefs [clothing]; Exercise suits; Knitwear [clothing]; Singlets; Topcoats; Sweat-absorbent underwear; Pants (Am); Underwear; Wetsuits for water-skiing; Waistcoats; Hosiery.

6. The opponent states that the applied for mark consists of the numeral '11' and the word 'eleven', both of which are repeated twice in a mirror image. The opponent's

earlier EU TM 011244266 contains the numeral '11' together with the words 'Team sports' in a stylised logo format. The Opponent's earlier EU TM 013449384 contains the numeral '11' and the word 'running'. They submit that the number '11' is highly distinctive for clothing and therefore this is a core element of the opponent's earlier marks. On this basis, the opponent submits that the respective marks are similar to a high degree, visually, aurally and conceptually. Further, they state that the applied for mark covers identical goods to those covered by the opponent's earlier marks, namely a range of clothing items in Class 25. As a result of the high similarity between the marks, and the identical nature of the goods, the opponent claims that there exists a "strong possibility" that any use of the later mark will be mistakenly regarded by consumers as use by the opponent.

7. In its counterstatement, the applicant states that the marks at issue do not look the same or represent the same goods or services whatsoever. It claims that the only resemblance between the marks is the numeral '11' and that the overall stylization and get up in the marks is very different. It adds that its trade mark represents a time format (11.11 am) whilst it believes that the opponent's trade marks refer to the number of members in a football team. The applicant states that its company only supplies music and art slogan t-shirts to the dance music underground, i.e. DJs and underground dance music fans, whilst the opponent supplies clothing to the sportswear market, an area that the applicant has no interest in expanding into.
8. The applicant did not file evidence or written submissions. The opponent filed written submissions and evidence. The evidence is comprised of a witness statement of Sarah Talland, partner at Wilbore Gibbons LLP, the opponent's representative, and two exhibits. Ms Talland's witness statement merely confirms her standing in these proceedings and introduces the two exhibits, ST1 and ST2.
9. Exhibit ST1 comprises extracts from the website of Sports Direct.com, a well-known clothing retailer, showing tee-shirts for sale. Ms Talland claims, in paragraph 13 of her witness statement, that the information provided under ST1 is evidence of different types of clothing, particularly sportswear and slogan tee-shirts, being sold in the same establishments. As a result, she states that consumers are used to viewing both types of clothing in the same retail environments and therefore consider the

goods to be highly similar at the very least. This exhibit is not particularly clear, and it is not obvious as to whether the opponent's marks or goods are depicted in any of the extracts. That being the case, exhibit ST1 provides nothing more than an illustration that large clothing retailers generally provide a wide range of goods for their customers consideration.

10. Exhibit ST2 comprises a copy of an EU IPO opposition decision, which Ms Talland suggests is supportive in this case, as the marks and goods involved in that decision are very similar to those in this matter. In the EU IPO decision, the marks at issue contain the numeral '11' and/or the word 'eleven' and the goods involved are clothing. I take note of this decision, but I am not convinced of its relevance due primarily to the question of relevant territory. In the EU IPO decision, the relevant territory was Spain, in which the relevant public might be said to be unaware of the meaning of the English word 'eleven'.

11. The opponent's written submissions state that the applicant is entirely incorrect in its assessment of the level of similarities between the marks at issue. The opponent states that all of the marks are dominated by the numeral '11', which also comprises the distinctive element in each of the marks. The opponent states that the numeral '11' forms the beginning of each mark and that it is established in case law that consumers will attach greater importance to the first part of a word¹. The opponent also states that the consumer will pay more attention to the verbal elements in a mark than the visual elements².

12. The opponent states that the applied for mark will be pronounced as 'eleven, eleven' which will reinforce the similarities between the marks, due to the repetition of the numeral. The opponent also adds that the goods at issue are everyday consumer items and the relevant public will therefore pay no more than an average degree of care and attention when purchasing the goods. As far as the applicant's claim that the goods sold by the opponent are sportswear items unrelated to the applicant's area of interest, the opponent rejects this argument. The opponent states that the goods at issue are identical and that the scope of the class 25 specifications of their

¹ GC, 13 February 2008, *Sanofi-Aventis/OHIM – GD Searle, T-146/06*, paragraph 49

² GC, 22 May 2008, *NewSoft Technology/OHIM – Soft, T-205/06*, paragraph 54

earlier marks includes all types of clothing including casual clothing such as tee-shirts.

13. The opponent claims that, as the marks are highly similar and the goods are identical, there is a likelihood that consumers will be confused when faced with these marks in the marketplace.

14. No hearing was requested and so this decision is taken following a careful perusal of the papers.

15. The applicant has represented itself throughout the proceedings and the opponent has been professionally represented by Wildbore Gibbons LLP.

Decision

Section 5(2)(b) of the Act

16. 5(2)(b) of the Act states:

“(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.”

17. The following principles are gleaned from the decisions of the Court of Justice of the European Union (“the CJEU”) 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.

Comparison of goods

18. The applied for goods are 'Tee-shirts' in class 25. The opponent's earlier goods, as set out above in paragraph 5, include the goods 'Tee-shirts'. The goods at issue are therefore identical.

Average consumer and the purchasing act

19. 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, Case C-342/97*.

20. 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.”

21. The average consumer of Tee-shirts will be a member of the general public.
22. The selection of clothing is largely a visual process, as the average consumer will wish to see the goods and assess the overall aesthetic impact. I do not, however, ignore the potential for the marks to be spoken, for example, by sales assistants in a retail establishment or when making a purchase from a catalogue, over the telephone. However, in those circumstances, the consumer will have had an opportunity to view the goods, perhaps electronically via an online catalogue or website, or on paper in the traditional sense of catalogue shopping. Therefore, when considering the aural impact of the marks, the visual impression of these goods will already have played a part in the consumer’s mind.
23. As the goods at issue are day to day items of clothing, the average consumer will pay no more than a medium level of attention during the selection of those goods.

Comparison of marks

24. 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.”

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

26. I will begin by comparing the application with the opponent’s EU TM **013449384**. I will move on to consider the other earlier mark, later in this decision.

27. The respective trade marks are shown below:

EUTM 013449384	Contested trade mark
11running	

28. The opponent’s mark consists of the numeral ‘11’ and the word ‘running’, presented together in a conjoined manner and in standard plain typeface. The word ‘running’ is non-distinctive for tee-shirts intended to be worn whilst running. The overall impression in the mark lies in the totality of the expression ‘11running’, although I accept that the numeral ‘11’ is likely to have more significance in the overall impression.

29. The applicant’s mark is comprised of the numeral ‘11’ presented twice, with a black square placed between them. This element may be perceived as indicating a date, i.e. the eleventh of November, or a time displayed digitally. Equally, it may be perceived merely as the numeral ‘11’ duplicated. The word ‘Eleven’ is also presented

twice, in a mirrored effect beneath the numerals, and the words 'CLOTHING COMPANY LTD' are placed in very small lettering at the bottom of the mark underneath a thin red line. The elements with greatest relative weight in the overall impression lie in the more dominant element '11.11' which is the much larger, eye-catching part of the applied for mark, together with the slightly smaller repeating and mirrored words eleven eleven. The element CLOTHING COMPANY LIMITED has little relative weight in the overall impression given the size and role it plays in the mark.

Visual similarity

30. Visually, the respective marks are similar in that both share the numeral '11'. They differ however, in the word 'running' in the earlier mark, which has no counterpart in the applied for mark. They also differ in the fact that in the later mark, the numeral '11' is presented twice; in the word 'Eleven' which is displayed twice in a mirrored design; in the thin red underlining of the mirrored element 'neveEEleven' and in the words 'CLOTHING COMPANY LTD' (although I accept these two differences are not overly significant), which are all present in the later mark and share no counterpart in the earlier mark. The marks are considered to be visually similar to a low degree.

Aural similarity

31. Aurally, the opponents' mark will be articulated as *EL/EV/EN/RUN/ING*. The applicant's mark will be articulated in the conventional manner, with the enunciation of each of the verbal elements in turn. It is likely that a part of the relevant public may refer to the applicant's mark as '*ELEVEN ELEVEN*', as the two numerals in that mark are the more dominant elements. In that regard, where the other verbal elements in the applicant's mark are not enunciated, the marks are considered to be aurally similar to a medium degree. It is also the case however, that the first four verbal elements in the applicant's mark could be identically enunciated as *EL/EV/EN*. Where the word 'eleven' will be enunciated four times in succession and followed then by the words 'CLOTHING COMPANY LIMITED', the marks are found to be aurally similar to a low degree.

Conceptual similarity

32. The earlier mark is the number '11' coupled with the word 'running', which has no obvious meaning overall. The conceptual impression in that mark will primarily be of the number itself. Whilst the applied for mark has no concrete meaning when considering the mark in totality, the numerals '11.11' may be perceived as a time or a date. The applied for mark also contains the descriptive expression 'CLOTHING COMPANY LTD' albeit, that word string is presented in very small lettering and may be considered *de minimus* as a result of its size within the mark. The marks are found to be conceptually similar to a medium degree.
33. In conclusion, the marks are found to be visually similar to a low degree, aurally similar to either a low degree or a medium degree, depending on the perception of the average consumer, and conceptually similar to a medium degree.

Distinctive character of the earlier trade mark

34. 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. The opponent has made no claim that either of its earlier marks have acquired an enhanced degree of distinctive character. I must therefore assess the marks purely on their inherent distinctive character. The earlier mark under consideration is comprised of the numeral ‘11’ and the word ‘running’ conjoined. In *Kurt Geiger v A-List Corporate Limited*, BL O/075/13, Mr Iain Purvis Q.C., sitting as the Appointed Person, observed 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.”

36. In this instance, the common element ‘11’ has no particular link or association with the goods at issue and is therefore found to have some level of distinctive character. However, as the use of numerals on clothing is not particularly uncommon, the distinctiveness of the element ‘11’ can be said to be lower than a medium level. The word ‘running’, when considered independently, will be perceived merely as a descriptive term used to indicate that the goods can be used when running or doing

some exercise that involves running. However, the assessment of distinctiveness of the earlier mark must be based on the combination '11running' which has no obvious meaning as a whole. The addition of the word 'running' to the numeral '11' does add something to the overall distinctiveness of the mark, as the totality is unusual. However, based on the observations of Mr Purvis set out above, this does not necessarily assist. As a consequence, I find the earlier mark to have an average degree of inherent distinctive character.

Likelihood of Confusion

37. The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

38. Confusion can be direct (which effectively occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same, but puts the similarity that exists between the marks/services down to the responsible undertakings being the same or related).

39. In *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03, the General Court stated that:

“49. However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (*BUDMEN*, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumer choose the product themselves

and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs.”

40. In *Quelle AG v OHIM*, Case T-88/05, the General Court found that visual similarity (and difference) is most important in the case of goods that are self-selected or where the consumer sees the mark when purchasing the goods. The Court stated:

“69. Likewise, the degree of phonetic similarity between two marks is of less importance in the case of goods which are marketed in such a way that, when making a purchase, the relevant public usually perceives visually the mark designating those goods (*BASS*, paragraph 56 supra, paragraph 55, and Case T-301/03 *Canali Ireland v OHIM – Canal Jean (CANAL JEAN CO. NEW YORK)* [2005] ECR II-2479, paragraph 55). That is the case with respect to the goods at issue here. Although the applicant states that it is a mail order company, it does not submit that its goods are sold outside normal distribution channels for clothing and shoes (shops) or without a visual assessment of them by the relevant consumer. Moreover, while oral communication in respect of the product and the trade mark is not excluded, the choice of an item of clothing or a pair of shoes 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 (*NLSPORT, NLJEANS, NLACTIVE and NLCollection*, paragraph 53 supra, paragraph 50). The same is true of catalogue selling, which involves as much as does shop selling a visual assessment of the item purchased by the consumer, whether clothing or shoes, and does not generally allow him to obtain the help of a sales assistant. Where a sales discussion by telephone is possible, it takes place usually only after the consumer has consulted the catalogue and seen the goods. The fact that those products may, in some circumstances, be the subject of discussion between consumers is therefore irrelevant, since, at the

time of purchase, the goods in question and, therefore, the marks which are affixed to them are visually perceived by consumers.”

41. Due to the nature of the goods at issue, namely tee-shirts, the visual impact of the marks will carry the most weight in the mind of the average consumer, during the selection and purchasing process.

42. The marks have been found to be visually similar only to a low degree. Notwithstanding the aural and conceptual similarities that have been identified earlier, the visual differences between the marks at issue are clear. Therefore, in terms of direct confusion, I do not consider it likely that the average consumer will mistake the applicant's marks for the opponent's, even having found that the goods are identical, and even taking into account imperfect recollection.

43. Having found that there is no direct confusion between the marks, I must consider the possibility of indirect confusion.

44. Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10 noted that:

“16. ...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.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but

the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

45. These examples are not exhaustive, but provide helpful focus.

46. In the present case, the commonalities between the marks at issue lie in the numeral ‘11’. The use of numerals on clothing, particularly casual items such as tee-shirts, cannot be said to be so strikingly distinctive that the average consumer of such goods would be surprised to find other traders utilising such elements on their products.

47. In my opinion, the applicant’s mark cannot be said to simply add a non-distinctive element to the opponent’s earlier mark ‘11running’. In fact, the opposite could be said to be the case. The stylised use of the word ‘Eleven’ presented twice, in a mirror effect, is likely to be perceived as distinctive matter, serving to set these marks apart in the mind of the average consumer.

48. The applied for mark would not, in my opinion, be considered by the relevant public to be a logical brand extension or evolution of the opponent’s earlier mark. The use of a numeral on clothing is not so unusual that the inclusion of the numeral ‘11’ on the applicant’s products would automatically be considered by the relevant public as a brand extension of the opponent’s product range when the mark, as a whole, is taken into account.

49. 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.

50. In this instance, I find that the visual differences between the marks are so significant that, whilst the inclusion of the numeral '11' and the word 'eleven' may possibly call the opponent's mark to mind, this would represent mere association and indirect confusion would not occur.

51. Having found that the marks will not be confused, I now go on to consider the opponent's second earlier mark namely, **EU TM 011244266** for the mark:



52. Whilst the goods at issue are identically covered in both cases, namely 'Tee-shirts', this earlier mark is, due to the stylisation incorporated in the overall design, less similar to the applied for mark than the opponent's first earlier mark compared above. I find that there would be no direct confusion between these marks, as the average consumer would readily appreciate the visual differences between them and would not mistake one for the other.

53. For the reasons I have previously stated, I do not believe that indirect confusion would occur between these marks either.

Conclusion

54. There is no likelihood of confusion. The opposition fails. The application may, subject to appeal, proceed to registration.

Costs

55. The applicant has been successful and is entitled to a contribution towards its costs. I bear in mind that the relevant scale is contained in Tribunal Practice Notice ("TPN") 2/2016. I award costs to the applicant as follows:

Preparing a statement of case and considering the counterstatement:	£200
Considering the opponent's evidence:	£500
<u>Total</u>	<u>£700</u>

56.I therefore order eleven teamsports GMBH to pay Eleven Eleven Clothing Limited the sum of £700. 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 8th day of October 2018

**Andrew Feldon
For the Registrar
The Comptroller-General**