

O-026-19

TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK APPLICATION NO 3257253
BY JAMIE BUNYAN
& STEPHANIE AFONSO CADETE
TO REGISTER

ADDICTION
ITS
AN

AS A TRADE MARK
IN CLASS 25
AND OPPOSITION THERETO (UNDER NO. 411269)
BY
LONDON IP EXCHANGE LIMITED

Background & pleadings

1. Jamie Bunyan and Stephanie Afonso Cadete ('the applicants') applied to register the mark outlined on the title page on 17 September 2017. The mark was published on 6 October 2017 in class 25 for the following goods: *Clothing*.

2. London IP Exchange Limited ('the opponent') opposes the mark under Section 5(2)(b) of the Trade Marks Act 1994 ('the Act') against all goods in the application, on the basis of its earlier UK trade mark set out below.

| | |
|--|------------------|
| UK TM No. 3074256 | Goods relied on: |
| ADDICTION Filing date: 26 September 2014 Registration date: 16 October 2015 | 25: Clothing. |

3. The applicants filed a counterstatement in which they give details of involvement in previous proceedings with the opponent and state that there are many other TM owners using the mark **Addiction**.

4. The opponent's trade mark is an earlier mark, in accordance with section 6 of the Act, but as it has not been registered for five years or more before the publication date of the applicant's mark, it is not subject to the proof of use requirements, as per section 6A of the Act.

5. In these proceedings the applicants are representing themselves whilst the opponent is represented by Fieldfisher LLP.

6. The applicants filed evidence but neither side filed written submissions. A hearing was not requested so I make this decision based on a consideration of the papers before me.

Applicants evidence and other preliminary issues

7. The applicants filed a witness statement and appended two exhibits. The content of the witness statement did not comprise the usual information required of evidence and is more akin to submissions relating to the meaning of the mark, which I have taken into account. The first exhibit consists of a representation of the mark and the second exhibit is an undated image of two models. The female model in the image is wearing shorts which show the contested mark on the waistband. Having reviewed this exhibited material, I do not consider it to be of assistance to me as I must consider the marks on a fair and notional basis with consideration to the marks and the goods as registered.

8. I must also address the point made by the applicants in their counterstatement that “there are many previous trade marks using the word ‘addiction’ and many similar clothesline trademarks running with no confusion”. The issue of co-existing trade marks on the register containing the same element has previously been considered and found to be not relevant, most notably in *Zero Industry Srl v OHIM*, Case T-400/06, where the General Court dismissed this type of approach, stating that “the mere fact that a number of trademarks relating to the goods at issue contain the word ‘zero’ [i.e. the shared element] is not enough to establish that the distinctive character of that element has been weakened”.

Decision

9. 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.

10. The leading authorities which guide me are from the Court of Justice of the European Union (‘CJEU’): *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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

11. The opponent's earlier mark is registered for *clothing* in class 25 which is self-evidently identical to the *clothing* in the contested application.

Average consumer and the purchasing act

12. It is necessary to consider the role of the average consumer and how the goods are purchased. 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*.

13. 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.”

14. The guidance given in *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03 is also appropriate here as the goods in that case were also clothing. 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.”

And

“50..... Generally in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to

purchase. Accordingly the visual aspect plays a greater role in the global assessment of the likelihood of confusion.”

15. The average consumer for the contested goods in this case is a member of the general public. The goods can be sold in traditional bricks and mortar retail clothing stores as well as online and through mail order. As set out above in *New Look*, the act of purchasing clothing will be a primarily visual process and factors such as aesthetics, functionality and fit in addition to the cost will come into play. In traditional bricks and mortar retail premises, the average consumer will be viewing and handling the clothing and possibly trying garments on. In an online website or mail order catalogue, a consumer will be viewing images of the goods before selection. Given that clothing prices can vary from garment to garment, I conclude that an average consumer will be paying a reasonable degree of attention during the purchasing process. Although I have found the purchasing process to be primarily visual, I do not discount any aural consideration such as word of mouth recommendations.


Comparison of the marks

16. It is necessary to compare the marks. 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.”

17. 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.

18. The marks to be compared are:

| Opponent's mark | Applicants' mark |
|------------------|--|
| ADDICTION |  |

19. The opponent's trade mark consists of a single word **ADDICTION** in upper case. It has no other elements to it. The overall impression of the mark and its distinctiveness rests solely in that word.

20. The applicants' mark is a stylised arrangement of the words **ITS AN ADDICTION** with an underlining of the last four letters. Although the words **ITS AN** are positioned in place of a cross bar of the letter A in **ADDICTION**, the word is clearly readable as 'addiction'. In the mark as a whole, the words **ITS AN** play a subordinate and weaker role given their relatively small size in comparison to the word **ADDICTION**, which in my view forms the dominant and distinctive element.

21. In a visual comparison, the point of similarity is the word **ADDICTION**. This is the entirety of the opponent's mark and the dominant element of the applicants' mark. Although the applicants have the words **ITS AN** and the underlining as a point of visual difference, these are much smaller in scale, play only a weak role and have much less visual impact. Overall, when taking these factors into account, I find there is high level of visual similarity.

22. In an aural comparison, the point of similarity is again the word **ADDICTION**, which will be pronounced identically in each mark. The opponent has no other aspect to its mark, whereas the applicants have the additional words **ITS AN**. It is arguable as to whether those words would be verbalised, given their size and positioning within the letter A. If those words are verbalised then I find that there is a

medium degree of aural similarity. If they are not verbalised then I would categorise the level of aural similarity as identical.

23. Turning now to the conceptual comparison, the word **Addiction** will bring to mind its usual dictionary definition and this concept will be identical in both marks. The applicants, in their witness statement, state that the addition of the words **ITS AN** act as a confirmation of the word **ADDICTION**. I agree that in the context of the contested mark, the words **ITS AN** do act in a confirmatory sense in relation to word **ADDICTION** but do not add anything significantly more to the overall concept of the mark. It merely renders the mark as at least conceptually highly similar to the earlier right.

Distinctive character of the earlier mark

24. The distinctive character of the earlier mark must be considered. The more distinctive it is, either inherently or through use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or

services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

25. There is no evidence before me in relation to the earlier mark so I have only the inherent position to consider. The earlier mark consists of an ordinary dictionary word which is not descriptive or allusive of the goods for which it is registered. As such I find it to be inherently distinctive to an average degree.

Likelihood of confusion

26. I now draw together my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors and those outlined in paragraph 10:

- a) The interdependency principle, whereby a lesser degree of similarity between the goods may be offset by a greater similarity between the marks, and vice versa (*Canon*).
- b) The principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*).
- c) Imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer*).

27. Confusion can be direct (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/goods down to the responsible undertakings being the same or related).

28. So far, I have found that that the contested goods are identical and that the average consumer will be paying a reasonable degree of attention in a primarily visual purchasing process. In addition I have found that the earlier mark is inherently distinctive to an average degree and that the marks in this case are visually similar to a high degree, aurally similar to a medium degree but the aural

similarity being identical if the words **ITS AN** are not pronounced, and the marks are conceptually highly similar.

29. Taking all of this into account, I find that the visual similarity being so high, given that the goods are primarily purchased visually, is a key factor in my decision. In my view the visual, aural and conceptual differences, such as they are, between the marks are insufficient to offset the similarities in the mind of the average consumer purchasing the goods. I must consider that the average consumer rarely has the chance to make a direct comparison of the marks, instead relying on the imperfect picture of them that they have kept in their mind, and bearing in mind the fact that both parties' marks contain the identical and distinctive element **ADDICTION**, I find there is a likelihood of direct confusion.

Conclusion

30. The opposition succeeds under section 5(2)(b) and, subject to any successful appeal against my decision, the application is refused in its entirety.

Costs

31. As the opponent has been successful, it is entitled to a contribution towards the costs incurred in these proceedings. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 2/2016. Using the guidance in that notice I make the following award:

£100 Official fee for filing the Notice of Opposition

£200 Preparing the Notice of Opposition

£300 Total

32. I order Jamie Bunyan and Stephanie Afonso Cadete to pay London IP Exchange Limited the sum of £300. This sum is to be paid within 14 days of the expiry of the appeal period or within 14 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 15th day of January 2019

**June Ralph
For the Registrar,
The Comptroller General**