

O-628-19

TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK APPLICATION NO. 3318906
BY DEBORAH REID
TO REGISTER




Imperfect Angel
perfectly imperfect

AS A TRADE MARK
IN CLASS 25
AND OPPOSITION THERETO (UNDER NO. 413647)
BY
FIVE SEASONS S.R.L.

Background & Pleadings

1. Deborah Reid ('the applicant') applied to register the trade mark set out on the title page on 19 June 2018. It was published in the Trade Mark Journal on 6 July 2018 in class 25. The goods will be set out later in this decision.

2. Five Seasons S.r.l. ('the opponent') opposes the application on the ground of section 5(2)(b) of the Trade Marks Act 1994 ('the Act') on the basis of the two EU Trade Marks ('EU TM') set out below. The goods relied on will be set out later in this decision. The opponent also pleaded an additional ground under section 5(3) in the Notice of Opposition. However, this ground was subsequently withdrawn in its written submissions dated 18 March 2019.

EU TM No.12871703	EU TM No.13743968
<p data-bbox="204 969 632 1025">IMPERFECT 22</p> <p data-bbox="204 1122 692 1211">Filing date: 13 May 2014 Registration date: 8 October 2014</p>	 <p data-bbox="810 1151 1238 1240">Filing date: 16 February 2015 Registration date: 6 July 2015</p>

3. The opponent claims under section 5(2)(b) that the applicant's mark is similar to its earlier marks and is applied for in respect of identical or similar goods to those in the specifications of the earlier marks. In consequence, there exists a likelihood of confusion.

4. The opponent's trade marks are earlier marks, in accordance with section 6 of the Act but, because they have not been registered for five years or more at the publication date of the applicant's mark, they are not subject to the proof of use requirements, as per section 6A of the Act.

5. The applicant is not represented in these proceedings and the opponent is represented by Keltie LLP. Both parties provided written submissions in lieu of a hearing. I make this decision from the material before me.

Section 5(2)(b)

6. Section 5(2)(b) of the Act states 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.

7. 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

8. In her written submissions dated 24 July 2019 the applicant states that,

“The brand Imperfect are already an international name, that trades worldwide with a completely different clothing line and presence. It is more of a high fashion clothing brand that is a far cry from that of Imperfect Angel. Imperfect Angel is geared toward the fitness and leisure industry, initially starting with t-shirts and sweatshirts then branching out to include jogging bottoms, polo shirts, caps etc.”

9. Even if I accept that the applicant and the opponent operate in different clothing markets, this would not in any case be relevant to the issue of confusion which I must decide in these proceedings. It is settled law that in assessing whether there is a likelihood of confusion I must make my comparison on the basis of notional and fair use of the marks for the whole range of goods covered by the parties' respective specifications. My task, therefore, is to conduct the comparison of the goods as they are set out in the respective specifications. The concept of 'notional and fair use' is outlined in *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220 , particularly paragraph 78,

“78.the court must.... consider a notional and fair use of that mark in relation to all of the goods or services in respect of which it is registered. Of course it may have become more distinctive as a result of the use which has been made of it. If so, that is a matter to be taken into account for, as the Court of Justice reiterated in *Canon* at paragraph [18], the more distinctive the earlier mark, the greater the risk of confusion. But it may not have been used at all, or it may only have been used in relation to some of the goods or services falling within the specification, and such use may have been on a small scale. In such a case the proprietor is still entitled to protection against the use of a similar sign in relation to similar goods if the use is such as to give rise to a likelihood of confusion.”

10. The following case law is also applicable in these proceedings. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, 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”.

11. Both earlier marks share the same specification so it will only be set out once. For reasons which are explained below, I will be comparing the following class 25 goods only:

Opponent’s goods	Applicant’s goods
Clothing, and in particular t-shirts, shirts, pullovers, trousers, skirts, jeans, jackets, swimsuits, underwear, headgear, footwear.	Clothing; Boys' clothing; Cyclists' clothing; Shorts [clothing]; Childrens' clothing; Infants' clothing; Babies' clothing; Beach clothing; Weatherproof clothing; Tops [clothing]; Knitted clothing; Knitwear [clothing]; Bottoms [clothing]; Athletic clothing; Jerseys [clothing]; Ties [clothing]; Casual clothing; Slipovers [clothing]; Bikinis; Tracksuits; Tracksuit tops; Tracksuit bottoms; Sportswear; Leisurewear; Shoes for leisurewear; Casualwear; Shirts; Dress shirts; T-shirts; Tee-shirts; Polo shirts; Sweat shirts; Under shirts; Collared shirts; Sports shirts; Sport shirts; Casual shirts; Football shirts; Soccer shirts; Rugby shirts; Tennis

	shirts; Turtleneck shirts; Woven shirts; Knit shirts; Yoga shirts; Tops; Halter tops; Hooded tops; Vest tops; Tank- tops; Tube tops; Baby tops; Jogging tops; Beachwear; Shoes.
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12. Both parties have *clothing* in their specifications which is self-evidently identical. The remaining individual clothing items listed in the opponent’s specification are caught by the broader term *clothing* in the applicant’s specification in any case and as such are considered as identical under the *Meric* principle.

13. As I have found the applicant’s goods to be identical with the opponent’s class 25 goods, I do not intend to make a further comparison with the opponent’s class 35 services as it does not put the opponent in any stronger a position.

Average consumer and the purchasing process

14. 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*.

15. 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.”

16. As the contested goods in this case are clothing, the guidance given in *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03 is appropriate here. 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.”

17. The average consumer for the contested goods is the general public. The goods will be sold in 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. Moreover factors such as aesthetics, functionality and fit in

addition to the cost will come into play. In traditional retail premises, the average consumer will be viewing and handling garments. 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 medium 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 seeking advice from sales staff or from word of mouth recommendations.



Comparison of the marks

18. 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.”

19. It would be wrong, therefore, artificially to 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.

20. The marks to be compared are:

Opponent's marks	Applicant's mark
<p data-bbox="204 315 630 367">IMPERFECT 22</p> 	

21. The opponent's EU TM No. 12871703 ('the word mark') consists of the word IMPERFECT followed by the number 22. Given that the goods at issue in this case are clothing, it is pertinent to point out that 22 is a UK female clothing size, which may lessen the number's distinctiveness. The mark has no additional stylisation and its overall impression is based on this word/number combination.

22. The opponent's EU TM No. 13743968 ('the figurative mark') is a composite mark comprising a device of two square brackets enclosing an exclamation mark and a word element. The square bracket device is positioned above what is meant to be read as the word IMPERFECT with an exclamation mark in place of the letter I and a question mark in place of the letter P. The word IMPERFECT is the same width as the device above it but is smaller in scale. However, this word element, although smaller, is distinctive and makes an important contribution to the overall impression but to a slightly lesser extent than the device.

23. The applicant's mark is also a composite comprising a device and word elements. The device is a silhouette of a female figure with wings depicting an angel, positioned above the words **Imperfect Angel** which itself is presented in a slightly stylised typeface. In turn these words sit above the words **perfectly imperfect** which are presented in a cursive script style of typeface. Both word elements form their own self-contained phrases. Given the size and positioning I consider the angel device to have roughly equal weight in the overall impression with the **Imperfect Angel** word element. It is those two distinctive elements which make

the greatest contribution to the overall impression of the mark, with the smaller words playing a smaller role

24. When making a visual comparison, clearly the element in common is the word **Imperfect**, appearing twice in the applicant's mark and being the sole word element in the opponent's word mark. With regard to the opponent's figurative mark, although two letters have been replaced by devices of punctuation marks, in my view the average consumer would see it as the word **Imperfect**. In terms of differences the applicant's mark contains the additional words **angel** and **perfectly** and the opponent's word mark contains the number **22**. The device elements of the applicant's mark and the opponent's figurative mark are completely different. Taking these factors into account, I find there is a low degree of similarity.

25. In aural comparison terms, the device element of the parties' marks will not be verbalised, which leaves only the word elements to be considered. The element in common is again the word **Imperfect**. The opponent's word mark will likely be verbalised in full as the word and number and its figurative mark will be verbalised as **Imperfect**, despite two characters of that word being punctuation marks. With regard to the applicant's mark, if only the two larger word elements, **Imperfect** **Angel**, are verbalised, which seems most likely given their size and prominence, then I find there to be a medium degree of aural similarity. It is unlikely that an average consumer would verbalise all four of the word elements in the applicant's mark, but if they did then I find the degree of aural similarity would decrease slightly. Although the shared element **Imperfect** is repeated, it would also lengthen the applicant's mark and adds in the additional word elements.

26. Turning to the conceptual comparison, the opponent submits that:¹

“Conceptually, the signs are also similar as IMPERFECT is a common English word which is understood to mean not perfect or incomplete”

¹ See the opponent's written submissions dated 18 March 2019.

Whilst I accept the opponent's definition of the word Imperfect, that is not the only factor at play given the complexity of the contested mark. In my view the applicant's mark has three separate conceptual elements. The first is the device which is likely to bring to mind the concept of an angel. This concept is reinforced by the words **Imperfect Angel**. This adjective/noun combination will easily bring to mind the concept that an angel is imperfect, i.e. the 'imperfect' element referring to a particular individual being which is a step beyond the mere definition of 'imperfect' outlined above. Furthermore, the applicant's additional word element **perfectly imperfect** is a self-contained phrase with its own concept being a juxtaposition of being perfect and imperfect at the same time. By contrast the opponent's word mark will bring to mind the definition it has given for the word Imperfect and the number 22. It may be that some UK consumers would see 22 as a female clothing size but to others it may be a number without an obvious meaning, so it does not bring to mind a clear concept. With regard to the opponent's figurative mark the concept brought to mind will be the definition given above of the word imperfect.

27. At a basic level I find there is a shared conceptual similarity for the word **Imperfect**, but I would pitch this similarity overall at a low degree, given the more complex concepts brought to mind by the applicant's mark as a whole.

Distinctiveness of the earlier marks

28. The distinctive character of the earlier marks must be considered. The more distinctive they are, 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).”

29. There is no evidence before me in these proceedings so I only have the inherent position to consider. The earlier word mark consists of an ordinary dictionary word and a number which as previously stated may be seen as a UK female clothing size in which case I would consider the number itself to be non-distinctive, however the word does not describe the goods for which the mark is registered so, overall, I find the mark to be distinctive to a medium degree. The earlier figurative mark has a device element and devices standing in place of letters in the word **Imperfect** so is distinctive to a slightly above a medium degree.

Likelihood of confusion

30. Drawing together my earlier findings on the global assessment of the likelihood of confusion, I keep in mind the following factors and those set out in paragraph 7:

- 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 Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc*).
- b) The principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*).
- c) The factor of 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 & Co. GmbH v Klijsen Handel BV*).

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

32. In terms of indirect confusion, this was dealt with by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10 where he noted 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”.

33. Whereas in *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., also sitting 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.

34. I also find the guidance given in *Anncos, Inc. v OHIM*, Case T-385/09 to be useful, where the General Court considered an appeal against OHIM's decision that there was no likelihood of confusion between ANN TAYLOR LOFT and LOFT (both for clothing and leather goods) and found that:

“48. In the present case, in the light of the global impression created by the signs at issue, their similarity was considered to be weak. Notwithstanding the identity of the goods at issue, the Court finds that, having regard to the existence of a weak similarity between the signs at issue, the target public, accustomed to the same clothing company using sub-brands that derive from the principal mark, will not be able to establish a connection between the signs ANN TAYLOR LOFT and LOFT, since the earlier mark does not include the ‘ann taylor’ element, which is, as noted in paragraph 37 above (see also paragraph 43 above), the most distinctive element in the mark applied for.

49 Moreover, even if it were accepted that the ‘loft’ element retained an independent, distinctive role in the mark applied for, the existence of a likelihood of confusion between the signs at issue could not for that reason be automatically deduced from that independent, distinctive role in that mark.

50 Indeed, the likelihood of confusion cannot be determined in the abstract, but must be assessed in the context of an overall analysis that takes into consideration, in particular, all of the relevant factors of the particular case (*SABEL*, paragraph 18 above, paragraph 22; see, also, Case C-120/04 *Medion* [2005] ECR I-8551, paragraph 37), such as the nature of the goods and services at issue, marketing methods, whether the public’s level of attention is higher or lower and the habits of that public in the sector concerned. The examination of the factors relevant to this case, set out in paragraphs 45 to 48 above, do not reveal, *prima facie*, the existence of a likelihood of confusion between the signs at issue.”

35. So far in this decision, I have found the parties’ goods to be identical and have concluded that they will be purchased visually by the general public who will be paying a medium level of attention during the purchasing process. In addition, I have found the earlier word mark to be distinctive to a medium degree and the earlier figurative mark to be slightly higher than medium in distinctiveness.

36. With regard to the visual similarity, I found this to be low. In terms of the aural similarity I found this to be medium if only two of the words in the applicant’s marks

were verbalised and slightly higher if all four words are said. Finally turning to the conceptual similarity, I also found this to be low.

37. Taking all this into account, I find that a lack of visual similarity is a key factor for the opponent's figurative mark and the applicant's mark especially as the goods are primarily purchased visually. With regard to the opponent's word mark, I find there is too big a difference between an abstract concept of being imperfect and the notion of an imperfect angel being a single individual. In my view the differences between the marks are enough to offset the similarities, in the mind of the average consumer purchasing the goods. As a result, I find there is no likelihood of direct confusion.

38. As I have found no direct confusion between the marks at issue, I turn to whether there is a likelihood of indirect confusion. As per the extract given above from *Anncó*, although the goods in this case are identical, in my view the global impression of the marks results in weak similarity, in particular as the applicant's mark has a distinctive device and self-contained distinctive phrase in **Imperfect Angel**. Although sub brands are commonplace in the clothing sector, I do not believe that an average consumer will see the applicant's mark as being a sub-brand of the opponent's mark as the angel element of the applicant's mark is not a logical brand extension, as per, the comments made in *LA Sugar*. I find that the *Duebros* guidance is also applicable here, namely that if an average consumer saw the shared word element **imperfect** it may bring the earlier marks to mind, but they would not think the goods came from the same source and would not confuse the marks. Consequently, I find there is no likelihood of indirect confusion.

Conclusion

39. The opposition fails under section 5(2)(b). The application can proceed to registration subject to any appeal.

Costs

40. The applicant has been successful and is therefore, in principle, entitled to a contribution towards her costs. As the applicant is unrepresented, at the conclusion of the evidence rounds the tribunal invited her, in the official letter dated 2 July 2019, to indicate whether she wished to make a request for an award of costs, and if so, to

complete a pro-forma including a breakdown of her actual costs, including providing accurate estimates of the number of hours spent on a range of given activities relating to the defence of the opposition; it was made clear to the applicant that if the pro-forma was not completed “no costs may be awarded”. The applicant did not respond to that invitation. Consequently, I make no order as to costs.

Dated this 17th day of October 2019

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