

**O/242/20**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. UK00003379139**

**BY MUHAMMAD HASSAN WAHEED**

**TO REGISTER THE TRADE MARK:**



**IN CLASS 18**

**AND**

**IN THE MATTER OF OPPOSITION THERETO**

**UNDER NO. 416504 BY**

**JD SPORTS FASHION PLC**

## **BACKGROUND AND PLEADINGS**

1. On 27 February 2019, Muhammad Hassan Waheed (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 8 March 2019 and registration is sought for the goods set out in paragraph 29 below.

2. On 5 June 2019, JD Sports Fashion Plc (“the opponent”) opposed the application based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon EUTM no. 2980829 for the trade mark **CARBRINI**. The opponent’s mark was filed on 17 December 2002 and registered on 8 October 2004. The opponent relies upon some of the goods for which the mark is registered, namely:

Class 18      Bags; holdalls; backpacks; rucksacks; sports bags; sports holdalls; parts and fittings for all the aforesaid goods.

3. The opponent claims that there is a likelihood of confusion because the trade marks are similar, and the goods are identical or similar.

4. The applicant filed a counterstatement denying the claims made.

5. The opponent is represented by Urquhart-Dykes & Lord LLP and the applicant is unrepresented. Both parties filed evidence. No evidence in reply was filed by the opponent. No hearing was requested, but both parties filed written submissions in lieu of attendance. This decision is taken following a careful perusal of the papers.

## **EVIDENCE**

### **Opponent’s Evidence**

6. The opponent filed evidence in the form of the witness statement of Siobhan Mawdsley dated 22 October 2019, which is accompanied by 7 exhibits. Ms Mawdsley is the General Counsel and Company Secretary of the opponent, a position she has held since October 2015.

7. Ms Mawdsley states that the opponent has been using the earlier mark in relation to sportswear, leisure wear and athletic apparel since 1986. Ms Mawdsley states that the mark has been used in relation to football kits provided for professional clubs.<sup>1</sup>

8. Ms Mawdsley explains that the opponent has licensed the earlier trade mark to Argos Limited (“Argos”) since 1 April 2013 in relation to: “bags, holdalls, backpacks, rucksacks, sports bags, sports holdalls, parts and fittings for all the aforesaid goods”. Under the terms of the license, Argos is permitted to use the earlier mark in relation to these goods in return for a royalty payment to the opponent.

9. Print outs from the Argos catalogues for Autumn/Winter 2017, Spring/Summer 2018, Spring/Summer 2019 and Autumn/Winter 2019 show the earlier mark used in relation to sports bags, backpacks, holdalls, boot bags, backpacks and swim bags.<sup>2</sup> The earlier mark appears both on the products themselves and in the product description. Ms Mawdsley explains that Argos publishes catalogues twice a year with a Spring/Summer edition issued in January for use between February and the end of July and an Autumn/Winter edition issued in July for use between August and the end of January the following year. It is, therefore, my understanding that the Autumn/Winter 2019 catalogue relates to a period after the relevant date i.e. August 2019 to January 2020.

10. Ms Mawdsley notes that Argos operates from over 800 locations across the United Kingdom.<sup>3</sup> Ms Mawdsley also notes that Argos sells products bearing the earlier mark through its website [argos.co.uk](http://argos.co.uk). Print outs from that website dated 27 July 2017 and 16 January 2018 show a range of backpacks, holdalls, kit bags and shoe bags all displaying the earlier mark both on the product and in the product description.<sup>4</sup>

11. Ms Mawdsley states that the opponent’s records confirm that between 1 February 2014 and 31 July 2019, Argos has sold in excess of 464,000 pieces of luggage and

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<sup>1</sup> Exhibit SM1

<sup>2</sup> Exhibit SM4

<sup>3</sup> Exhibit SM5

<sup>4</sup> Exhibit SM6

sports bags bearing the earlier mark in the UK and Republic of Ireland. Ms Mawdsley states that the records show that the majority of these sales have occurred in the UK. Ms Mawdsley states that the total turnover generated by Argos in respect of these sales is over £7million.

12. Reports provided by Argos to the opponent show the following number of units sold in relation to backpacks, shoe bags, messenger bags, holdalls and kit bags (as well as sets including these bags) sold under the earlier mark:

01/02/2016 – 31/07/2016	42,322
01/08/2016 – 31/01/2017	62,118
01/02/2017 – 31/07/2017	34,871
01/08/2017 – 31/01/2018	39,088
01/02/2018 – 31/07/2018	17,987 <sup>5</sup>
Total	196,386

13. The number of units sold during the period 1 August 2018 to 31 January 2019 have also been provided. However, there are two different figures contained within the opponent's evidence for this period – 35,814 and 26,380. I return to this point below.

14. Ms Mawdsley has provided the following figures for sports bags and luggage sold per catalogue:

Spring/Summer 2014	36,707
Autumn/Winter 2014	52,313
Spring/Summer 2015	46,906
Autumn/Winter 2015	69,714
Spring/Summer 2016	42,322
Autumn/Winter 2016	62,118
Spring/Summer 2017	34,871
Autumn/Winter 2017	39,088
Spring/Summer 2018	17,987

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<sup>5</sup> Exhibit SM7

Autumn/Winter 2018	35,814
Spring/Summer 2019	26,380

15. I note that the figures provided for the duplicate period referred to in paragraph 13 above coincide with the figures provided for the Autumn/Winter 2018 and Spring/Summer 2019 periods. I assume, therefore, that they have been recorded as reflecting the same period in Exhibit SM7 in error. The Autumn/Winter 2018 catalogue would have been issued in July 2018 for use between August 2018 and January 2019. The Spring/Summer 2019 catalogue would have been issued in January 2019 for use between February 2019 and July 2019. Given the date of the application in issue, only a very small proportion of the sales made under the latter catalogue would have been prior to the relevant date.

16. As noted above, the opponent filed written submissions in lieu of a hearing. I have read these submissions in their entirety and will refer to them below where necessary.

### **Applicant's Evidence**

17. The applicant filed a witness statement dated 16 December 2019, which is accompanied by 2 exhibits. The applicant explains that he is operating a new business, established in 2019, to launch a collection of long-life handmade leather goods.

18. The applicant has provided various photographs of his products displaying the applied-for mark.<sup>6</sup>

19. The applicant states that:

“5. The term “Caprini” is the taxonomical Latin term for the prominent tribe within the Caprinae subfamily of ruminants. This tribe comprises of mammal species of various genera, which include the genus Capra (goats) and the genus Ovis (sheep). More widely, the Caprini tribe summarily encapsulates all animals

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<sup>6</sup> Exhibit MW1

colloquially grouped as medium-sized hooved-mammals (or more accurately medium-sized bovids) such as the ibex, the tur, the Markhor, in addition to the more populous and commonly recognised sheep and goat.

20. The applicant explains that this name was chosen because of the link between these animals and the provision of leather (an important characteristic of the goods being sold by the applicant) and the characteristics of many animals included within this group being associated with the applicant's brand (such as robustness, hardiness and purposefulness).

21. The applicant states that he wanted to ensure that his brand was differentiated from other brands in the market place by including the inward-rotated horns as a device in his mark, to further demonstrate the intended connection. The applicant has provided photographs of ibex to demonstrate the type of horns that he was trying to replicate in the device.

22. The applicant's evidence was accompanied by written submissions. The applicant re-filed these submissions as written submissions in lieu of attendance at a hearing. I have read these submissions and have taken them into account in reaching my decision. I will refer to them, where necessary, below.

## **PRELIMINARY ISSUES**

23. In his written submissions, the applicant has made reference to various other trade marks that are currently on the Register. In this regard, he states:

"[...] there should already be a significant level of confusion in the marketplace associated with multiple registered trademarks, registered both before and after the earlier trade mark was registered.

[...] This listed trademarks have a similar level of dissimilarity with the earlier trademark as between the earlier trade mark and the trademark in the application, some more than others. I submit that there does not exist a confusion between any of these trademarks and the earlier trademark, and

therefore should be strong grounds for establishing there should not be confusion assumed to develop between the earlier trademark and the trademark in the application.”

24. Firstly, the fact that there are other trade marks on the Register which may be slightly less or more similar to the opponent’s mark than the applicant’s mark (as alleged by the applicant) is not relevant to the decision I must make. This is because I am required to assess the similarity between the marks in issue. The existence of other trade marks on the Register is not a factor which forms part of that assessment. Secondly, the mere presence of these trade marks on the Register cannot be said to demonstrate that there has (or has not been) confusion in the marketplace. Two of the trade marks referred to by the applicant are expired and are, therefore, presumably not being used. Further, there is no evidence that the remaining trade marks are actually being used or, indeed, in relation to what goods. I do not, therefore, consider that this submission assists the applicant’s case.

## **DECISION**

25. Section 5(2)(b) of the Act states as follows:

“5(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.”

26. Section 5A of the Act states:

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

27. The trade mark upon which the opponent relies qualifies as an earlier trade mark because it was applied for at an earlier date than the applicant’s mark pursuant to section 6 of the Act. As the opponent’s mark had completed its registration process more than 5 years before the application date of the mark in issue, it was open to the applicant to request that the opponent prove use of its mark. However, in his counterstatement, the applicant confirmed that he did not require the opponent to provide proof of use. Consequently, the opponent can rely upon all of the goods it has identified.

### **Section 5(2)(b) – case law**

28. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

(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 to mind the earlier mark, 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

29. The competing goods are as follows:

<b>Opponent's goods</b>	<b>Applicant's goods</b>
<p><u>Class 18</u> Bags; holdalls; backpacks; rucksacks; sports bags; sports holdalls; parts and fittings for all the aforesaid goods.</p>	<p><u>Class 18</u> Airline travel bags; All purpose sport bags; All-purpose athletic bags; All-purpose carrying bags; All-purpose sports bags; Athletic bags; Athletics bags; Attaché bags; Attache cases; Attaché cases; Attache cases made of leather; Back packs; Backpacks; Backpacks [rucksacks]; Baggage; Bags; Bags for climbers; Bags for clothes; Bags for school; Bags for sports; Bags for sports clothing; Bags for travel; Bags made of leather; Banknote holders; Billfolds; Book bags; Boston bags; Brief cases; Briefbags; Briefcases; Briefcases and attache cases; Briefcases for documents; Briefcases [leather goods]; Briefcases [leatherware]; Briefcases made of leather; Briefcase-type portfolios; Bucket bags; Bum bags; Bumbags; Business card cases; Business card holders in the nature of card cases; Business card holders in the nature of wallets; Business cases; Cabin bags; Camping bags; Canvas bags; Card holders made of leather; Card wallets; Card wallets [leatherware]; Carriers for suits, for shirts and for</p>

	<p>dresses; Carriers for suits, shirts and dresses; Carry-all bags; Carryalls; Carrying bags; Carrying cases; Carrying cases for documents; Cases for business cards; Cases for holding keys; Cases for keys; Cases of leather or leatherboard; Cases, of leather or leatherboard; Casual bags; Change purses; Cloth bags; Clutch bags; Clutch handbags; Clutch purses; Clutch purses [handbags]; Clutches [purses]; Coin holders; Coin purses; Coin purses not made of precious metal; Coin purses, not of precious metal; Coin purses, not of precious metals; Cosmetic bags; Cosmetic bags sold empty; Cosmetic cases sold empty; Cosmetic purses; Credit card cases [wallets]; Credit card holders; Credit card holders made of leather; Credit-card holders; Diplomatic bags; Document cases; Document cases of leather; Document holders [carrying cases]; Drawstring bags; Drawstring pouches; Duffel bags; Duffel bags for travel; Duffle bags; Evening bags; Evening handbags; Evening purses; Fanny packs; Fashion handbags; Flexible bags for garments; Flight bags; Garment bags; Garment bags for travel; Garment bags for travel made of leather; Garment carriers; General purpose sport trolley bags; Gentlemen's handbags; Gent's</p>
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	handbags; Gladstone bags; Gym bags; Hand bags; Handbags; Handbags for ladies; Handbags for men; Handbags made of leather; Handbags, not made of precious metal; Handbags, purses and wallets; Handles (Suitcase -); Hiking bags; Hiking rucksacks; Hip bags; Hipsacks; Holdalls; Hold-alls; Holdalls for sports clothing; Holders in the nature of cases for keys; Holders in the nature of wallets for keys; Hunters' game bags; Hunting bags; Key bags; Key cases; Key cases [leather goods]; Key cases made of leather; Key cases of leather; Key pouches; Key wallets; Keycases; Key-cases; Key-cases of leather and skins; Kit bags; Ladies handbags; Ladies' handbags; Leather; Leather bags; Leather bags and wallets; Leather briefcases; Leather cases; Leather cases for keys; Leather cloth; Leather coin purses; Leather credit card cases; Leather credit card holder; Leather credit card wallets; Leather handbags; Leather key cases; Leather pouches; Leather purses; Leather shopping bags; Leather suitcases; Leather wallets; Luggage; Luggage bags; Luggage, bags, wallets and other carriers; Luggage covers; Luggage label holders; Luggage labels; Luggage straps; Luggage tags; Luggage tags [leatherware]; Luggage trunks; Lunge reins; Makeup bags; Make-up
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	bags; Make-up bags sold empty; Make-up boxes; Make-up cases; Messenger bags; Music bags; Notecases; Overnight bags; Overnight cases; Pocket wallets; Pocketbooks [handbags]; Portfolio cases [briefcases]; Portmanteaus; Portmanteaux; Pouches; Pouches for holding make-up, keys and other personal items; Pouches of leather; Pouches, of leather, for packaging; Pouchettes; Protective suit carriers; Purse frames; Purse frames [handbags]; Purses; Purses [leatherware]; Purses, not made of precious metal; Purses not made of precious metal; Purses, not made of precious metal [handbags]; Purses [not of precious metal]; Purses, not of precious metal; Roll bags; Roller bags; Roller suitcases; Ruck sacks; Rucksacks; Rucksacks for mountaineers; Rucksacks on castors; Satchels; Satchels (School -); School backpacks; School bags; School book bags; School knapsacks; School satchels; Schoolbags; Schoolchildren's backpacks; Shoulder bags; Sling bags; Small backpacks; Small bags for men; Small clutch purses; Small purses; Small rucksacks; Small suitcases; Sport bags; Sports bags; Sports [Bags for -]; Sports packs; Suit bags; Suit carriers; Suitcase handles; Suitcases; Suitcases with wheels; Toiletry bags; Toiletry bags sold
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	empty; Toiletry cases sold empty; Travel bags; Travel cases; Travel luggage; Traveling bags; Traveling trunks; Travelling bags; Travelling bags [leatherware]; Travelling bags made of leather; Travelling cases; Travelling cases of leather; Travelling trunks; Trunks and suitcases; Trunks and traveling bags; Trunks and travelling bags; Trunks being luggage; Trunks [luggage]; Waist bags; Waist packs; Waist pouches; Wallets; Wallets for attachment to belts; Wallets including card holders; Wallets incorporating card holders; Wallets, not of precious metal; Wallets [not of precious metal]; Wallets (Pocket -); Wallets with card compartments; Waterproof bags; Weekend bags; Work bags.
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30. In the *Treat* case, [1996] R.P.C. 281, Jacob J. (as he then was) identified the following factors for assessing similarity:

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

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and, in particular, whether they are or are likely to be found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance, whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

31. 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 for 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.”

32. The opponent states:

“The Contested Goods consist of a very long, often repetitive, list of items which fall into the broad categories of bags, luggage and wallet/purses. These goods are, using the established tests, identical or, in the alternative, similar to a high degree to the goods for which the Earlier Trade Mark is registered.”

33. “Bags” appears identically in both the opponent’s specification and the applicant’s specification.

34. “Back packs”, “Backpacks”, “Backpacks [rucksacks]”, “Ruck sacks” and “Rucksacks” in the applicant’s specification are self-evidently identical to “backpacks” and “rucksacks” in the opponent’s specification.

35. “Holdalls” and “Hold-alls” in the applicant’s specification are self-evidently identical to “holdalls” in the opponent’s specification.

36. “Holdalls for sports clothing” in the applicant’s specification is self-evidently identical to “sports holdalls” in the opponent’s specification.

37. “Baggage” in the applicant’s specification is a term used to describe the bags that someone takes with them when they travel.<sup>7</sup> Consequently, I consider this to be self-evidently identical to “bags” in the opponent’s specification.

38. “Bags for sports”, “Sport bags”, “Sports bags”, “Sports [Bags for -]” and “Sports packs” in the applicant’s specification are self-evidently identical to “sports bags” in the opponent’s specification.

39. “All purpose sport bags”, “All-purpose sports bags”, “Bags for sports clothing” and “General purpose sport trolley bags” in the applicant’s specification all fall within the broader categories of “sports bags” and “bags” in the opponent’s specification. These goods can, therefore, be considered identical on the principle outlined in *Meric*.

40. “Hiking rucksacks”, “Rucksacks for mountaineers”, “Rucksacks on castors” and “Small rucksacks” in the applicant’s specification all fall within the broader categories of “rucksacks” and “bags” in the opponent’s specification. These goods can, therefore, be considered identical on the principle outlined in *Meric*.

41. “School backpacks”, “Schoolchildren's backpacks” and “Small backpacks” in the applicant’s specification all fall within the broader categories of “backpacks” and “bags” in the opponent’s specification. These goods can, therefore, be considered identical on the principle outlined in *Meric*.

42. The following goods in the applicant’s specification all fall within the broader category of “bags” in the opponent’s specification and can, therefore, be considered identical on the principle outlined in *Meric*:

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<sup>7</sup> <https://www.collinsdictionary.com/dictionary/english/baggage>



Airline travel bags; All-purpose athletic bags; All-purpose carrying bags; Athletic bags; Athletics bags; Attaché bags; Bags for climbers; Bags for clothes; Bags for school; Bags for travel; Bags made of leather; Book bags; Boston bags; Briefbags; Bucket bags; Bum bags; Bumbags; Cabin bags; Camping bags; Canvas bags; Carry-all bags; Carryalls; Carrying bags; Casual bags; Carrying cases; Carrying cases for documents; Cloth bags; Clutch bags; Clutch handbags; Cosmetic bags; Cosmetic bags sold empty; Diplomatic bags; Drawstring bags; Duffel bags; Duffel bags for travel; Duffle bags; Evening bags; Evening handbags; Fanny packs; Fashion handbags; Flexible bags for garments; Flight bags; Garment bags; Garment bags for travel; Garment bags for travel made of leather; Gentlemen's handbags; Gent's handbags; Gladstone bags; Gym bags; Hand bags; Handbags; Handbags for ladies; Handbags for men; Handbags made of leather; Handbags, not made of precious metal; Hiking bags; Hip bags; Hipsacks; Hunters' game bags; Hunting bags; Key bags; Kit bags; Ladies handbags; Ladies' handbags; Leather bags; Leather handbags; Leather shopping bags; Makeup bags; Make-up bags; Make-up bags sold empty; Messenger bags; Music bags; Overnight bags; Portmanteaus; Portmanteaux; Roll bags; Roller bags; Satchels; Satchels (School -); School bags; School book bags; School knapsacks; School satchels; Schoolbags; Shoulder bags; Sling bags; Small bags for men; Suit bags; Toiletry bags; Toiletry bags sold empty; Travel bags; Traveling bags; Travelling bags; Travelling bags [leatherware]; Travelling bags made of leather; Waist bags; Waist packs; Waterproof bags; Weekend bags; Work bags.

43. In my view, the following goods in the applicant's specification are all products typically used for storing and carrying goods from one place to another securely. They all, therefore, overlap in use, method of use and nature with "bags" in the opponent's specification. They will all overlap in user and they are likely to be sold through the same trade channels. There may also be a degree of competition between them. Consequently, I consider the following goods in the applicant's specification to be similar to at least a medium degree to "bags" in the opponent's specification:

Attache cases; Attaché cases; Attache cases made of leather; Banknote holders; Billfolds; Brief cases; Briefcases; Briefcases and attache cases; Briefcases for documents; Briefcases [leather goods]; Briefcases [leatherware]; Briefcases made of leather; Briefcase-type portfolios; Business card cases; Business card holders in the nature of card cases; Business card holders in the nature of wallets; Business cases; Card holders made of leather; Card wallets; Card wallets [leatherware]; Carriers for suits, for shirts and for dresses; Carriers for suits, shirts and dresses; Cases for business cards; Cases for holding keys; Cases for keys; Cases of leather or leatherboard; Cases, of leather or leatherboard; Change purses; Clutch purses; Clutch purses [handbags]; Clutches [purses]; Coin holders; Coin purses; Coin purses not made of precious metal; Coin purses, not of precious metal; Coin purses, not of precious metals; Cosmetic cases sold empty; Cosmetic purses; Credit card cases [wallets]; Credit card holders; Credit card holders made of leather; Credit-card holders; Document cases; Document cases of leather; Document holders [carrying cases]; Drawstring pouches; Evening purses; Garment carriers; Holders in the nature of cases for keys; Holders in the nature of wallets for keys; Key cases; Key cases [leather goods]; Key cases made of leather; Key cases of leather; Key pouches; Key wallets; Keycases; Key-cases; Key-cases of leather and skins; Leather briefcases; Leather cases; Leather cases for keys; Leather coin purses; Leather credit card cases; Leather credit card holder; Leather credit card wallets; Leather key cases; Leather pouches; Leather purses; Leather suitcases; Leather wallets; Luggage; Luggage bags; Luggage trunks; Make-up boxes; Make-up cases; Notecases; Overnight cases; Pocket wallets; Pocketbooks [handbags]; Portfolio cases [briefcases]; Pouches; Pouches for holding make-up, keys and other personal items; Pouches of leather; Pouches, of leather, for packaging; Pouchettes; Protective suit carriers; Purses; Purses [leatherware]; Purses, not made of precious metal; Purses not made of precious metal; Purses, not made of precious metal [handbags]; Purses [not of precious metal]; Purses, not of precious metal; Roller suitcases; Small clutch purses; Small purses; Small suitcases; Suit carriers; Suitcases; Suitcases with wheels; Toiletry cases sold empty; Travel cases; Travel luggage; Traveling trunks; Travelling cases; Travelling cases of leather; Travelling trunks; Trunks and suitcases; Trunks being luggage; Trunks [luggage]; Waist pouches; Wallets;

Wallets for attachment to belts; Wallets including card holders; Wallets incorporating card holders; Wallets, not of precious metal; Wallets [not of precious metal]; Wallets (Pocket -); Wallets with card compartments.

44. “Handbags, purses and wallets”, “Leather bags and wallets”, “Luggage, bags, wallets and other carriers”, “Trunks and traveling bags” and “Trunks and travelling bags” in the applicant’s specification all include goods that are *Merici* identical to “bags” in the opponent’s specification. However, they also include goods such as luggage, wallets and purses which overlap in user, uses, method of use, nature and trade channels with “bags” in the opponent’s specification. There will also be a degree of competition between some of the goods. Consequently, I consider the goods to be highly similar.

45. “Handles (Suitcase -)”, “Leather”, “Leather cloth”, “Luggage covers”, “Luggage label holders”, “Luggage labels”, “Luggage straps”, “Luggage tags”, “Luggage tags [leatherware]”, “Purse frames”, “Purse frames [handbags]” and “Suitcase handles” in the applicant’s specification are all parts and fittings for bags and luggage. Consequently, some of these goods will be self-evidently identical to “parts and fittings for the aforesaid goods” in the opponent’s specification. For those that are not identical, I consider there to be an overlap in use, user, method of use, nature and trade channels with “parts and fittings for the aforesaid goods” in the opponent’s specification. These goods will, therefore, be highly similar.

46. I understand that “lunge reins” in the applicant’s specification are a type of rein used in horse riding. These do not, therefore, overlap in use, nature or method of use with any of the applicant’s goods. I recognise that there may be overlap in user but this is not enough, on its own, for a finding of similarity. In the absence of any submissions to assist me, I see no reason to find any overlap in trade channels. The goods are neither in competition nor complementary.<sup>8</sup> I consider the goods to be dissimilar. As some degree of similarity between the goods is necessary to engage the test for likelihood of confusion<sup>9</sup>, the opposition must fail in respect of these goods.

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<sup>8</sup> *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

<sup>9</sup> *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

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

47. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. 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.”

48. The average consumer for the goods will be a member of the general public. The cost of the purchase is likely to be relatively low. The goods are likely to be purchased reasonably infrequently. Even where the cost of the purchase is low, various factors will still be taken into consideration such as size, aesthetic appearance and suitability for the user's particular requirements. Consequently, I consider that a medium degree of attention will be paid during the purchasing process.

49. The goods are most likely to be obtained by self-selection from the shelves of a retail outlet or their online or catalogue equivalent. Consequently, visual considerations are likely to dominate the selection process. However, given that advice may also be sought from a sales assistant, I do not discount that there will also be an aural component to the purchase of the goods.


## Comparison of trade marks

50. 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 the trade marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union (“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.”

51. 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.

52. The respective trade marks are shown below:

Opponent's trade mark	Applicant's trade mark
CARBRINI	

53. In his written submissions, the applicant states:

“I submit to the tribunal the following acts:

- The trademark was submitted as a visual trademark, not text-only, for the apparent reason that it contains a significant important visual element which forms an integral part of the mark.”

54. Further, the applicant states that he chose the device element of his mark because he was of the view that it would act as a significant visual differentiator in the marketplace. The applicant’s evidence includes examples of his mark in use which display the mark as applied-for, as well as only the device element of the mark used in place.

55. In its written submissions, the opponent states:

“The Applicant makes much of the inclusion of the device of “a pair of inward-rotated horns imitating the shape of horns common among various species of the taxonomical tribe Caprini” in its submissions of 16 December 2019. For the reasons set out above, the comments of the Applicant in relation to the use of the mark of the Application (or part of it) are not relevant when comparing the signs in question. The Opponent does not deny that the mark of the Applicant includes a device consisting of a pair of horns which will have a bearing on the visual comparison between the mark of the Application and the Earlier Trade Mark. [...]”

56. Further, the opponent makes reference to the decision in *Wassen International*<sup>10</sup> in which it was stated that where a trade mark is composed of verbal and figurative elements, the verbal element should be considered more distinctive than the figurative elements.

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<sup>10</sup> Case T-312/03

57. I recognise that the device element of the mark is of significant importance to the applicant and his intended business. However, my assessment must take into account the marks as a whole, whilst bearing in mind the distinctive and dominant elements of the marks, and the role they play in the overall impression. The assessment that I must undertake must determine the role of the different elements of the mark in the overall impression, from the perspective of the average consumer. The fact, therefore, that the applicant considers the device element to be of particular importance does not necessarily mean that it will play a significant role in the overall impression for the purposes of my assessment.

58. The applicant's mark consists of the word CAPRINI presented in a very slightly stylised font, beneath a device of two curved prongs (which the applicant describes as horns). I recognise that the device element does, of course, play a role in the overall impression. However, as the opponent states, it is well established in the case law that the eye is naturally drawn to the element of the mark that can be read and by which it will be referred. Consequently, I consider the word CAPRINI to play the greater role in the overall impression of the mark, with the device playing a slightly lesser role. The stylisation of the word CAPRINI plays a much lesser role in the overall impression of the mark.

59. The opponent's mark consists of the word CARBRINI. There are no other elements to contribute to the overall impression, which lies in the word itself.

60. In his written submissions, the applicant states:

“[...] while on objective grounds a true “visual” comparison would be unwarranted due to the differences in the types of trademarks and the horns visual, as already discussed; this ‘visual’ comparison is simply entertaining the opponent’s insistence on visually comparing only the words.”

61. I am required to undertake an assessment of the visual comparison of the marks. This is part of the process required in assessing likelihood of confusion, being one of the factors that I must take into account when making the necessary global assessment. However, for the avoidance of doubt, my assessment of the visual

similarities will, of course, take into account the presence of the device element of the applicant's mark as well as the similarities between the word elements.

62. Visually, the marks coincide in the presence of the letters CA-RINI. In the opponent's mark these letters are separated by the letters RB whereas in the applicant's mark they are separated by the letter P. I consider the word elements of these marks to be visually highly similar. The opponent's mark is a word only mark, which covers use in any standard typeface. The stylisation of the text in the applicant's mark does not, therefore, create a significant visual difference between the marks. However, the presence of the device in the applicant's mark is a point of visual difference. I consider the marks overall to be visually similar to a medium degree.

63. Aurally, the opponent's mark is likely to be pronounced CAR-BREE-NEE. The only element of the applicant's mark that will be pronounced is the word, which is likely to be pronounced CAP-REE-NEE. The pronunciation of the first two syllables of each mark are similar and the pronunciation of the last element is identical. Overall, I consider these marks to be aurally highly similar.

64. Conceptually, I recognise that it is the applicant's evidence that the name CAPRINI was chosen because it was a taxonomical reference to a particular group of animals. However, I consider it unlikely that average consumers will recognise this meaning. I recognise that some average consumers may recognise a similarity between the word CAPRINI and the star sign Capricorn (which is associated with a goat). This may further be reinforced by the device in the applicant's mark which may be recognised as horns. However, I consider that a significant proportion of average consumers will view both marks as foreign language or invented words, with no particular meaning. That being the case, the conceptual comparison between the word elements of the marks will be neutral. However, I recognise that the device in the applicant's mark, if it is recognised as a set of horns, will act as a point of conceptual difference between them.



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

65. 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-2779, 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).”

66. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

67. The opponent has filed evidence setting out the use that has been made of its mark. I note that the mark has been licensed to Argos since 2013. Since that time, it is clear that the mark has been used on products, in catalogues and on Argos' website.

I note that Argos has 800 stores across the United Kingdom, but it is not clear from Ms Mawdsley's evidence whether the opponent's goods are available to purchase from all of these. The relevant date for assessing enhanced distinctiveness is the date of the application in issue i.e. 27 February 2019. Some of the figures provided in the opponent's evidence relate to the period after the relevant date. However, it is clear from the opponent's evidence, that at least 400,000 units were sold through Argos catalogues between Spring/Summer 2014 and Autumn/Winter 2018. That amounts to around 100,000 units per year. I have been provided with no information regarding advertising and marketing expenditure or market share figures. However, it seems that the market for bags and sports bags in the UK must be of significant size. In terms of how long standing the use of the mark has been, whilst I recognise that it may have been used much earlier in relation to clothing, there is no evidence that it was used prior to 2013 in relation to the goods in issue. Taking all of these factors into account, I am not satisfied that the opponent has demonstrated that the distinctive character of its mark has been enhanced through use.

68. I turn now to consider the inherent distinctiveness of the opponent's mark. As noted above, the word CARBRINI will be viewed as an invented or foreign language word with no particular meaning. It is neither descriptive nor allusive of the goods for which the mark is registered. Consequently, I consider the opponent's mark to have a high degree of inherent distinctive character.

### **Likelihood of confusion**

69. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where 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 services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of

the opponent's trade mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

70. I have found the marks to be visually similar to a medium degree and aurally similar to a high degree. I have found that a significant proportion of average consumers will view both marks as invented or foreign language words, meaning the conceptual position is neutral (although if the device in the applicant's mark is recognised as a set of horns then this will act as a point of conceptual difference between them). I have found the opponent's mark to have a high degree of inherent distinctive character. I have identified the average consumer to be a member of the general public who will select the goods primarily by visual means (although I do not discount an aural component). I have concluded that a medium degree of attention will be paid during the purchasing process. I have found the parties goods to be either identical or highly similar (except for those goods that I have found to be dissimilar).

71. There are clearly similarities between the marks, particularly when encountered aurally. Whilst I recognise that the purchasing process is predominantly visual there is, in my view, a likelihood of direct confusion where the marks are encountered aurally. This is particularly the case as the opponent's mark is highly distinctive and they will be used on identical or highly similar goods. In my view, when encountered aurally, there is a likelihood that the marks will be mistakenly recalled or misremembered as each other. In these circumstances, I consider there to be a likelihood of direct confusion.

72. I recognise that the device in the applicant's mark is not likely to go unnoticed. Consequently, when encountered visually (as is most likely to be the case) the marks as a whole are unlikely to be mistakenly recalled or misremembered as each other and there will not, therefore, be a likelihood of direct confusion. However, in my view, the similarity between the words themselves are still likely to lead to the average consumer to mistakenly recall or misremember them when encountered visually, particularly given the principle of imperfect recollection. In my view, when encountered visually, the differences between the words themselves will be forgotten by the

average consumer, and the presence of the device in the applicant's mark will simply be viewed as an alternative mark being used by the same or economically linked undertaking. I, therefore, consider there to be a likelihood of indirect confusion.

## **Final Remarks**

73. In *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, Kitchin L.J. stated that:

“if, having regard to the perceptions and expectations of the average consumer, the court concludes that a significant proportion of the relevant public is likely to be confused such as to warrant the intervention of the court then it may properly find infringement.”

74. This was, of course, in the context of infringement. However, the same approach is appropriate under section 5(2).<sup>11</sup> My finding that there is a likelihood of confusion amongst a significant proportion of average consumers (i.e. those who will recognise no meaning associated with either the opponent's mark or the word element of the applicant's mark) is enough to prevent registration of the applicant's mark for the goods identified as similar under section 5(2)(b) of the Act.

75. However, for the avoidance of doubt, even for those consumers who do identify a conceptual difference between the marks, I do not consider this will be sufficient to outweigh the significant aural similarities between the marks and, indeed, the visual similarities between the words themselves. In my view, there will still be a likelihood of direct confusion (where the marks are encountered aurally) and indirect confusion (where they are encountered visually).

## **CONCLUSION**

76. The opposition is partially successful, and the application is refused for the following goods:

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<sup>11</sup> *Soulcycle Inc v Matalan Ltd* [2017] EWHC 496 (Ch), Mann J.

Class 18      Airline travel bags; All purpose sport bags; All-purpose athletic bags; All-purpose carrying bags; All-purpose sports bags; Athletic bags; Athletics bags; Attaché bags; Attache cases; Attaché cases; Attache cases made of leather; Back packs; Backpacks; Backpacks [rucksacks]; Baggage; Bags; Bags for climbers; Bags for clothes; Bags for school; Bags for sports; Bags for sports clothing; Bags for travel; Bags made of leather; Banknote holders; Billfolds; Book bags; Boston bags; Brief cases; Briefbags; Briefcases; Briefcases and attache cases; Briefcases for documents; Briefcases [leather goods]; Briefcases [leatherware]; Briefcases made of leather; Briefcase-type portfolios; Bucket bags; Bum bags; Bumbags; Business card cases; Business card holders in the nature of card cases; Business card holders in the nature of wallets; Business cases; Cabin bags; Camping bags; Canvas bags; Card holders made of leather; Card wallets; Card wallets [leatherware]; Carriers for suits, for shirts and for dresses; Carriers for suits, shirts and dresses; Carry-all bags; Carryalls; Carrying bags; Carrying cases; Carrying cases for documents; Cases for business cards; Cases for holding keys; Cases for keys; Cases of leather or leatherboard; Cases, of leather or leatherboard; Casual bags; Change purses; Cloth bags; Clutch bags; Clutch handbags; Clutch purses; Clutch purses [handbags]; Clutches [purses]; Coin holders; Coin purses; Coin purses not made of precious metal; Coin purses, not of precious metal; Coin purses, not of precious metals; Cosmetic bags; Cosmetic bags sold empty; Cosmetic cases sold empty; Cosmetic purses; Credit card cases [wallets]; Credit card holders; Credit card holders made of leather; Credit-card holders; Diplomatic bags; Document cases; Document cases of leather; Document holders [carrying cases]; Drawstring bags; Drawstring pouches; Duffel bags; Duffel bags for travel; Duffle bags; Evening bags; Evening handbags; Evening purses; Fanny packs; Fashion handbags; Flexible bags for garments; Flight bags; Garment bags; Garment bags for travel; Garment bags for travel made of leather; Garment carriers; General purpose sport trolley bags; Gentlemen's handbags; Gent's handbags; Gladstone bags; Gym bags; Hand bags;

Handbags; Handbags for ladies; Handbags for men; Handbags made of leather; Handbags, not made of precious metal; Handbags, purses and wallets; Handles (Suitcase -); Hiking bags; Hiking rucksacks; Hip bags; Hipsacks; Holdalls; Hold-alls; Holdalls for sports clothing; Holders in the nature of cases for keys; Holders in the nature of wallets for keys; Hunters' game bags; Hunting bags; Key bags; Key cases; Key cases [leather goods]; Key cases made of leather; Key cases of leather; Key pouches; Key wallets; Keycases; Key-cases; Key-cases of leather and skins; Kit bags; Ladies handbags; Ladies' handbags; Leather; Leather bags; Leather bags and wallets; Leather briefcases; Leather cases; Leather cases for keys; Leather cloth; Leather coin purses; Leather credit card cases; Leather credit card holder; Leather credit card wallets; Leather handbags; Leather key cases; Leather pouches; Leather purses; Leather shopping bags; Leather suitcases; Leather wallets; Luggage; Luggage bags; Luggage, bags, wallets and other carriers; Luggage covers; Luggage label holders; Luggage labels; Luggage straps; Luggage tags; Luggage tags [leatherware]; Luggage trunks; Makeup bags; Make-up bags; Make-up bags sold empty; Make-up boxes; Make-up cases; Messenger bags; Music bags; Notecases; Overnight bags; Overnight cases; Pocket wallets; Pocketbooks [handbags]; Portfolio cases [briefcases]; Portmanteaus; Portmanteaux; Pouches; Pouches for holding make-up, keys and other personal items; Pouches of leather; Pouches, of leather, for packaging; Pouchettes; Protective suit carriers; Purse frames; Purse frames [handbags]; Purses; Purses [leatherware]; Purses, not made of precious metal; Purses not made of precious metal; Purses, not made of precious metal [handbags]; Purses [not of precious metal]; Purses, not of precious metal; Roll bags; Roller bags; Roller suitcases; Ruck sacks; Rucksacks; Rucksacks for mountaineers; Rucksacks on castors; Satchels; Satchels (School -); School backpacks; School bags; School book bags; School knapsacks; School satchels; Schoolbags; Schoolchildren's backpacks; Shoulder bags; Sling bags; Small backpacks; Small bags for men; Small clutch purses; Small purses; Small rucksacks; Small suitcases; Sport bags; Sports bags; Sports [Bags for -]; Sports packs; Suit bags; Suit carriers;

Suitcase handles; Suitcases; Suitcases with wheels; Toiletry bags; Toiletry bags sold empty; Toiletry cases sold empty; Travel bags; Travel cases; Travel luggage; Traveling bags; Traveling trunks; Travelling bags; Travelling bags [leatherware]; Travelling bags made of leather; Travelling cases; Travelling cases of leather; Travelling trunks; Trunks and suitcases; Trunks and traveling bags; Trunks and travelling bags; Trunks being luggage; Trunks [luggage]; Waist bags; Waist packs; Waist pouches; Wallets; Wallets for attachment to belts; Wallets including card holders; Wallets incorporating card holders; Wallets, not of precious metal; Wallets [not of precious metal]; Wallets (Pocket -); Wallets with card compartments; Waterproof bags; Weekend bags; Work bags.

77. The opposition is unsuccessful in relation to the following goods for which the application can proceed to registration:

Class 18      Lunge reins.

## **COSTS**

78. The opponent has enjoyed the greater degree of success and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the opponent the sum of **£1,300** as a contribution towards its costs, calculated as follows:

Preparing a Notice of opposition and considering the applicant's counterstatement	£200
Filing evidence and considering the applicant's evidence	£650
Filing written submissions in lieu	£350
Official fee	£100

**Total**

**£1,300**

79. I therefore order Muhammad Hassan Waheed to pay JD Sports Fashion Plc the sum of £1,300. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

**Dated this 17<sup>th</sup> day of April 2020**

**S WILSON**

**For the Registrar**