

O-445-21

**TRADE MARKS ACT 1994**  
**IN THE MATTER OF**  
**TRADE MARK APPLICATION NO. 3435730**  
**BY ABERDEEN LYNX ICE HOCKEY CLUB**  
**TO REGISTER**



**AS A TRADE MARK IN CLASS 25**

**AND**

**OPPOSITION THERETO**  
**UNDER NO. 419264**  
**BY CHARLES CLAIRE LLP**

## Background and pleadings

1. On 11 October 2019, Aberdeen Lynx Ice Hockey Club (“the applicant”) applied to register the trade mark shown on the cover page of this decision.
2. The application was published for opposition purposes on 1 November 2019 for the following goods:

Class 25 Ankle socks; Anoraks; Anoraks [parkas]; Articles of clothing; Articles of underclothing; Athletic clothing; Babies' clothing; Babies' undergarments; Baby bibs [not of paper]; Baby clothes; Baseball caps; Baseball caps and hats; Baseball hats; Beanie hats; Beanies; Bed jackets; Belts for clothing; Berets; Blazers; Blouses; Blouson jackets; Blousons; Bobble hats; Bodies [clothing]; Body warmers; Bodysuits; Bomber jackets; Bonnets; Bonnets [headwear]; Bucket caps; Bucket hats; Bushjackets; Cagoules; Cap peaks; Cap visors; Capes (clothing); Caps; Caps being headwear; Caps [headwear]; Cardigans; Casual clothing; Casual jackets; Casual shirts; Casual wear; Casualwear; Children's clothing; Children's headwear; Children's outerclothing; Children's wear; Clothes; Clothes for sport; Clothes for sports; Clothing for children; Clothing for infants; Clothing for leisure wear; Clothing for men, women and children; Clothing for sports; Collared shirts; Costumes for use in children's dress up play; Cover-ups; Cravates; Crew neck sweaters; Dance costumes; Down vests; Dressing gowns; Duffel coats; Ear muffs [clothing]; Embroidered clothing; Fabric belts; Fancy dress costumes; Fashion hats; Figure skating clothing; Fingerless gloves; Fleece jackets; Fleece shorts; Fleece tops; Fleece vests; Fleeces; Footwear for sports; Formal wear; Girls' clothing; Gloves; Gloves [clothing]; Gloves for apparel; Golf caps; Golf clothing, other than gloves; Guernseys; Handwarmers [clothing]; Hats; Head scarves; Head wear; Headgear; Headgear for wear; Headscarfs; Heavy

coats; Heavy jackets; Hooded pullovers; Hooded sweat shirts; Hooded sweatshirts; Hooded tops; Hoodies; Infant clothing; Jackets; Jackets being sports clothing; Jerseys [clothing]; Jogging sets [clothing]; Jumpers [pullovers]; Jumpers [sweaters]; Ladies' clothing; Ladies' outerclothing; Leggings [leg warmers]; Leisure suits; Leisure wear; Light-reflecting coats; Long jackets; Long sleeve pullovers; Long sleeved vests; Loungewear; Men's clothing; Men's socks; Mitres [hats]; Mock turtleneck sweaters; Money belts [clothing]; Neck scarfs [mufflers]; Neck scarves; Neckwear; Outer clothing; Outerclothing for men; Overcoats; Padded jackets; Padded pants for athletic use; Padded shirts for athletic use; Padded shorts for athletic use; Parkas; Party hats [clothing]; Peaked caps; Peaks (Cap -); Pocket squares [clothing]; Polar fleece jackets; Polo knit tops; Polo sweaters; Ponchos; Printed t-shirts; Pullovers; Rain coats; Rain hats; Rain jackets; Rain ponchos; Rain suits; Raincoats; Rainproof clothing; Rainproof jackets; Reversible jackets; Scarfs; Scarves; Shapewear; Shawls and headscarves; Shell jackets; Shell suits; Shirts; Shorts; Short-sleeved T-shirts; Skating outfits; Sleeping garments; Sleepwear; Slipovers [clothing]; Small hats; Socks; Socks and stockings; Socks for infants and toddlers; Socks for men; Soles for footwear; Sport coats; Sport shirts; Sport shoes; Sport stockings; Sports bibs; Sports caps; Sports clothing; Sports garments; Sports headgear [other than helmets]; Sports jackets; Sports jerseys; Sports jerseys and breeches for sports; Sports over uniforms; Sportswear; Sweat bands for the head; Sweat bands for the wrist; Ties [clothing]; Track suits; Tracksuit bottoms; Tracksuit tops; Turtleneck pullovers; Turtleneck tops; Visors being headwear; V-neck sweaters; Waistcoats [vests]; Warm-up tops; Waterproof capes; Waterproof clothing; Waterproof jackets; Waterproof outerclothing; Wind jackets; Wind pants; Wind resistant jackets; Winter coats; Winter gloves; Woolen clothing; Woollen socks; Woolly hats; Wrist bands.

3. Charles Claire LLP (“the opponent”) filed a notice of opposition on 30 January 2020 based on sections 5(2) (a) and (b) and 5(3) of the Trade Marks Act 1994 (“the Act”). As the opponent chose not to file evidence, the grounds under section 5(3) of the Act were later deemed withdrawn. Accordingly, the proceedings continue based only on sections 5(2)(a) and (b) of the Act. The opponent relies upon the below mentioned UK trade mark registration:

Mark: Lynx

Registration no. 3234750

Filing date: 1 June 2017

Registration date: 18 August 2017

Goods:

Class 18 Golf umbrellas; golf umbrella covers; bags and cases; suitcases; holdalls; luggage covers; fitted protective covers for luggage; parts, fittings and accessories for all the aforesaid goods.

Class 25 Golf shirts; golf polo shirts; golf t-shirts; golf tank tops; golf sweaters; golf jackets; golf outer clothing; golf water-proof clothing; golf socks; golf trousers; golf skirts; golf skorts; golf shorts; golf shoes; golf caps; golf hats; golf visors; parts, fittings and accessories for all the aforesaid goods.

Class 28 Golf clubs; golf club grips; golf club shafts; golf club heads; golf club handles; shafts for golf clubs; covers for golf heads (headcovers); golf balls; golf tees; golf tee bags; golf putters; golf bags; golf bags, with or without wheels; golf bag carts; golf bag trolleys; caddy bags; golf gloves; parts, fittings and accessories for all the aforesaid goods.

4. The opponent argues that there is a likelihood of confusion, including a likelihood of association because the competing marks and goods are identical or highly similar. However, there appears to be a discrepancy in the details provided on Form TM7 and the statement of grounds on the nature of the opposition. On Form TM7, the opponent has indicated that the opposition is directed against only some goods in Class 25. However, in the comparison

table provided in the statement of grounds, the opponent has listed all of the goods in Class 25 for which registration is sought and described those goods as “relevant to the opposition”. Despite the inconsistency, I consider the opponent’s statement can be reasonably interpreted as a total opposition to the application. There is no indication from the applicant that it understood the proceedings as only a partial opposition. In the counterstatement, the applicant appears to have denied the identity or similarity between all the goods covered by its mark and the earlier mark.<sup>1</sup> I also note that although the applicant had opportunities to file written submissions later in the proceedings, it chose not to file either to clarify or resile from the position adopted in its counterstatement. Therefore, I am proceeding on the basis that this opposition is directed against all the goods in Class 25 in the application.

5. Given its date of filing, the trade mark upon which the opponent rely qualifies as an earlier trade mark in accordance with section 6 of the Act.
6. The opponent is represented by Briffa and the applicant is represented by Lincoln IP. Neither party filed evidence. No hearing was requested. Only the opponent filed written submissions in lieu of a hearing. I make this decision after a careful reading of all the papers filed by the parties.

### **Section 5(2)**

7. Section 5(2) of the Act is as follows:

“5(2) A trade mark shall not be registered if because-

- (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or

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<sup>1</sup> See the applicant’s comparison table in the counterstatement.

(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”.

## Case law

8. The following principles are gleaned from the judgments of the European Union (“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 C3/03, *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 the 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.

### **Average consumer and the nature of the purchasing act**

9. 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 these goods are likely to be selected by the average consumer.

10. 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”.

11. The average consumer of the applicant's goods is a member of the general public. In relation to the various sporting goods covered by the application, the average consumer is a member of the general public with interest in sports. The goods overall (whether sporting or otherwise) are likely to be purchased fairly frequently. The goods are most likely to be the subject of self-selection from retail outlets, websites or catalogues. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount an aural element to the purchase, particularly when advice is sought from a sales representative or a purchase is made further to a word-of-mouth recommendation. When making a purchase, factors such as size, material, colour, cost (which will vary according to the item) may be considered. These factors suggest that the average consumer will pay a medium level of attention when making the selection.

12. The average consumer of the opponent's goods is likely to a member of the general public with interest in golfing. Although some golfing equipment may be



expensive, on the whole, the opponent's goods are relatively inexpensive items. The average consumer is likely to pay some care and attention to ensure to choose the right size, material or colour. These considerations are likely to entail a medium degree of attention.

### **Comparison of goods**

13. When making the comparison, all relevant factors relating to the goods in the specification should be taken into account. In *Canon*, the Court of Justice of the European Union ("CJEU") stated at paragraph 23 of its judgment:

"In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary".

14. Guidance on this issue has also come from Jacob J. (as he then was) in *British Sugar Plc v James Robertson & Sons Ltd* (the Treat case), [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (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.

15. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“[...] Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question”.

16. In *Kurt Hesse v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the General Court (“GC”) stated that ‘complementary’ means:

“[...] there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that

customers may think that the responsibility for those goods lies with the same undertaking”.

17. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. chicken against transport services for chickens. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C., sitting as the Appointed Person, noted in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL O/255/13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes”,

whilst on the other hand:

“[...] it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together”.

18. In *Gérard Meric v OHIM*, the GC held that the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application or vice versa.<sup>2</sup>

## **Comparison of goods**

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<sup>2</sup> case T-133/05

19. The competing goods are as follows:

<b>Applicant's goods</b>	<b>Opponent's goods</b>
<p><u>Class 25</u></p> <p>Ankle socks; Anoraks; Anoraks [parkas]; Articles of clothing; Articles of underclothing; Athletic clothing; Babies' clothing; Babies' undergarments; Baby bibs [not of paper]; Baby clothes; Baseball caps; Baseball caps and hats; Baseball hats; Beanie hats; Beanies; Bed jackets; Belts for clothing; Berets; Blazers; Blouses; Blouson jackets; Blousons; Bobble hats; Bodies [clothing]; Body warmers; Bodysuits; Bomber jackets; Bonnets; Bonnets [headwear]; Bucket caps; Bucket hats; Bushjackets; Cagoules; Cap peaks; Cap visors; Capes (clothing); Caps; Caps being headwear; Caps [headwear]; Cardigans; Casual clothing; Casual jackets; Casual shirts; Casual wear; Casualwear; Children's clothing; Children's headwear; Children's outerclothing; Children's wear; Clothes; Clothes for sport; Clothes for sports; Clothing for children; Clothing for infants; Clothing for leisure wear; Clothing for men, women and children; Clothing for sports; Collared shirts; Costumes for use in children's dress up play; Cover-</p>	<p><u>Class 18</u></p> <p>Golf umbrellas; golf umbrella covers; bags and cases; suitcases; holdalls; luggage covers; fitted protective covers for luggage; parts, fittings and accessories for all the aforesaid goods.</p> <p><u>Class 25</u></p> <p>Golf shirts; golf polo shirts; golf t-shirts; golf tank tops; golf sweaters; golf jackets; golf outer clothing; golf water-proof clothing; golf socks; golf trousers; golf skirts; golf skorts; golf shorts; golf shoes; golf caps; golf hats; golf visors; parts, fittings and accessories for all the aforesaid goods.</p> <p><u>Class 28</u></p> <p>Golf clubs; golf club grips; golf club shafts; golf club heads; golf club handles; shafts for golf clubs; covers for golf heads (headcovers); golf balls; golf tees; golf tee bags; golf putters; golf bags; golf bags, with or without wheels; golf bag carts; golf bag trolleys; caddy bags; golf gloves; parts, fittings and</p>

<p>ups; Cravates; Crew neck sweaters; Dance costumes; Down vests; Dressing gowns; Duffel coats; Ear muffs [clothing]; Embroidered clothing; Fabric belts; Fancy dress costumes; Fashion hats; Figure skating clothing; Fingerless gloves; Fleece jackets; Fleece shorts; Fleece tops; Fleece vests; Fleeces; Footwear for sports; Formal wear; Girls' clothing; Gloves; Gloves [clothing]; Gloves for apparel; Golf caps; Golf clothing, other than gloves; Guernseys; Handwarmers [clothing]; Hats; Head scarves; Head wear; Headgear; Headgear for wear; Headscarfs; Heavy coats; Heavy jackets; Hooded pullovers; Hooded sweat shirts; Hooded sweatshirts; Hooded tops; Hoodies; Infant clothing; Jackets; Jackets being sports clothing; Jerseys [clothing]; Jogging sets [clothing]; Jumpers [pullovers]; Jumpers [sweaters]; Ladies' clothing; Ladies' outerclothing; Leggings [leg warmers]; Leisure suits; Leisure wear; Light-reflecting coats; Long jackets; Long sleeve pullovers; Long sleeved vests; Loungewear; Men's clothing; Men's socks; Mitres [hats]; Mock turtleneck sweaters; Money belts [clothing]; Neck scarfs [mufflers]; Neck scarves; Neckwear; Outer clothing; Outerclothing for men; Overcoats;</p>	<p>accessories for all the aforesaid goods.</p>
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Padded jackets; Padded pants for athletic use; Padded shirts for athletic use; Padded shorts for athletic use; Parkas; Party hats [clothing]; Peaked caps; Peaks (Cap -); Pocket squares [clothing]; Polar fleece jackets; Polo knit tops; Polo sweaters; Ponchos; Printed t-shirts; Pullovers; Rain coats; Rain hats; Rain jackets; Rain ponchos; Rain suits; Raincoats; Rainproof clothing; Rainproof jackets; Reversible jackets; Scarfs; Scarves; Shapewear; Shawls and headscarves; Shell jackets; Shell suits; Shirts; Shorts; Short-sleeved T-shirts; Skating outfits; Sleeping garments; Sleepwear; Slipovers [clothing]; Small hats; Socks; Socks and stockings; Socks for infants and toddlers; Socks for men; Soles for footwear; Sport coats; Sport shirts; Sport shoes; Sport stockings; Sports bibs; Sports caps; Sports clothing; Sports garments; Sports headgear [other than helmets]; Sports jackets; Sports jerseys; Sports jerseys and breeches for sports; Sports over uniforms; Sportswear; Sweat bands for the head; Sweat bands for the wrist; Ties [clothing]; Track suits; Tracksuit bottoms; Tracksuit tops; Turtleneck pullovers; Turtleneck tops; Visors being headwear; V-neck sweaters;

Waistcoats [vests]; Warm-up tops; Waterproof capes; Waterproof clothing; Waterproof jackets; Waterproof outerclothing; Wind jackets; Wind pants; Wind resistant jackets; Winter coats; Winter gloves; Woolen clothing; Woollen socks; Woolly hats; Wrist bands.	
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*Anoraks; Anoraks [parkas]; Articles of clothing; Athletic clothing; Baseball caps;  
 Baseball caps and hats; Baseball hats; Beanie hats; Beanies; Berets; Blazers;  
 Blouses; Blouson jackets; Blousons; Bobble hats; Body warmers; Bodysuits; Bomber  
 jackets; Bonnets; Bonnets [headwear]; Bucket caps; Bucket hats; Bushjackets;  
 Cagoules; Cap peaks; Cap visors; Capes (clothing); Caps; Caps being headwear;  
 Caps [headwear]; Cardigans; Casual clothing; Casual jackets; Casual shirts; Casual  
 wear; Casualwear; Children's clothing; Children's headwear; Children's outerclothing;  
 Children's wear; Clothes; Clothes for sport; Clothes for sports; Clothing for children;  
 Clothing for leisure wear; Clothing for men, women and children; Clothing for sports;  
 Collared shirts; Cover-ups; Cravates; Crew neck sweaters; Down vests; Duffel coats;  
 Embroidered clothing; Fashion hats; Fingerless gloves; Fleece jackets; Fleece shorts;  
 Fleece tops; Fleece vests; Fleeces; Footwear for sports; Formal wear; Girls' clothing;  
 Gloves; Gloves [clothing]; Gloves for apparel; Golf caps; Golf clothing, other than  
 gloves; Guernseys; Handwarmers [clothing]; Hats; Head scarves; Head wear;  
 Headgear; Headgear for wear; Headscarfs; Heavy coats; Heavy jackets; Hooded  
 pullovers; Hooded sweat shirts; Hooded sweatshirts; Hooded tops; Hoodies; Jackets;  
 Jackets being sports clothing; Jerseys [clothing]; Jogging sets [clothing]; Jumpers  
 [pullovers]; Jumpers [sweaters]; Ladies' clothing; Ladies' outer clothing; Leggings [leg  
 warmers]; Leisure suits; Leisure wear; Light-reflecting coats; Long jackets; Long  
 sleeve pullovers; Long sleeved vests; Men's clothing; Mitres [hats]; Mock turtleneck  
 sweaters; Neck scarfs [mufflers]; Neck scarves; Neckwear; Outer clothing; Outer  
 clothing for men; Overcoats; Padded jackets; Padded pants for athletic use; Padded  
 shirts for athletic use; Padded shorts for athletic use; Parkas; Peaked caps; Peaks  
 (Cap -); Pocket squares [clothing]; Polar fleece jackets; Polo knit tops; Polo sweaters;*

*Ponchos; Printed t-shirts; Pullovers; Rain coats; Rain hats; Rain jackets; Rain ponchos; Rain suits; Raincoats; Rainproof clothing; Rainproof jackets; Reversible jackets; Scarfs; Scarves; Shawls and headscarves; Shell jackets; Shell suits; Shirts; Shorts; Short-sleeved T-shirts; Slipovers [clothing]; Small hats; Sport coats; Sport shirts; Sport shoes; Sports bibs; Sports caps; Sports clothing; Sports garments; Sports headgear [other than helmets]; Sports jackets; Sports jerseys; Sports jerseys and breeches for sports; Sports over uniforms; Sportswear; Ties [clothing]; Track suits; Tracksuit bottoms; Tracksuit tops; Turtleneck pullovers; Turtleneck tops; Visors being headwear; V-neck sweaters; Waistcoats [vests]; Warm-up tops; Waterproof capes; Waterproof clothing; Waterproof jackets; Waterproof outer clothing; Wind jackets; Wind pants; Wind resistant jackets; Winter coats; Winter gloves; Woollen clothing; Woolly hats.*

20. *Collins English Dictionary* defines clothing as things people wear.<sup>3</sup> I am satisfied that that definition accords with the average consumer's understanding of the term. On that basis, I am of the view that golf outer clothing in the opponent's specification is a broad term and cover goods such as jackets, headwear or shoes worn for golfing by men, women or children. Accordingly, I find that the applicant's goods mentioned above are either identically contained in the opponent's specification or to be regarded as identical to golf outer clothing on the principles outlined in *Meric* or highly similar to golf outer clothing.

*Belts for clothing; Money belts [clothing]; Fabric belts*

21. The belts mentioned above covered by the application are worn around the body to hold up clothing such as pants. Although money belts are designed to safely store money, they also function as ordinary belts. As these goods are likely to be used as accessories for golf outer clothing in the opponent's specification, I find that the competing goods are identical under the *Meric* principle.

*Soles for footwear*

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<sup>3</sup> <https://www.collinsdictionary.com/dictionary/english/clothing> (accessed on 24 May 2021)



22. The applicant's soles for footwear are parts for shoes. I have already concluded that the opponent's golf outer clothing is broad enough to include shoes. Given that the opponent's specification also covers parts and fitting for golf outer clothing, I find that the competing goods are identical under the *Meric* principle.

*Ankle socks; Men's socks; Socks; Socks and stockings; Socks for men; Sport stockings; Woollen socks*

23. The contested goods mentioned above are identical to golf socks under *Meric* principle.

*Articles of underclothing*

24. These are clothes worn next to one's skin under other clothes. As socks are generally worn inside shoes, next to skin, I see no reason why articles of underclothing in the applicant's specification would not cover golf socks. On that basis, I find that the competing goods are identical under *Meric* principle.

*Bodies [clothing]; Shapewear*

25. The contested goods mentioned above are different types of underclothing. As the applicant's goods, broadly speaking, are aimed at covering or protecting a particular part of the body and are worn next to skin, it shares purpose with golf socks in the opponent's specification. The nature and method of use of these goods are similar. The goods are likely to share channels of trade and users. However, they are neither complementary in the sense described by the case law nor do they compete. Considering these factors, I find that the goods are similar to a high degree.

*Figure skating clothing; Skating outfits*

26. These are types of sportswear. The goods share nature and method of use with golf outer clothing in the opponent's specification. The users and channels of

trade are the same. While the applicant's goods are used for skating, the opponent's goods are items worn during golfing. They are neither complementary nor do they compete. Considering these factors, I find that the competing goods are similar to a medium degree.

*Costumes for use in children's dress up play; Dance costumes; Fancy dress costumes*

27. The applicant's goods mentioned above are costumes worn while dancing, dress-up play or fancy-dress parties or competitions. The purpose of these goods differs from golf outer clothing in the opponent's specification that are mainly worn while playing golf. The nature and method of use are likely to be the same. The users may also be the same, at a high level of generality. Their channels of trade are unlikely to overlap. The goods are neither complementary nor do they compete. Considering these factors, I find that the goods are similar to a low degree.

*Bed jackets; Dressing gowns; Loungewear; Sleeping garments; Sleepwear*

28. The goods mentioned above are sleepwear items. The applicant's goods are indoor clothing, while the opponent's golf outer clothing is outdoor wear. However, both categories of clothing are worn to keep the body warm. The goods, therefore, coincide in their purpose. Their method of use is also the same. The goods are likely to share channels of trade and users. However, they are neither complementary nor in competition. Considering these factors, I find that the competing goods are similar to a low degree.

*Earmuffs [clothing]*

29. Earmuffs are clothing worn over the ears to protect them or keep them warm. Although golf caps in the opponent's specification are worn on the head, they share the same purpose with earmuffs, i.e. to protect or keep a body part warm. The method of use of the goods is different. The goods may coincide in users and trade channels. However, they are not complementary in the sense described

by the case law, nor do they compete. Considering these factors, I find that the competing goods are similar to a low degree.

*Sweat bands for the head; Sweat bands for the wrist*

30. The contested goods mentioned above are brands worn around the head or wrist to absorb sweat. The purpose and method of use of these goods is different from the opponent's golf outer clothing or hats. However, they are likely to overlap in channels of trade and users. Considering these factors, I find that the competing goods are similar to a low degree.

*Babies' clothing; Babies' undergarments; Baby clothes; Clothing for infants; Infant clothing; Socks for infants and toddlers; Baby bibs [not of paper]*

31. The goods mentioned above are clothes made for infants. Broadly speaking, these goods share purpose with golf outer clothing and socks in the opponent's specification because all of the competing goods are worn to keep body warm. Their nature and method of use are also likely to be the same. The users may overlap. Their channels of trade are unlikely to overlap. The goods are neither complementary nor do they compete. Considering these factors, I find that the goods are similar to a very low degree.

*Party hats [Clothing]*

32. Party hats are worn over head at parties. I can see no meaningful similarity in terms of nature, intended purpose, or method of use nor are the goods at issue in competition with or complementary to the opponent's goods in Classes 18, 25 or 28. On that basis, I find that the competing goods are dissimilar.

### **Distinctiveness of the earlier mark**

33. The distinctive character of the earlier mark 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).

34. Invented words usually have the highest degree of distinctive character, while words which are allusive of the goods have the lowest. Distinctiveness can also be enhanced through the use of the marks. The opponent has neither claimed nor filed evidence to substantiate that its mark possesses an enhanced distinctive character. Therefore, I have only the inherent position to consider.

35. According to *Collins English Dictionary*, Lynx is a wild animal similar to a large cat.<sup>4</sup> In that context, the word is neither allusive nor suggestive of the opponent's various goods for golfing. On that basis, I find that the mark possesses a medium degree of distinctive character.

### **Comparison of marks**

36. 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 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 in paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:


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<sup>4</sup> <https://www.collinsdictionary.com/dictionary/english/lynx> (accessed on 24 May 2021).

“.....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.”

37. 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.

38. The trade marks to be compared are as follows:

Opponent's trade mark	Applicant's trade mark
Lynx	

39. The opponent's mark is comprised of the word "Lynx", and the overall impression of the mark lies in that word.

40. The applicant's mark contains two circular devices presented, one inside the other. The outer circle is shown in black. On this circle appears the words "ABERDEEN" at the top and "LYNX" at the bottom. The letters are presented in the same size and font in white and are separated by two red dots on either side of the circle. The combination "ABERDEEN LYNX" is likely to be read as a unit, with "ABERDEEN" qualifying "LYNX". The inner circle of the applicant's mark is presented in red and upon which appears a device of an open-mouthed animal head possibly in an attack mode. The applicant himself has described

this figurative element as a cat head. I think that description is consistent with how the average consumer is likely to perceive the device. Even though the words Aberdeen and lynx are presented in a proportionately smaller size than the figurative element at the centre, the average consumer's attention is likely to be naturally drawn towards the verbal elements - "Aberdeen Lynx". In terms of contribution to the overall impression of the mark, I consider that the words and the device at the centre make roughly an equal contribution.

41. Visually both marks coincide in the word "Lynx", which is the only element in the opponent's mark. In terms of differences, the applicant's mark contains additional elements such as the circular devices, a cat head and the word Aberdeen. Weighing up the similarities and differences, I find that the marks are visually similar to a low degree.

42. In an aural comparison the applicant submits:

"The addition of the three-syllable word ABERDEEN at the beginning of the mark applied for will allow the marks to be distinguished from each other – the word ABERDEEN is longer than the word LYNX and will not go unnoticed in an aural comparison."

Aurally, the marks coincide in the pronunciation of the word lynx, which will be pronounced entirely conventionally. The device in the applicant's mark will not be verbalised because it is a well-established rule that in a trade mark comprising of both verbal and device elements, the average consumer is most likely to refer to the mark by its verbal elements. Aberdeen and Lynx are the only verbal elements in the Applicant's mark. I have already found that the average consumer is likely to read "Aberdeen Lynx" together. In those circumstances, the marks coincide in the pronunciation of the word Lynx, and the marks are aurally similar to a medium degree. I also think that due to its geographic reference, some average consumers may omit Aberdeen when referring aurally to the mark. In those circumstances, the marks are aurally identical as the competing marks will both be referred to as Lynx.

43. Regarding the conceptual comparison, the applicant argues that its mark has the appearance of a sporting badge or emblem that is entirely lacking from the earlier mark. Conceptually, I find that the marks coincide in the concept of lynx, which is a wild animal similar to a large cat. The cat head in the applicant's mark is only likely to reinforce the concept of a lynx. Aberdeen being a geographical location is likely to conjure up the idea of a lynx found in Aberdeen. Overall, I think the conceptual focus of the applicant's mark is likely to be on a lynx. On that basis, I find that the marks are similar to a high degree if not identical.

### **Likelihood of Confusion**

44. I have concluded that party hats [clothing] covered by the application is dissimilar to the opponent's goods. Since some similarity of goods is an essential requirement to succeed in a claim under section 5(2)(b), the opposition against these goods fails.<sup>5</sup>

45. In relation to the remaining goods, in determining whether there is a likelihood of confusion, I need to bear in mind several factors. The first is the interdependency principle, i.e. a lesser degree of similarity between the respective goods may be offset by a greater degree of similarity between the trade marks (*Canon* at [17]). It is also necessary for me to bear in mind the distinctive character of the opponent's trade mark, as the more distinctive the trade mark is, the greater the likelihood of confusion (*Sabel* at [24]). I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks, relying instead upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

46. Confusion can be direct (which occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertaking being the same or related).

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<sup>5</sup> See for example *Waterford Wedgwood plc v OHIM* – C-398/07 P (CJEU).

47. The difference between direct and indirect confusion was explained in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, by Iain Purvis Q.C., sitting as the Appointed Person, where he explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark”.

48. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, James Mellor Q.C., 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 another mark to mind. This is mere association not indirect confusion.

49. I have also found the respective marks to be visually similar to a low degree, aurally identical or similar to a medium degree depending on how the mark is articulated and conceptually similar to a high degree if not identical. The goods will be selected with a medium degree of attention by the general public. The goods are either identical or similar to varying degrees.

50. Following my findings above, there are visual and aural differences between the competing marks. As the trade mark relied upon by the opponent is not identical to the applicant’s mark, the opponent cannot seek benefit from section



5(2)(a) of the Act.<sup>6</sup> The grounds of opposition under section 5(2)(a) is dismissed accordingly. I turn now to the grounds of opposition under section 5(2)(b).

51. In my view, the additional elements such as the circular devices and the animal head in the applicant's mark are sufficiently prominent to avoid direct confusion. That leaves only indirect confusion to be considered.

52. On likelihood of confusion, the applicant argues:

"... the average consumer will readily identify that the logo denotes the commercial origin of the goods on which it is applied. Given the relative position of the words and logo, with the shared word LYNX being much smaller than the logo and positioned at the bottom of the mark, it is submitted that there is no likelihood of confusion."

53. The applicant further argues that Aberdeen does not have an association with clothing or fashion in the same way as London or Milan and, therefore, Aberdeen is a distinctive component of the mark. On the contrary, the opponent submits that Aberdeen being a geographical location is not a distinctive element of the applicant's mark. As far as I am aware, Aberdeen, a city in Scotland, is not famous for fashion or clothing. However, because of its suggested reference to the geographical origin of the goods, I find that the word Aberdeen in the applicant's mark possesses only a weak distinctive character. Accordingly, it is the word LYNX that is the more distinctive element in the applicant's mark. Moreover, during a visual purchase the concept that is likely to be immediately graspable from the word lynx is that of a wild cat. Therefore, having noticed the word lynx, the average consumer who is likely to be familiar with its meaning will understand that lynx refers directly to the cat head depicted at the centre of the mark; with the result that one reinforces the other. Given the limited distinctive character of the word Aberdeen, it is the word lynx that is likely to aid the average consumer to identify the origin of the applicant's goods

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<sup>6</sup> In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, the CJEU held that a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.

– Aberdeen is only likely to qualify the word lynx. Accordingly, I find that the similarity between the marks arising from the common word “lynx” is sufficient to result in a likelihood of indirect confusion. Even when encountered with goods that are similar only to a very low degree, the impact of the common concept of lynx on the average consumer is likely to outweigh the visual differences between the marks. The average consumer is likely to think that there is an economic connection between the undertakings which use the word “lynx” in their respective trade marks. The likelihood of confusion is more likely when the competing goods are identical or similar to a high or medium degree. Given that Aberdeen in the applicant’s mark is only likely to signify the geographic origin of the goods, and the cat head merely reinforces the concept of lynx, I consider the average consumer is likely to perceive those additional elements as a brand variation of the opponent’s word only mark.

## **Conclusion**

54. The opposition is partially successful. The application will proceed to registration only in relation to party hats [clothing] in Class 25.

## **Costs**

55. The opponent has been largely successful and is entitled to an award of costs. Awards of costs are governed by Tribunal Practice Notice (“TPN”) 2/2016. Although the opponent paid an official fee of £200 to cover an additional claim based on section 5(3) of the Act, this ground was later deemed withdrawn. As the opposition continued only based on a claim under section 5(2) of the Act, I award only £100 to cover the official fee. The costs are awarded to the opponent on the following basis:

Official fee:	£100
Preparing the notice of opposition and considering the counterstatement:	£200
Filing written submissions:	£300

Total: £600

56. I order Aberdeen Lynx Ice Hockey Club to pay Charles Claire LLP the sum of £600. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 15th June 2021**

**Karol Thomas  
For the Registrar  
The Comptroller-General**