

O-410-13

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2634611
BY
MORE UK LTD**

TO REGISTER THE TRADE MARK

BENITO

IN CLASS 25

AND

**THE OPPOSITION THERETO
UNDER NO 104239
BY
BONITA GMBH & CO. KG**

BACKGROUND


1. On 12 September 2012, More UK Ltd (the applicant) applied to register the above trade mark in class 25 of the Nice Classification system¹, as follows:

Class 25

Clothing, Ladieswear

2. Following publication of the application, on 19 October 2012, BONITA GmbH & Co. KG (the opponent) filed notice of opposition against the application.

3. The grounds of opposition were brought under section 5(2)(b) of the Trade Marks Act 1994 (the Act). The opponent relies upon the marks and goods shown below:

| Mark details and dates | Goods and Services |
|--|--|
| <p>CTM 6766703</p> <p>Mark:</p>  <p>Filed: 10 March 2008</p> <p>Priority date: 1 February 2008</p> <p>Registered: 9 January 2009</p> | <p>Class 18</p> <p>Briefcases, beach bags, wallets, bags for campers, attaché cases, boxes of leather or leatherboard, net bags for shopping, shopping bags, casings of leather for springs, umbrella or parasol ribs, purses, travelling bags (suitcases), travelling bags, travelling bag handles, handbags, handbag frames, hat boxes of leather, waist packs, game bags, card cases (wallets), chain mesh purses, sling bags for carrying infants, garment bags for travel, vanity cases, synthetic leather, boxes of leather or leatherboard, leather, raw or partly processed, leather twist, imitations of leather, leatherboard, thongs (leather straps), leather laces, valves of leather, straps for soldiers' equipment, moleskin (imitations of leather), trimmings of leather for furniture, furniture coverings of leather, music cases, fur-skins, umbrellas, handles for umbrellas, trunks (travelling bags), trunks, travelling sets (leatherware), holdalls, bags for climbers, rucksacks, butts (parts of hides), boxes of leather or leatherboard, umbrella covers, frames for umbrellas or parasols, umbrella rings, umbrella sticks, straps for skates, key cases (leatherware), satchels, school satchels, bandoliers, walking stick seats, parasols, sports bags, walking stick/cane handles, sticks (walking sticks), bags with wheels, haversacks (knapsacks), leather shoulder straps, bags (envelopes, pouches) of leather, for packaging, leather tool bags (empty).</p> |

¹ *International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).*

Class 25

Heelpieces for shoes, heels (for shoes), suits, babies' pants, babies' napkins of textile, babywear, bathing suits, bathing trunks, bath robes, bathing caps, bath sandals, bath slippers, bandanas (kerchiefs for clothing), berets, clothing of imitation leather, clothing for motorists, clothing, clothing of paper, boas (clothing), bodies, bras, bodices, chasubles, women's clothing, shower caps, insoles, dress handkerchiefs, carnival costumes, mittens, fishermen's smocks, football boots, footmuffs, not electrically heated, gabardines, galoshes, gaiters, money belts (clothing), non-slipping devices for shoes, gymnastic clothing, gymnastic shoes, belts (clothing), half boots, scarves, gloves (clothing), slippers, slips (undergarments), blouses, dickies, shirts, detachable collars, shirt fronts, wooden shoes, trousers, trouser straps, braces, hat frames (skeletons), girdles, hats, jackets, jerseys (clothing), stuff jackets, hoods, ready-made linings (parts of clothing), pockets for clothing, ready-made clothing, headgear, camisoles, corsets, collars (clothing), neckties, ascots, skull caps, leather clothing, sweat-absorbent underclothing, underwear, liveries, bibs, not of paper, maniples, cuffs (clothing), mantillas, bodices, mitres (hats), dressing gowns, muffs (clothing), coats (fur-lined), coats, caps, cap peaks, outerclothing, ear muffs, ear muffs (clothing), overalls, slippers, paper hats (clothing), parkas, pelerines, furs (clothing), petticoats, pullovers, pyjamas, cyclists' clothing, raincoats, skirts, sandals, saris, scarves, shawls, pyjamas, sleeping masks, veils (clothing), briefs, lace-up boots, iron fittings for shoes, shoes, welts, shoe soles, footwear uppers, tips for footwear, footwear, dress shields, aprons (clothing), aprons, ski boots, panties, socks, sock suspenders, boots for sports, sports shoes, boots, boot uppers, headbands (clothing), esparto shoes or sandals, fur stoles, stoles, studs for football boots, beachwear, beach shoes, garters, heel pieces for stockings, suspenders, tights, stockings (sweat-absorbent), stockings, sweaters, T-shirts, togas, knitwear, jerseys, turbans, uniforms, underclothing (sweat-absorbent), underclothing, underwear, leggings, waterski suits, waistcoats, hosiery (clothing), underwear (clothing), top hats, overcoats (clothing).

4. In its statement of grounds, with regard to 5(2)(b) the opponent submits:

“4. The mark subject of the application comprises the word BENITO which has no meaning in the English language. The opponent’s trade mark is for essentially the word BONITA which also has no meaning in the English language. The differences between the marks are in the vowel sounds within the mark and at the end but both marks comprise the same hard

stem, namely B-NIT-. As a consequence, the marks are visually and phonetically similar to one another, particularly considering the principle of imperfect recollection.

The opponent's trade mark is registered in respect of goods in classes 18 and 25. The class 25 goods of the opponent are clearly identical to the class 25 goods of the subject application...

Given the close similarity of the marks and the identity or similarity of goods, there is a clear likelihood of confusion between the marks."

5. On 20 February 2013, the applicant filed a counter statement. It denies the grounds upon which the opposition is based. It states:

"8. We do not believe that the two brand names are similar or confusing

BENITO, BONITA

Both have a completely different sound when read aloud; they are neither visually or phonetically similar, in the first instance the brand start 'BEN' and in the second instance it starts with 'BON'

The font used on both BENITO & BONITA have no resemblance, in the word BONITA the artwork is showing a large 'DOTS' above and below the letter 'I' no way could anyone be confused with the two names, they are not similar or confusing"

6. The opponent's mark is an earlier mark not subject to proof of use because, at the date of publication of the application, it had not been registered for five years.²

7. Only the opponent filed evidence; neither party asked to be heard or filed written submissions in lieu of attendance at a hearing.

EVIDENCE

8. The opponent's evidence consists of a witness statement by Helene Whelbourn, of JE Evans-Jackson & Co Limited t/a Novagraaf UK, dated 19 April 2013. Ms Whelbourn is a trade mark attorney. Attached to the witness statement is a single exhibit, HMW1, which consists of a copy of the registration of the trade mark relied upon by the opponent.

9. The remaining pages are submissions which I will refer to as necessary below.

DECISION

10. Section 5(2)(b) of the Act reads as follows:

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

² See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations 2004: SI 2004/946) which came into force on 5th May 2004.

(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, or there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

Section 5(2)(b) case law

11. In his decision in *La Chemise Lacoste SA v Baker Street Clothing Ltd* - BL O/330/10 (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), the Appointed Person, Mr Geoffrey Hobbs QC, expressed the test under this section (by reference to the CJEU cases mentioned) on the basis indicated below:

The CJEU cases

Sabel BV v Puma AG [1998] RPC 199; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117; *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77; *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723; *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-6/01; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04; *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P.

The principles

“(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.”

The average consumer and the nature of the purchasing act

12. In accordance with the above cited case law, I must determine who the average consumer is and also identify the nature of the purchasing process. The average consumer is reasonably well informed and reasonably circumspect and observant but with a level of attention likely to vary according to the category of goods. The attention paid is likely to vary depending on price and, to some extent, the nature of the goods and the frequency of the purchase.

13. The average consumer of the goods at issue will be a member of the general public. The purchase is likely to be primarily visual as it is likely to be made from a website or directly from a shelf. The goods cover a range of products which vary in price and frequency of purchase. Consequently, the level of attention is likely to vary. A dinner suit is likely to be a fairly expensive, infrequent purchase, which will be purchased according to the particular requirements of the purchaser. It will demand a higher level of attention to be paid than, for example, buying a t-shirt or a pair of socks.

14. In respect of the goods in class 25, in considering the level of attention that will be paid to such a purchase and the nature of the purchasing act, I am mindful of the decision of the General Court (GC) in *New Look Ltd v Office for the Harmonization in the Internal Market (Trade Marks and Designs) Joined cases T-117/03 to T-119/03 and T-171/03*, in which it commented:

"43 It should be noted in this regard that the average consumer's level of attention may vary according to the category of goods or services in question (see, by analogy, *Case C-342/97 Lloyd Schuhfabrik Meyer [1999] ECR I- 3819, paragraph 26*). As OHIM rightly pointed out, an applicant cannot simply assert that in a particular sector the consumer is

particularly attentive to trade marks without supporting that claim with facts or evidence. As regards the clothing sector, the Court finds that it comprises goods which vary widely in quality and price. Whilst it is possible that the consumer is more attentive to the choice of mark where he or she buys a particularly expensive item of clothing, such an approach on the part of the consumer cannot be presumed without evidence with regard to all goods in that sector. It follows that that argument must be rejected.

...

53. Generally in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly the visual aspect plays a greater role in the global assessment of the likelihood of confusion."

15. The selection process for each of the goods is primarily visual, though I do not discount the fact that there may be an aural element given that some articles may be selected with the assistance of a member of staff. The goods may be purchased on the high street, online or by mail order and the level of attention paid will be reasonable the consumer paying the attention necessary to obtain, inter alia, the correct size, colour and fit.

Comparison of goods

16. In making a comparison between the parties' goods I will only consider the opponent's goods in class 25 as they represent its best case.

17. The goods to be compared are as follows:

| The opponent's goods | The applicant's goods |
|---|--|
| <p>Class 25 Heelpieces for shoes, heels (for shoes), suits, babies' pants, babies' napkins of textile, babywear, bathing suits, bathing trunks, bath robes, bathing caps, bath sandals, bath slippers, bandanas (kerchiefs for clothing), berets, clothing of imitation leather, clothing for motorists, clothing, clothing of paper, boas (clothing), bodies, bras, bodices, chasubles, women's clothing, shower caps, insoles, dress handkerchiefs, carnival costumes, mittens, fishermen's smocks, football boots, footmuffs, not electrically heated, gabardines, galoshes, gaiters, money belts (clothing), non-slipping devices for shoes, gymnastic clothing, gymnastic shoes, belts (clothing), half boots, scarves, gloves (clothing), slippers, slips (undergarments), blouses, dickies, shirts, detachable collars, shirt fronts, wooden shoes, trousers, trouser straps, braces, hat frames (skeletons), girdles, hats, jackets, jerseys (clothing), stuff jackets, hoods, ready-made linings (parts of clothing), pockets for clothing, ready-made clothing, headgear, camisoles, corsets, collars (clothing), neckties, ascots, skull caps, leather clothing, sweat-absorbent underclothing, underwear, liveries, bibs, not of paper, maniples, cuffs (clothing), mantillas, bodices, mitres (hats), dressing gowns, muffs (clothing), coats (fur-lined), coats, caps, cap peaks, outerclothing, ear muffs, ear muffs (clothing), overalls, slippers, paper hats (clothing), parkas, pelerines, furs (clothing), petticoats, pullovers, pyjamas, cyclists' clothing, raincoats, skirts, sandals, saris, scarves, shawls, pyjamas, sleeping masks, veils (clothing), briefs, lace-up boots, iron fittings for shoes, shoes, welts, shoe soles, footwear uppers, tips for footwear, footwear, dress shields, aprons (clothing), aprons, ski boots, panties, socks, sock suspenders, boots for sports, sports shoes, boots, boot uppers, headbands (clothing), esparto shoes or sandals, fur stoles, stoles, studs for football boots, beachwear, beach shoes, garters, heel pieces for stockings, suspenders, tights, stockings (sweat-absorbent), stockings, sweaters, T-shirts, togas, knitwear, jerseys, turbans, uniforms, underclothing (sweat-absorbent), underclothing, underwear, leggings, waterski suits, waistcoats, hosiery (clothing), underwear (clothing), top hats, overcoats (clothing).</p> | <p>Class 25 Clothing, Ladieswear</p> |

18. In comparing the goods, I bear in mind the following guidance provided by the General Court (GC) in *Gérard Meric v OHIM*, Case T-133/05:

“29. ...goods can be considered identical when the goods designated by the earlier mark are included in a more general category, designated by

the trade mark application or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

19. The opponent’s specification includes the broad term ‘clothing’ which clearly includes the applicant’s goods, ‘clothing, ladieswear’. I find the parties’ goods to be identical.

Comparison of marks

20. The marks to be compared are as follows:

| The opponent’s mark | The applicant’s mark |
|---------------------|----------------------|
| BONİTA | BENITO |

21. In making a comparison between the marks, I must consider the respective marks’ visual, aural and conceptual similarities with reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components³, but without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

22. The opponent’s mark consists of the single word ‘BONITA’. The first three letters are presented in plain block capitals, while the remaining letters ‘I’, ‘T’ and ‘A’ have a small degree of stylisation. The degree of stylisation of the capital letters ‘T’ and ‘A’ is minimal and is unlikely to be noticed. The letter ‘I’ has a tittle presented above the letter and another below the letter. Even if they are noticed they are not dominant and do not detract from it being seen as a letter ‘I’, or prevent the word being seen as a single word. The distinctive and dominant element of the mark is the word ‘BONITA’.

23. The applicant’s mark consists of the single word ‘BENITO’ in plain block capitals. No part of the word is stylised or emphasised in any way. Consequently, the mark does not possess any distinctive or dominant elements, the distinctiveness lies in the mark as a whole.

Visual and aural similarities

24. In its counterstatement the applicant states:

“...Both have a completely different sound when read aloud they are neither visually or phonetically similar, in the first instance the brand start “BEN” and in the second instance it starts “BON”

³ *Sabel v Puma AG, para.23*

the font used on both BENITO & BONITA have no resemblance, in the word BONITA the artwork is showing a large “DOTS” above and below the letter “I” no way could anyone be confused with the two names, they are not similar or confusing”

25. In its submissions, dated 22 April 2013, the opponent submits:

“1. The applicant’s trade mark is the word BENITO.

The opponent’s trade mark is the word BONITA in a stylised form. The stylisation of the trade mark does not disguise the word element which is still clearly the word BONITA.

The two marks share the same number of letters and syllables. Both marks begin with the letter B and share a similar structure, namely B-NIT-. The letters that differ from one another in the respective marks are vowels and are buried within the respective marks.

As a result, we would submit that there are both visual and phonetic similarities between the marks.”

26. Any similarity between the marks rests in the common letters B, N, I, T which follow the same sequence in both marks. Both marks are six letters long and will be pronounced with three syllables. The applicant’s mark will be pronounced BEN-EAT-O, the opponent’s mark will be pronounced BON-EAT-A. The dots above and below the letter ‘I’ in the opponent’s mark will not be given any origin significance by the average consumer. Taking these factors into account, I find there to be a moderate degree of visual similarity and aural similarity between the marks.

Conceptual similarities

27. The opponent states:

“To the average English consumer, both marks are conceptually meaningless and so there is no way to distinguish the marks conceptually.”

28. The applicant’s mark consists of the word ‘BENITO’. Benito is an Italian forename, perhaps most famously the forename of Mussolini.

29. The opponent’s mark consists of the word ‘BONITA’ which means ‘pretty’ or ‘beautiful’ in Spanish and is also a female forename.

30. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.⁴ The assessment must be made from the point of view of the average consumer. The average consumer cannot be assumed to know the meaning of everything. In the *Chorkee* case (BL O-048-08), Anna Carboni, sitting as the Appointed Person, stated in relation to the word CHEROKEE:

⁴ This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R. 29.

“36. ...By accepting this as fact, without evidence, the Hearing Officer was effectively taking judicial notice of the position. Judicial notice may be taken of facts that are too notorious to be the subject of serious dispute. But care has to be taken not to assume that one’s own personal experience, knowledge and assumptions are more widespread than they are.

37. I have no problem with the idea that judicial notice should be taken of the fact that the Cherokee Nation is a native American tribe. This is a matter that can easily be established from an encyclopedia or internet reference sites to which it is proper to refer. But I do not think that it is right to take judicial notice of the fact that the average consumer of clothing in the United Kingdom would be aware of this. I am far from satisfied that this is the case. No doubt, some people are aware that CHEROKEE is the name of a native American tribe (the Hearing Officer and myself included), but that is not sufficient to impute such knowledge to the average consumer of clothing (or casual clothing in the case of UK TM no. 1270418). The Cherokee Nation is not a common subject of news items; it is not, as far as I am aware, a common topic of study in schools in the United Kingdom; and I would need evidence to convince me, contrary to my own experience, that films and television shows about native Americans (which would have to mention the Cherokee by name to be relevant) have been the staple diet of either children or adults during the last couple of decades.”

31. Similarly in this case, I am aware that Mussolini’s forename was Benito, and am familiar with the meaning of the word Bonita. However, in the absence of any evidence from the parties to the contrary, I am not able to take judicial notice of the fact that the average consumer for the goods at issue would know this.

32. Whilst some may be familiar with both parties’ words being used as forenames, it is more likely that they will simply be seen as words of foreign origin with no particular meaning such that the conceptual position is neutral.

Distinctive character of the earlier mark

33. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been used as coming from a particular undertaking and thus to distinguish those goods and services from those of other undertakings - *Windsurfing Chiemsee v Huber* and *Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

34. The opponent’s mark is the plain word ‘BENITO’, I have already concluded that the average consumer will consider the mark to consist of an invented word. Consequently, the mark possesses a high degree of inherent distinctive character.

Likelihood of confusion

35. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them he has kept in his mind.⁵ I must also keep in mind the average consumer for the goods, the nature of the purchasing process and have regard to 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 vice versa.

36. I have found the marks to have a moderate degree of visual and aural similarity and have found them to be conceptually neutral. I have found a high level of inherent distinctive character in the earlier mark and have found the goods to be identical. I have identified the average consumer, namely a member of the general public and have concluded that the purchase will be primarily visual. The level of attention paid to the purchase will be no more than average, to the extent that the consumer will ensure the correct size, fit, material, colour, and so on.

37. Taking all of these factors into account, particularly the concept of imperfect recollection, and being mindful of the fact that the average consumer does not encounter the marks side by side, the similarity of the marks is such that in the context of goods which are identical there will be direct confusion (where one mark is mistaken for the other).

Conclusion

38. The opposition succeeds.

⁵ *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27.

Costs

39. The opposition having succeeded, the opponent, is entitled to a contribution towards its costs. I have taken into account that no hearing has taken place, but that the opponent filed evidence and written submissions in lieu of a hearing. I make the award on the following basis.

| | |
|---|--------------|
| Preparing a statement and considering the other side's statement: | £ 300 |
| Written submissions: | £ 300 |
| Official fee: | £ 200 |
| Total: | £ 800 |

40. I order More UK Ltd to pay BONITA GmbH & Co. KG. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 17th day of October, 2013

**Ms Al Skilton
For the Registrar,
The Comptroller-General**