

O-077-15

**TRADE MARKS ACT 1994**  
**IN THE MATTER OF APPLICATION NO. 3048602**  
**BY DENNIS BENCE**  
**TO REGISTER THE TRADE MARK:**

**OMEN**

**IN CLASS 25**

**AND**

**IN THE MATTER OF OPPOSITION THERETO**  
**UNDER NO. 402616 BY NEMA S.R.L.**

## BACKGROUND

1. On 26 March 2014, Dennis Bence applied to register the word **OMEN** as a trade mark. The application was published for opposition on 2 May 2014 for the following goods in class 25:

Clothing; footwear; headgear; outfits; costumes; uniforms; underclothing; lingerie; corsetry; belts.

2. The application was opposed by NEMA S.R.L (“the opponent”) under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition, which is directed against all of the goods in the application, was originally based upon two International Registrations (“IR”) one designating the United Kingdom (no. 797113) and the other designating the Community (no. 1180258). However, as IR no. 797113 was subject to the proof of use provisions contained in section 6A of the Act, and as Mr Bence sought proof of use which the opponent did not provide, the tribunal, in a letter dated 2 December 2014, advised the parties that the opposition would proceed in respect of IR no. 1180258 alone. Although the opponent relies upon all of the goods and services in IR no. 1180258 (i.e. classes 14, 18, 25 and 35), only the goods shown below are relevant:

Trade mark:	Designation date:	Protection date:	Relevant Goods
AMEN	7 January 2013  I.C. Priority claimed: 4 October 2012 (Italy)	Not applicable	<b>Class 25</b> - Clothing, footwear, headgear.

The opponent states:

“The application covers identical and similar goods to the goods protected. The marks are highly similar as both consist of four letters and they differ by a single letter. Having regard to consumer’s imperfect recollection, there is a likelihood of confusion on the part of the public, which includes the likelihood of association with the opponent’s earlier right.”

3. Mr Bence filed a counterstatement in which he denies the ground upon which the opposition is based.

4. Neither party filed evidence. Neither party asked to be heard nor did they file written submissions in lieu of attendance at a hearing.

## DECISION

5. The opposition is based upon section 5(2)(b) of the Act which reads as follows:

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

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

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

6. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6.-(1) In this Act an “earlier trade mark” means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

7. In these proceedings, the opponent is now relying solely upon the trade mark shown in paragraph 2 above, which qualifies as an earlier trade mark under the above provisions. As this trade mark has not achieved protected status, it is not subject to the proof of use provisions. Any decision in the opponent’s favour will, given the provisions of section 6(2) of the Act, be conditional upon the earlier trade mark achieving protected status.

### **Section 5(2)(b) – case law**

8. 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.

### **The principles:**

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

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

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

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

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

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

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

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

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

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

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

## **Comparison of goods**

9. The competing goods are as follows:

<b>Opponent's goods in class 25</b>	<b>Mr Bence's goods</b>
Clothing, footwear, headgear.	Clothing; footwear; headgear; outfits;

	costumes; uniforms; underclothing; lingerie; corsetry; belts
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In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM) case T-133/05, the General Court (“GC”) stated:

“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 the trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 Oberhauser v OHIM – Petit Liberto (Fifties) [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 Vedral v OHIM – France Distribution (HUBERT) [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 Koubi v OHIM – Flabesa (CONFORFLEX) [2004] ECR II-719, paragraphs 41 and 42).”

10. As both parties’ specifications in class 25 include the terms clothing, footwear and headgear, these goods are literally identical. As the remaining goods in Mr Bence’s specification i.e. outfits, costumes, uniforms, underclothing, lingerie, corsetry and belts would all be encompassed by the term clothing in the opponent’s specification, these goods are also to be regarded as identical on the principles outlined in *Merica*.

### **The average consumer and the nature of the purchasing decision**

11. As the case law above indicates, it is necessary for me to determine who the average consumer is for the goods at issue; I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. 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.”

12. The average consumer of the goods at issue is a member of the general public. As to how such an average consumer selects such goods, 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 the GC stated:

“50. The applicant has not mentioned any particular conditions under which the goods are marketed. 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.”

13. As the goods at issue are, in my experience, most likely to be the subject of self selection from traditional retail outlets on the high street, catalogues and websites, I agree that visual considerations are likely to dominate the selection process, but not to the extent that aural considerations can be ignored. The cost of the goods at issue can vary considerably. In *New Look* the GC also considered the level of attention taken when purchasing goods in the clothing sector. It stated:

“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.”

14. When selecting the goods at issue, factors such as material, size, colour, cost and compatibility with other items of clothing etc. may all come into play. As a consequence, the average consumer will, in my view, pay a reasonable degree of attention (i.e. no lower or higher than the norm) to the selection of the goods at issue, a degree of attention which, I accept, may increase as the cost and importance of the item increases.

### **Comparison of trade marks**

15. 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.”

16. 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 trade marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the trade marks.

17. The competing trade marks are: **OMEN** (the application) and **AMEN** (the opponent's earlier trade mark). As both parties' trade marks consist of a single word presented in upper case, there are no dominant or distinctive elements; the overall impression created by both trade marks is of a single word. Both trade marks consist of four letters and two syllables; the last three letters and second syllable of each are identical, whereas the first letter of each word differs. The above analysis results, in my view, in the competing trade marks being visually and aurally similar to at least a reasonable degree. As both words will be very well known to the average consumer as meaning a word used at the end of a prayer (AMEN) and as an occurrence regarded as a sign of future happiness or disaster (OMEN), the competing trade marks are conceptually dissonant.

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

18. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. 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 registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. As the opponent has not filed any evidence in these proceedings, I have only the inherent characteristics of its trade mark to consider. Although the word AMEN will be very well known to the average consumer, as it has neither descriptive nor allusive qualities in relation to the goods in class 25 for which protection has been sought, it is, in my view, possessed of an average degree of inherent distinctive character.

### **Likelihood of confusion**

19. In determining whether there is a likelihood of confusion, 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 vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark as the more distinctive this trade mark is, the greater the likelihood of confusion. 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 and must instead rely upon the imperfect picture of them he has retained in his mind. Earlier in this decision, I concluded that:

- the competing goods are identical;
- the average consumer is a member of the general public who will select the goods by primarily visual means and who will pay at least a reasonable degree of attention when doing so;
- the competing trade marks are visually and aurally similar to at least a reasonable degree and conceptually dissonant;
- the opponent's earlier trade mark is possessed of an average degree of inherent distinctive character.

20. In *The Picasso Estate v OHIM*, Case C-361/04 P, the Court of Justice of the European Union ("CJEU") found that:

"20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law."

In *Nokia Oyj v OHIM*, Case T-460/07, the GC stated that:

"Furthermore, it must be recalled that, in this case, although there is a real conceptual difference between the signs, it cannot be regarded as making it possible to neutralise the visual and aural similarities previously established (see, to that effect, Case C-16/06 P *Éditions Albert René* [2008] ECR I-0000, paragraph 98)."

21. I begin by reminding myself that identical goods are involved. Whilst I am mindful of the guidance in *Nokia*, the fact that the competing trade marks have different meanings which will be very well known to the average consumer and will act as a conceptual hook to aid their recollection, is, in my view, more than sufficient in this case, to counteract the visual and aural similarities I have identified above. The consequence of that conclusion is that the opposition fails.

## Overall conclusion

**22. The opposition to the application has failed, and subject to any successful appeal, the application will proceed to registration.**

## Costs

23. Mr Bence has been successful and is entitled to a contribution towards his costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide, I award costs to Mr Bence on the following basis:

Preparing a statement and considering the opponent's statement:	£300
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<b>Total:</b>	<b>£300</b>
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24. I order NEMA S.R.L. to pay to Dennis Bence the sum of **£300**. 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 February 2015**

**C J BOWEN  
For the Registrar  
The Comptroller-General**