

O-136-17

**TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK APPLICATION NO 3143790
BY TOM DAVID STEPHENSON
TO REGISTER**



**AS A TRADEMARK
IN CLASS 25
AND OPPOSITION THERETO (UNDER NO.406753)
BY
VELUM LIMITED ITM SA**

BACKGROUND AND PLEADINGS

1. Tom David Stephenson ('the applicant') applied to register the following mark on 11 January 2016:



2. It was accepted and published on 15 April 2016 for the following goods in class 25: **Sports jerseys and breeches for sports.**

3. Velum Limited ITM SA ('the opponent') opposed the trademark under section 5(2)(b) of the Trade Marks Act 1994 (the Act) on the basis of the two trademarks set out below:

Opponent's marks	Goods relied on
UK trademark no. 1436931 LAZER Filing date: 2/8/90 Registration date: 18/8/95	Class 25: Long johns, spray suits, spray tops, dry tops, sweatshirts, rugby shirts and tee shirts, all being articles of clothing; all included in class 25
EU Trademark no. 208686 LAZER Filing date: 1/4/96	Class 25: clothing; clothing for sailing

Registration date: 29/11/2000	
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4. The opponent's trademarks are earlier marks, in accordance with Section 6 of the Act and as they completed their registration procedure more than 5 years prior to the publication date of the applicant's mark, they are subject to the proof of use conditions, as per section 6A of the Act. The opponent made a statement of use in respect of all the goods it relies on.

5. The applicant filed a counterstatement denying the grounds of opposition. In answer to question 7 of Form TM8 which states "Do you want the opponent to provide 'proof of use'?", the applicant ticked the "No" box. Consequently, the opponent is entitled to rely on the full breadth of the goods for which it made a statement of use.

6. Both parties filed evidence. However, I do not consider it necessary to summarise it. The opponent's evidence is irrelevant as it largely focusses on sailing boats and does not give any information regarding use of the mark for the class 25 goods at issue for this opposition. The applicant's evidence is also irrelevant as it consists of examples of how the applicant uses its mark on its website and of pre-action letters between them and the opponent. None of this information is of any relevance to the matter before me.

7. Neither party requested to be heard. Only the opponent filed written submissions in lieu. The applicant submitted a costs pro-forma only. I now make this decision on the papers before me. Given that the two earlier marks relied upon are identical and that EU Trademark no. 208686 covers a broader range of goods, I will use this mark as the basis for the comparison. The opponent is in no better position in relation to other mark.

DECISION

8. Section 5(2)(b) of the Act is 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.

9. The leading authorities which guide me are from the Court of Justice of the European Union ('CJEU'): *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles

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

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

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

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks

bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

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

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

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

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

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

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

COMPARISON OF GOODS

10. The goods to be compared are:

Opponent's goods	Applicant's goods
Class 25: clothing; clothing for sailing	Class 25: Sports jerseys and breeches for sports.

11. The opponent's earlier mark contains the term 'clothing' at large. That is to say the term will cover all forms of clothing. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court ('GC') stated that:

"29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut fur Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark".

12. Therefore the term 'clothing' will cover all of the applicant's goods and are considered as identical goods.

13. In reaching the above conclusion, I have not overlooked the applicant's submissions regarding the kinds of goods that they currently use their mark on and the trade channels through which they sell those goods, which they state are different to the way in which the opponent markets its goods. The way in which either party currently uses their marks is irrelevant. I must compare the parties' goods on the basis of notional and fair use of the goods listed in the parties' specifications. In *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchen L.J. stated that:

"78.the court must.... consider a notional and fair use of that mark in relation to all of the goods or services in respect of which it is registered. Of course it may have become more distinctive as a result of the use which has been made of it. If so, that is a matter to be taken into account for, as the Court of Justice reiterated in *Canon* at paragraph [18], the more distinctive the earlier mark, the greater the risk of confusion. But it may not have been used at all, or it may only have been used in relation to some of the goods or

services falling within the specification, and such use may have been on a small scale. In such a case the proprietor is still entitled to protection against the use of a similar sign in relation to similar goods if the use is such as to give rise to a likelihood of confusion.”

14. In addition in *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06, the CJEU stated at paragraph 66 of its judgment that when assessing the likelihood of confusion under Section 5(2) it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered. In *Oakley v OHIM* (case T-116/06) it is made clear that consideration of likelihood of confusion is prospective and not to be restricted to the current marketing or trading patterns of the parties:

“...since the particular circumstances in which the goods covered by the marks are marketed may vary in time, and depending on the wishes of the proprietors of the trade marks, the prospective analysis of the likelihood of confusion between the two marks, ...cannot be dependent on the commercial intentions, whether carried out or not – and which are naturally subjective –of the trade mark proprietors...”

AVERAGE CONSUMER AND THE PURCHASING PROCESS

15. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

16. 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.”

17. The goods at issue in this matter are clothing. 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:

“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.”

18. The average consumer for the contested goods are the general public and those with an interest in sport. As stated by the GC, items of clothing vary in price and quality. Ordinarily I would expect a normal level of attention to be paid by the consumer when selecting such goods. The purchasing act will be mainly visual and will likely be based on the aesthetic appeal of a garment. It is likely that goods will be selected after perusal of racks/shelves in retail establishments, or from photographs on Internet websites or in catalogues. However, I do not discount aural considerations which may also play a part.

COMPARISON OF THE MARKS

19. The marks to be compared are:

Opponent's mark	Applicant's mark
LASER	 <p>The logo for 'LAZER TEAM KITS' features a stylized, bold, black 'Z' shape above the word 'LAZER' in a bold, sans-serif font, with 'TEAM KITS' in a smaller, bold, sans-serif font below it.</p>

20. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union 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.”

It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

21. The opponent’s mark consists of the single word LASER. The overall impression is based solely on that word. The applicant’s mark is a composite mark comprising a device, the stylised word LAZER and the words TEAM KITS in plain block capitals. The words TEAM KITS will be seen as descriptive matter given the goods covered in the specification and therefore carry little weight in the overall impression of the mark. It is the remaining two elements, that is LAZER and the device which have equal weight in forming the overall impression of the mark.

22. In a visual comparison of the marks, the only point of similarity are the words LASER/LAZER. The opponent’s mark has no other visual elements whereas the applicant’s mark has a device placed above the word LAZER which is the same width as the word. The word LAZER is stylised with the letter Z being slightly larger than the two letters either side of it. The descriptive words TEAMS KITS are placed beneath. I find there is a medium degree of visual similarity.

23. In an aural comparison of the marks, the words LASER and LAZER are pronounced in the same way. It is unlikely that a consumer would vocalise the device element. Furthermore I also consider it unlikely that the consumer will vocalise the TEAM KITS part of the mark. It is more likely that only LAZER will be pronounced. On that basis, the marks would be aurally identical. However, even allowing for vocalisation of all of the words, LAZER TEAM KITS, I still consider there would be a reasonable degree of aural similarity.

24. In a conceptual comparison of the marks, the immediate concept portrayed by the opponent’s mark is that of a laser beam or a device producing such a beam. Although the word laser is itself made up of an acronym for Light Amplification by

Stimulated Emission of Radiation, it is unlikely that the average consumer would be aware of this full scientific definition and would simply know the general meaning I have identified. I would expect the immediate concept portrayed by the applicant's mark to be the same given that the word LAZER so closely resembles the well-known word LASER and that the consumer may not, in any event, be aware of the correct spelling. The device element is unlikely to form part of the conceptual hook and the words TEAM KITS are entirely descriptive of the nature of the goods. I find there is high degree of conceptual similarity.

DISTINCTIVE CHARACTER OF THE EARLIER MARKS

25. The distinctive character of the earlier mark must be considered. The more distinctive it is, either inherently or through use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from

chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

26. The opponent did not file any relevant evidence showing use for the goods relied on so I can only consider the inherent distinctiveness of the earlier mark.

27. The word LASER, being an ordinary dictionary word, does not describe or allude to the relevant goods. I find that there is a normal level of inherent distinctiveness.

LIKELIHOOD OF CONFUSION

28. In the counterstatement, the applicant refers to an earlier registration in his name which pre-dates the opponent’s mark. He contends that the opponent’s claims must therefore be “very weak”. However the applicant’s earlier registration can have no bearing on my decision here for the reasons set out in Tribunal Practice Notice 4/2009 which states:

“1. A number of counterstatements in opposition and invalidation actions have sought to introduce as a defence that the applicant for registration/registered proprietor has a registered trade mark (or trade mark application) for the same or a highly similar trade mark to that which is the subject of the proceedings that predates the earlier mark upon which the attacker relies.

2. Sections 5(1) and 5(2) of the Act turn upon whether the attacker has an earlier trade mark compared to the mark under attack, as defined by section 6 of the Act. Whether the applicant for registration/registered proprietor has another registered trade mark (or trade mark application) that predates the earlier mark upon which the attacker relies cannot affect the outcome of the case in relation to these grounds.

3. The position was explained by the Court of First Instance in *PepsiCo, Inc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) T-269/02*:

"24 Nor did the applicant claim, and even less prove, that it had used its earlier German mark to obtain cancellation of the intervener's mark before the competent national authorities, or even that it had commenced proceedings for that purpose.

25 In those circumstances, the Court notes that, quite irrespective of the question whether the applicant had adduced evidence of the existence of its earlier German mark before OHIM, the existence of that mark alone would not in any event have been sufficient reason for rejecting the opposition. The applicant would still have had to prove that it had been successful in having the intervener's mark cancelled by the competent national authorities.

26 The validity of a national trade mark, in this case the intervener's, may not be called in question in proceedings for registration of a Community trade mark, but only in cancellation proceedings brought in the Member State concerned (Case T 6/01 *Matratzen Concord v OHIM - Hukla Germany (MATRATZEN)* [2002] ECR II 4335, paragraph 55). Moreover, although it is for OHIM to ascertain, on the basis of evidence which it is up to the opponent to produce, the existence of the national mark relied on in support of the opposition, it is not for it to rule on a conflict between that mark and another mark at national level, such a conflict falling within the competence of the national authorities."

29. I must now draw together my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors:

- a) The interdependency principle, whereby a lesser degree of similarity between the goods may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc*).
- b) The principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*).

- c) The factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*).

30. I have found that the marks are visually similar to a medium degree, aurally identical or similar to a reasonable degree at least, and conceptually highly similar. Taking these factors into account together with the identical goods in play, the normal level of attention that will be paid by the average consumer and the normal level of distinctiveness of the earlier mark, I find that there is a likelihood of confusion. Even if the consumer does not mistake one mark for the other, they are, at the very least, likely to believe that the respective goods come from the same or linked undertakings.

CONCLUSION

31. The opposition succeeds under section 5(2)(b) of the Act for all the goods claimed.

COSTS

32. As the opponent has been successful, they are entitled to a contribution towards their costs incurred in the proceedings. It appears that the Tribunal incorrectly attached a Tribunal Costs Pro-Forma to the representative for the opponent with a letter dated 17 January 2017. The Pro-Forma is only intended to be sent to litigants in person. As the representative is a professional legal IP practitioner, the Costs Pro-Forma is not necessary. Using the guidance in Tribunal Practice Notice 4/2007 (which was in force when the opposition was filed) I make the following award:

£100 official fee for TM7

£200 preparing a statement and considering the other side's statement.

£300 written submissions

33. I am not awarding costs for the preparation of evidence as it was considered irrelevant to the decision made in this case.

34. I order Tom David Stephenson to pay Velum Limited ITM SA the sum of £600. This sum is to be paid within 14 days of the expiry of the appeal period or within 14 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 23rd day of March 2017

June Ralph
For the Registrar,
The Comptroller General