

**O-015-18**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK REGISTRATION NO. 3158688**

**IN THE NAME OF DJ2GO LTD**

**IN RESPECT OF THE TRADE MARK:**



**AND**

**AN APPLICATION FOR A DECLARATION OF INVALIDITY THERETO**

**UNDER NO 501541 BY DG INTERNATIONAL HOLDINGS LIMITED**

**& DG CAPITAL LIMITED**

## Background and pleadings

1. The trade mark shown on the cover page of this decision stands registered in the name of DJ2GO Ltd (“the proprietor”). It was applied for on 9 April 2016 and entered in the register on 8 July 2016. It is registered in class 9 for: “Travel adaptors for electric plugs.”

2. On 31 January 2017, DG International Holdings Limited and DG Capital Limited (“the applicants”) filed an application to have this trade mark declared invalid under the provisions of sections 47(2)(a) and 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The relevant provisions read as follows:

“47(2) The registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b)...

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2A) But the registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless—

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if–

(a) within the period of five years ending with the date of the application for the declaration the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) For these purposes–

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered,

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(2D) In relation to a Community trade mark, any reference in subsection (2B) or (2C) to the United Kingdom shall be construed as a reference to the European Community.

2E) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

.....

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made.

Provided that this shall not affect transactions past and closed.”

And:

“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.”

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.”

3. The applicants rely upon the goods (shown in paragraph 8 below), in the following United Kingdom trade mark registrations:

No. 2563013 for the trade mark shown below which was applied for on 2 November 2010 and entered in the register on 20 December 2013:



No. 2649748 for the same trade mark shown above which was applied for on 23 January 2013 and entered in the register on 1 August 2014.

4. The trade marks shown above qualify as earlier trade marks under the above provisions. As these trade marks had not been registered for more than five years when the application for invalidation was filed, they are not subject to proof of use, as per section 47(2)(2A) of the Act. As a consequence, the applicants are entitled to rely upon them in relation to the goods claimed without having to establish genuine use.

5. The proprietor filed a counterstatement in which the basis of the application is denied.

6. In these proceedings, the applicants are represented by Marks & Clerk LLP; the proprietor represents itself. Although neither party filed evidence, both filed written submissions during the course of the evidence rounds. Whilst neither party asked to be heard, the applicants filed written submissions in lieu of attendance at a hearing. I shall refer to these submissions, as necessary, later in this decision.

## **DECISION**

### **Section 5(2)(b) – case law**

7. The following principles are gleaned from the decisions of the courts of the European Union 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 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 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**

8. The competing goods are as follows:

<b>Applicants' goods</b>	<b>Proprietor's goods</b>
<b>No. 2563013</b>  Class 9 - Electrical plugs; fittings and adapters for electrical plugs; parts and fittings for all the aforesaid goods.	Class 9 - Travel adaptors for electric plugs.
<b>No. 2649748</b>  Class 9 - Adaptors; travel adaptors; travel chargers for small electronic devices; emergency phone chargers;	

parts and fittings for all the aforesaid goods.	
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9. The applicants' specifications include, inter alia, "fittings and adapters for electrical plugs" (no. 2563013) and "travel adaptors" (no. 2649748). Such goods are, self-evidently, identical to the goods for which the proprietor's trade mark is registered.

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

10. 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."

11. The average consumer of the goods at issue is a member of the general public. As such goods will, for the most part, be the subject of self-selection from the shelves of a bricks and mortar retail establishment or from the equivalent pages of a website or catalogue, visual considerations are likely to dominate the selection process. That said, as such goods may also be the subject of, for example, word of mouth recommendation or oral requests to sales assistants (both in person and by telephone), aural considerations must be kept in mind. Although the cost of the goods is unlikely to be high, as the average consumer will need to be satisfied that the adaptor is suitable for the country or countries in which it is to be used, I would expect a normal degree of attention to be paid during the selection process.



## Comparison of trade marks

12. 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 them, 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.”

13. It would be wrong, therefore, artificially to dissect the trade marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions they create. As the applicants’ earlier trade marks are identical, the comparison is between:

Applicants’ trade mark	Proprietor’s trade mark
 The logo for 'Go TRAVEL' consists of the word 'Go' in a large, white, rounded font inside a black rounded square, with the word 'TRAVEL' in a smaller, white, sans-serif font below it.	 The logo for 'DJ2GO Travel' features a stylized blue wave graphic above the text 'DJ2GO Travel' in a blue, sans-serif font. A yellow sun-like shape is partially visible behind the wave.

14. In reaching a conclusion, I will keep in mind (but do not intend to record here) the parties’ competing submissions on this aspect of the case. That said, the proprietor’s submissions regarding: (i) online searches it has carried out, (ii) the results of the ex-parte examination (of what was then its trade mark application) and (iii) the results of

the proprietor's own search of the trade mark's register (and the conclusions it reaches as a result) are not relevant and will form no part of my considerations.

15. The applicants' trade mark consists of a number of components. The first, is a device consisting of a black square (with three rounded corners), a white border (also with three rounded corners) and black edging. The second component, presented in white, consists of what the average consumer will, in my view, interpret as a stylised upper case letter "G" and a lower case letter "o", forming the word "Go". The third and final component is the word "TRAVEL" presented in white in block capital letters.

16. Turning first to the device, notwithstanding its size in the context of the trade mark as a whole, consisting as it does of a background upon which the words appear, its contribution to the overall impression the trade mark conveys and any distinctiveness it may possess will be limited. The words "Go" and "TRAVEL" and their meanings will be very well-known to the consumer. In their submissions filed during the evidence rounds, the applicants explain that the Oxford English dictionary defines "go" as meaning "move from one place to another; travel". While the component which will be interpreted as the word "Go" will, given its size and positioning, make an important contribution to the overall impression conveyed, when considered in the context of the goods at issue i.e. travel adaptors, it has, despite its stylisation, only a low degree of inherent distinctive character. Although much smaller, the word "TRAVEL" will contribute to the overall impression conveyed. However, when considered in relation to the goods at issue it is descriptive and has no distinctive character. Drawing those conclusions together, when considered in the context of the goods at issue, the applicants' trade mark is, in my view, most likely to be interpreted by the average consumer in one of two ways i.e. as either "Go" branded goods for travel or as a "unit" which will be construed as an exhortation to the average consumer to embark on a journey. In the first example, the overall impression conveyed by the trade mark and its distinctiveness is likely to be dominated by the stylised word "Go" and in the second example, in the unit the words "Go" and "TRAVEL" create.

17. The proprietor's trade mark also consists of a number of components. The first, is a device presented in yellow, white and various shades of blue. The second and third components consists of a yellow triangle (appearing in the top left hand corner) and a smaller blue triangle (appearing in the bottom right hand corner). The fourth and fifth components consist of the letter and numeral "DJ2GO" presented in blue and, also presented in blue, the word "Travel" presented in title case.

18. Given their size and positioning in the context of the trade mark as a whole, the second and third components are, in my view, likely to go unnoticed. However, even if they are noticed, any contribution to the overall impression the trade mark conveys or its distinctive character will be very low. As the first component appears at the top of the trade mark and is clearly significant within the context of the trade mark as a whole, it will contribute to the overall impression conveyed. The average consumer is, in my view, most likely to interpret this device as a stylised landscape in which the elements are interpreted as (i) a sun (the yellow element), (ii) skyscrapers (the rectangular elements) and (iii) the sea (the dark blue, white and light blue elements). As such stylised representations of landscapes are, in my experience, commonly used in relation to, inter alia, travel related goods, its distinctive character is likely to be at best moderate. Like the applicants' trade mark, although the word "Travel" will contribute to the overall impression conveyed, it will be a descriptive contribution. That leaves the combination "DJ2GO" to consider. Given its size and positioning, this component will make an important contribution to the overall impression the proprietor's trade mark conveys. As to the distinctiveness of this component, it is presented as a conjoined whole in which no letter or numeral is emphasised in any way; it is, in my view, a highly distinctive component of the proprietor's trade mark.

19. The device elements in the competing trade marks have no similarity whatsoever. The competing trade marks do, however, coincide in that both contain either a component which will be interpreted as the word "Go", contain the letters "G-O" and both contain the word "TRAVEL"/"Travel" presented as a standalone word. The words "Go TRAVEL" or "...GO" Travel (or features which will be construed as these letters) appear in the same order in both trade marks. However, the word "Go" is presented in a stylised fashion as a standalone component in the applicants' trade mark, whereas in the proprietor's trade mark the letters "GO" are simply the last two

letters of a four letter and one numeral conjoined word. Balancing the similarities between the competing trade marks, including the relevance of the shared components, results in a very low degree of visual similarity between them.

20. As to the aural similarity it is well-established that when trade marks consist of a combination of verbal and figurative components, it is by the verbal components that the trade marks are most likely to be referred. Applied to these proceedings in the light of my conclusions above and in particular the descriptive nature of the word travel, the applicants' trade mark is most likely to be referred to as either "Go" or, much more likely in my view, "Go TRAVEL", whereas the proprietor's trade mark is most likely to be referred to as either "DeeJayTwoGo" or "DeeJayTwoGo Travel". The highpoint of the applicants' case lies in the average consumer articulating the competing trade marks as "Go TRAVEL" and "DeeJayTwoGo Travel." However, even in those circumstances, the degree of aural similarity that results is low.

21. Finally, the conceptual comparison. As I mentioned earlier, if the applicants' trade mark creates any conceptual impression in the average consumer's mind it is likely to be of an encouragement to travel. As the proprietor's trade mark is also likely to evoke the concept of travel, the competing trade marks are, to that very limited extent, conceptually similar. However, that is a purely descriptive conceptual image, whereas the letters and numeral "DJ2GO" in the proprietor's trade mark are unlikely to convey any concrete conceptual image in the mind of the average consumer.

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

22. 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.

23. As the applicants have filled no evidence of any use they may have made of their earlier trade mark, I have only its inherent characteristics to consider. I have already commented upon how the applicants' trade mark is likely to be construed above. As the applicants point out, the word "Go" means, inter alia, to travel. Considered on that basis in the context of the goods at issue, whether it is construed as "Go" branded travel goods or as a unit meaning an encouragement to travel, it is, when considered as a whole, in my view, possessed of a low degree of inherent distinctive character. It is of course only the distinctive character of the components in conflict that matters; I shall return to this point below.

#### **Likelihood of confusion**

24. 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 applicants' trade mark as the more distinctive it 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.

25. In reaching a conclusion I remind myself that the competing goods are identical; this is a point in the applicants' favour. I further concluded that the average consumer would select the goods at issue by predominantly visual means whilst paying a normal degree of attention and having assessed the competing trade marks distinctive and dominant components, that they were visually similar to a very low degree, aurally similar to a low degree, conceptually similar to the limited extent that both evoke the descriptive concept of travel and that absent use, the applicants' trade mark is possessed of a low degree of inherent distinctive character. In *Kurt*

*Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He stated:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

26. Confusion can be direct or indirect. In their submissions filed during the evidence rounds, the applicants stated:

“7. The Applicants note also that the challenged mark is likely to be perceived as a sub-brand or range offered by the applicants under its GO TRAVEL marks.”

27. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, 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.”

28. The only similarity between the competing trade marks is in relation to components which either have low i.e. “Go” or no distinctive character i.e. “TRAVEL”. In addition, in the proprietor’s trade mark, the letters “GO” form part of a conjoined whole. Bearing those points in mind and notwithstanding the identity in the competing goods, given the various differences in the competing trade marks I have identified earlier, I think it highly unlikely that an average consumer paying a normal degree of attention during the selection process would mistake one trade mark for the other i.e. there will be no direct confusion. In addition, I see no reason why an average consumer would assume the proprietor’s trade mark is a sub-brand or range offered by the applicants, simply because of the mere presence in it of the letters “G-O” (as part of a conjoined whole) and a word “Travel” which describes the nature of the goods at issue i.e. there is no likelihood of indirect confusion. Having reached those conclusions, the application for invalidity fails.

### **Overall conclusion**

**29. The application has failed and, subject to any successful appeal, the proprietor’s trade mark will remain registered.**

### **Costs**

30. As the proprietor has been successful, it is, in principle, entitled to a contribution towards its costs. Awards of costs in proceedings commenced after 1 July 2016 are governed by Annex A of Tribunal Practice Notice (“TPN”) 2 of 2016. In its submissions, the proprietor stated:

“5...If we win, I DO NOT SEEK ANY costs involved as we are not seeking compensation or trying to make money off the back of another company, we

are just defending our trademark that relates to our business and has nothing to do with [the applicants'] business.”

31. As the proprietor is unrepresented, at the conclusion of the evidence rounds the tribunal invited it, inter alia, to indicate whether it intended to make a request for an award of costs, and if so, to complete a pro-forma indicating a breakdown of its actual costs, including providing accurate estimates of the number of hours spent on a range of given activities relating to the prosecution of the opposition; it was made clear to the proprietor that if the pro-forma was not completed “no costs, other than official fees arising from the action and paid by the successful party...will be awarded”.

32. In an e-mail dated 11 September 2017, the proprietor responded to the tribunal indicating “[It was] happy for the hearing to go to “decision from the papers.” Attached to that email was a copy of the tribunal’s letter of 1 September 2017 and the costs pro-forma referred to above, which was blank. The fact that the proprietor did not complete the pro-forma is, in my view, a clear indication that its original position on costs mentioned above had not changed and, as a consequence, I make no order as to costs.

**Dated this 8<sup>th</sup> day of January 2018**

**C J BOWEN**

**For the Registrar**

**The Comptroller-General**