

**O-542-18**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3270839 BY  
GOPRO, INC  
TO REGISTER:**

**GOPRO**

**AS A TRADE MARK IN CLASSES 18 & 25**

**AND**

**OPPOSITION THERETO (UNDER NO. 60000812) BY  
OLIVIER GOLDBERG**

## Background and pleadings

1. GoPro, Inc (“the applicant”) applied to register the trade mark **GOPRO** in the UK on 15 November 2017. It was accepted and published in the Trade Marks Journal on 1 December 2017. Registration is sought in relation to:

**Class 18:** Bags, camera bags, bags and covers for cameras and accessories, tote bags, backpacks, duffel bags, travel bags, luggage, overnight bags, athletic bags, gym bags, grip bags, kit bags, sports bags, sports packs, waist bags, shoulder bags, crossbody bags, purses, wallets, handbags and clutches; umbrellas.

**Class 25:** Clothing, footwear, headgear; Women’s, men’s and children’s clothing; shirts, tops, polo shirts, t-shirts, tank tops, sweatshirts, sweaters, hoodies, pullovers, jerseys, sports jerseys, vests, jackets, rain gear, rain jackets, slickers, wind-jackets and vests; pants, slacks, jeans, athletic clothing and gear, shorts, athletic pants, yoga pants, sweat pants, warm up suits, track suits, sports skirts, athletic tights, socks, stockings, underwear, sports bras, pajamas, and loungewear; jerseys, pants, shorts and uniforms for skiing, hang gliding, snowboarding, hockey, wrestling, surfing, skateboarding, cycling, motocross, running, water-skiing, diving, and engaging in sports related activities; bathing suits, bathing trunks, wet suits, athletic sleeves, compression sleeves, bandanas, belts, gloves; headwear, hats, caps, scarves, headbands, sweatbands, and visors; footwear, shoes, tennis shoes, sneakers, running shoes, sandals, slippers, rain boots, boots for sports.

2. Mr Olivier Goldberg (“the opponent”) opposed the registration of the mark using the fast track opposition procedure. The opposition is based on section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), with the opponent relying on a single earlier European Union trade mark registration, namely:

Registration 12244273 for the mark **G PRO** which was filed on 22 October 2013 and registered on 21 December 2017. Although it is registered for

more goods, the opponent relies only on the following goods for the purpose of these proceedings:

**Class 18:** Leather and imitations of leather; Animal skins, hides; Trunks and travelling bags; Umbrellas, big umbrellas and walking sticks; Whips, harness and saddlery.

**Class 25:** Clothing, footwear, headgear.

3. The opponent contends that some of the goods are identical, others highly similar, and that the marks are highly similar overall, which will lead to a likelihood of confusion between the marks.

4. The applicant filed a counterstatement denying the ground of opposition.

5. In these proceedings, the applicant has been represented by Lane IP Limited, the opponent by Barker Brettell LLP.

6. Rule 6 of the Trade Marks (Fast Track Opposition)(Amendment) Rules 2013, S.I. 2013/2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.

7. The net effect of these changes is to require parties to seek leave in order to file evidence in fast track opposition proceedings. No leave was sought in respect of these proceedings.

8. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken. Neither party, nor the Tribunal, requested a hearing. Both sides did, however,

file written submissions, although the opponent merely provided another copy of what it had already provided in its statement of case. I note that the applicant's submissions contained three annexes, one containing prints of searches undertaken on Google for the respective marks, another containing submissions the opponent made in EUIPO proceedings which differ from those made to this Tribunal on certain points, and the other containing examples of the letter G being used in trade as an abbreviation for "girls"; none of this material will be taken into account. The role of submissions are to provide legal argument about the merits of the case, not to provide what is clearly intended to be evidential material, and for which no leave has been sought.

## **Decision**

9. Section 5(2)(b) of the Act states that:

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.

10. An "earlier trade mark" is defined in section 6 of the Act:

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.

11. The registration upon which the opponent relies qualifies as an earlier trade mark under the above provisions. As it was registered within the five years before the date on which the applicant's mark was published, it is not subject to proof of use. The opponent is therefore entitled to rely upon it for all the goods it identified in its statement of case.

### **Section 5(2)(b) case law**

12. 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):

- (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. The average consumer 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**

13. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer*, the Court of Justice of the European Court of Justice (“CJEU”) stated:

In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.<sup>1</sup>

14. Guidance on this issue has also come from Jacob J in *British Sugar Plc v James Robertson & Sons Limited ("Treat")*<sup>2</sup> where the following factors were highlighted as being relevant when making the comparison:

- (a) the respective uses of the respective goods or services;
- (b) the respective users of the respective goods or services;
- (c) the physical nature of the goods or acts of service;
- (d) the respective trade channels through which the goods or services reach the market;
- (e) in the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) the extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

15. The applicant seeks registration for the following goods in class 25:

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1 - C-397/97, para. 23  
2 - [1996] RPC 281

**Class 25:** Clothing, footwear, headgear; Women's, men's and children's clothing; shirts, tops, polo shirts, t-shirts, tank tops, sweatshirts, sweaters, hoodies, pullovers, jerseys, sports jerseys, vests, jackets, rain gear, rain jackets, slickers, wind-jackets and vests; pants, slacks, jeans, athletic clothing and gear, shorts, athletic pants, yoga pants, sweat pants, warm up suits, track suits, sports skirts, athletic tights, socks, stockings, underwear, sports bras, pajamas, and loungewear; jerseys, pants, shorts and uniforms for skiing, hang gliding, snowboarding, hockey, wrestling, surfing, skateboarding, cycling, motocross, running, water-skiing, diving, and engaging in sports related activities; bathing suits, bathing trunks, wet suits, athletic sleeves, compression sleeves, bandanas, belts, gloves; headwear, hats, caps, scarves, headbands, sweatbands, and visors; footwear, shoes, tennis shoes, sneakers, running shoes, sandals, slippers, rain boots, boots for sports.

16. The opponent's earlier mark covers clothing, footwear and headgear.

17. Goods can be considered identical if they are encompassed by a competing term<sup>3</sup>. In this case, the opponent argues that all of the applied for goods are identical to goods of the earlier marks because they all fall within either clothing, footwear or headgear. This is an attractive argument to make because, on face value, all of the applied for goods do appear to be encompassed by one, or other, of those terms. However, the applicant takes issue with this approach particularly with respect to the terms athletic sleeves and compression sleeves, arguing that such items are not really clothing and would be better classified as sporting or medical equipment. I disagree with the applicant. Whilst the items may assist a sportsperson when the items are being worn, the fact that they are worn (on the arms) indicates that they are still items of clothing. They are, therefore, still encompassed by the term clothing which, itself, covers sports clothing. All of the class 25 goods are identical to goods covered by the earlier mark.

18. The competing specifications in class 18 are set out below:

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<sup>3</sup> See, for example, *Gérard Meric v OHIM* (Case T-133/05).



### Applicant's goods

**Class 18:** Bags, camera bags, bags and covers for cameras and accessories, tote bags, backpacks, duffel bags, travel bags, luggage, overnight bags, athletic bags, gym bags, grip bags, kit bags, sports bags, sports packs, waist bags, shoulder bags, crossbody bags, purses, wallets, handbags and clutches; umbrellas.

### Opponent's goods

**Class 18:** Leather and imitations of leather; Animal skins, hides; Trunks and travelling bags; Umbrellas, big umbrellas and walking sticks; Whips, harness and saddlery.

19. The applied for umbrellas are clearly identical as the term is covered by both specifications.

20. In relation to the various bags applied for, the applicant makes the point, which I agree with in general terms, that not all bags are the same. The closest term covered by the earlier mark to the various applied-for bags is likely to be "travelling bags". Although for travelling, it is still a bag and may have no set style or shape and could range from a duffel-type bag, a holdall, or even a rucksack-type bag. Consequently, I consider the following terms to be either identical or highly similar to the opponent's travelling bags: bags, backpacks, duffel bags, travel bags, luggage, overnight bags, athletic bags, gym bags, grip bags, kit bags and sports bags.

21. In relation to the applied-for "camera bags, bags and covers for cameras and accessories", even if designed to carry camera equipment, the bag may still have a similar nature to a travelling bag and be made from the same material. Whilst the general purpose is different, it could still be the case that someone looking to travel may be looking for a particular type of camera bag to use whilst on their travels. The channels of trade could also be similar. I accept, though, that there is no material level of competition or complementarity. I consider there to be a medium degree of similarity.

22. In relation to the applied for tote bags, handbags and clutches, these are smaller items used for carrying more personal items. In comparison to travelling bags, the materials used could be the same, but the general structure likely to be somewhat different. They could, though, be sold through similar trade channels. Again, there is no material level of competition or complementarity. I consider these goods to have only a low level of similarity. In relation to purses and wallets, I consider the assessment here to be analogous to the other goods assessed in this paragraph. There is only a low level of similarity. The opponent's position is not improved when comparing these terms to its other class 18 goods or, indeed, the goods in class 25.

23. That leaves: sports packs, waist bags, shoulder bags, crossbody bags. Even if they were not the type of item that would naturally be described as a travelling bag, they are still the sort of items that could be used by people whilst travelling to safely carry items such as money, passports and valuables. The nature may be similar and the trade channels potentially the same. I consider there to be a reasonably high degree of similarity here.

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

24. In accordance with the case law cited in paragraph 12, I must determine who is the average consumer and the nature of the purchasing act. 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 in question.<sup>4</sup>

25. The average consumer of all of the goods is a member of the general public. The items are purchased reasonably frequently and are not, generally speaking, greatly expensive. The goods will be inspected to ensure fitness for purpose, style, size etc. I consider this equates to a medium, normal level of attention being paid during the selection process, via predominantly visual means.

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<sup>4</sup> *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV*, C-342/97, para. 26

## Comparison of marks

26. 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 CJEU stated in *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.<sup>5</sup>

27. It would be wrong, therefore, to artificially dissect the 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 created by the marks.

28. The respective marks are shown below:

**GOPRO**

v

**G PRO**

29. Although submissions have been made about the distinctiveness of the PRO element in the marks, the submissions about mark similarity have all been based upon an objective assessment of the marks as wholes. In terms of the marks' overall

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<sup>5</sup> C-591/12P, para. 34

impressions, I record first that the GOPRO mark is easily recognisable as a conjoining of the words GO and PRO. In terms of impact, neither of the marks give greater or lesser impact or prominence to the G/GO element over the PRO element. I consider that in both marks, both elements play a roughly equal role in the overall impression they make on the eye and the ear.

30. Visually, there is some similarity because both marks begin with the letter G and end with the letters P-R-O. However, there are also differences on account of the additional O in the applied for mark and, whilst the marks are roughly the same length, one is a conjoined mark thus creating a single string, whereas the opponent's mark has a space between the letter G and the word PRO. I consider there to be a medium degree of visual similarity.

31. Whilst noting what the parties have put forward as the likely articulations of the marks, I consider that the respective articulations will be fairly conventional ones based upon the words of which they comprise: the applied-for mark will be articulated as GO-PRO, the applicant's mark as JEE-PRO. The ending is the same, the beginnings quite different. The applicant notes the absence of the rhyming quality of GO PRO from G PRO, which I accept creates a further difference. The opponent notes that aural similarity is present not just because of the ending, but also due to the G sound at the beginning, however, the beginning sounds created by the respective Gs are different, so in my view this does not greatly assist. I consider this equates to a low degree of aural similarity.

32. Conceptually, both sides appear to agree that PRO is a word which refers to either a professional, or a word used to indicate being in favour of something. I think the former will be the predominant meaning appreciated by the average consumer. In relation to GOPRO, I agree (with both sides) that this creates a concept as a whole indicating an encouragement to go pro, become professional or professional-like. Whilst G PRO may also make reference to a professional, the overall message is not the same, with G not indicating anything in particular (beyond the letter). This means that there is no conceptual similarity as a whole.

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

33. Having compared the marks, it is necessary to determine the distinctive character of the earlier mark, in order to make an assessment of the likelihood of confusion. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, the ECJ stated that:

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).

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).<sup>6</sup>

34. No evidence of use having been filed, I have only the inherent characteristics of the earlier G PRO mark to consider. Whilst as a whole the earlier mark has a medium degree of similarity, it is noteworthy that the PRO element is, in my view, a fairly weak one (suggesting some form of professional quality). This forms part of the considerations of whether there exists a likelihood of confusion.

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<sup>6</sup> C-342/97, paras. 22-23

## Conclusions on likelihood of confusion

35. I have so far considered the factors that need to be taken into account when assessing the likelihood of confusion and now come to a global assessment. As the CJEU stated:

A global assessment of the likelihood of confusion implies some interdependence between the relevant factors, and in particular a similarity between the trade marks and between these goods or services. Accordingly, a lesser degree of similarity between these goods or services may be offset by a greater degree of similarity between the marks, and vice versa. The interdependence of these factors is expressly mentioned in the tenth recital of the preamble to the Directive, which states that it is indispensable to give an interpretation of the concept of similarity in relation to the likelihood of confusion, the appreciation of which depends, in particular, on the recognition of the trade mark on the market and the degree of similarity between the mark and the sign and between the goods or services identified.<sup>7</sup>

36. There are two types of confusion that must be considered:

- direct confusion, where one mark is mistaken for another; and
- indirect confusion, where the similarities lead the consumer to believe that the goods or services come from the same, or a related, undertaking.

37. In terms of direct confusion, I bear in mind that imperfect recollection has a role to play in what is a largely visual selection process. The opponent's primary argument is that the average consumer may, when selecting the goods, overlook the difference created by the O (of GO) in the applied for mark. However, I agree with the applicant that this is not likely. Whilst the degree of care and attention used when selecting the goods is not high, neither will the process be a completely casual one.

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<sup>7</sup> *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, C-39/97, para. 17

The average consumer will exercise sufficient perspicacity to realise that one mark is made up purely of the letter G and the word PRO, whereas the other is made up of the words GO and PRO conjoined. That recognition, and the conceptual hooks they create, also means that the marks are unlikely to be miss-recalled as each other. There will be no direct confusion even in relation to the identical goods in play.

38. In terms of indirect confusion, I see no reason why the average consumer would assume that the goods come from the same or related trade source. Whilst they both share the ending PRO, this is a weak element, and its inclusion in the respective marks would be seen purely as co-incidental. That the marks both share the same initial letter is not enough, particularly bearing in mind that one mark goes on to form a whole word and phrase GOPRO, whereas the other does not. It is not as though G PRO would be regarded as an abbreviation of GOPRO. The opposition fails.

## **OUTCOME**

39. Subject to appeal, the applied for mark may proceed to registration in respect of all of its goods.

## **COSTS**

40. The applicant has been successful and is entitled to a contribution towards its costs. Awards of costs in proceedings commenced on or after 1 July 2016 are governed by Tribunal Practice Notice (TPN) 2/2016. For fast track opposition proceedings, costs are capped at £500, excluding the official fee.<sup>8</sup>

*Official fee - £100*

*Preparing a statement and considering the other side's statement - £100*

*Written submissions - £300*

***Total: £500***

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<sup>8</sup> TPN 2/2015.

41. I therefore order Olivier Goldberg to pay GoPro, Inc. the sum of £500. The above sum should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

**Dated this 30<sup>th</sup> day of August 2018**

**Oliver Morris**

**For the Registrar,**

**The Comptroller-General**