

O-245-10

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NOS 2494244 AND 2496539

BY

SILENTNIGHT FOOTWEAR LIMITED

TO REGISTER THE TRADE MARKS:

FLOMOTION

FLO- MOTION

(A SERIES OF TWO)

AND



IN CLASSES 18 AND 25

AND

THE CONSOLIDATED OPPOSITIONS THERETO

UNDER NOS 98416 AND 98641

BY

ADIDAS INTERNATIONAL MARKETING BV

Trade Marks Act 1994

**In the matter of application nos 2494244 and 2496539
by Silentnight Footwear Limited
to register the trade marks:
FLOMOTION and FLO-MOTION (a series of two)
and**



**in classes 18 and 25
and the consolidated oppositions thereto
under nos 98416 and 98641
by adidas International Marketing BV**

1) The applications to register the trade marks **FLOMOTION** and **FLO-MOTION** (a series of two) and:



were made by Silentnight Footwear Limited (Silentnight) on 1 August and 1 September 2008 respectively. Both applications include goods in class 18 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended, however, these consolidated oppositions do not concern the goods in this class. The applications were published for opposition purposes on 10 October and 28 November 2008 respectively. The class 25 goods of the applications (the subject of these oppositions) are for the following goods:

clothing, footwear, headgear.

2) On 10 December 2008 and 22 January 2009 adidas International Marketing BV (adidas) filed oppositions against the registration of the trade marks in respect of the class 25 goods of the applications. adidas bases its oppositions on section 5(2)(b) of the Trade Marks Act 1994 (the Act). According to section 5(2)(b) of the Act a trade mark shall not be registered if because:

“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.”

adidas relies on its Community trade mark registration no 3160991. This registration is for the trade mark FORMOTION. The application for registration was made on 9 May 2003 and the registration process was completed on 18 January 2007. It is registered for the same goods as those of the applications. adidas claims that its trade mark has a reputation. It does not state in relation to which goods it claims that there is a reputation.

3) Silentsnight filed counterstatements in which it denies the grounds of opposition and puts adidas to proof of its claim to a reputation in respect of its earlier trade mark.

4) Both sides filed evidence. A hearing was held on 6 July 2010. adidas was represented by Mr Simon Malynicz of counsel, instructed by J A Kemp & Co. Silentsnight was represented by Mr Ian Silcock of counsel, instructed by Harrison Goddard Foote.

EVIDENCE OF ADIDAS

5) The evidence of adidas consists of witness statements furnished by Ms Sarah Talbot and Ms Inge Cupers (jointly) and by Ms Sarah Talbot and Mr Peter Troester (jointly). Ms Talbot is senior IP counsel of adidas, Ms Cupers is a legal representative of adidas, Mr Troester is head of controlling licensees of adidas.

6) adidas is a wholly owned subsidiary of adidas AG.

7) The FORMOTION brand was launched in respect of clothing in 2004, it was used in relation to promotional products which were supplied to athletes and which were not available in retail stores. World champion sprinters Kim Collins and Debbie Ferguson wore FORMOTION sprint suits during the 2004 Athens Olympics, where Ms Ferguson won a bronze medal. Exhibited at TT1 is a copy of an article originally published in *Business Wire* (no details of this publication are given) on 20 August 2004. This article refers to the intention of Mr Collins and Ms Ferguson to wear adidas FORMOTION sprint suits. The long distance runner Haille Gebreselassie also wears FORMOTION branded material, no indication is given as to when this commenced. The FORMOTION brand was launched on the retail market in 2005 “in respect of three-dimensionally engineered clothing, which was designed to move naturally with the athlete’s body during sport”.

8) The footwear which currently bears the FORMOTION brand was originally launched under the brand GROUND CONTROL. In 2007 it was rebranded

FORMOTION. As of 20 August 2009, FORMATION branded clothing was marketed for use in football, tennis, running, basketball and training. Sales of goods bearing the trade mark FORMOTION in the United Kingdom are as follows:

Year	Volume	Net sales £
2005	6,733	156,960.79
2006	31,592	489,402.70
2007	126,142	2,235,909.25
2008 (partly after the dates of application)	267,323	4,580,240.35
2009 (to end of May) (after the dates of application)	34,452	602,242.22

9) Global sales figures for running footwear and running apparel are given. There is no breakdown in relation to either the European Union and/or the United Kingdom and so these figures are not of assistance in this case. Figures are given in relation to promotion for running goods. However, these figures do not identify the amount spent in relation to FORMOTION and so are not of assistance.

10) adidas has produced a range of catalogues and promotional materials during the period that FORMOTION branded goods have been offered for sale in the United Kingdom. At TT2 is a copy of a brochure for adidas apparel and accessories, it bears a date of Q2 (presumably second quarter) 2005. On page 2 of the brochure information about the FORMOTION brand appears, this is also referred to as ForMotion. Contact details for adidas in the United Kingdom, Ireland and the Benelux are given. Exhibited at TT3 is a copy of a specialist catalogue of adidas, which bears a date of Q3 (presumably third quarter) 2005. Contact details for adidas in the United Kingdom, Ireland and the Benelux are given. Pictures of the following FORMOTION products appear: tees, shorts, tights (long and short), light jackets and polos for men; tees, wind jackets, short and long tights, polos and skorts for women. A copy of an adidas catalogue for apparel and accessories is exhibited at TT4. It bears a date of Q4 (presumably fourth quarter) 2005. Contact details for adidas in the United Kingdom, Ireland and the Benelux are given. On page 2 of the catalogue there is information about FORMOTION clothing. Exhibited at TT5 is a copy of an adidas catalogue entitled *Concept*, it bears a date of Q1 (presumably first quarter) 2008. Various running shoes for men and women appear: Supernova Control 10, Response CTL7, Supernova Cushion 7, Response CTL 7W, Supernova Cushion 7W and

Tempaya W. All of the shoes have a number of trade marks in relation to them in addition to the main trade marks eg Supernova Control 10 includes the trade marks adiPRENE, quickstrike, adiWEAR, OrthoLife, pro-moderator, noseam, goeFiT and FORMOTION. ForMotion is described as giving, inter alia, motion control, a smooth touchdown and responsiveness. Various brands of adidas clothing are shown in the catalogue: Supernova (for running) Predator (for football), Competition (for tennis) and Clima (for women for training). FORMOTION and ForMotion are used in relation to these products. Contact details for adidas in the United Kingdom, Ireland and the Benelux are given. The catalogue bears a copyright date of 2007. Exhibited at TT6 is a promotional magazine produced by adidas entitled *Inside Running*. The catalogue is for fall/winter 2008 and so appears to emanate from after the dates of application. This magazine is an in-house magazine for adidas employees and “partners”. There are various references to FORMOTION running shoes and apparel. The following appears on page 12 of the magazine:

“Our running shoes feature the ForMotion™ heel, a freely-movable unit that adjusts to different running style and surfaces. The specially cut ForMotion™ apparel has strategically placed seams designed to follow the contours of your body and mimic your natural movement.”

Page 13 of the magazine gives details of the FORMOTION heel and the FORMOTION trail. The FORMOTION brand is used in relation, inter alia, to Supernova Riot trail shoes, Supernova Sequence running shoes and adiSTAR tights.

11) Exhibited at TT7 is a list of United Kingdom athletes who have been supplied with FORMOTION branded footwear, this list relates to the position in 2009. adidas also supplies Liverpool, Chelsea and Newcastle United football clubs with FORMOTION branded footwear for use in training and competition. Ms Talbot and Ms Cupers state that Stephen Gerrard “is known to wear FORMOTION branded footwear in training”. Exhibited at TT8 is a copy of a press release from adidas made on 13 August 2004 in relation to the Athens 2004 Olympic Games. The press release advises of the rôle of adidas in the Olympics. On page 2 adidas refers to its innovations for the Athens Olympics: ClimaCool, ForMotion, JetConcept and Demolisher II sprint spike. ForMotion is promoted as being a material. Exhibited at TT9 is a press release for adidas T-MAC 6 footwear. The press release advises, in some detail, that the shoes use ForMotion technology. The shoes are for use in basketball. The article advises that the shoes will be released between October 2006 and February 2007. The price of the shoes is given in US\$, Euros and RMBs (the currency of China). Exhibited at TT10 is a print from the adidas Press Room website. adidas states that this print relates to the sprint suit from 2004 (the actual print bears a copyright date of 2009).

12) The first three pages of a Google® search for the term *formotion and footwear* are exhibited. The search was conducted on 3 February 2010 and is

not limited by jurisdiction(s). So it emanates from after the material date and is not specific to either the United Kingdom and/or the European Union. The hits shown have many references to adidas.

EVIDENCE OF SILENTNIGHT

13) Mr Gary John Potter filed a witness statement. Mr Potter is a director of Silentnight, he has worked in the footwear industry since 1987. Most of the statement is submission and/or opinion, rather than evidence of fact. Mr Potter states that in his experience “motion” is commonly used in relation to footwear, both as a part of trade marks and as a descriptor. He states that using the term in a Google® search *motion footwear* brings up 5,300,000. Exhibited at G1 are the first two pages of a Google® search using this term. The search is not limited by jurisdiction. The absence of use of Boolean operators means that the search will pick up use of footwear and motion with no direct relationship between the terms. Exhibited at G2 are various pages downloaded from the Internet on 26 October 2009:

- Details of Fila Motion 5 running trainer.
- Details of Nike Cortez Fly Motion trainers.
- Ace Feet in Motion. Ace Feet in Motion provides “specialist performance footwear and advice to sports men and women”.
- Assisted Motion. This supplies services related to medical conditions and as part of its services supplies custom made footwear.
- A picture of Prime Motion Low trainers.
- Details of the Motion range of Crocs shoes.

All of the pages emanate from the United Kingdom.

14) Mr Thomas Farrand filed a witness statement. Mr Farrand is a registered trade mark attorney. Mr Farrand conducted a search of the trade mark register using the on-line search facility of the Intellectual Property Office for trade marks containing the word “motion” in class 25. 99 registered trade marks were found, these include Community trade marks. Exhibited is a list of the 40 trade marks which Mr Farrand states excludes words such as emotion and promotion. However, included in the list are the trade marks: jemotion and e-motion. No actual specifications are produced.

15) Mr Adam Foster filed a witness statement which he made on 18 December 2009. Mr Foster is the sports buyer for Courtesy Shoes Ltd. Courtesy Shoes Ltd is an importer and wholesaler of footwear, including sports shoes. He is responsible for the buying of sports shoes for distribution in the United Kingdom. Mr Foster is familiar with a range of sports shoes sold under the brand FILA which are known as FILA MOTION. There are several versions of FILA MOTION sports shoes, including FILA MOTION 5 and FILA MOTION 90. Courtesy Shoes Ltd buys and distributes FILA MOTION shoes to retail outlets in the United

Kingdom. In the last 24 month period for which Mr Foster has a complete record, Courtesy Shoes Ltd had sold 21,901 pairs of adult FILA MOTION shoes and 16,836 pairs of children's FILA MOTION shoes.

CLAIM TO REPUTATION

16) It is the case of adidas that owing to the reputation of the trade mark FORMOTION it enjoys broader protection, as per the judgment of the European Court of Justice (ECJ) in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117ⁱ. The trade mark is a Community trade mark. In *PAGO International GmbH v Tirol Milch registrierte Genossenschaft mbH* Case C-302/07 the ECJ, in relation to Article 9(1)(c) of the Community trade mark regulation, decided that the requisite reputation could arise in one member state. Mutatis mutandis, the same reasoning will apply to a reputation in respect of a claim of likelihood of confusion. In this case, the evidence that is jurisdictionally specific relates to the United Kingdom. Mr David Kitchin QC, sitting as the appointed person, in BL/O/268/04ⁱⁱ held that to benefit from the broader protection the earlier trade mark does not have to be a household name, however, it has to be used on a significant scale. In this case the matter has to be considered at the dates of application of each of Silentnight's trade marks, 1 August 2009 and 1 September 2009.

17) adidas has never clearly formulated in relation to which specific goods it claims to have a reputation, the specification covers all clothing, headgear and footwear.

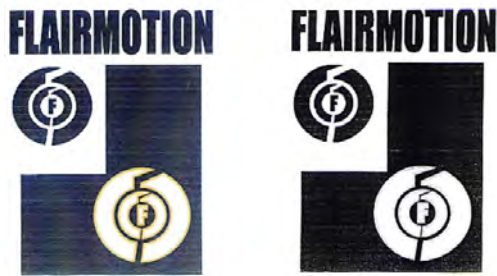
18) There is no indication as to the extent that the promotional material exhibited at TT2 was used or the extent of the distribution of the catalogues that are exhibited, there is no clear indication as to whether the catalogues were primarily for retailers or for purchasers. There is no certainty that *Inside Running* was published prior to the dates of application, it is also an internal publication and so will not reach the average consumer of the goods. adidas makes reference to its sponsorship of sports persons. However, this is sponsorship and promotion primarily of the adidas brand. Adidas refers to Mr Gerrard being "known to wear" goods bearing the trade mark but there is nothing to indicate that the average consumer for, for example sports clothing, knows this. On pages 14 and 15 of *Inside Running* there are pictures of "adidas athletes going for gold in Beijing", in this article it is the three stripes and adidas that is being promoted. The average consumer is unlikely to have any way of knowing what the secondary or tertiary brands that are being worn on the athletic track or football field. That an athlete is wearing a pair shoes that have FORMOTION characteristics is not going to be known to this average consumer, owing to the nature of the use of the trade mark as a secondary or more likely tertiary trade mark. Indeed in the case of some of the footwear there is use of a plethora of sub-brands. The adidas super nova control 10 running shoes are identified with a further nine trade marks, the adidas response CTL 7 running shoes with four other trade marks. adidas refers to its

global promotion and submits that promotion of the FORMOTION trade mark should be viewed in relation to this global promotion; this is effectively conflating the adidas brand with one of its sub-brands. There is some evidence of use of FORMOTION as a brand in relation to particular adidas clothing as in the catalogues for clothing exhibited at TT3 and TT4. However, there is no indication as to the distribution of this catalogue or of sales of these particular goods, or of how the trade mark appears upon the goods. In the clothing in the catalogue exhibited at TT5, FORMOTION is at best a tertiary trade mark, there is no indication as to where and how the trade mark appears upon the actual goods.

19) A sub-brand or sub-sub brand can have a reputation. It is a question of fact and the evidence furnished. adidas gives figures for goods sold which bear the trade mark, however, this says little owing to the nature of the use and the use of other trade marks. In some cases the average consumer would be expected to remember the FORMOTION trade mark from eleven other trade marks. Unless there is reinforcement by use and emphasis on use even the purchaser of goods which use the FORMOTION trade mark is quite likely not to take any cognisance of it. That consumer is likely to remember primarily the adidas trade mark and, for example, the SUPERNOVA trade mark. The evidence does not establish that FORMOTION is known on a significant scale by the average consumer for clothing and footwear at large, or for sports clothing. adidas's case is based more on assertion than on evidence. **The claim to a reputation has not been substantiated.**

MOTION TRADE MARKS

20) Silentnight contends that the motion element of the trade marks is non-distinctive in relation to clothing. The case is to be considered at the dates of application and so it needs to establish its claim at these dates. Mr Potter states that motion is commonly used in relation to footwear as a descriptor and as a part of trade marks. Mr Potter exhibits no evidence that emanates from before the dates of application. His exhibited material was downloaded on 26 October 2009. The material which shows some detail, at G2, shows that in the cases of Assisted Motion and Ace Feet in Motion, that services are primarily being supplied. Silentnight has also supplied state of the register evidence. Many of the trade marks are multi-class and so it is not possible to ascertain what goods are of real interest to the proprietors. The actual specifications are also not supplied and so it is not possible to dig any deeper there. Of those trade marks which are in class 25 only, some are Community trade marks and so do not indicate the position or the perception in the United Kingdom. The United Kingdom and international registrations with protection in the United Kingdom in class 25 only are for the trade marks: LOCAL MOTION (two registrations), FLOW-MOTION, BLU MOTION,



WORLD MOTION and tradition in motion. Of these three do not include footwear in their specifications and the rest have general specifications and so there is nothing to indicate if the motion element is being used with any reference to footwear. Mr Foster states that in the twenty four month period prior to 18 December 2009 Courtesy Shoes Ltd has sold 38,737 of FILA MOTION shoes. The wording of his statement is unfortunate as it is not clear when the sales began.

21) Silentnight has not clearly shown use by any others of trade marks covering goods in class 25 including the word motion as of the material dates. If use had been shown it would not have necessarily indicated that the term was lacking in distinctiveness as Floyd J stated in *Nude Brands Limited v Stella McCartney Limited and others* [2009] EWHC 2154 (Ch):

“29. Whilst the use by other traders of the brand name NUDE in relation to perfume may give those traders relative rights to invalidate the mark, it does not give those rights to any defendant. I am not at this stage persuaded that this evidence has a bearing on any absolute ground of invalidity. It certainly does not go as far as establishing ground 7(1)(d) - customary indication in trade. Ground 7(1)(b) is concerned with the inherent character of the mark, not with what other traders have done with it. The traders in question are plainly using the mark as a brand name: so I do not see how this use can help to establish that the mark consists exclusively of signs or indications which may serve to indicate the kind or quality or other characteristics of the goods, and thus support an attack under 7(1)(c).”

The state of the register evidence is also weak. State of the register evidence has been rejected in many decisions and judgments. In *GfK AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-135/04* the General Court (GC) stated:

“68. As regards the search of the Cedex database, the mere fact that a number of trade marks relating to Class 35 contain the word ‘bus’ is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned. Firstly, the search in question does not provide any information on the trade marks

actually used in relation to the services concerned. Secondly, it includes a number of trade marks in which the word 'bus' is used descriptively by public transport businesses.”

(A position re-iterated by the GC in *Zero Industry Srl v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-400/06*.) So the GC wants to see actual use and it wants to see the nature of the use. Silentnight prays in aid the judgment of Mr Daniel Alexander QC, sitting as a deputy judge of the High Court, in *Digipos Store Solutions Group Ltd v Digi International Inc* [2008] RPC 24. It is to be noted that in that case Mr Alexander was not referred to the judgment of the GC in *GfK AG* and his judgment preceded the judgment of Mr Floyd in *Nude Brands Limited*. *Digipos* also turns very much upon its own facts. In his judgment Mr Alexander referred to the *Madame* case being an absolute grounds case and appeared to consider this of some significance. The GC cases referred to above are both relative grounds cases so clearly the GC considered that the principle of not giving weight to state of the register evidence applies in relative grounds cases.

22) At paragraph 56 Mr Alexander stated:

Mr Tibber's evidence shows that it is not possible to draw firm conclusions as to whether the marks revealed by the search are in use, are in use in the United Kingdom or were in use at any relevant date, but there is, nonetheless, a significant number of undertakings which are either using or at least appear to wish to use the prefix DIGI- to denote digital in a number of contexts.”

In this case the evidence does not support any claim that there are a significant number of undertakings who are either using or wish to use the word MOTION in the United Kingdom in relation to footwear, which is the extent of Mr Potter's claim. At paragraph 65 Mr Alexander states:

“It is, in my judgment, to be inferred that the reason that the prefix DIGI- is intended to be used (as these registrations or applications demonstrate) in at least a significant proportion of those marks is so as to indicate that the product or service is or involves digital apparatus, computers or software and that, to a large number of traders, that is what it means. That seems the most logical explanation for (a) the number and (b) the diversity of such marks. This provides further support for the proposition that DIGI- used as a prefix has a limited capacity as such to distinguish goods or services of one undertaking from those of another when used in relation to goods or services involving digital apparatus, computers or software and is common to this general trade.”

In this case there is no clear link of meaning between footwear and MOTION.

23) The evidence of Silentnight does not substantiate the claim that MOTION lacks distinctiveness in relation to clothing, footwear and headgear at large or in relation to footwear in specific.

AVERAGE CONSUMER, NATURE OF PURCHASING DECISION AND STANDARD FOR LIKELIHOOD OF CONFUSION

24) The specifications of both the applications and the earlier trade mark cover class 25 goods at large. The goods are bought by the public at large. They can be of low cost and high cost. Mr Silcock argued that in the clothing market the average consumer is likely to pay particular attention to the brand. No evidence to this effect has been filed. 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.”

In considering this case it is necessary to take into all aspects of the market and all types of goods. Consequently, it is necessary to take into account such articles of clothing and footwear such as socks and flip-flops that could be of very low cost and bought without a good deal of attention. The result of this is that the effects of imperfect recollection are increased. However, it is necessary to bear in mind that the average consumer “is deemed to be reasonably well informed and reasonably circumspect and observant”ⁱⁱⁱ. In relation to clothing it is the visual impression of the trade mark that is most important^{iv}. The goods are likely to be primarily purchased by reference to labels rather than by oral communication.

COMPARISON OF TRADE MARKS

25) The trade marks to be compared are:

FORMOTION



FLOMOTION

FLO- MOTION

26) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details^v. The visual, aural and conceptual similarities of the marks must, therefore, be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components^{vi}. Consequently, it is not permissible to indulge in an artificial dissection of the trade marks, although it is necessary to take into account any distinctive and dominant components. The average consumer rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he/she has kept in his/her mind and he/she is deemed to be reasonably well informed and reasonably circumspect and observant^{vii}. The assessment of the similarity of the trade marks must be made by reference to the perception of the relevant public^{viii}.

27) Mr Silcock submitted that the first three letters of the stylised trade mark would be seen as FLO. The comparison of the trade marks is made upon this basis.

28) It is Silentnight's argument that motion lacks distinctiveness and so this part of the trade marks is neither dominant nor distinctive. It is contended that the goods may assist motion and so motion is allusive to their properties. Using the word motion would be a very stilted means of describing both clothing at large and footwear in particular. It is difficult to see how motion could be allusive to such goods as ties, formal trousers, shirts, vests and hats. In relation to footwear the term is at best a very vague allusion, however, it is difficult to see allusive qualities if it is used for, for instance, high heeled fashion shoes for women. It has been held often that in comparing words the beginnings are more important than the ends in most circumstances. In this case there is nothing to suggest that this rule of thumb does not apply. There is nothing in the nature of the trade marks that gives rise to the dominance of any particular element in them other

than the position of the elements in the trade marks. So, in so far as there is a dominant element, it arises simply through position rather than through meaning and rests with the first syllables of the trade marks. However, this positional dominance does not overwhelm the rest of the trade marks; any dominance is very limited and is more akin to a slight emphasis than dominance, a word which of its nature requires the corollary of subservience.

29) The motion element, as it is a common word, will not be subsumed into the rest of the trade marks so that part of it forms a syllable with the beginning of the trade marks, this is all the more so in relation to the stylised and hyphenated trade marks of Silentnight. So phonetically the respective trade marks will begin with the elements FOR and FLO rather than FORM and FLOM, this will also be the case in relation to the visual perception of the trade marks. As the trade marks are all essentially word marks the perception of the consumer will be influenced by the knowledge of elements which are readily identifiable as words.

30) All four trade marks, owing to the presence of the common word motion, fall into two parts. All four trade marks contain the word motion at their ends and so the final two syllables are identical and in the same position in respect of the rest of the trade marks. All four trade marks begin with an f and so start with the same consonant sound. It is likely that the first syllable of the trade mark of adidas will be pronounced as per the number four. The first syllable of the trade marks of Silentnight is like to be pronounced as in the word flow. Consequently, in the four trade marks the first syllable begins with the same consonant but the next two letters are sounded differently in the trade mark of adidas and those of Silentnight. The difference in sound is towards the beginning of the trade marks but not the very first letter. It is necessary to consider the trade marks in their entirety, the motion elements are large parts of the trade marks that the first syllables do not overwhelm or subsume. There is a reasonable degree of phonetic similarity.

31) Visually the series trade marks have the same letters as the earlier trade mark with the exception of the 'l' in the series and 'r' in the trade mark of adidas. The letter o appears in the first, and visually short, syllable in a different place but still in that short syllable. One of the trade marks of the series includes a hyphen which is alien to the trade mark of adidas. However, the hyphenated trade mark is very much a word trade mark and it is unlikely that the average relevant consumer will imbue this hyphen with a great deal of weight and it will not greatly impinge on his or her consciousness. There is a good deal of visual similarity between the trade mark of adidas and the series of trade marks. There is a good deal of stylisation of the first element of the stylised trade mark but Mr Silcock does not consider that this militates against the average consumer seeing this element as the letters FLO. The stylised trade mark is in colour. This does not have a bearing on the issue of similarity as the trade mark of adidas is registered without regard to colour, therefore, the presence of colour in Silentnight's trade mark cannot create a significant difference, the matter must be assessed on the

similarity between the respective words and configurations without regard to colour^{ix}. The FLO element of the stylised trade mark is in a stylised form that is noticeable and is completely alien to the trade mark of adidas. The stylised trade mark must be less similar to the trade mark of adidas than the non-stylised trade mark. However, the visual impression of a trade mark that consists of a word(s) or letters will be dominated by the letters or words as the average consumer will, through familiarity with letters and words, perceive them in the terms that have been learnt from infancy onwards (see *Ontex NV v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T- 353/04^x*). The perception of the average consumer is key to the issue of similarity and the effects of similarity. Consequently, although less similar than the series of trade marks, the stylised trade mark still enjoys a good deal of visual similarity with the trade mark of adidas, taking into account that Mr Silcock submits that the stylised trade mark will be read as FLO MOTION.

32) Mr Silcock submitted that adidas's trade mark is capable of conveying the impression of a word advocating (for) motion or a word indicating that the products are for use in motion based activities, such as running. (It is difficult to see how this would apply to the broad spectrum of goods that the specification encompasses.) He submitted that the trade marks of Silentnight are a play on the phrase slow motion and also a play on the words flow motion, referring to a smooth or flowing motion. Consequently, the conceptual associations of the trade marks of Silentnight and adidas are not similar. To have an effect in the consideration of the similarity of trade marks the conceptual meaning of a trade mark or trade marks must be clear and obvious^{xi}. None of the proposed meanings of Mr Silcock in relation to the trade marks in their entirety are clear and obvious. Mr Silcock's submissions are based on a premise of an average consumer analysing the trade marks and seeking meaning. In relation to a trade mark the average consumer is seeking an indicator of origin, he or she is not seeking meaning, hence the requirement that any meaning is clear and obvious. The trade marks in their entirety do not give rise to any meanings that can be readily grasped, or even grasped if seeking meaning. The most that can be said is that, in that each trade mark includes the word motion, there is conceptual identity in this element, and in that if FLO gives rise to the perception of flow, there is conceptual dissonance between the FLO and FOR elements, the latter being a preposition.

33) Overall the trade mark of adidas and those of Silentnight have a reasonable degree of similarity (although slightly less in relation to the stylised trade mark).

LIKELIHOOD OF CONCLUSION

34) In considering whether there is a likelihood of confusion various factors have to be taken into account. There is the interdependency principle – a lesser degree of similarity between trade marks may be offset by a greater degree of

similarity between goods, and vice versa^{xii}. In this case the respective trade marks have a reasonable degree of similarity and the respective goods are identical.

35) It is necessary to consider the distinctive character of the earlier trade mark; the more distinctive the earlier trade mark the greater the likelihood of confusion^{xiii}. 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^{xiv}. In determining the distinctive character of a 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 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^{xv}. Mr Malynicz submitted that the trade mark of adidas has an average degree of distinctiveness. The trade mark of adidas does not directly describe any characteristic of the goods. If the arguments of Silentnight in relation to the MOTION element were taken into account, all that this would give rise to is a loose allusion that could apply to a limited number of the goods; and this approach would require not considering the trade mark in its entirety. It is accepted that the trade mark of adidas has an average degree of distinctiveness.

36) In *New Look Ltd v Office for the Harmonization in the Internal Market (Trade Marks and Designs)* the GC stated:

“49 However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (*BUDMEN*, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumer choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs.”

In this case the goods will primarily be bought by the eye and so visual similarity is of greater importance than aural similarity and the case of adidas is strongest in relation to visual similarity.

37) Silentnight put many of its eggs into the basket of claiming the MOTION element of the trade marks is non-distinctive. This claim has two hurdles. First,

the proof of the proposition; in which Silentnight failed. Second, effectively not considering the trade marks in their entirety. Even if Silentnight had substantiated its case in relation to the MOTION element the trade marks would still be similar. Part of Silentnight's case effectively conflates lack of distinctiveness with an absence of a likelihood of confusion. In *Air Products and Chemicals, Inc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Joined Cases T – 305/06 to T 307/06* the GC held:

“59 With regard to the weak distinctiveness of the common components and of the earlier marks as a whole, it should be recalled that the finding of a weak distinctive character for the earlier trade mark does not preclude a finding that there is a likelihood of confusion. While the distinctive character of the earlier mark must be taken into account when assessing the likelihood of confusion (see, by analogy, *Canon*, paragraph 24), it is only one of a number of elements entering into that assessment. Even in a case involving an earlier mark of weak distinctive character, there may be a likelihood of confusion on account, in particular, of a similarity between the signs and between the goods or services covered (Case T-134/06 *Xentral v OHIM – Pages jaunes (PAGESJAUNES.COM)* [2007] ECR II-5213, paragraph 70; see, to that effect, Case T-112/03 *L'Oréal v OHIM – Revlon (FLEXI AIR)* [2005] ECR II-949, paragraph 61).

60 In addition, the argument of OHIM and of the applicant in that regard would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that, where the earlier mark is only of weak distinctive character, a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question (order of the Court of 27 April 2006 in Case C-235/05 P *L'Oréal v OHIM*, not published in the ECR, paragraph 45). Such a result would not, however, be consistent with the very nature of the global assessment which the competent authorities are required to undertake by virtue of Article 8(1)(b) of Regulation No 40/94 (judgment of 15 March 2007 in Case C-171/06 P *T.I.M.E. ART v Devinlec and OHIM*, not published in the ECR, paragraph 41, and *PAGESJAUNES.COM*, paragraph 71).”

This is a clear warning against such conflation and in considering the issue of distinctiveness in place of that of confusion. In *mPAY24 GmbH v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-557/08* the GC found that the importance of the distinctive character of an earlier trade mark may vary according to the degree of similarity found between the goods concerned and the signs at issue.

38) There is a likelihood of confusion in relation to both applications in respect of the class 25 goods.

COSTS

39) adidas has been successful and so is entitled to a contribution towards its costs. No award is made in respect of the evidence of adidas as this was directed towards establishing a reputation and signally failed to do so. I award costs on the following basis:

Opposition fee x 2:	£400
Considering the counterstatements of Silentnight:	£500
Considering evidence of Silentnight:	£200
Preparation and attendance at hearing:	£500
Total:	£1,600

Silentnight Footwear Limited is to pay adidas International Marketing BV the sum of £1,600. 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 14 day of July 2010

**David Landau
For the Registrar
the Comptroller-General**

ⁱ “18. Furthermore, according to the case-law of the court, the more distinctive the earlier mark, the greater the risk of confusion (SABEL, paragraph 24). Since protection of a trade mark depends, in accordance with Article 4(1)(b) of the Directive, on there being a likelihood of confusion, marks with a highly distinctive character, either *per se* or because of the reputation they possess on the market, enjoy broader protection than marks with a less distinctive character.”

ⁱⁱ “17. The global assessment of the likelihood of confusion must therefore be based on all the circumstances. These include an assessment of the distinctive character of the earlier mark.

When the mark has been used on a significant scale that distinctiveness will depend upon a combination of its inherent nature and its factual distinctiveness. I do not detect in the principles established by the European Court of Justice any intention to limit the assessment of distinctiveness acquired through use to those marks which have become household names. Accordingly, I believe the observations of Mr. Thorley Q.C in *DUONEBS* should not be seen as of general application irrespective of the circumstances of the case. The recognition of the earlier trade mark in the market is one of the factors which must be taken into account in making the overall global assessment of the likelihood of confusion. As observed recently by Jacob L.J. in *Reed Executive & Ors v. Reed Business Information Ltd & Ors*, EWCA Civ 159, this may be particularly important in the case of marks which contain an element descriptive of the goods or services for which they have been registered. In the case of marks which are descriptive, the average consumer will expect others to use similar descriptive marks and thus be alert for details which would differentiate one mark from another. Where a mark has become more distinctive through use then this may cease to be such an important consideration. But all must depend upon the circumstances of each individual case.”

ⁱⁱⁱ *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [2000] FSR 77.

^{iv} See *Société provençale d'achat and de gestion (SPAG) SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-57/03* and *React Trade Mark* [2000] RPC 285.

^v *Sabel BV v Puma AG* [1998] RPC 199.

^{vi} *Sabel BV v Puma AG* [1998] RPC 199.

^{vii} *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* [2000] FSR 77.

^{viii} *Succession Picasso v OHIM - DaimlerChrysler (PICARO) Case T-185/02*.

^{ix} *Mary Quant Cosmetics Japan Ltd v Able C & C Co Ltd* BL O/246/08 Mr Geoffrey Hobbs QC, sitting as the appointed person:

“10. The present oppositions under Section 5(2)(b) are based on the rights conferred by registration of a device mark recorded in the register in black-and-white. It follows that colouring is immaterial to the distinctiveness of the Opponent’s device mark as registered and therefore irrelevant for the purposes of the assessment of similarity in both oppositions.”

^x “68 It must be pointed out that although, strictly speaking, the visual impression of a sign consists of the overall impression it produces, the fact that some of its constituents produce a greater or lesser visual impact cannot be ruled out. That is also true in a case such as the present, in which the sign consists of a single word. The sequence ‘e-u-r-o’ of the earlier mark immediately attracts the visual attention of consumers. That is due to the multiple repetition, in consumers’ everyday life, of situations in which they are led to perceive various words constituted by that sequence of letters, including, in particular, the word ‘euro’, relating to the single currency, or even the words ‘Europe’ and ‘European’. The visual attraction of the sequence in question is instinctive. It does not, therefore, depend on a conceptual analysis of the earlier mark by consumers or on the fact that they attribute a specific meaning to it.”

^{xi} See, inter alia, *GfK AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-135/04*

^{xii} *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117.

^{xiii} *Sabel BV v Puma AG* [1998] RPC 199.

^{xiv} *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

^{xv} *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.