

O-268-11

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2540931
BY
CARLO D'ALTERIO
TO REGISTER THE TRADE MARK**

MARTA FABI

IN CLASS 25

AND

**THE OPPOSITION THERETO
UNDER NO 100807
BY
FABI S.P.A.**

Trade Marks Act 1994

**In the matter of application 2540931
by Carlo D'Alterio
to register the trade mark:**

MARTA FABI

**in class 25
and the opposition thereto
under no 100807
by FABI S.p.A.**

1. Carlo D'Alterio applied to register the above trade mark on 4 March 2010 for the following goods in class 25¹:

Ladies' footwear.

2. The application was published on 11 June 2010 in the *Trade Marks Journal*, following which an opposition was filed by FABI S.p.A ("the opponent"). The opponent claims that the application offends section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). This section states:

"5. (2) A trade mark shall not be registered if because –

(a)

(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."

3. The opponent relies upon the following goods of its registered Community trade mark (number 2063881):

¹ As per 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.



Class 25: *Clothing of textile, leatherwear and knitwear, hats, footwear.*

4. The opponent claims that the goods are identical (footwear) and that the mark applied for contains the entirety of the opponent's mark, the latter being contained within a non-distinctive border. It also claims that MARTA is a female forename which, particularly in relation to ladies' footwear, will be seen merely as indicating a sub-brand or brand extension of the more distinctive FABI brand.

5. The opponent's mark was applied for on 29 January 2001 and its registration procedure was completed on 19 August 2005: consequently this is an earlier trade mark which is not subject to proof of use² because at the date of publication of the application (11 June 2010) it had been registered for less than five years. The significance of this is that the opponent's registration can be taken into account across the full breadth of the goods relied upon (class 25) on the basis of notional and fair use of the terms in its specification.

6. Mr D'Alterio filed a counterstatement, in essence denying a likelihood of confusion. He states that his goods are for Nigerian ladies only and that there would be no clash with the opponent's business.

7. Neither side filed evidence. Neither side asked for a hearing, being content for a decision to be made from the papers on file. The opponent filed written submissions in lieu of a hearing, which I bear in mind in reaching my decision.

Decision

8. The leading authorities which guide me in this ground are from the CJEU: *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P (LIMONCELLO). It is clear from these cases that:

² See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations) 2004 (SI 2004/946) which came into force on 5th May 2004.

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,

(b) the matter must be judged through the eyes of the average consumer for the goods/services in question; *Sabel BV v Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,

(d) 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; *Sabel BV v Puma AG*,

e) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

f) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*.

(g) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

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

(i) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(j) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,

(k) further, 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; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,

(l) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*

Comparison of goods

9. As both specifications include footwear, the goods are identical (ladies' footwear is covered by the opponent's wider term 'footwear').


Average consumer and the purchasing process

10. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect, but his/her level of attention is likely to vary according to the category of goods. The average consumer for footwear is the general public. Footwear will be tried on for size and comfort and so a reasonable level of attention will be paid to its purchase, but not the highest level of attention. The purchase of footwear will be primarily visual, but I do not discount the potential for oral use of the mark.

Comparison of trade marks

11. The above authorities direct that, in making a comparison between the marks, I must have regard to each mark's visual, aural and conceptual characteristics. I have to decide which, if any, of their components I consider to be distinctive and dominant, without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

12. The marks to be compared are:

| Opponent's mark | Application |
|---|-------------------|
|  | MARTA FABI |

The dominant and distinctive element of the opponent's mark is FABI, the square border being non-distinctive. The application consists of two word elements,

neither of which is a known word in the English language. The opponent submits that MARTA is a female name and that FABI is name, although not one which is common in the UK. Neither of these words is known to me as a name and I consider that also to be the position for the average consumer of footwear in the UK. I will come on to consider the concept of the words below but I consider that both elements are distinctive. As MARTA is the first and longest element, it has the edge over FABI in terms of dominance, but this is not to any great degree.

13. The point of similarity from a visual and aural perspective is the word FABI, spelled the same way in both marks. MARTA is the element which will be perceived first in the application both visually and aurally. The pronunciation of FABI will be the same in both marks because the spelling is the same, although it is difficult to say with any precision how the average UK consumer will pronounce it because it is unlike any familiar English word. Although the earlier mark (the word part of it) is entirely reproduced in the application, MARTA appears at the beginning of the applicant's mark and so the degree of visual and aural conceptual similarity between the marks is neither high nor low, but is of a reasonable degree.

14. The opponent submits that MARTA is a female forename. MARTHA is a female forename but if MARTA is a female name, it is not common in the UK and is not a name of which the average consumer is likely to be aware. Invented words can be evocative of concepts³. However, in this case I consider that context is important for any evocative concept to come into play. If MARTA was followed by an obvious surname (e.g. MARTA COLLINS), then the impression of a female forename may be created. MARTA is followed by the word FABI which, again, the opponent claims is a name, albeit not a common name in the UK. I do not think the average UK consumer will see it as a name/surname and consequently will not attach to MARTA the meaning of a female forename⁴. I consider that neither side's mark has a meaning; there is neither conceptual similarity nor dissimilarity.

³ The General Court ("GC") has considered how trade marks or parts of trade marks may have a conceptual connotation despite not being in themselves dictionary words. In *Usinor SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-189/05* the CFI referred to a "suggestive connotation". In *Ontex NV v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T- 353/04* it referred to the "evocative effect" and in *Hipp & Co v OHIM T-221/06* the perception of words that consist of parts with concrete meanings.

⁴ As per the comments of Ms Amanda Michaels, sitting as the Appointed Person, in *Topypy Trademarks Limited v Cofra Holding AG*, BL O/092/11: "25. What the Hearing Officer had to consider was how the mark would be perceived by the average UK consumer. Whilst of course there are many persons whose mother tongue is not English who live and work in the UK, such persons are not the average UK consumer for the purposes of considering the pronunciation or meaning of a word."

15. Taking all the above into consideration, overall, the marks are reasonably similar.

Distinctiveness of the earlier mark

16. I must consider the distinctive character of the earlier mark because the more distinctive it is, either by inherent nature or by use (nurture) the greater the likelihood of confusion⁵. The distinctive character of the earlier trade mark must be assessed by reference to the goods for which it is registered and by reference to the way it is perceived by the relevant public⁶. As the opponent has not filed any evidence of use of its mark, I have only the inherent position to consider. FABI is not descriptive of and does not allude to any characteristic of footwear. FABI is not an English word and so, to the average consumer in the UK, appears as an invented word. Invented words have a high degree of distinctive character. FABI is a mark which has a high degree of distinctive character.

Likelihood of confusion

17. In deciding whether there is a likelihood of confusion between the marks, I must weigh the various factors I have identified and also bear in mind the principle of interdependency, whereby a lesser degree of similarity between the goods may be offset by a greater degree of similarity between the trade marks, and vice versa (*Canon*). I have found identity between the respective goods. It cannot assist Mr D'Alterio that he refers in his counterstatement to his goods as being aimed at the Nigerian female market as both parties have cover for ladies' footwear and current marketing strategies form no part of the notional comparison of the marks and the goods for which they have cover.

18. I bear in mind the whole mark comparison and the dominant and distinctive elements within the marks. I should guard against dissecting the marks so as to distort the average consumer's perception of them; the average consumer perceives trade marks as wholes and rarely has the opportunity to compare marks side by side, relying instead upon the imperfect picture he has of them in his mind. Both marks share a dominant distinctive component and neither mark has a meaning. In comparing two marks with different meanings, if at least one meaning is capable of immediate understanding by the average consumer, this can offset visual and aural similarity between the marks⁷; however, this cannot operate here as neither mark has a meaning for the average UK consumer of footwear. Lack of conceptual similarity in this case cannot mitigate the effect of visual and aural similarity between the marks.

⁵ *Sabel BV v Puma AG* [1998] RPC 199.

⁶ *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

⁷ Visual and aural similarity can be offset by a lack of conceptual similarity, as found in *Ruiz Picasso v OHIM*, case 361/04 P [2006] E.T.M.R. 29.

19. A further factor to consider in the global appreciation is the weight which I should attach to the type of purchasing process. I have said buying footwear is primarily a visual activity which means the marks will be seen, so the level of visual similarity is important. I have found the marks to be visually similar to a reasonable level. The level of attention during the purchasing process is not at a high level and the purchase will be for identical goods. Neither mark has a meaning by which the average consumer will differentiate them and they both share an invented, distinctive component which is the only component in the earlier mark which will be remembered (the line border being non-distinctive). If not a case of direct confusion, the similarities between the marks, combined with the identical goods offered under both marks, will cause the average consumer to expect the undertaking responsible for each mark to be economically connected, thereby leading to indirect confusion. **The opposition succeeds under section 5(2)(b): the application is refused.**

Costs

20. The opponent has been successful and is entitled to an award of costs which are on the basis of contribution rather than compensation. I have reduced the scale award⁸ for written submissions in lieu of a hearing owing to their brevity and repetition from the statement of case. The costs breakdown is:

| | |
|--|-------------|
| Preparing a statement and considering the other side's statement | £200 |
| Preparing submissions in lieu of a hearing | £100 |
| Opposition fee | £200 |
| Total: | £500 |

21. I order Carlo D'Alterio to pay FABI S.p.A. the sum of £500. 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 04 day of August 2011

**Judi Pike
For the Registrar,
the Comptroller-General**

⁸ As per the scale in Tribunal Practice Notice 4/2007.