

O-269-14

TRADE MARKS ACT 1994

IN THE MATTER OF UK REGISTRATION NO 3029521
IN THE NAME OF TEDIM INTERNATIONAL LIMITED
IN RESPECT OF TRADE MARK:

Tedim

AND

AND OPPOSITION THERETO
UNDER NO 600000080 BY TEDI GMBH & CO KG

BACKGROUND

1. On 6 November 2013, Tedim International Limited (the applicant) applied to register the above trade mark in class 25 of the Nice Classification system.¹ The specification stands as follows:

Men's clothing; womens clothing; childrens clothing; T-shirts; jumpers; pullovers; hooded garments; cardigans; sweatshirts; blouses; vests; hats; headware; caps; beanies; trousers; jeans; corduroy; skirts; dresses; clothing; footwear; headgear; casual clothing.

2. Following publication of the application, Tedi GmbH & Co. KG (the opponent) filed notice of opposition against the application, on 28 February 2014, under the fast track opposition procedure.

3. The opposition was brought under section 5(2)(b) of the Trade Marks Act 1994 (the Act). The opponent relies upon the mark insofar as it is registered for the goods as shown below:

Mark details and relevant dates	Goods relied on
CTM: 11280369 Mark: TEDI Filing date: 19 October 2012 Date of entry on the register: 15 April 2013	Clothing; Footwear; Headgear for wear; Suits; Eyemasks for sleeping purposes; Layettees [clothing]; Swimsuits; Bathing trunks; Bath robes; Bathing caps; Bath sandals; Bandannas; Bikinis; Body suits; Brassieres; Pocket squares; Masquerade costumes; Mittens; Football boots; Shoes for the garden; Moneybelts (clothing); Non-slipping devices for boots; Wellies; Belts (clothing); Clothing for gymnastics; Gymnastic shoes; Scarfs; Gloves (clothing); Slipper; Shirts; Trousers; Suspenders; Hats; Jackets [clothing]; Caps; Pockets for clothing; Bodies; Costumes, Father Christmas costumes; Neckties; Bibs (not of paper); Clothing of leather; Leggings; Coats; Dressing gowns; Caps [headwear]; Combinations [clothing]; Slippers; Pullovers; Pyjamas; Waterproof clothing; Sandals; Collar protectors; Sleepsuits; Aprons (clothing); Ski boots; Underpants; Socks; Hats; Boots for sports; Boots; Head bands; G-strings; Stockings; Tights; Sweaters; Singlets; Tee-shirts; Mantles [clothing]; Uniforms; Pants; Underclothing.

4. On 8 April 2014, the applicant filed a counterstatement, denying the ground of opposition. 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.”

¹ *International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).*

5. The net effect of these changes is to require parties to seek leave in order to file evidence in fast track oppositions.

6. No leave was sought in respect of these proceedings.

7. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if 1) the Office requests it or 2) 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.

8. A hearing was neither requested nor considered necessary. The opponent filed written submissions, which I will refer to as necessary, below.

9. I give this decision following a review of all of the material before me.

DECISION

10. Section 5(2)(b) of the Act reads as follows:

“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, or there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

11. 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.”

12. The opponent's mark is an earlier mark, which is not subject to proof of use because, at the date of publication of the application, it had not been registered for five years.²

Section 5(2)(b) case law

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 5 May 2004

13. In his decision in *La Chemise Lacoste SA v Baker Street Clothing Ltd* - BL O/330/10 (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), the Appointed Person, Mr Geoffrey Hobbs QC, expressed the test under this section (by reference to the Court of Justice of the European Union (CJEU) cases mentioned) on the basis indicated below:

The CJEU cases

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; *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market* (Trade Marks and Designs) (OHIM), Case T-6/01; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04; *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market* (Trade Marks and Designs) (OHIM) C-334/05 P.

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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.”

The average consumer and the nature of the purchasing act

14. In accordance with the above cited case law, I must determine who the average consumer is and also identify the nature of the purchasing process. The average consumer is reasonably well informed and reasonably circumspect and observant but with a level of attention likely to vary according to the category of goods. The attention paid is likely to vary depending on price and, to some extent, the nature of the goods and the frequency of the purchase.

15. The goods are, broadly speaking, clothing. In considering the level of attention that will be paid to such a purchase and the nature of the purchasing act, I am mindful of the decision of the General Court (GC) 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, in which it commented:

"43. It should be noted in this regard that the average consumer's level of attention may vary according to the category of goods or services in question (see, by analogy, *Case C-342/97 Lloyd Schuhfabrik Meyer [1999] ECR I-3819, paragraph 26*). As OHIM rightly pointed out, an applicant cannot simply assert that in a particular sector the consumer is particularly attentive to trade marks without supporting that claim with facts or evidence. As regards the clothing sector, the Court finds that it comprises goods which vary widely in quality and price. Whilst it is possible that the consumer is more attentive to the choice of mark where he or she buys a particularly expensive item of clothing, such an approach on the part of the consumer cannot be presumed without evidence with regard to all goods in that sector. It follows that that argument must be rejected.

...

53. Generally in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly the visual aspect plays a greater role in the global assessment of the likelihood of confusion."

16. The average consumer of the goods at issue will be a member of the general public. The purchase is likely to be primarily visual as it is likely to be made from a website or directly from a shelf. The goods cover a range of products which vary in price and frequency of purchase. Consequently, the level of attention is likely to vary. A dinner suit is likely to be a fairly expensive, infrequent purchase, which will be purchased according to

the particular requirements of the purchaser. It will demand a higher level of attention to be paid than, for example, buying a t-shirt or a pair of socks.

17. The selection process for each of the goods is primarily visual, though I do not discount the fact that there may be an aural element given that some articles may be selected with the assistance of a member of staff. The goods may be purchased on the high street, online or by mail order and the level of attention paid will be reasonable, the consumer paying the attention necessary to obtain, inter alia, the correct size, colour and fit.

Comparison of goods

18. The goods to be compared are as follows:

The opponent's goods	The applicant's goods
<p>Class 25 Clothing; Footwear; Headgear for wear; Suits; Eyemasks for sleeping purposes; Layettees [clothing]; Swimsuits; Bathing trunks; Bath robes; Bathing caps; Bath sandals; Bandannas; Bikinis; Body suits; Brassieres; Pocket squares; Masquerade costumes; Mittens; Football boots; Shoes for the garden; Moneybelts (clothing); Non-slipping devices for boots; Wellies; Belts (clothing); Clothing for gymnastics; Gymnastic shoes; Scarfs; Gloves (clothing); Slipper; Shirts; Trousers; Suspenders; Hats; Jackets [clothing]; Caps; Pockets for clothing; Bodies; Costumes, Father Christmas costumes; Neckties; Bibs (not of paper); Clothing of leather; Leggings; Coats; Dressing gowns; Caps [headwear]; Combinations [clothing]; Slippers; Pullovers; Pyjamas; Waterproof clothing; Sandals; Collar protectors; Sleepsuits; Aprons (clothing); Ski boots; Underpants; Socks; Hats; Boots for sports; Boots; Head bands; G-strings; Stockings; Tights; Sweaters; Singlets; Tee-shirts; Mantles [clothing]; Uniforms; Pants; Underclothing.</p>	<p>Class 25 Mens clothing; womens clothing; childrens clothing; T-shirts; jumpers; pullovers; hooded garments; cardigans; sweatshirts; blouses; vests; hats; headware; caps; beanies; trousers; jeans; corduroy; skirts; dresses; clothing; footwear; headgear; casual clothing.</p>

19. In comparing the goods, I bear in mind the following guidance provided by the General Court (GC) in *Gérard Meric v OHIM*, Case T-133/05:

“29. ...goods can be considered identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

20. Both parties' specifications contain the broad term 'clothing, footwear, headgear'. All of the items listed individually are included within these broad terms. In accordance with the principles laid down in *Meric*, the parties' goods are identical.

Comparison of marks

21. The marks to be compared are as follows:

The opponent's mark	The applicant's mark
TEDI	Tedim

22. In making a comparison between the marks, I must consider the respective marks' visual, aural and conceptual similarities with reference to the overall impressions created by them, bearing in mind their distinctive and dominant components³, but without engaging in an artificial dissection of them, because the average consumer normally perceives a mark as a whole and does not analyse its details.

23. The opponent's mark consists of the single word 'TEDI' in block capitals. No part of the word is stylised or emphasised in any way. Consequently, the distinctiveness lies in the mark as a whole.

24. The applicant's mark consists of the word 'Tedim'. The letter 'T' is a capital with the remaining letters in lower case. No part of the word is stylised in any way. The distinctiveness lies in the mark as a whole.

25. In its counter statement the applicant submits:

"The two marks, 'Tedim' and 'TEDI' are totally different words, can not [sic] be mistaken for each other in any way..."

Visual similarity

26. In its submissions (the paragraphs of which are not numbered) the opponent states:

"We submit that the marks are highly similar. All of the Opponent's Mark is included in the Applicant's Mark. The only difference is the last letter in the Applicant's Mark which we submit would not be noticed by the average consumer."

³ *Sabel v Puma AG, para.23*

The marks are visually similar and the same four letters in the Opponent's Mark are repeated in the Applicant's Mark. This will lead to confusion as consumers read from left to right."

27. Whether or not the parties' marks are presented in upper or lower case is not a factor which can be taken into account as it is clear from cases such as *Sadas*⁴ and *Peek & Cloppenburg v OHIM*⁵ that normal and fair use of a word trade mark includes use in a range of fonts and cases. Accordingly, the fact that the earlier mark is registered in block capitals does not prevent its use in title case, nor is the applicant's mark restricted to title case.

28. The opponent's mark consists of the four letters 'TEDI'. The applicant's mark consists of five letters, the first four of which are identical to the earlier mark, namely, 'Tedi'. The final additional letter is the letter 'm'. The marks are visually highly similar.

Aural similarity

29. The opponent submits:

"The marks are aurally similar both consisting of two syllables with the same first syllable. The last part of the second syllable in the Applicant's Mark is likely not to be pronounced or not to be remembered by consumers."

30. The opponent's mark will be pronounced TED-EE (as in TEDDY). The applicant's mark will be pronounced TED-IM (the same TED sound as the beginning of the word TEDDY, IM as in IMPOSSIBLE).

31. The marks are aurally similar to a high degree.

Conceptual similarity

32. The average consumer will consider both parties' marks to be invented words with no particular meaning such that the conceptual position is neutral.

Distinctive character of the earlier mark

33. 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 used 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.

34. The opponent has not filed any evidence to show that it has used its mark, so I have only the inherent position to consider. The earlier mark consists of the word TEDI. This will be seen as an invented word and is therefore not descriptive nor allusive of any of the goods relied upon. The earlier mark has a high level of inherent distinctive character.

⁴ *Sadas SA v OHIM*, T-346/04

⁵ T-386/07

Likelihood of confusion

35. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them he has kept in his mind.⁶ I must also keep in mind the average consumer for the goods, the nature of the purchasing process and have regard to 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.

36. I have found the marks to be highly similar visually and aurally and to be conceptually neutral. I have found the earlier mark to have a high level of inherent distinctive character. I have found the parties' goods to be identical. I have identified the average consumer, namely any member of the general public, and have concluded that the level of attention paid will vary but will be at least reasonable to the extent that the purchaser will need to consider, inter alia, size, fit, style, colour. I have concluded that the purchase will be primarily visual, though I do not discount an aural element as enquiries may be made, or advice sought, prior to purchase.

37. There is a general rule, clear from decisions such as joined cases T-183/02 and T-184/02⁷ that the first parts of words catch the attention of consumers. However, it is also clear that each case must be decided on its merits considering the marks as wholes. In this case the word TEDI, which is the entirety of the opponent's mark makes up the first four of five letters in the application. They differ only in the addition of a letter M at the end of the applicant's mark.

38. I also bear in mind the comments of the GC with regard to identical goods when considering the likelihood of confusion. In *Aldi GmbH & Co KG v Office for Harmonization in the Internal Market*⁸ the GC stated:

“91 In addition, the Opposition Division considered that the goods at issue were identical, as was recalled in the contested decision, without the Board of Appeal's taking a final decision in that regard (see paragraph 40 et seq. above). That implies, in accordance with the case-law cited at paragraph 23 of the present judgment, that, if there is to be no likelihood of confusion, the degree of difference between the marks at issue must be high (see, to that effect, judgment of 29 January 2013 in Case T-283/11 *Fon Wireless v OHIM – nfon (nfon)*, not published in the ECR, paragraph 69).”

39. Taking all of these factors into account, particularly the concept of imperfect recollection and the fact that the earlier mark is an invented word with a high degree of inherent distinctive character, in my view, the similarity of the marks is such that in the context of identical goods purchased, for the most part, visually, I find that there will be direct confusion (where one mark is mistaken for the other).

⁶ *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27

⁷ *El Corte Ingles v OHIM - Gonzales Cabello and Iberia Lineas Aereas de Espana (MUNDICOR)* [2004] ECR II – 965, paragraph 81

⁸ *(Trade Marks and Designs) (OHIM) Case T-505/11*

Conclusion

40. The opposition succeeds under section 5(2)(b) of the Act.

Costs

41. The opposition having succeeded, the opponent, is entitled to a contribution towards its costs. I make the award on the following basis:

Preparing a statement and considering the other side's statement: £200

Preparing submissions: £200

Official fee: £100

Total: £500

42. I order Tedim International Limited to pay Tedi GmbH & Co. KG 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 16th day of June 2014

**Ms A Skilton
for the Registrar,
The Comptroller General**