

O-257-15

TRADE MARKS ACT 1994

**IN THE MATTER OF THE APPLICATION BY
PM SURREY LIMITED
UNDER NO 3055035 FOR THE TRADE MARK**



AND

**IN THE MATTER OF OPPOSITION NO. 402482 THERETO
BY JASON ROBERTSON**

THE BACKGROUND AND THE PLEADINGS

1) On 10 May 2014 PM Surrey Limited (“the Applicant”) filed application no. 3055035 to register the following mark for the following goods:



Class 25: *Clothing, footwear, headgear; casual clothing; clothing for skiing.*

The application was published in the Trade Marks Journal on 13 June 2014.

2) On a ground under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) Mr Jason Robertson opposes the registration of the mark in respect of all the goods covered by the application. For the purposes of his claim he relies on UK trade mark registration no. 3002462 (“the earlier mark”), filed on 17 April 2013, for the following mark and goods:

POWDER MONKEEZ

Class 25: *Clothing, footwear, headgear; casual clothing, hooded sweatshirts, jeans, printed T-shirts, lined and unlined jackets, short sleeve and long sleeve shirts, baggy shorts, long sleeve embroidered T-shirts, printed and embroidered sweatshirts, trousers, fleece pullovers, socks, skirts, shorts, scarves, gloves, underwear.*

Mr Robertson’s mark constitutes an earlier mark in accordance with section 6 of the Act, and is not subject to the proof of use conditions contained in section 6A of the Act, as its registration procedure had not been completed five years or more before the publication of the Applicant’s mark.

3) The Applicant filed a notice of defence and counterstatement, denying the grounds of opposition. While agreeing that the mark applied for is similar to the earlier mark, it stated: (1) that the existence of a POWDER MONKEY trade mark belonging to a third party, which had expired on 2 July 2014, meant that in making the present application for registration the Applicant was not “adding further confusion into the marketplace, rather taking over a trademark already in existence for 10 years”; (2) that its “application is accompanied by distinctive branding which will help to avoid confusion in the marketplace”; (3) that neither the Applicant nor Mr Roberts had put goods on the market under the respective marks, and that this made confusion of the public impossible to ascertain.

4) During the evidence rounds Mr Nick Bradley, on behalf of Mr Robertson, filed submissions which included exhibits. The Registry informed Mr Robertson that such exhibits amounted to evidence, which must be presented by means of a witness statement in proper form. He was given until 20 November 2014 to re-submit the evidence in proper form. When he failed to do so the Registry informed him that, since amended evidence had not been filed as required, only the submissions would be considered by the Hearing Officer. The Applicant filed a witness statement of its Director, Mr James Clancy, of 26 January 2015. It contains what amount to submissions, together with appended documents showing a website bearing the contested mark, and correspondence with Mr Nick Bradley on behalf of Mr Robertson and with a third party owner of a previously existing POWDER MONKEY trade mark which expired when it was not renewed in July 2014. I shall not summarise the evidence and submissions of the parties further at this point, but will return to them when considering their relevance to the matters I have to determine.

SECTION 5(2)(b)

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

“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”.

The following principles are gleaned from the decisions of the EU courts 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, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a 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 the goods

6) In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“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”.

The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services

- c) The respective trade channels through which the goods or services reach the market
- d) 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;
- e) 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.

In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05 (“*Meric*”), the General Court stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut fur Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

7) The Applicant submits that it has launched a website which “*isn’t a single clothing range as in Powder Monkeez, but a snow sports retail site ...*”, and that it feels there is room in the marketplace for both brands to co-exist. In the present proceedings, however, the Applicant has not applied for retail services in class 35. The specifications I have to compare are those set out for the respective marks which are both restricted to goods in class 25. It is settled law that in assessing whether there is a likelihood of confusion I must make my comparison on the basis of notional and fair use over the whole range of goods covered by the Applicant’s and (since the earlier mark is not subject to proof of use under section 6A of the Act) the Opponent’s respective specifications. It is the inherent nature of the goods of the specifications which I have to consider; current use and business strategy are irrelevant to this notional comparison (see *Devinlec Développement Innovation Leclerc SA v OHIM* Case T- 147/03). This is because they may change over time. As a result of future use and business strategies, the marks may be used to target the same consumers. Consequently, I am required to consider the likelihood of confusion “in all the circumstances in which the mark applied for might be used if it were to be registered” (See Case C-533/06, *O2 Holdings v Hutchison 3G UK* at paragraph 66).

8) The applied for *clothing, footwear, headgear* is identically covered by the *clothing, footwear, headgear* of the earlier mark. *Casual clothing* and *clothing for skiing* both fall within the ambit of the earlier mark’s *clothing*, and are therefore identical goods under the guidance in *Meric*. Therefore all of the Applicant’s goods are identical to goods in Mr Robertson’s earlier mark.

The average consumer and the purchasing process

9) 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 or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

10) The average consumer of the goods of the competing marks will consist of the general public. Clothing, footwear and headgear are regular consumer purchases. The average consumer of clothing for skiing will consist of those members of the general public interested in skiing. Items such as clothing for skiing will not be such frequent purchases, but they will not be unusual. The cost of all the goods can vary but they are not, generally speaking, highly expensive purchases. Whilst the average consumer of expensive clothing, for example, will probably pay higher attention to the selection of the goods, the position must also be considered from the perspective of more standard clothing. Overall, consumers will normally pay a reasonable degree of attention, neither higher nor lower than the norm, when selecting the goods. The purchasing of all these goods is a predominantly visual process, so visual aspects of the marks take on more importance; but there may be some scope for aural use of the marks, so aural aspects will not be overlooked in my comparison of the marks.

The distinctiveness of the earlier mark

11) The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark (on the basis either of inherent qualities or because of use made), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. 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).

23. 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).”

12) I have no evidence of acquired distinctiveness to consider. This leaves the question of inherent distinctiveness. The words POWDER and MONKEY are both ordinary words with well-known meanings. However, there is nothing before me to suggest that they are in any way descriptive or allusive of the goods of the earlier mark. As such, POWDER MONKEY has at least a normal degree of inherent distinctive character.


Comparison of the marks

13) 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 Court of Justice of the European Union stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

It would be wrong, therefore, to dissect the trade marks artificially, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

14) The marks to be compared are shown below.

The mark applied for	The earlier mark
	<p style="text-align: center;">POWDER MONKEEZ</p>

15) The mark applied for consists of a device and words and has been registered in a grey-green colour. The device consists of a circle, the darker lower part of which is consistent with both a diagrammatic representation of two snow-capped mountains and the dark lower half of a face with two eyes. The suggestion of a face is completed by a curved line representing the mouth, and two semi-circular projections representing the ears. The device appears, slightly raised, to the left of the words POWDER MONKEY, which are written in a conventional square typeface, although the descender of the final Y has been shifted above the baseline. The colour and the typeface used make some contribution to the overall impression and distinctiveness of the mark, but it is clearly the device and the phrase POWDER MONKEY which are its main distinctive elements.

16) The earlier mark consists of the words POWDER MONKEEZ. The words combine to create a phrase that “hangs together” even though it is not clear what it means. The distinctive character of the mark resides in this phrase as a whole.

17) I bear in mind that since the earlier mark is a word mark, notional and fair use of it would include use in a script comparable to that of the Applicant’s mark and that, being unlimited as to colour, it is registered for all colours¹. The device in the Applicant’s mark creates an obvious visual difference. A further difference consists of the quirky misspelling of the word “monkeys” in the earlier mark. Consumers are used to such misspellings in trade marks, however, and this one comes at the very end of the phrase. Similarly, the singular/plural difference is one which may well go unnoticed. Overall, there is at least a medium degree of visual similarity between the marks.

18) It is not normal for device elements of a mark to be expressed aurally, and therefore both marks are likely to be pronounced in a very similar way. The Applicant’s mark will be pronounced as POW-DER-MUN-KEE and the Opponent’s as POW-DER-MUN-KEEZ. There is a very high degree of aural similarity.

19) I do not consider that the visual pun I have described in the device of the Applicant’s mark (snow-capped mountains/face and eyes) will register without analysis. I had looked at the mark several times before I noticed it. The average

¹ See the observations of MannJ in *Specsavers International Healthcare Limited & Others v Asda Stores Limited* [2010] EWHC 2035 (Ch) at paragraph 119.

consumer normally perceives a mark as a whole and does not proceed to analyse its various details. Even if this visual pun registers with the consumer, I do not consider that it creates a substantial conceptual difference in the context of the overall impression of the mark. Apart from this, the device in the Applicant's mark is a simple design which straightforwardly reflects the semantic content of the word MONKEY. I have already discussed in paragraphs 12 and 16 the conceptual content of the phrase POWDER MONKEY from the perspective of the average consumer. The phrase POWDER MONKEY or POWDER MOMKEEZ creates an impression of monkeys. How "powder" applies to monkeys is not clear. Nevertheless, it will be perceived to apply to the word MONKEY/MONKEEZ. The perception will be identical for both marks. The meaning and significance which the average consumer would attach to the words POWDER MONKEY in the context of the Applicant's mark as a whole would be unaffected by the device element (or any other aspect of the mark). Even if the singular/plural difference and the variation in spelling between the marks are noticed, they will be accorded very little significance by the average consumer. There is a high degree of conceptual similarity between the marks.

Likelihood of confusion

20) Neither side in these proceedings is professionally represented, and the evidence and submissions filed betray considerable misunderstanding on the part of both with regard to the matters which I have to determine. The existence of another POWDER MONKEY trade mark which belonged to a third party is not relevant to these proceedings. That mark has expired, was not owned by Applicant, and therefore cannot be relied upon in these proceedings. The matter I have to determine is whether there is a likelihood of confusion between the mark which the Applicant has applied to register and the earlier mark owned by Mr Robertson. In its counterstatement the Applicant observes: "*...neither applicant or opposition have launched any clothing ranges or services using these brands within the marketplace and so opposition on the basis of public confusion is impossible to ascertain*". As these proceedings do not consist of an action for infringement, but rather are concerned with an opposition to an application to register a trade mark, it is notional and fair use across both parties' specifications which must be the basis for my assessment, and not the use made by the parties of their marks². Section 5(2)(b) is concerned with whether there is a *likelihood* of confusion, rather than whether there has been confusion. That is not to say that evidence of confusion, or its absence, might not, on occasion, assist in deciding whether there is a likelihood of confusion. For evidence of absence of confusion to assist the Applicant, however, it would not only need to establish use of the respective marks in actual concurrent trading by both parties targeting an approximately similar, or at least overlapping, audience; it would also need to show that the nature, extent and duration of that trading had been sufficient to satisfy the tribunal that any apparent capacity for confusion had been adequately tested and found not to exist³.

² See the observations of Arnold J in *Och-Ziff Management Europe Limited and another v Och Capital LLP and others* [2010] EWHC 2599 (Ch)

³ See the decision of the Appointed Person in *Ion Associates v Philip Stainton & Another* (O-211-09 at paragraph 52).

21) In his witness statement of 26 January 2015 Mr Clancy makes what amounts to a submission that the two marks “*are able to mutually co-exist as they form different purposes, one being branded clothing and the other a website brand name, which while similar are still quite distinct in their nature and role and would not lead to confusion for the public*”. As I have already explained, I must conduct an analysis based upon the respective specifications of goods and not analyse the actual use in the marketplace. The application is not in respect of retail website services. It is in respect of clothes, being identical to Mr Robertson’s listed goods.

22) I must make a decision based on whether I consider there to be a *likelihood* of confusion on the part of the average consumer. It is settled law that in doing so I must make my comparison on the basis of notional and fair use over the whole range of goods covered by the Applicant’s and Mr Robertson’s respective specifications.

23) The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

24) I have found the goods of the competing specifications to be identical. I have found a medium degree of visual similarity and a high degree of both conceptual and aural similarity between the competing marks. I have also found that the earlier mark has at least a normal degree of distinctive character. I consider that the presence of the device in the Applicant’s mark is sufficient to prevent that mark from being directly confused with the earlier mark. Nevertheless, I have also found that the meaning and significance which the average consumer would attach to the words POWDER MONKEY in the context of the Applicant’s mark as a whole would be unaffected by the device element or any other aspect of the mark. In other words, the phrase POWDER MONKEY has an independent distinctive role within the Applicant’s mark. Moreover, bearing in mind my findings on the average consumer and the purchasing process, the variation in spelling and difference between the singular and plural forms in the marks may well be lost through imperfect recollection. Even if they are noticed, the use of POWDER MONKEY and POWDER MONKEEZ on identical goods will not be regarded as a coincidence. The consumer will believe that they are marks used by the same or by economically linked undertakings – that they “come from the same stable”. There will be indirect confusion. **Accordingly, the opposition succeeds.**

OUTCOME

25) **The opposition has succeeded in its entirety, and the opposed mark is to be refused.**

COSTS

26) Mr Robertson has been successful and is entitled to a contribution towards his costs. The award reflects the fact that both sides were unrepresented in the proceedings and did not therefore incur the costs of legal representation. I hereby order PM Surrey Limited to pay Mr Jason Robertson the sum of £400. This sum is calculated as follows:

<i>Opposition fee</i>	£200
<i>Preparing a statement and considering the other side's statement</i>	£100
<i>Preparing submissions and considering the other side's evidence</i>	£100

The above sum should be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 4th day of June 2015

Martin Boyle
For the Registrar,
The Comptroller-General