

O-433-15

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3093596 BY
VEETEC LTD**

TO REGISTER:



**AS A TRADE MARK
IN CLASSES 18, 25 & 35**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 60000246 BY
B.FOREVER**

BACKGROUND

1. On 10 February 2015 (claiming International Convention priority dates of 26 January 2015 from earlier filings in Sri Lanka), Veetec Ltd (“the applicant”) applied to register the trade mark shown on the cover page of this decision. The application was published for opposition purposes on 6 March 2015 for the following goods and services:

Class 18 - Handbags.

Class 25 - Clothing; Footwear; Headgear.

Class 35 - Advertising; Business Management; Business Administration; Office Functions.

2. The application is opposed by b. forever (“the opponent”) under the fast track opposition procedure. The opposition, which is directed against all of the goods and services in the application, is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The trade mark and goods relied upon by the opponent are shown below:

Community Trade Mark (“CTM”) no. 7026231 for the trade mark:



applied for on 30 June 2008 and for which the registration procedure was completed on 18 June 2012:

Class 3 - Smoothing stones; cosmetics for tanning the skin; cosmetic preparations for baths; incense sticks; hair lotions; false eyelashes; cosmetics; make-up removing preparations; deodorants for personal use; soaps; essential oils; hair lacquers; dentifrices; hair lotions; make-up preparations; cosmetic kits; nail varnish; nail care preparations; preparations for perfuming linen; perfumery products; preparations for shaving; shampoos; nail varnish removing preparations.

Class 9 - Compact Discs and DVDs; eyewear cases; optical goods; Spectacles (optics); sunglasses; photographic apparatus; hands-free kits for telephones; mobile phones; telecommunication equipment and accessories; scientific apparatus and instruments (not for medical purposes).

Class 14 - Alloys of precious metal; jewellery; jewellery cases; cuff links; trinkets; watches; key rings; cases for clock- and watchmaking; jewellery; alarm clocks.

Class 18 - Card holders, wallets and purses; key wallets; briefcases; umbrellas; beach bags; handbags, travelling bags, sports bags; Leather goods; garment bags for travel; travelling sets; travelling bags and luggage; leather and imitations of leather.

Class 25 - Clothing; Gloves (clothing); Belts (clothing); Headgear; Sportswear (other than for diving).

The opponent states:

“The representation of a lizard contained in [the application] is very similar to the lizard representation the subject of the [opponent’s CTM]. The overall shape, style, and orientation of the two lizards are so similar that consumers would find it difficult to distinguish between the two. The goods covered by the [opponent’s CTM] are identical or very similar to those covered by [the application].”

3. The applicant filed a counterstatement in which the basis of the opposition is denied; I will return to its comments on the competing trade marks below. The applicant states:

“Furthermore, it is also apparent that there are numerous other goods and trade marks with this depiction of a lizard. However, it is fair to say that they are all most certainly unique in their design...available in the UK, EU and worldwide. With that said, it is fair to say, my logo seems more original over that of the opponent’s and the additional images displayed...”

Attached to its counterstatement were a number of images. In an official letter dated 21 July 2015, the applicant’s attention was drawn to the filing of evidence in fast track opposition proceedings and advised that: “the hearing officer will not take consideration of the additional images contained in figure 3.”

4. 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.”

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

5. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise written arguments will be taken. A hearing was neither requested nor considered necessary; the applicant filed written submissions which I will refer to, as necessary, below.

DECISION

6. The opposition is based upon section 5(2)(b) of the Act, which 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.”

7. 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.”

8. The trade mark upon which the opponent is relying qualifies as an earlier trade mark under the above provisions. In a letter to the applicant dated 3 September 2015, the Tribunal stated:

“A review of the submissions has been made prior to the case being passed to the hearing officer for a final decision and I must bring to your attention that your comments in paragraphs 4 to 8 do not appear to apply in these proceedings.

Your submission refers to the requirement of the opponent to provide proof of use evidence of the registration relied upon in the opposition. However, proof

of use does not apply in this case as the opponent's earlier mark became registered on 18 June 2012 and, therefore, has not been registered for a period of 5 years prior to the publication of the opposed mark. In addition, paragraph 5 of your submission refers to evidence of use submitted by the opponent, however, no evidence has been submitted in this case.

For the avoidance of doubt, the parties are notified that this case is proceeding to a final decision on the basis that proof of use of the opponent's earlier registration is not a requirement and paragraphs 4 to 8 of the applicant's submission will not be given consideration."

9. As the opponent's earlier trade mark is not subject to proof of use, it is entitled to rely upon all of the goods it has identified.

Section 5(2)(b) – case law

10. 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.

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 be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive

role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

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

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

11. The competing goods and services are as follows:

Opponent's goods	Applicant's goods and services
<p>Class 3 - Smoothing stones; cosmetics for tanning the skin; cosmetic preparations for baths; incense sticks; hair lotions; false eyelashes; cosmetics; make-up removing preparations; deodorants for personal use; soaps; essential oils; hair lacquers; dentifrices; hair lotions; make-up preparations; cosmetic kits; nail varnish; nail care preparations; preparations for perfuming linen; perfumery products; preparations for shaving; shampoos; nail varnish removing preparations.</p> <p>Class 9 - Compact Discs and DVDs; eyewear cases; optical goods; Spectacles (optics); sunglasses; photographic apparatus; hands-free kits for telephones; mobile phones; telecommunication equipment and accessories; scientific apparatus and instruments (not for medical purposes).</p> <p>Class 14 - Alloys of precious metal; jewellery; jewellery cases; cuff links; trinkets; watches; key rings; cases for clock- and watchmaking; jewellery; alarm clocks.</p>	<p>Class 18 - Handbags.</p> <p>Class 25 - Clothing; Footwear; Headgear.</p> <p>Class 35 - Advertising; Business Management; Business Administration; Office Functions.</p>

<p>Class 18 - Card holders, wallets and purses; key wallets; briefcases; umbrellas; beach bags; handbags, travelling bags, sports bags; Leather goods; garment bags for travel; travelling sets; travelling bags and luggage; leather and imitations of leather.</p> <p>Class 25 - Clothing; Gloves (clothing); Belts (clothing); Headgear; Sportswear (other than for diving).</p>	
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12. In the judgment of the Court of Justice of the European Union (“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”.

13. 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.

14. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

“I should add that I see no reason to give the word “cosmetics” and “toilet preparations”... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context.”

15. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

16. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court ("GC") stated that "complementary" means:

"...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking".

In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as 'complementary' and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

"It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes."

Whilst on the other hand:

".....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together."

17. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05, the GC stated:

"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 the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application

are included in a more general category designated by the earlier mark (Case T-104/01 Oberhauser v OHIM – Petit Liberto (Fifties) [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 Vedral v OHIM – France Distribution (HUBERT) [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03 Koubi v OHIM – Flabesa (CONFORFLEX) [2004] ECR II-719, paragraphs 41 and 42).”

18. In its submissions, the applicant states:

“13. It is conceded by the applicant that there is a degree of overlap between the goods in respect of which the disputed marks are registered. It is not denied, for example, that the class 25 clothing and headgear and class 18 handbag items appear in both registrations. It is not conceded, however, that all of the goods for which the disputed marks are registered are, by virtue of that overlap, sufficiently similar in the relevant sense. In the first place there is no mention in the earlier registration of the class 25 footwear item. Nor is there any mention in the earlier registration of the items that fall into class 35 in respect of which the applicant seeks registration.”

19. For the sake of convenience, I will deal with the matter on a class-by-class basis.

Class 18

20. As the applicant accepts, the word “handbags” appears in both parties’ specifications in this class; the goods are identical.

Class 25

21. As the applicant accepts, both parties’ specifications in this class include references to “clothing” and “headgear”; these goods are identical. Insofar as the term “footwear” in the application is concerned, this would include a range of goods including, for example, boots, shoes, slippers and socks. Given the similarity in, inter alia, the respective users, nature, intended purpose, method of use, trade channels and the potential complementary relationship that may exist, “footwear” in the applicant’s specification is, if not encompassed by the term “clothing” (and identical on the *Meric* principle), similar, in my view, to “clothing” to at least a reasonable degree.

Class 35

22. The opponent provides no explanation as to why it considers the applicant’s services in this class to be similar to its goods. Having applied the above case law, I am unable to identify any similarity between the applicant’s services in this class and any of the opponent’s goods. I will return to this point when I consider the likelihood of confusion.

The average consumer and the nature of the purchasing act

23. As the case law above indicates, it is necessary for me to determine who the average consumer is for those goods I have found to be identical or reasonably

similar; I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. 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.”

24. The average consumer for the goods in classes 18 and 25 is a member of the general public. As to the manner in which such an average consumer will select these goods, 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 considered the level of attention paid to and the manner in which clothing is selected. It 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.

50. The applicant has not mentioned any particular conditions under which the goods are marketed. 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.”

25. In my view, the conclusions reached in *New Look* apply equally to the selection of handbags. As handbags and items of clothing are, most likely to be the subject of self selection from traditional retail outlets on the high street, catalogues and websites, visual considerations are likely to dominate the selection process, though not to the extent that aural considerations can be ignored. The cost of the goods at issue can vary considerably. Nevertheless, as factors such as material, size, colour, cost and compatibility with other items may all come into play, the average consumer



will, in my experience, pay an average degree of attention when making their selection. This level of attention will, in my experience, increase as the cost and importance of the item increases.

Comparison of trade marks

26. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU 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.”

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

Opponent’s trade mark	Applicant’s trade mark
	

28. In its submissions, the applicant states:

“Similarity/Dissimilarity Between the Marks

14. When applying the global test laid down earlier to the two marks that are the subject of the present dispute, there exist sufficient differences, both in graphic detail and in overall design between those marks such, it is submitted, would clearly lead a member of the purchasing public to conclude that the products sold under their auspices were of differing origins.

15. In the first instance, the applicant's mark comprises both a word and an image whereas the opponent's mark comprises only an image. Secondly, the reptile in the opponent's mark is turned to the right whereas that in the applicant's mark is turned to the left. Thirdly, there is something quite distinctive about the word component in the applicant's mark in that it contains an alteration of the standard spelling of the word 'lizard' by replacing the third letter with an 's'. Fourthly, the reptile in the opponent's mark is significantly thicker in body-width and more articulated than the lizard depicted in the applicant's. This is particularly note-worthy around the head and tail areas: the former of which is more at an angle and the latter of which is more elongated and curved in the opponent's mark than in the applicant's. Fifthly, the eyes are noticeable on the reptile in the applicant's mark, but not so on the opponent's. Sixthly, the claws of the reptile in the applicant's mark are splayed and in a very distinctive floral pattern, whereas those of the reptile in the opponent's mark are more as they would be found in nature. Finally, there are gaps between the legs of the reptile in applicant's mark and its body, whereas this is not so in respect of the reptile in the opponent's mark.

16. Whilst it is accepted that the distinctive nature of a mark is measured against what would be noticed by the reasonably attentive consumer, it is submitted that the inclusion of these various components in the applicant's mark is designed to draw the eye of the observer to what is distinctive about the mark in a subtle but effective way specifically to distinguish a product which bears it from the produce of other brands."

29. As the opponent's trade mark consists exclusively of what both parties agree is a device of a lizard, this is the overall impression it will convey. The applicant's trade mark consists of two elements. The first is a device of what both parties agree is a lizard, to the right of which there appears the word LISARD presented in upper case in an unremarkable script. Whilst the applicant thinks: "there is something quite distinctive about the word component in [its] mark...", I disagree. I am far from convinced that the difference in spelling of the word LISARD would even be noticed by the average consumer, but even if it were, it is, in my view, more likely than not to be understood as an alternative spelling of the word. In my view, both elements in the applicant's trade mark contribute roughly equally to its distinctiveness and to the overall impression it conveys, the word element reinforcing the overall impression conveyed by the device of a lizard and vice versa.

30. As the applicant points out, there are a number of differences between the competing trade marks, most notably the word LISARD which appears in its trade mark. However, despite the forensic analysis the applicant has conducted of the competing device elements, I agree with the opponent that notwithstanding the differences the applicant identifies, the competing device elements share similarities in terms of their overall shape and orientation. When considered as totalities, the competing trade marks are, in my view, visually similar to at least an average degree.

31. As to the degree of aural similarity, it is well established that when a trade mark consists of a combination of words and devices, it is by the word element that the average consumer is most likely to refer to the trade mark; the applicant's trade mark will be referred to by the two syllable word LIS-ARD. Insofar as the opponent's trade mark is concerned, I am guided by the approach adopted by the GC in *Dosenbach-Ochsner AG Schuhe und Sport v OHIM*, Case T- 424/10 in which it stated:

“46. A figurative mark without word elements cannot, by definition, be pronounced. At the very most, its visual or conceptual content can be described orally. Such a description, however, necessarily coincides with either the visual perception or the conceptual perception of the mark in question. Consequently, it is not necessary to examine separately the phonetic perception of a figurative mark lacking word elements and to compare it with the phonetic perception of other marks.” (my emphasis).

32. As both parties' trade marks will be understood as referring to the concept of lizards, they are conceptually identical.

Distinctive character of the opponent's trade mark

33. 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 – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. 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 registered 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. These are fast track opposition proceedings in which it was not necessary for the opponent to provide evidence of the use it may have made of its earlier trade mark. As a consequence, I have only the inherent characteristics of its trade mark to consider. In its submissions, the applicant draws my attention to what it considers to be the similarities between these proceedings and the decision of the CJEU in *Sabel BV v Puma AG*. It states:

“20. It is submitted that, just as in the *Sabel* case, in the present dispute, whilst the visual representations in the two marks arguably show some semantic similarity in that they both portray reptiles in a somewhat contorted pose...the [opponent's trade mark] consists of an image with little imaginative content.”

35. Whilst I understand the applicant's point, there is no evidence to suggest that the trade mark upon which the opponent relies is anything other distinctive for the goods for which it stands registered. As a consequence, I must, as per the comments of the CJEU in *Formula One Licensing BV v OHIM*, Case C-196/11P, assume that the opponent's trade mark has some distinctive character. As it will not affect the overall

outcome of these proceedings (see paragraph 38), I will proceed on the basis that absent use, it has at least a low degree of inherent distinctive character.

Likelihood of confusion

36. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is 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. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind. Earlier in this decision I concluded that:

- The competing goods in class 18 and some of the goods in class 25 are identical; “footwear” in the applicant's specification in class 25 is either identical to “clothing” in the opponent's specification or similar to at least a reasonable degree;
- The applicant's services in class 35 are not similar to any of the opponent's goods;
- The average consumer is a member of the general public who will select the goods by predominately visual means and who will pay an average degree of attention during the selection process;
- The competing trade marks are visually similar to at least an average degree and conceptually identical;
- As the opponent's trade mark consists exclusively of a device, the aural comparison is not a relevant consideration;
- The opponent's trade mark is, absent use, possessed of at least a low degree of distinctive character.

37. As per the comments of the CJEU in *Waterford Wedgwood plc v OHIM* Case C-398/07, there must be some similarity in the competing goods and services to engage the test for the likelihood of confusion. Earlier in this decision, I concluded that there was no similarity between any of the opponent's goods and the applicant's services in class 35. Where there is no similarity in the competing goods and services there can be no likelihood of confusion and the opposition against the services in class 35 fails and is dismissed accordingly.

38. As I alluded to above, even if the opponent's trade mark has only a low degree of inherent distinctive character, it does not preclude a likelihood of confusion. In *L'Oréal SA v OHIM*, Case C-235/05 P, the CJEU found that:

“45. The applicant’s approach 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. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders.”

39. In relation to those goods I have found to be either identical or similar to at least a reasonable degree, I have found the purchasing process to be primarily visual with the consumer paying only an average degree of attention during the purchasing process. In reaching a conclusion, I have not lost sight of the applicant’s comments to the effect that the various differences between the competing trade marks will not go unnoticed. However, having concluded that the competing trade marks are visually similar to at least an average degree and conceptually identical, and as the average consumer rarely has the chance to compare trade marks side-by-side, the effects of imperfect recollection are a highly relevant consideration. Bringing all these factors together, I am satisfied there will be a likelihood of confusion. Even if the various differences between the competing trade marks are sufficient to avoid direct confusion i.e. where one trade mark is mistaken for the other, which, in my view, is arguable, there will still, in my view, be indirect confusion, the basis of which was explained by the Appointed Person in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10.

Overall conclusion

40. The opposition has succeeded in relation to the goods classes 18 and 25 but failed in respect of the services in class 35.

Costs

41. As the opponent has been successful in relation to two of the three classes it opposed it is entitled to a contribution towards its costs, reduced to reflect the measure of the applicant’s success. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide, and bearing the above in mind, I award costs to the opponent on the following basis:

Preparing a statement and considering the applicant’s statement:	£150
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Opposition fee:	£100
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Total:

£250

42. I order Veetec Ltd to pay to b.forever the sum of **£250**. This sum is to 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 14th day of September 2015

**C J BOWEN
For the Registrar**