

**O-435-15**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 3059780  
BY RANK LLC TO REGISTER THE TRADE MARK**

**URBAN FOX**

**IN CLASS 25**

**AND IN THE MATTER OF OPPOSITION  
THERE TO UNDER NO 402920  
BY FOX HEAD INC.**

## Background and pleadings

1) Rank LLC (“the applicant”) applied to register the trade mark URBAN FOX in the UK on 13 June 2014. It was accepted and published in the Trade Marks Journal on 25 July 2014 in respect of the following goods:

**Class 25:** *Articles of clothing; footwear; boots, shoes, slippers, sandals, trainers, socks and hosiery; headgear; hats; caps; berets; scarves; gloves; mittens; belts (being articles of clothing); shirts, blouses, casual shirts, T-shirts, vests, camisoles, bodysuits, polo shirts, sports shirts, football and rugby shirts; trousers, jeans, shorts, sports shorts, swimwear; underwear; lingerie; tracksuits; articles of outerwear, coats, jackets, ski jackets, casual jackets, waterproof and weatherproof jackets and coats, parkas, body warmers, ski wear; suits; dresses; skirts; culottes; jumpsuits, playsuits; sweatshirts; jumpers, shrugs and cardigans; knitwear; leggings; neckties; pyjamas; waistcoats; headbands and wristbands; legwarmers; menswear; womenswear; childrenswear.*

2) Fox Head Inc. (“the opponent”) oppose the mark on the basis of Section 5(2)(b), Section 5(3) and Section 5(4)(a) of the Trade Marks Act 1994 (the Act). The first two grounds are based upon conflict with its earlier Community Trade Mark (CTM) no. 2421824. The relevant details of which are shown below:

Mark and relevant dates	Goods relied upon
 <p>Filing date: 23 October 2001 Date of entry in register: 14 December 2005</p>	<p><b>Class 18:</b> <i>Luggage, backpacks, fanny packs, all purpose sports bags, tool packs sold empty.</i></p> <p><b>Class 25:</b> <i>Clothing, namely, jackets, raincoats, sweatshirts, jerseys, shirts, blouses, pants, tights, shorts, hats, caps, sweatbands, headbands, gloves, belts, shoes, boots, socks and aprons.</i></p>

3) The opponent submits that the respective goods are identical or similar, that the marks are similar and that the application, therefore, offends under Section 5(2)(b) of the Act. It claims use throughout the UK since 1992 in respect of all the goods listed in its Class 18 and Class 25 specifications.

4) In addition, the opponent claims that the application offends under Section 5(3) of the Act because it would take unfair advantage of, and be detrimental to the distinctive character of its earlier mark. It claims that its mark has a reputation for clothing in motocross, extreme sports and outdoor activities and that the applicant’s goods could be used for such purposes and the applicant would therefore benefit from the opponent’s reputation in those fields. It also claims that the consumer will believe there is a connection between the respective goods leading to a serious likelihood of a change in the economic behaviour of the relevant consumer.

5) The opponent also claims that the application offends under Section 5(4)(a) of the Act because it has generated substantial goodwill in the UK identified by the mark FOX and use of the applicant's mark will result in misrepresentation and damage because it is "highly feasible" that the public may believe that the respective goods are in some way connected.

6) The applicant filed a counterstatement denying the claims made and despite the opponent's mark being potentially subject to the proof of use requirements, it has chosen not to request that the opponent provides proof of use of its earlier trade mark. The consequence of this is that the opponent may rely upon the full list of goods included in the specifications of its earlier mark. The applicant claims that:

- the opponent's goodwill in the UK is restricted to the industrial clothing sector;
- that its mark contains no graphic representation;
- Its mark is used primarily in the field of women's lingerie and accessories and the use of the word FOX within its mark implies "young, savvy, sexy women";
- the word FOX is "so undistinctive" that to use it with the word URBAN creates an entirely new and entirely unique mark.

7) Only the opponent filed evidence in these proceedings. This will be summarised to the extent that it is considered necessary.

8) Only the opponent filed written submissions which will not be summarised but will be referred to as and where appropriate during this decision. No hearing was requested and so this decision is taken following careful consideration of the papers.

### **Opponent's Evidence**

9) This takes the form of a witness statement by David Scott Olivet, Interim Chief Executive Officer at the opponent, a position he has held for five months. He explains that the opponent is an action sports and clothing company founded in 1974 in the USA. He states that it is now a multi-national business trading in 50 countries and primary focused on the sports of motocross, mountain biking, surfing, BMX, snowboarding and wakeboarding, collectively described by Mr Olivet as "adventure sports".

10) In addition, Mr Olivet states that the opponent designs and manufactures a range of casual clothing. He states that the mark has been used in the UK "from as early as 1992" and has "been used consistently and widely throughout the UK since [then]"

11) Mr Olivet provides sales figures for the European Union totalling over €65 million between 2010 and 2013. No specific figures are provided for the UK, but Mr Olivet states that "the sales of the opponent's products within the UK alone amount to a large proportion of the total EU sales."

12) Exhibit DS02 consists of copies of 6 sample invoices showing sales in the UK. Each invoice carries the earlier mark in the header together with the address in the

UK for Fox Head Europe Ltd. One is dated in December 2009, three are dated in 2010, one in 2011 and one in 2012. They relate to five different customers and contain long lists of clothing goods. Five of the invoices amount to £716, £1580, £8852, £8960 and £7786 respectively. The sixth, addressed to “Designer Outlet – York” contains a 15 page list of goods sold at a recorded 99.99% discount.

13) Mr Olivet states that the opponent holds a substantial market share of 35-40% of all sales in the UK “in respect of motocross related goods which includes [clothing, footwear and headgear]” and 40-45% in the UK in respect of “mountain biking goods and accessories”.

14) Mr Olivet states that the opponent’s goods are advertised through its website [www.foxhead.com](http://www.foxhead.com), that was registered on 30 August 2003. He states that this website receives over 48,000 hits from the EU each month and that “a large percentage of this figure are from hits received from within the UK”. Mr Olivet states that the opponent is also the proprietor of the website [www.foxeurope.com](http://www.foxeurope.com), registered on 18 January 1999. Extracts from the opponent’s website are provided at Exhibit DS03. Pages printed on 13 October 2014 show various items of clothing many bearing versions of marks consisting of, or incorporating either or both the word FOX and the device of a fox’s head as seen in the earlier mark. The earlier mark itself is visible on the front of a “jersey” (on page 97), partially on the front of “jerseys” (on page 98), a wallet (on page 102) and a beanie hat (on page 106).

15) Mr Olivet states that the opponent also advertises its goods in its own branded catalogues and example pages from the “Fall 2009” and “Fall 2010” editions are provided at Exhibit DS04. These show a variety of casual clothing, namely hoodies, t-shirts, fleeces. The earlier mark is visible on the front of hoodies (on pages 146 and 152) and on a t-shirt (on page 148).

16) Mr Olivet states that the opponent has placed adverts in many publications throughout the UK and identifies the following publications: *Ride UK BMX*, *Cross* magazine and *Dirt* magazine. Sample adverts from publications “available in the UK” are provided at Exhibit DS05. A number of these are multi-lingual magazines with no indication that they are available in the UK. The remaining examples include:

- DIRT mountainbike magazine, October 2013, December 2013 and one other indiscernible date: These have a .co.uk website address of the publisher on the front cover and are in English. The earlier mark is not visible in any of the advertisements;
- DIRTBIKE magazine, June 2013, December 2013: in English but no other indication of its geographical target. The adverts shows motocross competitors wearing clothing bearing a number of the opponent’s marks (the word FOX and the fox head logo);
- UNLEASHED International Wake Magazine, undated. The copy of the advert is unclear and the earlier mark cannot be distinguished;
- Several French language magazines with a cover price is shown in Euros;

- RIDE UK BMX MAG, February 2013: The advertisement shows the fox head logo, but not the earlier mark;
- DBR Dirt Bike Rider, May 1997: An article entitled “The McGrath Report” includes two pictures of a motocross rider wearing clothing with the earlier mark appearing across his chest. Three other copies of the same magazine show motocross competitors wearing clothing featuring the fox head logo of the opponent.

17) Mr Olivet provides audience figures for all these magazines and the number of Facebook “likes” for each, but how these relate to the UK is not explained. Similarly, advertising spend figures are provided for the years 2009 to 2014, but it is not clear what proportion of these figures relate to the UK. Nine invoices relating to such spending are provided at Exhibit DS06. Most are payable to companies outside the UK, but one appears to be for advertising activity in the UK. This is from *Factory Jackson* (with an address in Worcester), dated 1 January 2013 and in respect of “12 months Ad @ Position 1”. The exhibit also includes a copy of a quote for “Fox advertising on Enduro21.com 2013 – Jan 1 to Dec 31”.

18) Mr Olivet states that the opponent regularly sponsors events that are sometimes held in the UK and broadcast on UK television and also sponsor participants of such events. The world moto championship is an example of such an event.

19) The opponent has a number of stores in the UK and at Exhibit DS07, Mr Olivet provides an indistinct map of the UK with their locations marked. Mr Olivet also states that the opponent’s goods are available for purchase under the opponent’s branding from distributors in the UK and at Exhibit DS08 he provides screen prints from the opponent’s website showing a selection of cities in the UK and the partial lists of local distributors within a 100km of each of these cities. The pages for Leeds and London are shown. A banner to the right of the page has room to show 8 retailers and in both cases 8 retailers are shown.

20) Mr Olivet identifies the retailer *Blue Tomato* as “one of the largest individual stockists in the EU (including UK)” of the opponent’s goods. Extracts from one of its catalogues and website are provided. Prices are shown in Euros and an international dialling code of “43” as part of its contact telephone number suggests that it is based in Germany.

## **DECISION**

### **Section 5(2)(b)**

21) Section 5(2)(b) of the Act is 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, or there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

### **Comparison of goods and services**

22) In the judgment of the Court of Justice of the European Union (“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”.

23) The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity also included the respective trade channels through which the goods or services reach the market.

24) The respective goods are:

<b>Goods relied upon by the opponent</b>	<b>Applicant’s goods</b>
<p><b>Class 18:</b> <i>Luggage, backpacks, fanny packs, all purpose sports bags, tool packs sold empty.</i></p> <p><b>Class 25:</b> <i>Clothing, namely, jackets, raincoats, sweatshirts, jerseys, shirts, blouses, pants, tights, shorts, hats, caps, sweatbands, headbands, gloves, belts, shoes, boots, socks and aprons.</i></p>	<p><b>Class 25:</b> <i>Articles of clothing; footwear; boots, shoes, slippers, sandals, trainers, socks and hosiery; headgear; hats; caps; berets; scarves; gloves; mittens; belts (being articles of clothing); shirts, blouses, casual shirts, T-shirts, vests, camisoles, bodysuits, polo shirts, sports shirts, football and rugby shirts; trousers, jeans, shorts, sports shorts, swimwear; underwear; lingerie; tracksuits; articles of outerwear, coats, jackets, ski jackets, casual jackets, waterproof and weatherproof jackets and coats, parkas, body warmers, ski wear; suits; dresses; skirts; culottes; jumpsuits, playsuits; sweatshirts; jumpers, shrugs and cardigans; knitwear; leggings; neckties; pyjamas; waistcoats; headbands and wristbands; legwarmers; menswear; womenswear; childrenswear.</i></p>

25) For the purposes of considering the issue of similarity of goods, it is permissible to collectively consider groups of terms where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* BL O-399-10 and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs [30] to [38].

26) I keep in mind the following guidance of the General Court (“the GC”) in *Gérard Meric v OHIM*, T-133/05 (citations omitted):

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

27) With the above guidance in mind, it is self evident that the applicant’s *footwear; boots, shoes, and trainers* are covered by, or are the same as the opponent’s terms *shoes and boots*.

29) All of the opponent’s *jackets, raincoats, sweatshirts, jerseys, shirts, blouses, pants, tights, shorts, ..., sweatbands, headbands, gloves, belts, ... socks and aprons* may all be *articles of clothing, menswear, womenswear or childrenswear*, all terms listed in the applicant’s specification and these respective goods are therefore identical when applying the *Meric* guidance. In addition, a number of specific goods listed in the applicant’s specification are identical to those of the opponent because the terms appear in both specifications or because one term is covered by a broader term in the other party’s specification, namely:

<b><i>Opponent’s goods</i></b>	<b><i>Applicant’s goods</i></b>
<i>jackets</i>	<i>Jackets, casual jackets, ski jackets, ski wear [that includes ski jackets]</i>
<i>raincoats</i>	<i>coats,... waterproof and weatherproof jackets and coats, parkas... articles of outerwear</i>
<i>sweatshirts</i>	<i>sweatshirts</i>
<i>shirts, blouses</i>	<i>shirts, blouses, casual shirts, T-shirts, polo shirts, sports shirts, football and rugby shirts</i>
<i>pants [insofar as the term is understood to be describing items of underwear]</i>	<i>underwear</i>
<i>pants [insofar as is an alternative term for trousers]</i>	<i>trousers, jeans</i>
<i>tights</i>	<i>hosiery</i>
<i>shorts</i>	<i>shorts, sports shorts</i>
<i>socks</i>	<i>socks</i>
<i>gloves</i>	<i>gloves; mittens</i>
<i>headbands</i>	<i>headbands</i>
<i>hats, caps</i>	<i>headgear, hats, caps, berets</i>
<i>belts</i>	<i>belts (being articles of clothing)</i>

30) The remaining goods are:

*slippers, sandals scarves, shrugs, neckties vests, camisoles, lingerie, bodysuits, body warmers, suits; waistcoats, dresses; skirts; culottes; jumpsuits, leggings jumpers, cardigans, knitwear; tracksuits, swimwear, playsuits, pyjamas, wristbands, legwarmers*

31) Whilst these are not identical to the opponent’s goods, they are none the less, still items of clothing or footwear that have the same purpose of covering or

protecting the body from the elements or for modesty. They share the same methods of use, namely, they are all worn on the body. Whilst their nature may be different to the extent that they may consist of different shapes in order to be used on different parts of the body, they are the same insofar that they may be made from the same or similar materials. Further, their respective trade channels are likely to be the same with it common place on the high street for broad clothing ranges to be offered for sale. Finally, they may be chosen as part of a fashion outfit with the goods listed in the opponent's specification. Taking all of this into account, I consider these goods to share a good deal of similarity with the goods listed in the opponent's Class 25 specification.

**Comparison of marks**

32) 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 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.”

33) It would be wrong, therefore, to artificially dissect the trade marks, 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.

34) The respective marks are shown below:

Opponent’s mark	Applicant’s mark
	<p style="text-align: center;">URBAN FOX</p>

35) The dominant and distinctive components of the opponent’s mark are the device of a fox’s head that is used to form the letter “O” in the word FOX and the word FOX itself, consisting of stylised letters “F” and “X” and the device of the fox’s head. Both the device and the word FOX share an equal relative weight when the mark is considered as a whole.

36) The applicant's mark consists of the two words URBAN and FOX that together describe a recognisable concept to the public, namely a fox that lives in an urban habitat. This recognisable concept means that the term holds together as a complete phrase with the distinctive character of the mark residing in the combination of the two words with no one word having more relative weight than the other.

37) Having considered the dominant and distinctive components of the mark, I must also consider the similarity between the marks. Visually, the opponent's mark creates the impression of the word FOX with a stylised device of a fox's head forming the letter "O". This creates some visual similarity with the applicant's mark because it also contains the word FOX, albeit unstylised. There are also a number of differences. The opponent's mark includes stylisation of the letters "F" and "X" in the form of a broad background border and, of course, the device of a fox's head, both of which are absent in the applicant's mark. The applicant's mark also contains the additional word URBAN appearing at the start of the mark. Taking all of this into account, I conclude that the respective marks share a moderate level of visual similarity.

38) I have already found that the device of the fox's head present in the opponent's mark will be perceived as being the letter "O" in the word FOX and, aurally, the mark will be referred to as the word FOX. This is identical to the last syllable of the applicant's mark. The applicant's mark also consists of two other syllables UR and BAN that occur at the start of the mark. Taking these similarities and differences into account, I conclude that the marks share a medium level of aural similarity.

39) Both marks create a similar meaning namely the wild dog, very common and native to the UK on the one hand and the same animal whose habitat is urban areas on the other. These similar meanings create a reasonably high level of conceptual similarity.

### ***Average consumer and the purchasing act***

40) 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.

41) In its written submissions, the opponent discusses its area of trade, namely "outdoor activities and active sports". The applicant, in its counterstatement, identifies women's lingerie as its area of business. However, I must consider the list of goods as presented in the specifications of the parties' marks. Here, general clothing terms are used and neither specification is limited to any particular activities. The average consumer of these broad goods will be ordinary members of the public who wish to purchase clothing, footwear and headgear. The purchase is normally made from high street or Internet retailers. In respect of the nature of the purchasing act for these goods, I am mindful of the comments of Mr Simon Thorley, sitting as the Appointed Person, in *React trade mark* [2000] R.P.C. 285:

“There is no evidence to support Ms Clark’s submission that, in the absence of any particular reputation, consumers select clothes by eye rather than by placing orders by word of mouth. Nevertheless, my own experience tells me it is true of most casual shopping. I have not overlooked the fact that catalogues and telephone orders play a significant role in this trade, but in my experience the initial selection of goods is still made by eye and subsequent order usually placed primarily by reference to a catalogue number. I am therefore prepared to accept that a majority of the public rely primarily on visual means to identify the trade origin of clothing, although I would not go so far as to say that aural means of identification are not relied upon.”

42) The GC has continued to identify the importance of visual comparison when considering the purchasing act in respect of clothing (see for example Joined Cases T-117/03 to T-119/03 and T-171/03 *New Look Ltd v OHIM (NLSPORT et al)* [2004] ECR II-3471 at [49]-[50] and Case T-414/05 *NHL Enterprises BV v OHIM (LA KINGS)* [2009] ECR II.). There is nothing before me in the current proceedings to lead me to conclude differently and, consequently, taking into account the above comments, I conclude that the purchasing act will generally be a visual one. However, I do not ignore the aural considerations that may be involved. The purchase of clothing and similar goods is, if not quite an everyday purchase, certainly a regular purchase for most consumers. Whilst these goods vary in cost, they are not normally very expensive. Taking account of this, the level of attention paid by the consumer is reasonable rather than high.

### ***Distinctive character of the earlier trade mark***

43) 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).”

44) In its written submissions, the opponent claims that, as a result of the widespread use of its mark, its mark has a high level of distinctive character. It points to the high level of recognition and being the “best-selling brand of motocross apparel in the world today”. There are numerous issues with the evidence that prevent me reaching the conclusion that its mark benefits from enhanced distinctive character because of the use made of it in the UK. In summary, these issues are:

- The sales figures provided are not specific to the UK;
- Extracts from its website show the use of numerous marks such as the fox head device alone and various forms of the word FOX, but only a limited number of examples of the earlier mark. This raises the question of whether the other information provided in the evidence relate solely to the earlier mark or to all its marks that it considers make up the FOX brand;
- Its catalogues provided relate to “Fall” rather than “Autumn” raising the question as to whether they are targeted at the UK consumer;
- Despite claiming that the opponent places adverts in many publications in the UK, many of the examples provided are foreign language or multi-language publications with no indication that they were sold in the UK. Further, the earlier mark is often not identifiable in the adverts. Audience figures provided for these magazines do not indicate those in the UK;
- Invoices relating to advertising spend are mostly in respect to companies outside the UK;
- The specific retailer of its goods identified appears to be based in Germany and it is not clear if, or what proportion of the opponent’s goods are sold to UK customers.

45) It is clear that the opponent has a large distributor network in the UK and that, on a global basis, it has a strong presence in certain niche fields. Mr Olivet states that, in the UK, the opponent has a 35-40% market share in respect of “motocross related goods” and a 40-45% share in respect of “mountain biking related goods and accessories”. Whilst this statement appears to indicate impressive market share in two specialist fields, it is not clear what proportion relates to clothing as opposed to other goods and accessories or what proportion relates to goods under the earlier mark as opposed to other FOX marks used by the opponent. Therefore, weighing up the evidence, I find that I am unable to conclude that the distinctive character of the earlier mark is enhanced because of the use made of it in the UK.

46) I must also consider the inherent level of distinctive character. The earlier mark consists of letters and device that are visually unusual with the stylised fox’s head replacing the letter “O” in the word FOX. Further, the concept of a fox is somewhat unusual when considered in the context of the goods at issue. Taking all of this into account, I conclude that the earlier mark is endowed with a reasonably high level of inherent distinctive character.

## **GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.**

47) 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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

48) I must adopt the global approach advocated by case law and take into account that marks are rarely recalled perfectly with the consumer relying instead on the imperfect picture of them he has in kept in his mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). I must take into account all factors relevant to the circumstances of the case, in particular the interdependence between the similarity of the marks and that of the goods or services designated (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*).

49) The applicant claims that there is no chance of confusion because its mark is used to imply young, savvy, sexy woman and its goods are primarily woman's lingerie and accessories. It also claims that the opponent has "goodwill within the industrial clothing sector" but not in the UK fashion marketplace. Neither of these arguments are persuasive because it is well established in the relevant case law that marketing strategies can change over time and consequently it is not appropriate to take account of the current marketing strategies of the parties (see for example, *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P, paragraph 59). Future marketing strategies may bring both marks into direct conflict and I must consider the issue of likelihood of confusion based upon the full list of goods listed in the respective specifications which are not limited to the marketing strategies described by the parties. In doing this, I have found the respective goods are identical or share a good deal of similarity.

50) The applicant also argues that there will be no confusion because its mark contains no graphic representation. I have found that the purchasing act is normally visual in nature and I agree that the absence of graphic representation will not go unnoticed by the average consumer. Consequently, the average consumer will notice visual differences between the marks and there will be no direct confusion (where one mark is confused with another).

51) However, this is not the end of the matter. The opponent submits that the average consumer will assume that the applicant's mark is some sort of variant form of the opponent's mark. I have found that there is a reasonably high level of conceptual similarity and that the concept of a fox or an urban fox is somewhat unusual in the context of clothing. I take this into account together with the fact that the goods being identical or sharing a good deal of similarity and that the attention level of the average consumer during the purchasing process is no more than reasonable. I find that these factors combine to overcome the differences in the marks and result in indirect confusion. This is where the average consumer assumes that the goods provided under the respective marks originate from the same or linked undertakings.

52) I add that, in reaching this conclusion, I dismiss the applicant's argument that the word FOX is "so undistinctive". In respect of clothing, I consider the word FOX to have reasonable distinctive character having no obvious meaning in respect of the parties' goods.

53) The opposition, insofar as it is based upon Section 5(2)(b) of the Act, is successful.

**Other grounds**

54) As the opposition is successful in its entirety based upon the Section 5(2)(b) ground, there is no need to consider the remaining grounds as they do not materially improve the opponent's position.

**COSTS**

55) The opponent has been successful and is entitled to a contribution towards its costs, according to the published scale in Tribunal Practice Notice 4/2007. I take account that only the opponent filed evidence, but that this was of minimal assistance and that no hearing took place. I award costs as follows:

Preparing a statement and considering the counterstatement	£300
Opposition fee	£200
Evidence	£300
Preparing written submissions	£300
<b>Total:</b>	<b>£1100</b>

56) I order Rank LLC to pay Fox Head Inc. the sum of £1100 which, in the absence of an appeal, should be paid within 14 days of the expiry of the appeal period.

**Dated this 15th day of September 2015**

**Mark Bryant**  
**For the Registrar,**