

**O-537-15**

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO 3 069 304 BY CHINA  
CAPITAL BRANDS LIMITED TO REGISTER THE TRADE MARK BOOBOO IN  
CLASS 24

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NO 403 317 BY  
BOOHOO.COM UK LIMITED

## Background and pleadings

1. China Capital Brands Limited (the applicant) applied to register the trade mark Booboo under Number 3 069 304 in the UK on 20<sup>th</sup> August 2014. It was accepted and published in the Trade Marks Journal on 14<sup>th</sup> November 2014 in respect of the following goods: *children's clothing; clothing, footwear, headgear* in Class 25.
2. Boohoo.com UK Limited (the opponent) opposes the trade mark under Number 403 317 on the basis of Section 5(2) (b) of the Trade Marks Act 1994 (the Act). This is on the basis of its earlier UK Trade Mark BOOHOO. The following goods are relied upon in this opposition:

Class 25:

*Articles of clothing; lingerie; bras; pants; thongs; stockings; tights; suspender belts; camisoles; dressing gowns; negligees; corsets; night dresses; sleep shirts; sarongs; shoulder wraps; leggings; footwear; boots; shoes; slippers; headgear; belts; trousers; shorts; jeans; wristbands; headbands; hats; gloves; jackets; coats; jumpers; shirts; t-shirts; sweaters; vests; trousers; skirts; waistcoats; waterproof clothing; bathing costumes; pyjamas; undergarments; scarves; socks; suits; dresses; blouses; sun visors; anoraks; articles of clothing for leisurewear; articles of clothing for casualwear; articles of clothing for sportswear; articles of outer clothing; articles of weatherproof clothing; blazers; denims; jerseys; knitwear; parkas; sweatshirts; tops; windcheaters; swimwear; mittens; layettes; sashes and shawls; bathing caps; braces; suspenders; collars; cuffs; ear muffs; fittings for boots and shoes; gaiters; garters.*

3. The opponent argues that the respective goods are identical or similar and that the marks are similar.
4. The applicant filed a counterstatement denying the claims made.
5. The opponent is represented by Wilson Gunn Patent and Trademark Attorneys and the applicant is self represented by its in house Legal Affairs Department.
6. Only the opponent filed evidence in these proceedings. This describes the use it has made of its earlier trade mark. However, the earlier trade mark relied upon is not subject to the proof of use provisions<sup>1</sup> as it was registered in March 2012, being less than five years before the publication of the contested trade mark. As such, the evidence will not be summarised.
7. Both sides filed written submissions, which will not be summarised but will be referred to as and where appropriate during this decision. It is noted that in its written submissions, the opponent relies upon a previous decision of the

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<sup>1</sup> See Section 6A of the Trade Marks Act 1994

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Appointed Person involving the same parties: BL O/387/11. No hearing was requested and so this decision is taken following a careful perusal of the papers.

### DECISION

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

8. Sections 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

9. In the judgment of the Court of Justice of the European Union 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”.

10. 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.

11. The earlier trade mark includes *articles of clothing; footwear; headgear*. These are self evidently identical to *clothing, footwear and headgear* in the later trade mark. As regards *children's clothing* in the later mark, the applicant makes much of the fact that they are targeted at children. However, this does not matter as the earlier term is *articles of clothing* which is a broad term that includes articles of clothing for children. They are identical.

## Comparison of marks

12. 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.”

13. 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.

14. The respective trade marks are shown below:

BOOHOO	Booboo
Earlier trade mark	Contested trade mark

15. As regards distinctive and dominant components, each of the marks is comprised of a single word element. Visually, the marks are identical except

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for the differing respective letters H and B which appear in the centre of the marks. They are highly similar visually.

16. Aurally, the articulation of the first syllable in each mark will be identical and the second syllable will be BOO versus HOO. They are highly similar.
17. Conceptually, the earlier trade mark will be seen as describing the act and sound of someone crying, whereas the later mark describes the making of a mistake. They are conceptually different.

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

18. 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*.

19. 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.”

20. The average consumer is the public at large. The goods in question are clothing, footwear and headgear. They are predominantly visually selected, with at least an average degree of care and attention being displayed in order to check fit, style etc.

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

21. 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

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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)."

22. The earlier trade mark has no meaning in respect of the goods to which it relates. Indeed it is considered to be odd and very unusual. It is considered to be highly distinctive *prima facie*. It is noted that the opponent considers its mark to be entitled to an enhanced degree of distinctiveness as a result of use made of it. However, bearing in mind the finding made on a *prima facie* basis, it is difficult to see how this places them in any better position.

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

23. 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

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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.

24. The relevant goods have been found to be identical. They are clothing, footwear and headgear. As already found, they are usually purchased visually and so this aspect has greater relative weight. As such, the following cases are noted:

In *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03, the General Court stated that:

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“49. However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (*BUDMEN*, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumer choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs.”

And

“50..... 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.”

And in *Quelle AG v OHIM*, Case T-88/05, the Court stated that:

“68..... If the goods covered by the marks in question are usually sold in self-service stores where consumers choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any phonetic similarity between the signs (*NLSPORT*, *NLJEANS*, *NLACTIVE and NLCollection*, paragraph 53 supra, paragraph 49).

69. Likewise, the degree of phonetic similarity between two marks is of less importance in the case of goods which are marketed in such a way that, when making a purchase, the relevant public usually perceives visually the mark designating those goods (*BASS*, paragraph 56 supra, paragraph 55, and Case T-301/03 *Canali Ireland v OHIM – Canal Jean (CANAL JEAN CO. NEW YORK)* [2005] ECR II-2479, paragraph 55). That is the case with respect to the goods at issue here. Although the applicant states that it is a mail order company, it does not submit that its goods are sold outside normal distribution channels for clothing and shoes (shops) or without a visual assessment of them by the relevant consumer. Moreover, while oral communication in respect of the product



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and the trade mark is not excluded, the choice of an item of clothing or a pair of shoes 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 (*NLSPORT*, *NLJEANS*, *NLACTIVE* and *NLCollection*, paragraph 53 supra, paragraph 50). The same is true of catalogue selling, which involves as much as does shop selling a visual assessment of the item purchased by the consumer, whether clothing or shoes, and does not generally allow him to obtain the help of a sales assistant. Where a sales discussion by telephone is possible, it takes place usually only after the consumer has consulted the catalogue and seen the goods. The fact that those products may, in some circumstances, be the subject of discussion between consumers is therefore irrelevant, since, at the time of purchase, the goods in question and, therefore, the marks which are affixed to them are visually perceived by consumers.”

25. The marks in question have been found to be visually similar to a high degree and the same is true aurally. It is true that they are conceptually different and that this may counteract visual and aural similarities (see *The Picasso Estate v OHIM*, Case C-361/04 P). However this counteractive effect is by no means inevitable (see *Nokia Oyj v OHIM*, Case T-460/07<sup>2</sup>). In respect of the marks in question here, not only is there a high degree of visual and aural similarity present, but the relevant goods are also primarily visually selected. It is considered that this significantly weakens any impact of a conceptual difference, the result being that confusion is deemed likely to occur. This is considered to be the case even if an average degree of attention is displayed during the purchasing process.
26. It is noted that in the earlier decision of the Appointed Person in BL O/387/11, a similar conclusion was reached in respect of marks which were if anything slightly further apart than those in issue here.
27. The opposition therefore succeeds in its entirety.

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<sup>2</sup> Where the General Court said: “Furthermore, it must be recalled that, in this case, although there is a real conceptual difference between the signs, it cannot be regarded as making it possible to neutralise the visual and aural similarities previously established (see, to that effect, Case C-16/06 P *Éditions Albert René* [2008] ECR I-0000, paragraph 98).”

**COSTS**

28. The opponent has been successful and is entitled to a contribution towards its costs. In the circumstances I award the opponent the sum of £900 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Opposition fee: £100

Considering statement of case: £300

Filing evidence and written submissions and considering written submissions: £500

29. I therefore order China Capital Brands Limited to pay Boohoo.com UK Limited the sum of £900. 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 18th day of November 2015**

**Louise White**

**For the Registrar,**