

O-579-15

**IN THE MATTER OF APPLICATION NO 3073092
BY
OLALERE FAGBULU
TO REGISTER THE TRADE MARK**

MADEWEAR

IN CLASS 25

**AND OPPOSITION THERETO
UNDER NO 403582
BY
ADENIYI ADEGBOYEGA**

BACKGROUND

1. On 18 September 2014 Olalere Fagbulu ('the applicant') applied to register the above trade mark in class 25 of the Nice Classification system¹. The specification stands as follows:

Class 25

Casual clothing; Casualwear.

2. The application was published on 10 October 2014, following which Adeniyi Adegboyega (the opponent) filed notice of opposition against the application.

3. The opposition was brought under sections 3(1)(b) and 3(1)(d) of the Trade Marks Act 1994 (the Act).

4. The opponent outlines his objections as follows:

"3(1)(b)... 'madewear' lacks any distinctive character and should not be allowed to be registered as a trade mark. It is a word (or slogan) generally associated with clothing. It is a commonly used slogan in the clothing trade often used to refer to clothing/wear which may or may not be bespoke or tailored that has been made/put together. The applicant has allegedly registered a company called 'madewear' Ltd to market and sell wears (class 25 items – clothing, footwear and headgear) that have been made/put together. This trade mark is therefore too descriptive as it simply consists of a characteristic of the goods/services that the applicant would like to market and sell.

And,

3(1)(d)... My opposition in this matter reflects the concern that a commonly used word (or slogan) that is often used when referring to clothing, 'madewear', should not be allowed to be monopolized for use by one party over others as this is not fair. It is an amalgamation of two words 'made' and 'wear' and it (ie, made-wear) as well as derivations of it (ie, such as ready-made-wear, custom-made-wear, etc) simply serve to describe the type or intended purpose of the goods/service. A simple search online using popular search engines such as Google or Bing typing in 'madewear' and 'made wear' suffixed with Class 25 items (ie, clothing, footwear and headgear) will return over 100,000+ sites and links, the majority of which relate to clothing – a clear demonstration of the commonality of this vernacular."

5. On 16 March 2015 the applicant filed a counter statement which denied all of the grounds raised in the notice of opposition. It submitted as follows:

"Contrary to the opponent's view, "madewear" is a distinctive formulation intelligently coined by the applicant. It is a single word. It is neither an

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

English word nor a slogan, and same is not generally associated with clothing. The opponent cannot assume to readily know the history, mind, purport, intention and/or plans (either short or long term) of the applicant as regards the use of the trademark, Of course, clothing/wears whether bespoke or tailored or not are made (created) or put together, but the coinage “madewear” as a singular word, is not commonly or rarely used as a slogan in the clothing trade or any trade at all. The trade mark therefore, is not descriptive because being a formulation of the applicant is only open to the meaning he ascribes to it. The opponent in expressing his own opinion cannot claim to know the etymology of the trade mark as regards the applicant, and the trade mark is not the same as — “made — wear”, “ready -. made — wear “, “custom — made — wear” etc. Typing in “madewear” alone into any search engine without suffixing it with any class item does not give the result stated by the opponent in his Statement of Grounds in Form TM7.

I submit that the opposition is frivolous, malicious, vexatious, and filed out of envy and in bad faith.”

6. Both parties filed evidence. A hearing took place on 2 December 2015, by video conference. The applicant filed a skeleton argument and was represented by David Fry of Agile IP. The opponent represented himself.

Evidence

7. I do not intend to summarise the evidence here but will refer to it as necessary in this decision. It consists of the following:

Opponent’s evidence

A witness statement of Adeniyi Adegboyega dated 25 June 2015 with 8 exhibits.

Applicant’s evidence

A witness statement of Olalere Fagbulu dated 22 July 2015 with 17 exhibits.

Opponent’s evidence in reply

A second witness statement of Adeniyi Adegboyega dated 24 September 2015 with 15 exhibits.

The decision

8. Section 3(1) of the Act is as follows:

“3. - (1) The following shall not be registered –

(a) ...

(b) trade marks which are devoid of any distinctive character,

(c) ...

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

9. It is well established that the absolute grounds for refusing registration must be examined separately, although there is a degree of overlap between sections 3(1)(b), (c) and (d) of the Act: see *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* [2004] E.T.M.R. 57, the Court of Justice of the European Union (“CJEU”), paragraphs 67 to 70.

10. In *Starbucks (HK) Limited, PCCW Media Limited, UK Broadband Limited v British Sky Broadcasting Group plc, British Sky Broadcasting Limited, Sky IP International Limited* [2012] EWHC 3074, Arnold J referred to summaries of the law in two decisions from the CJEU in relation to Articles 7(1)(b) and (c) of the Community Trade Mark Regulation, which correspond to sections 3(1)(b) and (c) of the Act:

“90. The principles to be applied under Article 7(1)(b) of the CTM Regulation were conveniently summarised by the Court of Justice of the European Union in Case C-265/09 P *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* [2010] ECR I-8265 as follows:

‘29. ... the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel v. OHIM* [2004] ECR I-5089, paragraph 32).

30. Under that provision, marks which are devoid of any distinctive character are not to be registered.

31. According to settled case-law, for a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (*Henkel v. OHIM*, paragraph 34; Case C-304/06 P *Eurohypo v. OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi v. OHIM* [2010] ECR I-0000, paragraph 33).

32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public (*Storck v. OHIM*, paragraph 25; *Henkel v. OHIM*, paragraph 35; and *Eurohypo v. OHIM*,

paragraph 67). Furthermore, the Court has held, as OHIM points out in its appeal, that that method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per se, three-dimensional marks and slogans (see, to that effect, respectively, Case C-447/02 P *KWS Saat v. OHIM* [2004] ECR I-10107, paragraph 78; *Storck v. OHIM*, paragraph 26; and *Audi v. OHIM*, paragraphs 35 and 36).

33. However, while the criteria for the assessment of distinctive character are the same for different categories of marks, it may be that, for the purposes of applying those criteria, the relevant public's perception is not necessarily the same in relation to each of those categories and it could therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories (see Joined Cases C-473/01 P and C-474/01 P and C-474/01 P *Procter & Gamble v. OHIM* [2004] ECR I-5173, paragraph 36; Case C-64/02 P *OHIM v. Erpo Möbelwerk* [2004] ECR I-10031, paragraph 34; *Henkel v. OHIM*, paragraphs 36 and 38; and *Audi v. OHIM*, paragraph 37).

34. In that regard, the Court has already stated that difficulties in establishing distinctiveness which may be associated with certain categories of marks because of their very nature – difficulties which it is legitimate to take into account – do not justify laying down specific criteria supplementing or derogating from application of the criterion of distinctiveness as interpreted in the case-law (see *OHIM v. Erpo Möbelwerk*, paragraph 36, and *Audi v. OHIM*, paragraph 38).

...

37. ... it should be pointed out that, even though it is apparent from the case-law cited that the Court has recognised that there are certain categories of signs which are less likely prima facie to have distinctive character initially, the Court, nevertheless, has not exempted the trade mark authorities from having to carry out an examination of their distinctive character based on the facts.

...

45. As is clear from the case-law of the Court, the examination of trade mark applications must not be minimal, but must be stringent and full, in order to prevent trade marks from being improperly registered and, for reasons of legal certainty and good administration, to ensure that trade marks whose use could be successfully challenged before the courts are not registered (see, to that effect, *Libertel*, paragraph 59, and *OHIM v. Erpo Möbelwerk*, paragraph 45).'

The relevant public

11. The distinctive character of the trade mark applied for must be assessed, first, by reference to the goods the subject of the opposition and, secondly, by reference to the perception of those goods by the relevant public.

12. The relevant public is defined in *Matratzen Concord AG v Hukla Germany SA* – C-421/04 (CJEU):

“24. In fact, to assess whether a national trade mark is devoid of distinctive character or is descriptive of the goods or services in respect of which its registration is sought, it is necessary to take into account the perception of the relevant parties, that is to say in trade and or amongst average consumers of the said goods or services, reasonably well-informed and reasonably observant and circumspect, in the territory in respect of which registration is applied for (see Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 29; Case C-363/99 *Koninklijke KPNNederland* [2004] ECR I-1619, paragraph 77; and Case C-218/01 *Henkel* [2004] ECR I-1725, paragraph 50).”

13. The relevant public for the opposed goods in class 25 is the general public.

14. The date at which the distinctiveness of the applicant’s trade mark must be assessed is the date of the application for registration, namely, 18 September 2014. I must make an assessment on the basis of the trade mark’s inherent characteristics, and, if I find the trade mark is open to objection on that basis, I must then determine, whether the trade mark has, in fact, before the date of the application for registration, acquired a distinctive character as a result of the use made of it.

Acquired distinctiveness

15. The applicant has filed evidence which includes, inter alia, copies of incorporation documents, domain name purchases, registration certificates, documents relating to the establishment of bank accounts, pages from a Nigerian magazine and several invoices. None of the evidence shows sales in the UK or advertising/promotion in the UK. No evidence has been filed by the applicant to explain, for example, the actual trade mark which may have been used, what goods, if any, were sold under the trade marks, any turnover achieved under the trade marks or any amounts spent on promoting the trade marks and so on. Consequently, I have only the inherent characteristics of the trade mark to consider.

The objection under section 3(1)(b)

16. The principles to be applied under article 7(1)(b) of the CTM Regulation (which is identical to article 3(1)(b) of the Trade Marks Directive and s.3(1)(b) of the Act) were conveniently summarised by the CJEU in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* (C-265/09 P) as follows:

“29..... the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 32).

30. Under that provision, marks which are devoid of any distinctive character are not to be registered.

31. According to settled case-law, for a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (*Henkel v OHIM*, paragraph 34; Case C-304/06 P *Eurohypo v OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi v OHIM* [2010] ECR I-0000, paragraph 33).

32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public (*Storck v OHIM*, paragraph 25; *Henkel v OHIM*, paragraph 35; and *Eurohypo v OHIM*, paragraph 67). Furthermore, the Court has held, as OHIM points out in its appeal, that that method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per se, three-dimensional marks and slogans (see, to that effect, respectively, Case C-447/02 P *KWS Saat v OHIM* [2004] ECR I-10107, paragraph 78; *Storck v OHIM*, paragraph 26; and *Audi v OHIM*, paragraphs 35 and 36).

33. However, while the criteria for the assessment of distinctive character are the same for different categories of marks, it may be that, for the purposes of applying those criteria, the relevant public's perception is not necessarily the same in relation to each of those categories and it could therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories (see Joined Cases C-473/01 P and C-474/01 P *Proctor & Gamble v OHIM* [2004] ECR I-5173, paragraph 36; Case C-64/02 P *OHIM v Erpo Möbelwerk* [2004] ECR I-10031, paragraph 34; *Henkel v OHIM*, paragraphs 36 and 38; and *Audi v OHIM*, paragraph 37)."

17. In his submissions and throughout the hearing the opponent sought to rely on a number of decisions including an application for 'Cool fresh'², 'Tasty Food' and 'RACEPARTS'³. The arguments advanced in support of the relevance of these cases all refer to section 3(1)(c) which has not been pleaded. In any case, these cases were decided on their own facts and the evidence before the decision maker in those cases and are not analogous to the issues before me.

18. The applicant states in its skeleton argument:

"11. The Mark as a whole is a made up word which has no recognition and provides no connotation to the relevant public.

12. The Mark consists of two words MADE and WEAR conjoined. The Claimant has not provided any evidence to show that the words MADE and WEAR are recognisable to the relevant public as being words that are commonly used together. The words do not have any description or connotation which specifically links them.

² *OHIM v Wrigley* [2003] E.C.R. I-12447 at Page 22 of 49 [32]
³ *BL O-222-14*

13. Whilst WEAR may imply something worn, the term MADE has no particular connotation to clothing. Combining the word MADE with WEAR does not alter the descriptiveness or connotation of MADE in any way.”

19. The relevant question under s.3(1)(b) is whether MADEWEAR is capable of distinguishing the clothing goods for which registration is sought. The mere fact that MADEWEAR is constructed of two common English words, one of which individually describes the purpose of the goods does not necessarily mean that it is incapable of distinguishing those goods. In *SAT.1 SatellitenFernsehen GmbH v OHIM*⁴ the CJEU set aside a judgment of the Court of First Instance upholding OHIM's decision to refuse 'SAT.2' as a Community trade mark. The court stated that:

“40 Although the way in which the term 'SAT.2' is made up is not unusual, in particular as regards the perception which the average consumer may have of services falling within the communications industry, and the juxtaposition of a verbal element such as 'SAT' with a digit such as '2', separated by a '.' does not reflect a particularly high degree of inventiveness, those facts are not sufficient to establish that such a word is devoid of distinctive character within the meaning of Article 7(1)(b) of the regulation.

41 Registration of a sign as a trade mark is not subject to a finding of a specific level of linguistic or artistic creativity or imaginativeness on the part of the proprietor of the trade mark. It suffices that the trade mark should enable the relevant public to identify the origin of the goods or services protected thereby and to distinguish them from those of other undertakings.

42 Where a trade mark which does not fall foul of the ground of refusal laid down in Article 7(1)(c) of the regulation is none the less devoid of distinctive character within the meaning of Article 7(1)(b) thereof, the Office must also set out the reasons why it considers that that trade mark is devoid of distinctive character.

43 However, in this case, the Office merely stated in the contested decision that the elements 'SAT' and '2' were descriptive and in current usage in the sector of media-related services, without stating in what way the term 'SAT.2', taken as a whole, was not capable of distinguishing the services of the appellant from those of other undertakings.

44 The frequent use of trade marks consisting of a word and a number in the telecommunications sector indicates that that type of combination cannot be considered to be devoid, in principle, of distinctive character.”

20. In order to be distinctive, to any degree, a trade mark must be able to carry out its essential function, namely, to guarantee the origin of the product to the consumer, taking into account the nature of those goods. Both parties agree that the mark is a

⁴ Case C-329/02

conjoining of two common words with which the average consumer will be familiar. The opponent submits that a combination of two known words does not mean the mark is distinctive. He has not filed any evidence to show that the mark at issue is not capable of functioning as a trade mark. The applicant states that no evidence has been filed to show that the words MADE and WEAR are recognisable to the relevant public as being commonly used together.

21. The first part of the mark is a common word meaning the creation of something. At the hearing the parties agreed that the word MADE may refer to any number of goods. The second part of the mark, the word WEAR, alludes to the purpose of the goods in respect of goods in class 25. However, such conclusions falls a long way short of finding the mark is incapable of distinguishing the applicant's goods from those other traders. In my view the mark in its totality is not an obvious combination of words and results in a mark which is greater than the sum of its parts. Consequently, I reject the ground for opposition based on s.3(1)(b) of the Act.

22. The opposition under s.3(1)(b) fails.

Pleadings and section 3(1)(c) of the Act

23. This opposition was brought in respect of 3(1)(b) and 3(1)(d) only. I note that in his submissions Mr Adegboyega also referred to the 3(1)(c) ground. At the hearing I explained that in order to rely on a ground it must be pleaded at the outset.

24. However, had I been in a position to consider the additional ground it is clear from the conclusions above that the opponent would not have succeeded. Whilst MADE may describe the creation of any number of goods and WEAR may indicate the intended purpose of the goods, the combination creates a neologism which has no clear meaning to the relevant public and does not result in a trade mark which consists exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services. Consequently, an opposition under 3(1)(c) of the Act would not have succeeded.

The opposition under section 3(1)(d)

25. The general principles with regard to this section of the Act are provided in *Telefon & Buch Verlagsgesellschaft mbH v OHIM*:⁵

“49. Article 7(1)(d) of Regulation No 40/94 must be interpreted as precluding registration of a trade mark only where the signs or indications of which the mark is exclusively composed have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought (see, by analogy, Case C-517/99 *Merz & Krell* [2001] ECR I-6959, paragraph 31, and Case T-237/01 *Alcon v OHIM – Dr. Robert Winzer Pharma* (BSS) [2003] ECR II-411, paragraph 37). Accordingly,

⁵ T-322/03 (GC)

whether a mark is customary can only be assessed, firstly, by reference to the goods or services in respect of which registration is sought, even though the provision in question does not explicitly refer to those goods or services, and, secondly, on the basis of the target public's perception of the mark (BSS, paragraph 37).

50. With regard to the target public, the question whether a sign is customary must be assessed by taking account of the expectations which the average consumer, who is deemed to be reasonably well informed and reasonably observant and circumspect, is presumed to have in respect of the type of goods in question (BSS, paragraph 38).

51. Furthermore, although there is a clear overlap between the scope of Article 7(1)(c) and Article 7(1)(d) of Regulation No 40/94, marks covered by Article 7(1)(d) are excluded from registration not on the basis that they are descriptive, but on the basis of current usage in trade sectors covering trade in the goods or services for which the marks are sought to be registered (see, by analogy, *Merz & Krell*, paragraph 35, and BSS, paragraph 39).

52. Finally, signs or indications constituting a trade mark which have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services covered by that mark are not capable of distinguishing the goods or services of one undertaking from those of other undertakings and do not therefore fulfil the essential function of a trade mark (see, by analogy, *Merz & Krell*, paragraph 37, and BSS, paragraph 40)."

26. In respect of its pleadings under this section the opponent submits:

My opposition in this matter reflects the concern that a commonly used word (or slogan) that is often used when referring to clothing, 'madewear', should not be allowed to be monopolized for use by one party over others as this is not fair.

27. The applicant submits:

Of course, clothing/wears whether bespoke or tailored or not are made (created) or put together, but the coinage "madewear" as a singular word, is not commonly or rarely used as a slogan in the clothing trade or any trade at all.

28. Registration should only be refused under this section of the act where the sign (MADEWEAR) has become customary in the current language or in the bona fide and established practices of the trade to designate the goods (or services) for which registration is sought (the applicant's goods in class 25).

29. Evidence in support of the opponent's case is contained in exhibit 11A-E. It comprises internet searches for companies and internet searches for the term 'madewear'. All of the pages were printed after the relevant date. 11A contains prints

from company databases describing those companies' business interests as, 'Ready Made Wear', 'Ready Made Ladies' Wear' and 'Ready Made Men's Wear'. All of the companies are registered outside the UK. Exhibits 11B-D are hits returned from a search for the term 'readymade'. All of the results contain the terms, 'Custom Made Wear', 'TJ's Tailor Made Jeans Wear' (from a Texan company) and 'MAE MADE WEAR' (from a New York based company). The remaining exhibit is taken from an eBay listing which is titled, 'Black adjustable wrist band *Fitbit* One custom made wear'. The opponent has highlighted the words 'MADE' and 'WEAR' on each exhibit.

30. Both sides made submissions in respect of searches carried out on *Google* in support of their cases and made particular reference to the nature of the results returned. Since such search engines carry out searches on the basis of the users' search history, this is not persuasive argument.

31. With regard to the search results I have described above, Mr Fry (for the applicant) stated that most of the returned results are for 'ready made wear', 'custom made wear' and 'tailor made wear' and that it is the first two words in each case which are the familiar terms. I agree. The additional word coming before 'made' in each case describes the nature of the word made to create terms which are familiar within the clothing trade, such as ready made, tailor made and custom made. In the remaining examples, such as 'tailor made jeans wear' the words 'made' and 'wear' do not appear next to each other in the search result. The evidence in its totality shows that the individual words 'made' and 'wear' sometimes appear within the same sentence but does not show that 'madewear' is customary in the current language or in the *bona fide* and established practices of the trade.

32. Taking all of the opponent's evidence and submissions into account there is nothing before me, in my judgment, to establish that the term 'madewear' was "*customary in the current language or in the bona fide and established practices of the trade*" from the viewpoint of relevant average consumers. Consequently, I reject the ground for invalidation based on s.3(1)(d).

33. The opposition under section 3(1)(d) fails.

Conclusion

34. The opposition fails under sections 3(1)(b) and 3(1)(d).

COSTS

35. The opposition having failed the applicant is entitled to an award of costs. Both parties are content with an award of costs in accordance with the scale provided in Annex A of Tribunal Practice Notice 4 of 2007. I award costs on the following basis:

Preparing a statement and considering the other side's statement:	£200
Preparation for and attending a hearing:	£500
Filing and considering evidence:	£500
Total	£1200

36. I order Adeniyi Adegboyega to pay Olalere Fagbulu the sum of £1200. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 8th day of December 2015

**Ms Al Skilton
For the Registrar,
the Comptroller-General**