

**O-019-16**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION 3060769  
BY NATALIE GRAY  
TO REGISTER THE FOLLOWING SERIES OF MARKS IN CLASSES 3 & 25:**



**&**



**AND**

**OPPOSITION THERETO (NO. 403131) BY  
INDUSTRIA DE CALÇADOS WEST COAST LTDA**

## **Background and pleadings**

1. These opposition proceedings concern whether the series of trade marks shown above should be registered for the following goods in classes 3 & 25:

**Class 3:** Beauty products, namely cosmetics, eye makeup, lipstick, foundation, moisturizer, mascara, face packs, bubble bath, body wash, soap, nail care, nail polish, nail polish remover, hair care, shampoo, conditioner, hair styling spray, hair styling gel.

**Class 25:** Clothing, footwear, headgear; namely, shirts, pants, dresses, jackets, footwear, hats and caps, athletic footwear, beach footwear, flip flops, footwear, footwear for men and women and children, insoles for footwear, thong footwear, water repelling footwear, waterproof footwear

2. The applicant is Ms Natalie Gray, who applied for the marks on 20 June 2014. The marks were published for opposition purposes on 25 July 2014.

3. The opponent is Industria De Calçados West Coast Ltda. Its opposition is based on grounds under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies on the following two earlier marks:

- i) UK registration 2607518 for the mark: **WEST COAST** which was filed on 19 January 2012 and was entered on the register on 20 July 2012. It is registered for the following class 25 goods:

Clothing, footwear, headgear; Bath sandals; Beach shoes; Belts; Boots; Boots for sports; Boots (Heelpieces for); Boots (Welts for); Football boots; Football shoes; Footwear; Half-boots; Heelpieces for boots and shoes; Heels; Lace boots; Sandals; Shoes; Shoes (Welts for); Soles for footwear; Sports shoes; Studs for football boots

- ii) Community trade mark (“CTM”) registration 7084569 for the mark:



The mark was filed on 23 July 2008 and entered on the register on 22 August 2010. It is registered for the following goods in class 25: “footwear, except orthopaedic”.

4. The opponent relies on mark i) to oppose all of the goods of the application, and mark ii) to oppose the applied for goods in class 25. In opposition proceedings, earlier marks which were entered on the register five years or more before the date on which the opposed mark was published, may only be relied upon to the extent that they have been used. This is provided for in section 6A of the Act. However, these provisions do not apply here because both earlier marks were entered on the register within (not before) the relevant five year period. The consequence of this is

that the opponent is entitled to rely on both of its earlier marks for the full breadth of their specifications. The opponent's main points in its statement of case are that:

- i) The marks in question are dominated by the words WEST COAST.
- ii) The opponent's registration consists of, or is dominated by (depending on which earlier mark is considered), the words WEST COAST and the applied for mark contains the words WEST COAST LONDON.
- iii) The applied for mark wholly encompasses the earlier mark (in the case of 2607518).
- iv) The marks are aurally and conceptually highly similar.
- v) LONDON (in the applied for marks) is not distinctive and will be given little significance because the average consumer is accustomed to seeing fashion cities used in relation to clothing and cosmetic products.
- vi) Visually the marks are similar as they all contain WEST COAST - the figurative element in the applied for mark does not prevent them from being "confusingly similar".
- vii) The goods in class 25 are identical (in relation to earlier mark 2607518) and identical or similar (in relation to 7084569).
- viii) The goods in class 3 are similar to the opponent's class 25 goods because they are "sold in the same stores and via the same trading channels".
- ix) The various factors mean that there is a likelihood of confusion on the part of the average consumer.

5. The applicant filed a counterstatement. The main points in defence are that:

- i) Whilst the respective marks contain the words WEST COAST, they are all filed/registered in a particular format and font.
- ii) There are several other marks registered in class 25 which contain the words WEST COAST (I will come back to these later).
- iii) Had the opponent's mark not been for a particular format/font it is unlikely to have been registrable on account of a pre-existing registration (CTM 4738051) which consists of the plain words WESTCOAST and which covers clothing products (for sports).
- iv) The image, format and font of the marks are quite different.
- v) Conceptually, WEST COAST and the applicant's LION/WEST COAST LONDON are very different.
- vi) The applicant's mark incorporates a unique font she created 30 years ago inspired by street art stencils.
- vii) The applicant's mark has an interplay of different cultures, the WEST Coast of America on the one part, London on the other. The lion represents Britain and the sunglasses L.A; London goes beyond denoting geographical origin.

- viii) The applicant is not aware of any use of the opponent's mark in the UK. Its website does not work, but the last time it was viewed it appeared to show boots and clothes for men designated as "Brazilian workwear".
- ix) The applicant's use relates to clothing for men, women and children which mostly embodies street art motifs and which are often individually commissioned. It is not accepted that the respective goods will be sold in the same stores.
- x) It is not accepted that the class 3 goods are similar to the class 25 goods and it asks the opponent to prove that its goods are sold in the same stores as class 3 goods.

6. The applicant is self-represented. The opponent is represented by Reddie & Grose LLP. Both sides filed evidence and submissions. Neither side asked for a hearing or filed written submissions in lieu of a hearing.

### **The evidence**

7. Rather than provide a self-standing evidence summary, I will, instead, refer to the evidence when it is relevant to the matters that need to be determined. For the record, those who have given evidence, and what, in summary, they give evidence about, are:

- For the opponent, Ms Justine Lynch, a "technical assistant" at Reddie & Grose. She gives evidence about the interplay between clothing and beauty brands. She also gives evidence about businesses and marks which contain a city name.
- For the applicant, Ms Natalie Gray, the applicant. As well as setting out some background she gives evidence of searches for marks containing WEST COAST LONDON on the USPTO database, and searches for that term on the Internet. She also gives evidence about her searches for marks containing WEST COAST (in class 25) on the website of the UK IPO.

8. Both sides also provided accompanying written submissions which I will bear in mind.

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

9. Section 5(2)(b) of the Act states that:

"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."

10. The following principles are gleaned from the judgments of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

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

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

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

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

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

11. I will focus initially on earlier mark 2607518 as if the opponent does not succeed with this mark then it is unlikely to be in any better position with regard to the other earlier mark given that the other earlier mark has an additional difference from the applied for marks (the additional letter W) and on account of the goods being narrower (and indeed is only relied upon to oppose the class 25 goods of the applicant).

### **Comparison of goods**

12. When making a comparison, all relevant factors relating to the goods/services in issue should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the Court of Justice of the European Union (“CJEU”) stated at paragraph 23 of its judgment:

“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. Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

“(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) 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;

(f) 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 terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or

relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v OHIM* Case T- 325/06 it was stated:

“It is true that goods are complementary if 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 (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 *P Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).”

15. In relation to complementarity, I also bear in mind the guidance given by Mr Daniel Alexander QC, sitting as the Appointed Person, in case B/L O/255/13 *LOVE* where he warned against applying too rigid a test:

“20. In my judgment, the reference to “legal definition” suggests almost that the guidance in *Boston* is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, 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. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to *Boston*.”

16. In relation to understanding what terms used in specifications mean/cover, the case-law informs me that “in construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of the trade”<sup>1</sup> and that I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning<sup>2</sup>. I also note the judgment of Mr Justice Floyd in *YouView TV Limited v Total Limited* where he stated:

“..... 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) (IPTRANSLATOR)* [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

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<sup>1</sup> See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

<sup>2</sup> See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

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.”

17. In relation to class 25, the applied for goods are:

Clothing, footwear, headgear; namely, shirts, pants, dresses, jackets, footwear, hats and caps, athletic footwear, beach footwear, flip flops, footwear, footwear for men and women and children, insoles for footwear, thong footwear, water repelling footwear, waterproof footwear

whereas the goods of the earlier mark are:

**Clothing, footwear, headgear**; Bath sandals; Beach shoes; Belts; Boots; Boots for sports; Boots (Heelpieces for); Boots (Welts for); Football boots; Football shoes; Footwear; Half-boots; Heelpieces for boots and shoes; Heels; Lace boots; Sandals; Shoes; Shoes (Welts for); Soles for footwear; Sports shoes; Studs for football boots

18. The terms I have emboldened above have a significant consequence. Even though the specification of the earlier mark goes on to list specific items of footwear, the existence of the broad term “clothing, footwear, headgear” means that the specification covers all items of clothing, footwear and headgear. As stated earlier in this decision, the earlier mark is not subject to the requirement to show genuine use and may be relied upon for all of the goods for which it is registered. The knock-on effect of this is that the applicant’s goods must be held to be identical because they are all items of clothing, footwear or headgear.

19. I note from the applicant’s counterstatement the point that Ms Gray sells clothing for men, women and children which mostly have street art motifs and which are often individually commissioned, whereas the opponent sells “Brazilian Workwear”. These points are re-enforced in the applicant’s submissions which make reference to her hand-painted and printed clothing compared to the opponent’s “inexpensive low-end goods”. The submission is made both in terms of the identification of the average consumer (which I will come on to) and the comparison of goods. Whilst noting the points, they are not, in my view, pertinent. Firstly, no evidence has been provided showing what the parties actually trade in. However, even if evidence had been provided it would still lack pertinence because matters must be determined on the basis of a notional comparison of the respective parties’ goods. As I have already stated, the opponent’s specification contains terms which cover all items of clothing, footwear and headgear with the consequence that the goods must be considered identical.

20. I next consider the goods applied for in class 3 which read:

Beauty products, namely cosmetics, eye makeup, lipstick, foundation, moisturizer, mascara, face packs, bubble bath, body wash, soap, nail care, nail polish, nail polish remover, hair care, shampoo, conditioner, hair styling spray, hair styling gel.



21. In its statement of case the opponent argues that such goods are similar to its class 25 clothing products because they are “sold in the same stores and via the same trading channels”.

22. The applicant does not accept that the goods are similar and it asked the opponent to provide evidence that its actual goods are sold in the same stores as beauty products. Whilst I note that the applicant denies similarity, I must observe that the request that the opponent prove that its actual goods are sold in the same stores as beauty products is not pertinent. The test, again, is not about actualities, but about similarity on a notional basis as I have attempted to explain above.

23. Nevertheless, the opponent has provided some evidence attempting to show a link between clothing and beauty products. The evidence comes from Ms Lynch. She explains that she conducted a Google search for “Clothing and beauty brands” and carried out research on the Internet looking at businesses of which she was aware which sell clothing and beauty products bearing the same mark and in the same retail store. Exhibit JL1 contains what Ms Lynch states are a selection of screenshots of websites of businesses which sell clothing, footwear and beauty products as part of its own range:

- i) The website of [superdry.com](http://superdry.com), showing a pair of boots and a “Bento Beauty Box”. The beauty box carries the Superdry branding. The prices are in £s.
- ii) The website of [victoriasecret.com](http://victoriasecret.com) showing a pair of skinny pants and a bottle of hair conditioner, both of which carry the Victoria’s Secret branding. This appears to be a US website on account of the use of terms such as “\$15 off \$100”.
- iii) The website of [hollisterco.com/shop/uk](http://hollisterco.com/shop/uk) which shows a Hollister branded t-shirt and some body lotion. The print is not particularly clear, but the body lotion appears to show the Hollister branding. The prices are in £s.
- iv) The website of [topshop.com](http://topshop.com) showing a Topshop branded t-shirt and a lipstick. The lipstick carries the word LIPS and the accompanying description the words “Lips in Inhibition”. It is not clear whether the product is Topshop branded. The prices are in £s.

24. Provided in Exhibit JL2 are prints obtained by Ms Lynch using Google Images showing the physical stores of the above websites. Ms Lynch states that she is personally aware that such businesses sell clothing and a range of beauty products all bearing the same mark. She adds that the beauty products are often sold near the tills. The images provided show:

- i) A Superdry store (location unknown) from which I can see various clothing products, but I can see no beauty products.
- ii) A Victoria’s Secrets store (location unknown) from which I can see various products, but I cannot clearly see what any of them are.

- iii) A Hollister store (location unknown) from which I can see various clothing products, but I can see no beauty products.
- iv) A Topshop Store (location unknown) from which I can see various products, but I cannot clearly see what any of them are.

25. Ms Lynch also makes reference to department stores (John Lewis, House of Fraser, Selfridges and Harvey Nichols) which sell both class 3 and class 25 goods, albeit, there is nothing to show that they have the same product branding. The opponent's supporting submission is that the evidence shows that it is commonplace for clothing brands to be used on cosmetics and beauty products. It is submitted that the respective users, trade channels and retail outlets will be the same.

26. The primary factors mentioned in the *Canon* case include the nature of the competing goods, the intended purpose, the method of use and whether they are in competition with each other or are complementary. In my view, the opponent fails on all these factors. The nature of the goods is, self-evidently, very different. Indeed, they are like chalk and cheese. The intended purpose is also different. Beauty products (and the like) are intended to be applied to the body or face to have a positive impact upon one's physical appearance, clothing, on the other hand, is to be worn on the body so as to clothe it. The opponent has not argued this point, but for the sake of clarity, any argument that both products enhance the physical appearance of a person would have been rejected as being an assessment at the wrong level of generality when the exact purpose of the goods is considered. The nature and intended purpose feed into the vastly different methods of use of the goods. The goods do not compete, one will hardly make a competitive choice between a beauty product and clothing given the differences in purpose I have identified. In terms of being complementary, this requires close connections such that the uses of the respective goods are important or indispensable for the use of the other. The use of one is neither important nor indispensable for the other, or vice versa. Whilst I am aware that items such as bags and footwear have been held to be complementary<sup>3</sup>, there is a closer link between such goods as they often form part of a co-ordinated look; the same does not apply to beauty products and clothing. There is no evidence to suggest that clothing and beauty products are matched in any way. I do not consider it significant that some businesses have sold beauty products and clothing under the same branding. First, the evidence provided on this is limited. Despite the opponent submitting that this is commonplace, only four examples are provided, one of which is from the US. Of those four it is not even clear if all of them carry the same branding. Even if they did, the evidence merely shows that a small number of clothing brands have expanded their range into certain beauty products – this, in and of itself, does not show that the goods are complementary or that they are similar more generally.

27. Other factors may also be considered in the assessment. The opponent points out that the users could be the same. I accept this, but given that the users are simply members of the general public, this point of similarity could apply to a huge

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<sup>3</sup> See *El Corte Inglés SA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (Case T-443/05)

variety of vastly different goods, and, so, this point has no material relevance. The opponent also highlights that the channels of trade and retail outlets may overlap. In this respect, the evidence from the websites of department stores is not helpful. By their very nature a department store will sell a whole host of products, many of which will be completely different from each other. That the competing goods are sold in different departments within a department store goes, in my view, against the opponent not for it. There is also the evidence of the four websites selling clothing and beauty products. However, the points I made earlier regarding the evidence also applies here – they do not show what generally occurs in the marketplace. It is also instructive to note that the images provided of the physical premises of these stores do not show the joint sale of the competing goods. Whilst I accept that there may be some instances where beauty products may be sold in a clothing store, I cannot hold that this is a common practice. Indeed, my own experience suggests that beauty products will normally be purchased in a specialist beauty care shop or from the beauty/cosmetic area of a larger retail store (such as a supermarket or a department store) whereas clothing is normally purchased from a specialist clothing store or from the clothing area of a larger retail store (or the online equivalents); furthermore, when it comes to areas within a larger store, there is nothing to suggest that those departments will necessarily be in close proximity to each other. I note that my views, certainly at least in relation to whether there exists a complementary relationship, accord with the judgment of the General Court in *Mühlens GmbH & Co KG v OHIM* Case T-150/04, where the comparison was between class 3 goods (albeit for perfumery and toiletries) and goods in classes 18 and 25 (bags and clothing); the court stated:

“34 In this regard, it is clear from Article 8(1)(b) of Regulation No 40/94 that a likelihood of confusion between two identical or similar marks can exist only within the limits of the principle of speciality, that is to say, where, as has been pointed out at paragraph 27, regardless of the distinctive character which the earlier mark enjoys as a result of the awareness which the relevant public may have of it, the goods or services at issue are identical or similar in the eyes of that relevant public.

35 Nevertheless, it cannot be ruled out, particularly in the fashion and body and facial care sectors, that goods whose nature, purpose and method of use are different, quite apart from being functionally complementary, may be aesthetically complementary in the eyes of the relevant public.

36 In order to give rise to a degree of similarity for the purposes of Article 8(1)(b) of Regulation No 40/94, this aesthetically complementary nature must involve a genuine aesthetic necessity, in that one product is indispensable or important for the use of the other and consumers consider it ordinary and natural to use these products together (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraphs 60 and 62).

37 However, the existence of an aesthetically complementary nature between the goods at issue, such as that referred to in the previous paragraph, is not enough to establish similarity between those goods. For that, the consumers must consider it normal that the goods are marketed under the same trade

mark, which normally implies that a large number of producers or distributors of these products are the same (*S/SSI ROSSI*, paragraph 63).

38 In the current proceedings, the applicant claims only that the public is accustomed to fashion industry products being marketed under perfume trade marks owing to the practice of granting licences. Yet, if proved, that point alone would not be sufficient to compensate for the absence of similarity between the goods at issue. Such a point does not, in particular, establish the existence of an aesthetically complementary connection between perfumery goods on the one hand and the leather goods and clothing, referred to at paragraph 3 above, on the other hand, so as to mean that one is indispensable or important for the use of the other and that consumers consider it ordinary and natural to use those goods together.

39 The applicant nevertheless claims that the goods at issue have in common their importance for a person's image and appear together in fashion magazines. In this respect, it should be pointed out that, apart from the fact that this argument, which was not pleaded in the hearings before OHIM, has been submitted out of time, the point does not suffice, in any event, to establish the existence of an aesthetically complementary nature, such as that referred to above in paragraph 36."

A similar point (albeit in relation to perfume) was also made in *Frag Comercio Internacional, SL, v OHIM*, Case T-162/08, in paragraph 30 of its judgment the General Court held that:

"Secondly, the Board of Appeal did not err in finding, in paragraph 20 of the contested decision, that the goods in Classes 18 and 25 covered by the earlier Community mark were not complementary in relation to the 'perfumery' in Class 3 covered by the mark applied for. In that regard, the Court has held previously that perfumery goods and leather goods in Class 18 cannot be considered similar. Perfumery goods and leather goods are plainly different as regards both their nature and their intended purpose or their method of use. Moreover, there is nothing that enables them to be regarded as in competition with each other or functionally complementary. The same conclusion must be drawn concerning a comparison between perfumery goods and clothing in Class 25. Those goods, as of themselves, also differ as regards both their nature and their intended purpose or their method of use. There is nothing, either, that enables them to be regarded as in competition with each other or complementary (Case T-150/04 *Mülhens v OHIM – Minoronzoni (TOSCA BLU)* [2007] ECR II-2353, paragraphs 31 and 32)."

28. In summary, although the applied for goods in class 25 are identical to the goods of the earlier mark, the applied for goods in class 3 are not similar to the goods of the earlier mark. The consequence of my finding in relation to class 3 is that there can be no likelihood of confusion in respect of those goods because some similarity between the goods is a pre-requisite (see, for example, *Waterford Wedgwood plc v OHIM – C-398/07 P (CJEU)*).

## Average consumer and the purchasing act

29. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

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

30. Where the goods conflict, they conflict in relation to clothing products. Such goods are “consumed” by members of the general public. The goods may be tried on and are likely to be inspected for colour, size, style, fitness for purpose etc. All of this increases the potential exposure to the trade mark. That being said, the purchase is unlikely to be a highly considered process as clothing is purchased relatively frequently and, although cost can vary, it is not, generally speaking, a highly expensive purchase. In terms of how the goods will be selected, this will normally be via self-selection from a rail or shelf (or the online equivalents) or perhaps chosen from catalogues/brochures. This suggests a process of mainly visual selection, a view which has been expressed in previous cases<sup>4</sup>.

31. Much of the applicant’s submissions focus on the differences between the parties’ target markets. However, for the reasons already given (see, for example, paragraph 19), this is not pertinent. The matter must be assessed on a notional basis. As the goods are identical on a notional basis, so too must the average consumer.

## 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:

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<sup>4</sup> See, for example, *New Look Ltd v OHIM* – Joined cases T-117/03 to T-119/03 and T-171/03 (GC)

“.....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. The marks to be compared are:

Applicant's marks	Opponent's mark
	<p data-bbox="820 730 1391 792"><b><i>WEST COAST</i></b></p>

34. In terms of the overall impression of the opponent's mark, this consists of the words WEST COAST in a slightly stylised script. The applicant has made much of the “image” and font used, so as to draw a distinction with her mark. However, my view is that the stylisation is fairly unremarkable with the consequence that the overall impression is very strongly dominated by the words themselves, the stylisation playing only a very minor role in the overall impression.

35. In terms of the overall impression of the applicant's marks, they both consist of two primary components, the stylised device of a lion on the left hand side, with the stylised words WEST COAST LONDON (the words represented one above the other) on the right hand side. In my view, the device and the words make a roughly equal contribution to the overall impression of the mark, with neither dominating the other. In terms of the words, the stylisation is somewhat stronger than the stylisation in the earlier mark, but it is still the words that play the more important role. For reasons that I come on to in the next paragraph, the words WEST COAST form a unit in themselves and play a more important role than the word LONDON.

36. Conceptually speaking, the earlier mark forms a unit which signifies the western coast of a particular area of land. Some may see it as a reference to the west coast of the USA, others just as a west coast more generally. In terms of the applicant's marks, two concepts will be packed away by the average consumer. One will be of a lion, the other of a western coast. Although the word LONDON also appears, this will have less significance in the conceptual analysis because London does not have a coast (let alone a western one), so the message the consumer will see in the word

element will be based upon WEST COAST as a unit, with LONDON merely signifying the origin of the goods or the designer creating them<sup>5</sup>. I reject the submission that the concept of the applied for marks creates an image of an interplay of differing cultures, such a message is too subtle for the average consumer to appreciate. The concept based on the lion creates a difference. However, the concept of WEST COAST creates a similarity. I conclude that there is a medium level of conceptual similarity.

37. Visually, that both marks contain the words WEST COAST is a clear point of similarity. There are, though, some differences, notably the lion device, but also the addition/absence of the word LONDON and the difference in stylisation. Overall, I come to the view that there is a medium level of visual similarity.

38. From an aural perspective, the earlier mark will be articulated as WEST-COAST. In terms of the applicant's mark, I do not consider that the device element will be articulated. In terms of its verbal elements, although there is potential for them to be shortened to WEST COAST alone, the fact remains that LONDON does form part of the mark. It will therefore most likely be articulated as WEST-COAST-LON-DON. I consider this to equate to a reasonably high (but not the highest) level of aural similarity.

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

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *WindsurfingChiemsee 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

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<sup>5</sup> There are a number of examples of brands using geographical indicators alongside brand names in the evidence, something which I would have accepted on the basis of judicial notice anyway.

chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

40. There is no evidence showing what, if any, use has been made of the earlier mark, so I have only its inherent characteristics to consider. From that perspective, the words WEST COAST combine to create a meaningful phrase as described earlier. Nevertheless, I see no reason to accord a low degree of distinctiveness. In terms of the capacity of the mark to be seen as referencing geographical origin, WEST COAST is fairly opaque as the west coast of what is not specified. In her submissions and evidence the applicant refers to various other WEST COAST marks that stand on the UK or CTM registers. Whilst put forward as examples of “multiple coexisting third party registrations”, part of the submission appears to go to the issue of distinctiveness. In her submissions the applicant states:

“It is apparent here, that the West Coast portion of the mark is not a unique identifier for clothing. Additional elements of the mark must be used by the relevant public to determine the source of the goods. Based on the multiple registrations of these co-existing marks, it is clear that UKIPO has created a history for allowing marks with geographically descriptive elements to exist where other elements or commercial impressions allow the consumer to determine the origin of the goods or services. Thus, there should be no reason for refusing Applicant’s mark to be registered.”

and

“Where there is common matter to separate marks, the relevant public will not perceive the common matter as distinguishing source because it is merely descriptive or diluted.

41. In view of the above, and despite the applicant not expressly stating that the distinctiveness of the earlier mark is weakened by the existence of various WEST COAST marks, I will take the submission as one to that effect.

42. In relation to what is often called “state of the register” evidence, I note that in *Henkel KGaA v Deutsches Patent- und Markenamt*, Case C-218/01, the CJEU found that:

“65... The fact that an identical trade mark has been registered in one Member State as a mark for identical goods or services may be taken into consideration by the competent authority of another Member State among all the circumstances which that authority must take into account in assessing the distinctive character of a trade mark, but it is not decisive regarding the latter’s decision to grant or refuse registration of a trade mark.

On the other hand, the fact that a trade mark has been registered in one Member State for certain goods or services can have no bearing on the examination by the competent trade mark registration authority of another Member State of the distinctive character of a similar trade mark for goods or services similar to those for which the first trade mark was registered.”



43. Also, in *Zero Industry Srl v OHIM*, Case T-400/06, the General Court stated that:

“73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word ‘zero’, it should be pointed out that the Opposition Division found, in that regard, that ‘... there are no indications as to how many of such trade marks are effectively used in the market’. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word ‘zero’ is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T-135/04 GfK v OHIM – BUS(Online Bus) [2005] ECR II-4865, paragraph 68, and Case T-29/04 Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH) [2005] ECR II-5309, paragraph 71).”

44. Such cases follow a well trodden path which was aptly summarised by Jacob J in *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 281 where he stated:

“In particular the state of the register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led to the Registrar to put the marks concerned on the Register. It has long been held that under the old Act that comparison with other marks on the Register is in principle irrelevant when considering a particular mark tendered for registration, see e.g. *MADAME Trade Mark* (1966 RPC 541) and the same must be true of the 1994 Act. I disregard the state of the register evidence.”

45. The applicant highlights the existence of 10 third party marks (in class 25) which contain the words WEST COAST, however, two of them are the opponent’s earlier marks. The other eight are:

i) CTM 4256996, an expired mark consisting of:



ii) CTM 4500971, a registration consisting of:



iii) CTM 4510418, a registration consisting of: Westcoast Customs.

iv) CTM 4738051<sup>6</sup>, a registration consisting of WESTCOAST.

<sup>6</sup> In the submissions, the number was erroneously given as 4510418, but from the information given in the counterstatement I was able to identify the correct number.



- v) CTM 7598791, a registration consisting of: **WEST COAST PIT BULL** .
- vi) CTM 11450657, a registration consisting of WEST COAST CHOPPERS.
- vii) CRM 13637525, a registration consisting of WEST COAST SUPPLY GROUP.



- vii) UK registration 2128996 consisting of .

46. The primary point to make in relation to the above marks is that there is no evidence to show that any of them have been, or are currently being, used in the marketplace. Therefore, what impact they have made on the average consumer is not known. The difficulty with the applicant's position can be further exemplified by highlighting the fact that all but one of the above marks are CTMs. Therefore, even if it were accepted (which for sake of clarity I do not) that the existence of the marks on their respective registers should be taken as a good indication that they have been used, it would be a considerable step too far to go on to accept that the CTMs have been used in the UK. I come to the very clear view that the third party marks have no impact on the assessment of the distinctive character of the earlier mark and, for sake of completeness, I should add that the existence of the third party marks have no impact on the capacity of the average consumer to differentiate between various WEST COAST marks.

47. Whilst not altogether clear, the applicant may be under the misapprehension that the registering authorities have in some way tolerated the registration (and use) of various WEST COAST marks. This is not the case. Neither the UK IPO nor the office that administers the CTM system, raise objections on the basis of earlier marks. Objections can only be raised by the owners of earlier marks in opposition or invalidation proceedings, as is the case here. Even if the owners of the third party marks have not taken action against each other, this would tell me little.

48. Based on my assessment of the inherent characteristics of the earlier mark, and the lack or pertinence of the evidence, I conclude that the earlier mark is one of an average or normal level of inherent distinctive character.

### **Likelihood of confusion**

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

50. In her written submissions the applicant submits that co-existence without actual confusion can be persuasive of an absence of a likelihood of confusion. It is stated (in submissions not evidence) that the applicant has been using its marks since as early as 10 October 2013 and she is not aware of any confusion. Whilst I do not necessarily disagree with the underlying point being made (although some caution must be exercised because an absence of confusion is often indicative of little<sup>7</sup>) the problem with the submission is that there is no evidence of the marks co-existing. Thus, no opportunity for confusion has so far been shown to have arisen.

51. In terms of whether there exists a likelihood of confusion, the applicant points, for obvious reasons, to the differences between the marks including the lion device. I agree that the lion is a striking image and I have already stated that it plays an equal role in the overall impression of the mark. Even bearing in mind the principle of imperfect recollection, I doubt that the average consumer will forget or not notice the device element in the applicant's mark. Given this, I do not consider it likely that the average consumer will directly mistake one mark for the other. Therefore, if there is to be a positive finding under section 5(2)(b), it will be on the basis of indirect confusion. Indirect confusion was dealt with by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10 where he noted that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

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<sup>7</sup> For example, In *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283 Millett L.J. stated that: “Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff's registered trade mark.”

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

52. Of course, I bear in mind that the three categories of indirect confusion identified by Mr Purvis QC are just illustrative – he stated that indirect confusion “tends” to fall in one of them. I think it also useful to highlight the guidance in relation to composite trade marks (of which the applicant’s mark is an example). In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. considered the impact of the CJEU’s judgment in *Bimbo*, Case C-591/12P, on the court’s earlier judgment in *Medion v Thomson*:

“18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

53. I have already commented on the third party marks; they do not assist the applicant. The opponent’s mark is WEST COAST with the stylisation playing only a minimal role in its overall impression. The applicant’s mark contains the words WEST COAST which forms a unit in the same way as those words in the earlier mark. As I have already stated, the inclusion of the word LONDON in the applicant’s mark does not form part of the WEST COAST unit but, instead, is more likely to be

seen as the place of origin of the goods or the designer. Consequently, the word LONDON does little to distinguish the marks in a trade origin sense. Whilst the device element in the applied for mark is striking (and indeed has prevented a finding of direct confusion), it does not dominate the mark; the finding I made earlier was that the device element and the verbal element play roughly equal roles. Bearing all this in mind, I come to the view that the inclusion of WEST COAST in the applicant's mark will indicate the brand name of the economic provider of those goods. It therefore has distinctive significance independent of the whole. Even though there is more to the applicant's mark, I consider it likely that the average consumer, when encountering the mark for the identical goods in play, will put the commonality of the words WEST COAST in the respective marks, despite the differences that also exist, down to the economic origin of the goods being the same (or related). My finding is that there is a likelihood of indirect confusion. The opposition succeeds in class 25.

### **Conclusion**

54. Given the findings I have made, the opposition succeeds in class 25 but fails in class 3. Therefore, subject to appeal, the application may proceed to registration in class 3 only.

### **Costs**

55. Given the roughly equal measure of success, neither party is to be favoured with an award of costs.

**Dated this 15<sup>TH</sup> day of January 2016**

**Oliver Morris  
For the Registrar,  
The Comptroller-General**