

**O-184-16**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3118313  
BY VROOM BY THE SEA LIMITED**

**TO REGISTER THE TRADE MARK:**



**IN CLASSES 9, 18, 25 AND 35**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 60000345  
BY ZIYLAN MAGAZACILIK VE PAZARLAMA ANONIM SIRKETI**

## **BACKGROUND**

1. On 17 July 2015 Vroom By The Sea Limited (“the applicant”) applied to register the mark shown on the cover page of this decision in respect of the following goods and services:

### **Class 9**

*Cases and bags adapted for portable computers, laptops, hand-held computers, computer tablets and mobile phones; holdalls for computers and laptops; computer bags and cases; laptop bags and cases; bags and cases adapted or shaped to contain hand held computers, tablet computers, personal digital assistants, global positioning system (GPS) devices, electronic organizers, electronic notepads and MP3 players; sleeves for portable computers, laptops, hand-held computers, computer tablets, personal digital assistants, global positioning system (GPS) devices, electronic organizers, electronic notepads, MP3 players and mobile phones; covers for computer tablets and mobile telephones; mobile telephone cases; purses for mobile telephones; bags and cases adapted or shaped to contain cameras and video cameras.*

### **Class 18**

*Luggage; wheeled luggage; trunks, travel bags; travel bags of leather, cotton, canvas and synthetic materials; travelling bags; suitcases; carrying cases; valises; bags; bags, carriers and holdalls of leather, cotton, canvas, jute, synthetic and imitation materials; sports bags; athletic bags; gym bags; holdalls; rucksacks; knapsacks; haversacks; backpacks; camping bags; duffle bags; courier bags; satchels; shoulder bags; waist-bags; kit bags; beach bags; garment bags; suit bags; boot bags; shoe bags; shopping bags; wheeled shopping bags; boxes of leather; handbags; clutch bags; purses; pouches; wallets; card wallets and cases; key cases; key purses; vanity cases; beauty cases; washbags; toiletry bags; cosmetic bags; briefcases; attaché cases; work bags; portfolios; portfolio cases; leather portfolios; document wallets; notecases; saddle bags; tool bags (empty); tool bags (empty) for motorcycles; saddle belts; shoulder belts; all-purpose leather and imitation leather straps; straps for luggage; luggage straps; bands of leather and imitation leather; harness straps; umbrellas, parasols; walking sticks.*

### **Class 25**

*Articles of clothing for men, women and children; footwear, headgear; belts; neckwear.*

### **Class 35**

*Retail services, including retail services provided via the internet, via mail order, or via the telephone, connected with luggage, wheeled luggage, trunks, travel bags, travel bags of leather, cotton, canvas and synthetic materials, travelling bags, suitcases, carrying cases, valises, bags, bags, carriers and holdalls of leather, cotton, canvas, jute, synthetic and imitation materials, sports bags, athletic bags, gym bags, holdalls, rucksacks, knapsacks, haversacks, backpacks, camping bags, duffle bags, courier bags, satchels, shoulder bags, waist-bags, kit bags, beach bags, garment bags, suit bags,*

*boot bags, shoe bags, shopping bags, wheeled shopping bags, boxes of leather, handbags, clutch bags, purses, pouches, wallets, card wallets and cases, key cases, key purses, vanity cases, beauty cases, washbags, toiletry bags, cosmetic bags, briefcases, attaché cases, work bags, portfolios, portfolio cases, leather portfolios, document wallets, notecases, saddle bags, tool bags (empty), tool bags (empty) for motorcycles, saddle belts, shoulder belts, all-purpose leather and imitation leather straps, straps for luggage, luggage straps, bands of leather and imitation leather, harness straps, umbrellas, parasols, walking sticks, clothing, footwear, headgear, belts, neckwear, cases and bags adapted for portable computers, laptops, hand-held computers, computer tablets and mobile phones, holdalls for computers and laptops, computer bags and cases, laptop bags and cases, bags and cases adapted or shaped to contain hand held computers, tablet computers, personal digital assistants, global positioning system (GPS) devices, electronic organizers, electronic notepads and MP3 players, sleeves for portable computers, laptops, hand-held computers, computer tablets, personal digital assistants, global positioning system (GPS) devices, electronic organizers, electronic notepads, MP3 players and mobile phones, covers for computer tablets and mobile telephones, mobile telephone cases, purses for mobile telephones, bags and cases adapted or shaped to contain cameras and/or video cameras.*

2. The application was published for opposition purposes on 31 July 2015, following which Ziylan Magazacilik ve Pazarlama Anonim Sirketi (“the opponent”) filed notice of opposition under the fast track opposition procedure.

3. The opposition is based on Section 5(2)(b) of the Trade Marks Act 1994 (the Act) and is directed against all of the goods and services in the application.

4. The opponent relies upon the International Trade Mark registration no. 1184716

for the mark  **LUMBERJACK** which has an international registration date/date of designation of the EU of 27 June 2013 and was granted protection in the EU on 14 October 2014, for the following goods and services:

**Class 18**

*Leather and imitations of leather, goods made of these materials and not included in other classes, bags, leather and stout leather boxes; animal skins, processed hides or rawhide; trunks and traveling bags; umbrellas and parasols; walking sticks; whips, harness and saddlery.*

**Class 25**

*Clothing, socks, footwear and headgear.*

**Class 35**

*Advertising, business management, business administration, office functions; bringing together for the benefit of others of a variety of goods especially leather and leather and imitations of leather, goods made of these materials, bags, leather and stout leather boxes, animal skins, processes hides or rawhide, trunks and traveling bags, umbrellas and parasols, walking sticks,*

*whips, harness and saddlery, clothing, socks, footwear and headgear, enabling customers to conveniently view and purchase those goods, such services may be provided by retail stores, wholesale outlets, through mail order catalogues or by means of electronic media for example through websites or television shopping programmes.*

5. The case details for this mark include the following text “*Trade mark type: Mark consists of colour or colours per se*”, however, the mark is not a colour mark per se since it consists of a device and a word element. Although what was actually intended is unclear, it will not affect the outcome of these proceedings, as I will explain later in my decision.

6. The opponent argues that all the goods and services claimed by the applicant are identical or similar to those covered by the earlier mark, and that the marks are similar. The applicant filed a counterstatement in which it denied the basis of the opposition.

7. Rules 20(1)-(3) of the Trade Marks Rules (TMR) (the provisions which provide for the filing of evidence) do not apply to fast track oppositions, but Rule 20(4) does. It reads:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

8. The net effect of the above is to require parties to seek leave in order to file evidence (other than the proof of use evidence which is filed with the notice of opposition) in fast track oppositions.

9. No leave was sought in respect of these proceedings.

10. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if 1) the Office requests it or 2) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost. Otherwise written arguments will be taken.

11. A hearing was neither requested nor considered necessary. Both parties filed written submissions which I will refer to as necessary, below.

## **DECISION**

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

“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”.

13. An earlier trade mark is defined in Section 6 of the Act, which states:

“6.-(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.

[...]

(2) Reference in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

14. Given its date of filing, the opponent’s mark is an earlier mark in accordance with Section 6 of the Act. The earlier mark had not been registered for more than five years at the date on which the applicant’s mark was published meaning that the proof of use provisions contained in Section 6A do not apply. The opponent can, as a consequence, rely upon its full specification as registered for its earlier mark in these proceedings.

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

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

### **The principles**

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

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

16. Some of the contested goods and services, e.g. *footwear and headgear*, are identical to the goods and services on which the opposition is based. For reasons of procedural economy, I will not undertake a full comparison of the goods and services listed above. The examination of the opposition will proceed on the basis that the contested goods and services are identical to those covered by the earlier mark. If the opposition fails, even where the goods and services are identical, it follows that the opposition will also fail where the goods and services are only similar.

### **The average consumer and the nature of the purchasing act**

17. As the case law above indicates, it is necessary for me to determine who the average consumer is for the goods and services at issue; I must then determine the manner in which these goods and services will be selected in the course of trade.

18. 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.”

19. The average consumer of the parties’ goods and (retail) services is the public at large, though in relation to some of the class 35 services, i.e. *advertising, business management, business administration, office functions*, I would expect these to be aimed principally at professionals in a business context.

20. In *New Look Ltd v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03 the General Court (GC) said in relation to the selection of clothing:

“43. It should be noted in this regard that the average consumer’s level of attention may vary according to the category of goods or services in question (see, by analogy, Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 26). As OHIM rightly pointed out, an applicant cannot simply assert that in a particular sector the consumer is particularly attentive to trade marks without supporting that claim with facts or evidence. As regards the clothing sector, the Court finds that it comprises goods which vary widely in quality and price. Whilst it is possible that the consumer is more attentive to the choice of mark where he or she buys a particularly expensive item of clothing, such an approach on the part of the consumer cannot be presumed without evidence with regard to all goods in that sector. It follows that that argument must be rejected.

And

“50.....The applicant has not mentioned any particular conditions under which the goods are marketed. Generally in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly the visual aspect plays a greater role in the global assessment of the likelihood of confusion.”

21. In relation to the parties’ goods in classes 9, 18 and 25, the goods may be purchased on the high street, online or by mail order, indicating that visual considerations are likely to dominate the selection process. The level of attention paid will be no more than average; the consumer will pay the attention necessary to obtain, inter alia, the correct size, colour and material (in relation to the goods in class 18 and 25) and to ensure compatibility (in relation to the goods in class 9, which are all cases and bags for electrical devices).

22. The parties' retail services include the retail of the aforementioned goods in classes 9, 18 and 25. Accordingly, the purchase is likely to be primarily visual as the average consumer will select the services having encountered the marks on, for example, signage in the high street, advertisements in catalogues and on the Internet. Again, the level of attention paid when selecting the services will be no more than average.

23. In relation to the opponent's services directed at business users, I also consider that the services are likely to be sought following visual perusal from, for example, brochures and the like (in hard copy and online). As the purchaser will select the services to fit the needs of their business, the level of care and attention paid will be above average but not high.

24. In relation to all the goods and services at issue, aural considerations will also form (albeit to a lower degree) part of the purchasing process, i.e. interactions with sales assistants, orders placed by telephone and word of mouth recommendations.

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

25. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the Court of Justice of the European Union (CJEU) stated at paragraphs 22 and 23 that:

“In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

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).”

26. These are fast track opposition proceedings in which it was not necessary for the opponent to provide any evidence of the use it may have made of its earlier mark, thus, I have only the inherent characteristics to consider.

27. Both parties made submissions on the distinctive character of the earlier mark. In that regard the opponent took what I consider to be a contradictory position. In its



Statement of Grounds (SOG) the opponent submitted that upon seeing 'lumber' in the applied for mark, the average consumer will think "of a lumberjack". It stated:

"12. In respect of the device elements of the marks and the element 'LUMBER', the marks have a similar semantic content. The relevant public will understand 'LUMBER' as a reference to timber, fortified by the images of a tree and a leaf. A lumberjack is a person who fells trees; a logger. The contested mark would cause the relevant public to associate it with 'lumberjack' given that 'timber' is more commonly used than 'lumber' in the United Kingdom. Upon seeing 'lumber', the relevant public would think of a 'lumberjack'."

28. Contrary to the above assertion, in its written submissions, the opponent rejected the applicant's claim that the meaning of 'LUMBERJACK' "would be widely known by the relevant public" and that the earlier mark is descriptive or allusive to the extent that the word 'LUMBERJACK' "is used in relation to a style of shirts, coats, as well as a style of boot (sic)". It stated:

"4. In respect to paragraph 3 of the Counterstatement, it is denied that "LUMBERJACK" would be widely recognised by the relevant public as having a precise meaning. It is submitted:

- a. The alleged association between the word "LUMBERJACK" and the Opponent's goods in the mind of the public is mere supposition;
- b. The Applicant has not demonstrated that the public is accustomed to "LUMBERJACK" to support its claim that is low in distinctive character;
- c. The assessment of the inherent distinctiveness of the earlier mark must be carried out with respect to the goods and services in conflict. The Applicant makes no reference to any goods when alleging low distinctive character other than *shirts, coats and boots* in paragraph 9 of its Counterstatement;
- d. The earlier mark has a presumption of validity".

29. At the same time, the opponent also stated that it "maintains its assertions provided in the [SOG] and repeats them herein". In particular, it referred to the aforementioned paragraph 12 twice; it stated:

"3. Paragraph 2 of the Applicant's Counterstatement is denied; the marks are visually, phonetically and conceptually similar. Paragraphs 11-13 SOG, are repeated".

[...]

5. The Opponent denies that the marks are, from a visual perspective, substantially differentiated as claimed in paragraph 4 in the Counterstatement; the marks consist of one word and a device element. The verbal element of the marks, "LUMBERJACK" and "LUMBERJUICE", are of similar length and coincide in the first seven letters: L-U-M-B-E-R-J, giving rise to a high degree of visual similarity. The overall similarity is reinforced by the presence of a tree/leaf in the marks respectively; paragraphs 11-13 SOG are repeated".

30. The opponent's arguments cannot be reconciled. It states at one moment that the average consumer will understand 'lumber' in both marks as a reference to

timber and that upon seeing the applied for mark, the average consumer will think “of a ‘lumberjack’”. However, this did not prevent the opponent from arguing that the meaning of the word ‘LUMBERJACK’ would be unknown to the average consumer in the UK. Such an argument was only advanced by the opponent in its written submissions, in response to the applicant’s claim that the word ‘LUMBERJACK’ might have descriptive connotations in relation to some of the goods covered by the earlier mark, i.e. shirts, coats and boots; a factor which, in turn, would result in the opponent’s mark having a low distinctive character in relation to such goods.

31. I do not consider the opponent’s second argument, i.e. that the meaning of the word ‘LUMBERJACK’ would be unknown to the average consumer in the UK, to be well-founded. In reaching a conclusion on this point, I have reminded myself of the comments of the Appointed Person in *Cherokee* (BL-O/048/08). In my view, the word ‘LUMBERJACK’ is in common parlance in the UK and it is used customarily as a synonym for a logger or a man who cuts trees. Whilst no evidence has been filed on how pervasive the use of the word ‘LUMBERJACK’ is in the UK, I am satisfied that my own state of knowledge is likely to accord with that of the average consumer of the parties’ goods and services.

32. As I have mentioned in the preceding paragraph, in its counterstatement the applicant claimed that the word ‘LUMBERJACK’ has descriptive or allusive connotations to the extent that it is associated with a style of shirt, coat and boots; in its written submissions it further submitted that the earlier mark has a low distinctive character not only in relation to clothing and footwear but also for the retail services related to the sale of these goods. Again, no evidence has been filed that the word ‘LUMBERJACK’ has any descriptive significance to the average consumer of these goods and services and I am not satisfied that, in the experience of the average consumer, the use of the word ‘LUMBERJACK’, in relation to shirts, coats and boots will be seen as a direct reference to a characteristic or quality of the goods (or indeed of the retail services related to the sale of these goods).

33. Whilst the device element, which is likely to be construed as the top half of a maple leaf, adds some distinctiveness to the mark as a whole, this added distinctiveness does not impact on the likelihood of confusion because it is the distinctiveness of the common element that is the key<sup>1</sup>. Approaching the opponent’s mark with the above in mind, I conclude that the earlier mark is possessed of an average degree of distinctive character for all the goods and services covered by the specification, in relation to which is neither descriptive nor non-distinctive.

### **Comparison of marks**

34. 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 them, 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>1</sup> *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, paragraph 39-40

“.....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.”

35. It would be wrong, therefore, artificially to dissect the 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.

36. The respective marks are shown below:

| Applicant's mark   | Opponent's mark  |
|--|--|
|  |  |

### Overall impression

37. Both marks consist of a device and a word element. Both parties submitted that the word element is the dominant feature of both marks; the opponent also submitted the alternative position that neither element can be said to be dominant over the other.

38. Dealing firstly with the applied for mark, it comprises a device consisting of two black overlapping triangles within which is placed a white Y shaped element, whose upper portion is incorporated in a stylised geometrical form. This device is likely to be construed as the silhouette of a mountain range in the background with a tree in the foreground and occupies the top half of the mark. Below it, is the word 'LUMBERJUICE' which occupies the bottom half of the mark; this is presented in a variety of upper and lower case letters, all of which are presented in the same size and in a slightly stylised font; for ease of reference I will refer to it hereafter as 'LUMBERJUICE'. Although the word 'LUMBERJUICE' conjoins two dictionary words, i.e. 'LUMBER' and 'JUICE', as I will explain below, these elements are combined to form one new word. In my view, given the size and positioning of the device, both the figurative and the word elements contribute in roughly equal measure to the overall impression created by the applied for mark.

39. Turning to the opponent's mark, it comprises a device which I have described as the top half of a maple leaf. The leaf is split into two parts: the first half, in white, is incorporated into a green quadrilateral-shaped background and the second half, in orange, is placed against a white background. This makes up approximately the first

quarter of the mark and it is followed by the word 'LUMBERJACK' presented in upper case and in a slightly stylised font. Despite the positioning of the device as the first element of the mark, its size in relation to the word element results in the word 'LUMBERJACK' having the greatest relative weight in the overall impression the mark conveys.

### **Visual similarity**

40. The opponent argues that the visual and phonetic similarity between the competing marks is accentuated by the position of the common element i.e. 'LUMBER' at the beginning of the word elements of the competing marks. Whilst there is a general rule, clear from decisions such as joined cases T-183/02 and T-184/027<sup>2</sup>, that the first parts of words (and consequently, first words of marks) catch the attention of consumers, it is also clear that each case must be decided on its merits considering the marks as wholes.

41. The marks have some degree of visual similarity, due to the fact that they coincide in the prefix 'LUMBER' followed by the letter 'J' which is placed at the beginning of the two word elements in both marks. As the concept of fair and notional use would allow either word to be used in upper or lower case, it matters not the difference in casing. The marks differ in the suffix elements, 'JACK' and 'JUICE' respectively, which, as I have said, share only the first letter 'J'. When reading a word, it is natural to start from the beginning; however, the difference in the endings of the word elements of the marks are readily discernable to the eye. In my view, the identity of the prefix 'LUMBER' does not draw the attention away from the differences between the endings 'JACK' and 'JUICE'.

42. In addition to this dissimilarity, there are significant differences resulting from the size and the positioning of the figurative elements of the marks, which cannot be said to be negligible. Although the earlier mark is presented in the colours green, orange and white, I bear in mind that notional and fair use of the applied for mark can include its representation in a variety of colours (including those in the earlier mark) thus, the colour difference is not material to the comparison and does not assist the applicant. Having regard to the similarities and differences, I consider there to be a low to medium degree of visual similarity.

### **Aural similarity**

43. It is well established that when a mark consists of a combination of words and figurative elements, it is by the word elements that the mark is most likely to be referred. Aurally, the pronunciation of both marks is entirely predictable. Whilst the beginning of the marks 'LUMBER' will be pronounced in an identical way giving rise to a phonetic similarity, the endings of the marks will create different sounds. Here, both endings have the letter 'J' but then the letters 'ACK', in the opponent's mark, will be pronounced as quite a hard sound whilst the letters 'UICE' in the applied for mark will bring a softer ending. In my view, the marks have a medium degree of aural similarity.

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<sup>2</sup> *El Corte Inglés v OHIM – González Cabello and Iberia Líneas Aéreas de España (MUNDICOR)* [2004] ECR II – 965, paragraph 81

## **Conceptual similarity**

44. I have already, to some extent, dealt with the conceptual aspect of the opponent's mark in the preceding paragraphs. In that respect, the word 'LUMBERJACK' in the opponent's mark will be understood as a word having a specific meaning, i.e. a man who cuts trees. The device element will reinforce this message by creating an association with the idea of leaves and trees. Further, I consider that the stylised representation of a maple leaf is likely to create an association with Canada (given that the average consumer will be aware that the maple leaf is a widely recognised symbol of Canada).

45. Insofar as the applied for mark is concerned, whereas the device element will convey the concept of a natural landscape, i.e. a mountain range and a tree, the word 'LUMBERJUICE' will not convey any clear message. Whilst it conjoins two dictionary words, i.e. 'LUMBER' and 'JUICE', it is presented as an invented word.

46. The opponent states that the average consumer will recognise the word 'lumber' in both marks as a synonym for timber (which is the term more commonly used in the UK). Whilst it is necessary to be mindful of how marks are made up, consumers do not normally approach marks in a spirit of analysis and are not prone to dissecting marks; it is the totality of the mark that will impress itself in the mind of the average consumer. Conceptually, it is the overall impression created by the word 'LUMBERJUICE' rather than the meaning of its components that will make an impact on the average consumer. It follows that the average consumer will perceive the applied for mark in its totality and will see the word 'LUMBERJUICE' as an invented word, with no meaning and neutral in the concept it conveys. On that basis, I conclude that there is no conceptual similarity. Insofar as the figurative elements of the marks are concerned they represent similar elements, i.e. a tree and a leaf, but other than that very high level of generality I can see no other point of conceptual similarity. If there is any conceptual similarity created by the figurative elements of the marks, it is at a very low level.

## **Likelihood of confusion**

47. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has retained in his mind. Earlier in this decision I have concluded that:

- For reasons of procedural economy I have proceeded on the basis (most favourable to the opponent), that the competing goods and services are identical;
- the average consumer of the parties' goods and services is a member of the general public or a business user who will select them by predominately visual

means although I do not discount aural considerations. The level of attention paid will range from no more than average to above average;

- the average consumer will understand the meaning of the word 'LUMBERJACK' in the opponent's mark as a synonym of 'a man who cut trees'. The earlier mark is possessed of an average degree of distinctive character in relation to all the goods and services covered by the specification for which is neither descriptive nor non- distinctive;
- the competing marks are visually similar to a low to medium degree, aurally similar to a medium degree and, at best, conceptually similar to a low degree; any conceptual similarity stemming from the device elements of the marks insofar as they represent similar natural elements, i.e. a tree and a leaf;
- the average consumer is likely to recognise that the applied for mark conjoins the word 'LUMBER' and 'JUICE' but will perceive the applied for mark 'LUMBERJUICE' in its totality and it will treat it as an invented word with no meaning.

48. In reaching a conclusion, I bear in mind the decision of the CJEU in *The Picasso Estate v OHIM*, Case C-361/04 P, where it found that:

"20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law."

49. Taking all the above factors into consideration, given the overall presentation of the respective marks and, in particular, the visual differences, I am satisfied, there is no likelihood of direct confusion in the sense that the average consumer will not mistake one mark for another. This leaves indirect confusion to be considered. This distinction was summed up by Mr Iain Purvis Q.C. sitting as the Appointed Person in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

"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.).

(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).”

50. On the basis of my findings, I have come to the view that there is no likelihood of indirect confusion as to the trade origin, even allowing for the fact that the marks may be used on identical goods and services and that the average consumer will pay a no more than average degree of attention for certain goods and services. Where the level of attention is higher, it will, of course, help consumers to even better distinguish between the marks and in doing so, it will militate against a likelihood of confusion. In the present case, the average consumer in the UK who is familiar with the opponent’s mark, upon encountering the applied for mark will not embark on an artificial dissection so as to focus on the identity of the shared element, i.e. ‘LUMBER’, ignoring the other elements of the marks. Both marks will be perceived in their totality; the clear conceptual message sent by the opponent’s mark combined with the perception of ‘LUMBERJUICE’ in the applied for mark as an invented word, will not cause the consumer, who is reasonably well informed and reasonably circumspect, to think that ‘LUMBERJUICE’ is a variant form of the ‘LUMBERJACK’ mark or that ‘LUMBERJUICE’ would be a logical brand extension for the ‘LUMBERJACK’ mark.

## **CONCLUSION**

51. The opposition has failed, and subject to any successful appeal, the application will proceed to registration.

## **COSTS**

52. As the applicant has been successful, it is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide, I award costs to the applicant on the following basis:

Preparing a statement and considering the other side's statement: £ 200

Preparing submissions: £ 200

**Total: £ 400**

53. I order Ziylan Magazacilik ve Pazarlama Anonim Sirketi to pay Vroom By The Sea Limited the sum of £ 400 as a contribution towards its costs. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case, if any appeal against this decision is unsuccessful.

**Dated this 12th day of April 2016**

**Teresa Perks  
For the Registrar  
The Comptroller - General**