

O-225-16

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION NO. 2557882
IN THE NAME OF WILLIAM LAMB GROUP LIMITED**

FOR THE FOLLOWING TRADE MARK:

lamb
SINCE 1887

IN CLASSES 18 AND 25

AND

**AN APPLICATION FOR A DECLARATION OF INVALIDITY
UNDER NO. 500660 BY LAMB-GRS, LLC**

BACKGROUND AND PLEADINGS

1. This is an application by LAMB-GRS, LLC (“the applicant”) to have registration number 2557882 for the mark shown below (“the registration”) declared invalid:



2. The application to register the trade mark was filed on 7 September 2010 by William Lamb Footwear Limited, which changed its name during proceedings to William Lamb Group Limited (“the proprietor”). The mark was registered on 28 January 2011 for the following goods:

Class 18 Bags, cases, handbags, clutch bags, shoulder bags, rucksacks, purses, wallets, personal organisers, credit card holders, folders, briefcases, diaries, address books, pilot cases, suitcases, holdalls, tote bags, travel bags, belts, articles of luggage, leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks.

Class 25 Clothing, footwear, headgear.

3. The application to invalidate the registration was filed on 22 October 2014 and is directed against all of the goods in the registration. The application was originally based on sections 5(2)(b), 5(3), 5(4)(a) and 56(1) of the Trade Marks Act 1994 (“the Act”). However, the applicant filed no evidence in support of the invalidation. In accordance with Rule 42(4) of the Trade Marks Rules 2008 (“the Rules”), the application was deemed withdrawn in respect of sections 5(3), 5(4)(a) and 56(1), and in respect of one earlier trade mark under section 5(2)(b) where proof of use was applicable and the proprietor had requested evidence of that use.

4. In the course of proceedings, the proprietor surrendered the registration on 13 November 2015. However, the applicant chose not to withdraw its application. The application for invalidation therefore proceeds on the basis of one earlier mark under section 5(2)(b) only.

5. The applicant relies upon its European Union Trade Mark (“EUTM”) registration no. 8319386 for the trade mark **L.A.M.B.**, applied for on 25 May 2009 and for which the registration procedure was completed on 13 January 2010. The applicant relies upon a range of goods in classes 3, 18 and 25.

6. In its application for invalidation, the applicant claims that there is a likelihood of confusion, including the likelihood of association, because “[t]he earlier right L.A.M.B. is highly similar to the later-filed mark and registered for highly similar and/or identical products”.

7. The proprietor filed a counterstatement, in which it denies the claim. It “admits the existence of CTM [now EUTM] Registration number 8319386 but, denies that this amounts to an earlier right than that of the proprietor”.

8. Neither party filed evidence. Neither party asked to be heard or filed written submissions in lieu of attendance at a hearing.

DECISION

9. Section 5 of the Act has application in invalidation proceedings because of the provisions set out in section 47. The relevant legislation is set out below:

“47. - (1) [...]

(2) The registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, [...]

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2A) But the registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if –

(a) within the period of five years ending with the date of the application for the declaration the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) it has not been so used, but there are proper reasons for non-use.

[...]

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made.

Provided that this shall not affect transactions past and closed”.

10. Section 5(2)(b) of the Act reads as follows:

“5 (2) A trade mark shall not be registered if because -

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

11. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“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) References 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”.

12. As can be seen from the details given above, the mark relied upon by the applicant has a filing date earlier than that of the proprietor’s mark and, as such, qualifies as an earlier trade mark under the above provisions. As this trade mark had not completed its registration process more than 5 years before the date on which the application for a declaration of invalidity was filed, it is not subject to proof of use. The applicant can, as a consequence, rely upon all of the goods it has identified.

Section 5(2)(b) – case law

13. 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

14. The competing goods are as follows:

Applicant's goods	Proprietor's goods
<p><u>Class 3</u></p> <p>Cosmetics, namely, lip pencils, eye shadow, eyeliner, eyebrow pencil, eye pencil, lip gloss, lipstick, non-medicated lip balm, mascara, nail polish, blush, concealer, compacts, artificial eyelashes, artificial fingernails, nail polish top coat, nail polish base coat, lip foundation, and eyebrow gloss; skin care products, namely, astringent for cosmetic purposes, bath gel, bath oil, bath powder, beauty mask, body cream, body lotion, bubble bath, eye cream, skin moisturizer, essential oils for personal use, eye make-up remover, facial scrubs, make-up remover, shower gel, hand cream, massage oil for cosmetic purposes, shaving cream, skin clarifiers, skin soap, skin emollients, sun screen preparations, suntanning preparations, depilatory creams, after-shave lotion, and anti-wrinkle cream for cosmetic purposes; hair care products, namely, hair dyes, hair conditioners, non-medicated hair care preparations, hair waving lotion, hair rinses, hair color removers, and hair shampoo; incense.</p> <p><u>Class 18</u></p> <p>Belts, animal leashes, animal carriers, athletic bags, briefcases, baby</p>	<p><u>Class 18</u></p> <p>Bags, cases, handbags, clutch bags, shoulder bags, rucksacks, purses,</p>

<p>backpacks, baby carriers worn on the body, beach bags, carry-on bags, clutch bags, diaper bags, tote bags, beach umbrellas, billfolds, horse blankets, business card cases, canes, wallets, backpacks, key cases, cosmetic cases sold empty, toiletry cases sold empty, coin purses, animal collars, luggage, luggage tags, saddles, walking sticks, shoe bags for travel, umbrellas, waist packs, whips, cane cases, wine/picnic backpacks, and wine carrying cases.</p> <p><u>Class 25</u></p> <p>Clothing, namely, shorts, sweatshirts, skirts, underwear, bandannas, scarves, aprons, socks, jackets, ties, neckties, coveralls, infantwear, loungewear, pajamas, ponchos, sweaters, suspenders, swim wear, dresses, and clothing wraps; headwear, namely, visors, baseball caps, and hats; and footwear.</p>	<p>wallets, personal organisers, credit card holders, folders, briefcases, diaries, address books, pilot cases, suitcases, holdalls, tote bags, travel bags, belts, articles of luggage, leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks.</p> <p><u>Class 25</u></p> <p>Clothing, footwear, headgear.</p>
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15. When making the comparison, all relevant factors relating to the goods in the specification 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”.

16. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services;
- c) The respective trade channels through which the goods or services reach the market;

- d) In the case of self serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- e) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

17. The General Court (“GC”) confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, that, even if goods/services are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut fur Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

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

19. As for whether the goods are complementary, in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that “complementary” means:

“...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”.

20. Regarding complementarity, I also bear in mind the guidance given by Mr Daniel Alexander QC, sitting as the Appointed Person, in case BL 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”.

21. Other than the applicant’s assertion in its application for invalidation that the goods are “highly similar and/or identical”, I have no submissions from either party on the similarity or identity of the goods.

Class 18

22. Both specifications contain the terms “clutch bags”, “wallets”, “briefcases”, “tote bags”, “belts”, “umbrellas” and “walking sticks”, which are self-evidently identical. Although expressed in different terms, “articles of luggage” and “rucksacks” in the proprietor’s specification are identical to “luggage” and “backpacks”, respectively, in the earlier mark.

23. The proprietor’s “cases”, “suitcases”, “holdalls”, “travel bags”, “trunks” and “travelling bags” would all be covered by the term “luggage” in the applicant’s specification. Following *Meric*, these goods are identical. “Pilot cases” in the proprietor’s specification are, if not identical, similar to the highest degree to “briefcases”, given the coincidence in their nature, their intended purpose, the method of use and the trade channels.

24. The proprietor’s specification includes the term “bags” at large. This would encompass the various types of bag listed in the applicant’s specification, such as “athletic bags”. These goods are, on the principle in *Meric*, identical. I recognise that “bags” is wider than the applicant’s specification and would notionally cover types of bag not included in the applicant’s specification. However, no fall-back specification has been provided to limit to such goods and, in any event, such goods would still, in my view, be highly similar: the nature of the goods may differ (for example, in size and shape) but the users, channels of trade and intended purpose are identical and they may be in competition.

25. “Handbags” and “shoulder bags” in the proprietor’s specification both include “tote bags” in the applicant’s specification and these goods are, following the principle in *Meric*, identical.

26. The term “articles of [...] leather and imitations of leather, and goods made of these materials and not included in other classes” in the proprietor’s specification would include belts in the applicant’s specification: these goods are, when applying the guidance in *Meric*, identical.

27. “Purses” in the proprietor’s specification include “coin purses” in the applicant’s specification. These goods are identical under the principle in *Meric*.

28. To the extent that “credit card holders” in the proprietor’s specification and “business card cases” in the applicant’s specification are both used to keep items together and transport them safely while one moves around, they have similar uses. The users and the channels of trade may be the same. Given that the goods are both used to house cards, albeit of different types, they may be in competition; as the goods may be part of a co-ordinated range of products, there is also a degree of complementarity to the extent that the average consumer might expect them to originate from the same undertaking. Overall, the goods are similar to a high degree.

29. “Parasols” in the proprietor’s specification are similar to a reasonable degree to “umbrellas” in the applicant’s specification. The respective goods are similar in nature and method of use but they are different in purpose and have neither a competitive nor a complementary relationship.

30. In relation to “personal organisers”, “folders”, “diaries” and “address books” in the proprietor’s specification, the applicant’s best case rests, in my view, in its “billfolds”, “business card cases”, “key cases” and “wallets”. I consider there to be a low degree of similarity between these goods. This is because, whilst the purpose of the goods at issue is different, they are all small leather goods likely to be sold through the same trade channels. They may be sold as part of co-ordinating sets and the users are likely to be identical.

31. Without the benefit of submissions to assist me, I can see no meaningful similarity between the proprietor’s “animal skins, hides” and any of the goods in the applicant’s specification. The applicant’s best case in relation to animal skins and hides lies, in my view, in its goods in class 18. However, animal skins and hides are raw materials which would be used in the manufacture of other goods. The goods in the applicant’s specification, such as bags and key cases, are finished articles. The respective goods have a different intended purpose and nature, the trade channels and users are different and they are neither in competition nor complementary. I consider that the goods in the applicant’s class 18 specification and “animal skins, hides” are dissimilar. The applicant’s position is not improved in relation to its class 3 or class 25 goods: the nature, intended purpose, trade channels and users of the applicant’s goods in classes 3 and 25 are different from those for animal skins and hides, and there is neither a competitive nor a complementary relationship. As some similarity between the goods is necessary to engage the test for likelihood of confusion,¹ my findings above mean the opposition must fail in respect of “animal skins, hides”.

Class 25

32. Use of the word “namely” in the class 25 specification must be approached as follows (as indicated in the Trade Mark Registry’s classification guidance):

“Note that specifications including “namely” should be interpreted as only covering the named Goods, that is, the specification is limited to those goods.

¹ *Waterford Wedgwood plc v OHIM*, C-398/07 P (CJEU)

Thus, in the above “dairy products namely cheese and butter” would only be interpreted as meaning “cheese and butter” and not “dairy products” at large. This is consistent with the definitions provided in Collins English Dictionary which states “namely” to mean “that is to say” and the Cambridge International Dictionary of English which states “which is or are”.

Accordingly, the scope of the applicant’s class 25 specification is in effect “shorts, sweatshirts, skirts, underwear, bandannas, scarves, aprons, socks, jackets, ties, neckties, coveralls, infantwear, loungewear, pajamas, ponchos, sweaters, suspenders, swim wear, dresses, and clothing wraps; visors, baseball caps, and hats; and footwear”. Consequently, the goods at issue are identical under the principle outlined in *Meric*, as the individual items of clothing and headwear identified in the applicant’s specification are encompassed by the proprietor’s broader terms “clothing” and “headgear”. “Footwear” appears in both specifications: these goods are plainly identical.

The average consumer and the nature of the purchasing act

33. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods. I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. 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”.

34. Given my findings regarding the similarity of the goods at paragraphs 22-32, the relevant average consumer is the consumer of the goods at issue in classes 18 and 25. I consider that the relevant average consumer of the goods at issue is a member of the general public.

35. It is my experience that the goods at issue are generally sold through bricks and mortar retail premises on the high street and their online equivalents. The goods will normally be chosen via self-selection from a shelf or the online equivalent. In *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03, the GC stated that:

“50..... Generally in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually.

Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly the visual aspect plays a greater role in the global assessment of the likelihood of confusion”.

Accordingly, while I do not rule out that there may be an aural component (advice may, for example, be sought from a shop assistant), when considered overall, the selection process will be mainly visual.

36. The consumer of the goods at issue will be attentive to ensure that the goods are suitable for their purpose and that they are, for example, the desired colour or style, particularly for those goods which are worn on the person. I am of the view that the average consumer will pay an average degree of attention in the selection of the goods.


Comparison of trade marks

37. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion”.

38. It would be wrong, therefore, artificially to dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the trade marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the trade marks.

39. The trade marks to be compared are as follows:

Applicant's trade mark	Proprietor's trade mark
L.A.M.B.	

40. The proprietor asserts in its counterstatement that “[t]he Proprietor’s use of LAMB (a surname) has no relation to L.A.M.B. which is clearly an acronym” (p. 2). The applicant states simply that “[t]he earlier right L.A.M.B. is highly similar to the later filed mark [...]”.

41. The proprietor’s mark consists of two elements. The first element is the word “lamb”, which appears in lower case and a stylised italic typeface. The second element is the phrase “SINCE 1887”, which is presented a smaller, non-italic font beneath the word “lamb”. The word “SINCE” is in capital letters. The phrase “SINCE 1887” is likely to be seen as having little distinctiveness and, as a consequence, lower relative weight in the overall impression conveyed by the mark. By virtue of its size and positioning, the word “lamb” has a greater visual impact, with a weaker role being played by the element “SINCE 1887”.

42. The applicant’s mark consists of the four letters “L-A-M-B”, presented in capitals, each followed by a full stop. While I acknowledge that the average consumer is likely to notice the full stops, where the letters of a mark resemble a known word it is the natural human tendency to perceive the mark as a representation of that word. This is particularly the case as “L.A.M.B” is not, as far as I am aware (and no evidence has been provided to show otherwise) a well-known acronym. As a result, I consider that the mark is most likely to be perceived as a representation of the word “LAMB” and that it is this word which dominates the overall impression.

43. Visually, both marks share the same four letters “L-A-M-B”/“l-a-m-b”. Although the earlier mark employs capital letters and the “lamb” element of the later mark is in lower case, this is likely to go unnoticed by the average consumer. There are differences because of the words “SINCE 1887” in the proprietor’s mark, the different typefaces and the presence of full stops separating the letters in the applicant’s mark. Having regard to all the similarities and differences, and bearing in mind my assessment of the overall impression of the respective marks, I consider there to be a medium degree of visual similarity.

44. Aurally, the words “LAMB” and “lamb” will be pronounced identically in each mark. I consider it unlikely that “SINCE 1887” in the proprietor’s mark will be articulated. Not only do the words appear underneath the “lamb” element and in a smaller font but they also contain the type of information which is commonly seen to describe the date when a business was established or began trading. As a consequence, I am of the view that the marks are aurally identical.

45. For a conceptual message to be relevant, it must be capable of immediate grasp by the average consumer.² I have indicated at paragraphs 41 and 42 that I consider that the overall impression of both marks will be dominated by the word “LAMB”. This is a common dictionary word with the meaning of a young sheep. In the UK, Lamb is also a common surname. Whichever of these two concepts the average consumer attributes to

² See Case C-361/04 P *Ruiz-Picasso and Others v OHIM* [2006] ECR I-00643; [2006] E.T.M.R. 29

one mark is as likely to be attributed to the other mark. I find that the marks are conceptually identical.

Distinctive character of the earlier trade mark

46. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)”.

47. The opponent has made no submissions regarding the distinctiveness of its trade mark and has filed no evidence in support of a claim of enhanced distinctiveness. As a consequence, the assessment I must make is of the inherent distinctiveness of the mark as registered. Although the letters are separated by full stops, the mark constitutes a recognisable word which has no particular meaning in relation to the goods at issue. I find that the earlier mark has average inherent distinctiveness.

Likelihood of confusion

48. 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 trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade mark, as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also bear in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind.

49. I have found that the parties' marks are visually similar to a medium degree and aurally and conceptually identical. I have found the earlier mark to have an average degree of inherent distinctive character. I have identified the average consumer as a member of the general public who will select the goods primarily by visual means (though I do not discount an aural component) and with an average degree of attention. I have found that the goods at issue are similar to varying degrees, from a low degree of similarity to identity.

50. Whilst I bear in mind the differences between the marks, I also take into account that the overall impression of the competing marks is dominated by the shared word "LAMB"/"lamb". As the other elements in the marks have little or no distinctive character, they have very low relative weight. Even when considered in relation to goods which are only similar to a low degree, taking all matters into account, I find that there is a likelihood of direct confusion, i.e. that the average consumer will mistake one mark for the other.

51. In case I am wrong on this point, I will also consider whether there is a likelihood of indirect confusion. I bear in mind the comments of Iain Purvis, Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10. In that case, indirect confusion was described at paragraph 16 as:

"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"".

52. I recognise that there are some visual differences between the marks. However, the marks are aurally and conceptually identical. Even in circumstances where the average consumer recognises the differences, when viewed in relation to the goods at issue, even those of low similarity, I consider that there would be an expectation on the part of the average consumer that the identical and similar goods at issue come from the same or economically linked undertakings. There would be a likelihood of indirect confusion.

Conclusion

53. The invalidation has failed in relation to “animal skins, hides” but has succeeded in relation to the other goods. **The registration is hereby declared invalid in respect of “bags, cases, handbags, clutch bags, shoulder bags, rucksacks, purses, wallets, personal organisers, credit card holders, folders, briefcases, diaries, address books, pilot cases, suitcases, holdalls, tote bags, travel bags, belts, articles of luggage, leather and imitations of leather, and goods made of these materials and not included in other classes; trunks and travelling bags; umbrellas, parasols and walking sticks” in class 18 and “clothing, footwear, headgear” in class 25.** Under the provisions of Section 47(6) of the Act, it is deemed never to have been made. The relevant date for “animal skins, hides” will remain the date of surrender, i.e. 13 November 2015.

Costs

54. As the applicant has been largely successful it is entitled to a contribution towards its costs. Neither party filed evidence. 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:

Official fees:	£200
Preparing a statement and considering the other side’s statement:	£200
Total:	£400

55. I order William Lamb Group Limited to pay LAMB-GRS, LLC the sum of **£400**. 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 5th day of May 2016

**Heather Harrison
For the Registrar
The Comptroller-General**