

O-424-16

TRADE MARKS ACT 1994

IN THE MATTER OF OPPOSITION NO. 404896 IN THE NAME OF PEEK & CLOPPENBURG KG

TO TRADE MARK APPLICATION NO. 3111737 IN THE NAME OF JAXKS LIMITED

DECISION

Introduction

1. On 3 June 2015 Jaxks Limited (“*the Applicant*”) applied to register **JAXKS** and **Jaxks** as a series of two trade marks in respect of ‘*Clothing, footwear and headgear*’ in Class 25.
2. The application for registration was opposed by Peek & Cloppenburg KG (“*the Opponent*”) in a Notice of Opposition dated 26 August 2015 on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (“*the Act*”). The earlier trade mark relied upon by the Opponent was EU Trade Mark No. 3587326 for the trade mark **Jake*s** which was applied for on 17 December 2003 and for which the registration was completed on 19 May 2005. The specification relied upon was ‘*Clothing, footwear and headgear*’ in Class 25.
3. The Applicant filed a counterstatement which denied the basis of the opposition and put the Opponent to proof of use of the trade mark upon which it relied.
4. Only the Opponent filed evidence. The Opponent also filed written submissions in the course of the evidence rounds. Neither side requested a hearing. The Opponent did however file further written submissions in lieu of attendance.
5. By a decision dated 8 February 2016, (O-065-16), Mr C J Bowen, acting for the Registrar dismissed the Opposition and ordered the Opponent to pay the Applicant £400 as a contribution towards its costs.

The Hearing Officer’s Decision

6. In the Decision, having acknowledged that the Opponent had been put to proof of use of its earlier trade mark under Section 6A of the Act (paragraph 8 of the Decision) the Hearing Officer nonetheless proceeded on the basis ‘*that the opponent is entitled to rely upon all the goods for which its earlier trade mark is registered*’ and made no findings on the basis of the evidence as to whether or not Section 6A of the Act had been satisfied (paragraph 9 of the Decision).

7. The Hearing Officer identified the approach, from the relevant case law of the EU courts, that he was required to take in making the required assessment under Section 5(2)(b) of the Act in paragraph 10 of his Decision. Quite rightly on this appeal there is no suggestion that the Hearing Officer did not identify the correct legal principles to be applied.
8. Having identified the relevant principles the Hearing Officer went on to find that:
 - (1) The competing specifications were identical (paragraph 11 of the Decision);
 - (2) The average consumer of the goods in issue was a member of the general public who will pay an average degree of attention during the selection process; a process which is likely to be dominated by visual considerations, although not to the extent that aural considerations can be ignored (paragraphs 13, 14 and 31 of the Decision);
 - (3) The competing trade marks were visually and aurally similar to a medium degree (paragraphs 20, 25 and 31 of the Decision);
 - (4) From the perspective of *'what the opponent describes as the "strict conceptual analysis"*, the parties agree that the applicant's trade mark has no meaning whereas the opponent's trade mark consists of a well-known male forename pluralised. In those circumstances, the opponent's trade mark would send a concrete conceptual message to the average consumer whereas the applicant's trade mark would send none.' (paragraph 28 of the Decision);
 - (5) If however the average consumer construes the applicant's trade mark as JACKS (the high point of the Opponent's case on conceptual similarity) then both trade marks would evoke the concept of a male forename, albeit quite different male forenames (paragraphs 28 and 31 of the Decision); and
 - (6) The Opponent's trade mark possessed no more than a normal level of inherent distinctive character (paragraphs 30 and 31 of the Decision).
9. On the basis of those findings the Hearing Officer concluded with regard to the likelihood of confusion as follows:

34. I begin by reminding myself that the opponent agrees that the selection process for the identical goods at issue is primarily visual. That being the case, I see no reason why the average consumer encountering the applicant's trade mark and who will acquire the goods at issue predominantly by self-selection would pause to consider how it would be verbalised. Much more likely, in my view, is that it would simply be treated as an invented word with no meaning. In those circumstances, the

very clear conceptual message sent by the opponent's trade mark is likely to fix itself in the average consumer's mind and in so doing will assist the average consumer's recall, thus making them less prone to the effects of imperfect recollection. The clear conceptual message sent by the opponent's trade mark is, in my view, more than sufficient to neutralise the medium degree of visual and aural similarity between the competing trade marks. However, even if the opponent is correct and the average consumer perceives the applicant's trade mark as the word Jacks, the mere fact that both trade marks convey the concept of a male forename, given that Jake and Jack are both very well-known and different male forenames, is still insufficient to create a likelihood of either direct or indirect confusion. By parity of reasoning, the same conclusion would apply to the position if the goods were to be selected by oral means.

35. Although I have reached the above conclusions in the context of, inter alia, an average consumer who will pay an average degree of attention during the selection process, I should make it clear, for the avoidance of doubt, that I would have reached the same conclusions even if I had characterised the degree of attention paid as low and the degree of visual and aural similarity between the competing trade marks as high.

10. On that basis the Hearing Officer found that the opposition failed, and that subject to any successful appeal, the application would proceed to registration.

The Appeal

11. The Opponent appealed to an Appointed Person under Section 76 of the Act. It is accepted by the Opponent that the Decision of the Hearing Officer '*sets out the relevant legal tests for assessing the likelihood of confusion, correctly assesses the relevant public and the levels of visual, aural and conceptual similarity between the Opposed Mark and the Earlier Trade Mark*' (paragraph 5 of the Grounds of Appeal dated 7 March 2016). However it is said that the Hearing Officer incorrectly applied the relevant legal principles leading to an erroneous finding of no likelihood of consumer confusion.
12. The three errors in the assessment of the likelihood of confusion which were identified by the Opponent as the basis for its appeal are in substance that:
 - (1) The Hearing Officer gave too much weight to the and/or overstated the perceived visual differences between the respective marks;
 - (2) The Hearing Officer was '*wrong to state that (at paragraph [34]) "the clear conceptual message sent by the Opponent's trade mark is . . . more than*

sufficient to neutralise the medium degree of visual and aural similarity between the competing trade marks’; and

- (3) Having found that there was a clear conceptual message sent by the Opponent’s earlier trade mark the Hearing Officer should not have found that such made the average consumer less prone to imperfect recollection in circumstances where the Hearing Officer had also found that the mark possesses only a normal level of distinctiveness.
13. No Respondent’s Notice was filed.
14. A hearing was appointed for the purpose of determining the Appeal in accordance with the procedure envisaged by Section 76(4) of the Act and Rules 73(1) and (2) of the Trade Mark Rules 2008. The Applicant confirmed by email that it would not attend the hearing of any appeal. Subsequently the Opponent filed written representations in lieu of attendance at the hearing of the appeal and requested that the hearing of the appeal be vacated and the appeal be determined on the basis of the Notice of Appeal and the written representations of the Opponent. The hearing was therefore vacated.

Standard of review

15. This appeal is by way of review. Neither surprise at a Hearing Officer’s conclusion, nor a belief that he has reached the wrong decision suffice to justify interference in this sort of appeal. Before that is warranted, it is necessary for me to be satisfied that there was a distinct and material error of principle in the decision in question or that the Hearing Officer was clearly wrong. See Reef Trade Mark [2003] RPC 5, and BUD Trade Mark [2003] RPC 25.
16. As correctly stated in the Written Representations submitted on behalf of the Opponent on the appeal guidance on the principles and parameters of appellate review has recently set out in the decision of Geoffrey Hobbs Q.C. in ALTI Trade Mark (O-169-16) at paragraphs [19] to [20] where he referred to the general applicability of the observations of Lord Neuberger PSC in Re B (a child) (Care Order Proceedings) [2013] UKSC 33 at paragraphs [93] and [94]:

[93] There is a danger in over-analysis, but I would add this. An appellate judge may conclude that the trial judge’s conclusion on proportionality was (i) the only possible view, (ii) a view which she considers was right, (iii) a view on which she has doubts, but on balance considers was right, (iv) a view which she cannot say was right or wrong, (v) a view on which she has doubts, but on balance considers was wrong, (vi) a view which she considers was wrong, or (vii) a view which is unsupportable. The appeal must be dismissed if the appellate

judge's view is in category (i) to (iv) and allowed if it is in category (vi) or (vii).

[94] As to category (iv), there will be a number of cases where an appellate court may think that there is no right answer, in the sense that reasonable judges could differ in their conclusions. As with many evaluative assessments, cases raising an issue on proportionality will include those where the answer is in a grey area, as well as those where the answer is in a black or a white area. An appellate court is much less likely to conclude that category (iv) applies in cases where the trial judge's decision was not based on his assessment of the witnesses' reliability or likely future conduct. So far as category (v) is concerned, the appellate judge should think very carefully about the benefit the trial judge had in seeing the witnesses and hearing the evidence, which are factors whose significance depends on the particular case. However, if, after such anxious consideration, an appellate judge adheres to her view that the trial judge's decision was wrong, then I think that she should allow the appeal.

17. It is necessary to bear these principles in mind on this appeal. In this connection I note that the Opponent submits that this appeal falls within category (vi) as identified by Lord Neuberger in the quotation set out above.

Decision

18. The first error is said to be the weight given by the Hearing Officer to the findings in relation to the visual similarity of the marks.
19. In paragraphs 15 to 28 of the Decision the Hearing Officer sets out the legal approach to the comparison of the trade marks and then proceeds to make findings on the basis of first an analysis of the visual similarity of the marks, then the aural (or phonetic) similarity and finally the conceptual similarity.
20. In respect of both the visual and the aural similarity the findings of the Hearing Officer was the same i.e. that the marks were similar to a medium degree. There is no criticism of the approach adopted by the Hearing Officer in making this assessment nor is there any criticism of the findings made in those paragraphs.
21. What is said is that in making the assessment of the likelihood of confusion the Hearing Officer put too much weight on the visual differences and was wrong to find that the average consumer would not pause to consider how to verbalise the word the subject of the trade mark application as he did in paragraph 34 of his Decision.

22. As has been made clear in the case law of the EU courts in the global assessment of the likelihood of confusion, the visual, oral or conceptual aspects of the opposing signs do not always have the same weight, see in particular Joined Cases T-117/03 to T-199/03 New Look Limited v. OHIM [2005] ETMR 425 (ECLI:EU:T:2004:293) at paragraph [49] which stated as follows:

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

23. That this is the position in law appears to have been accepted by the Opponent on this appeal. Moreover, as noted in the first sentence of paragraph 34 of the Decision it was accepted by the Opponent that the selection process by the average consumer of the goods in question is primarily visual.
24. In the premises, it seems to me that the Hearing Officer was entitled to take the view that he did that the average consumer would not pause to consider how the Applicant's mark **JAXKS** would be verbalised when self-selecting the goods in issue. Having made that finding it is not challenged upon this appeal that the Opponent's mark would send a concrete message and the Applicant's mark would send none being an invented word with no meaning. In such circumstances it also seems to me that the Hearing Officer was entitled to find, not least on the basis of the judgment in Case C-361/04P The Picasso Estate v. OHIM, which he cited, that the clear conceptual message of the Opponent's mark was more than sufficient to neutralise the medium degree of visual and oral similarity between the competing trade marks.
25. However, it is said on this appeal that it was not open to the Hearing Officer to make such a finding in circumstances where he had found that the average consumer would perceive the mark as an invented word with no meaning but would without pause perceive that Applicant's mark as the word 'Jacks' in respect of which it is said that there was a finding of conceptual similarity.

26. The first point to make clear is that the Hearing Officer in his Decision did go on to consider the position with regard to the likelihood of confusion where, contrary to his primary finding, the average consumer did perceive the Applicant's mark **JAXKS** not as an invented word with no meaning but as the word 'Jacks'. This was a *possibility* (but not certainty) that the Hearing Officer had recognised but not found in paragraph 28 of his Decision as follows (emphasis included in the original Decision):

. . . However, if on seeing the applicant's trade mark the average consumer (for whom it may not be necessary, given the predominantly visual selection process, to even consider how the applicant's trade mark should be verbalised) nonetheless construes it as the word JACKS, then I accept the competing trade marks MAY be conceptually similar to the limited extent that they both evoke the concept of a male forename, albeit quite different male forenames.

27. As stated in paragraphs 28 and 34 of his Decision 'Jack' and 'Jake' are both male albeit different forenames. It does not seem to me that the fact that the two words are both 'names' is such as to automatically or inevitably to give rise to a finding a conceptual similarity between the two words. That is because the fact that they are both names (which have a concept) would not necessarily lead to a finding of conceptual similarity because the public is not likely to make a conceptual link between the two words. In this connection I note that the Opposition Guidelines adopted by the President of the EUIPO in March 2016 and referred to by the Opponent support that view (see paragraph 3.4.3.4 of Section 2, Chapter 4).

28. In the circumstances, I think that the Hearing Officer was entitled, having found that both 'Jack' and 'Jake' are 'male forenames', to then go on to find that the 'names' were both well-known and different, i.e. not conceptually similar such that the similarities between the marks in issue were insufficient to create a likelihood of either direct or indirect confusion.

29. I further note that the Hearing Officer considered that his finding would be the same even if: (1) the goods were to be selected by oral means (paragraph 34 of this Decision); and (2) the visual and aural similarity of the competing trade marks had been found to be high (as opposed to medium) (paragraph 35 of his Decision).

30. In the light of the above I do not consider that the Hearing Officer can be said to have overstated the visual differences between the marks in suit. Nor do I consider that the Hearing Officer was precluded from adopting the course that he did with regard to his assessment of the likelihood of confusion as identified by the Opponent as the second error on this appeal.

31. With regard to the third error identified by the Opponent it seems to me that there is no force in the point.

32. The Hearing Officer found, and indeed it was the Opponent's position (see the quotation set out in paragraph 26 of the Decision) that the Opponent's mark comprised the well-known boy's name 'Jake'. That mark was also found by the Hearing Officer to send a concrete conceptual message to the average consumer (paragraph 28 of the Decision) and to possess a normal level of distinctive character (paragraph 30 of the Decision).
33. It is of course correct, as maintained by the Opponent, that as a matter of principle even consumers with a high level of attention need to rely upon their imperfect recollection of trade marks . However, it was not suggested by the Hearing Officer that imperfect recollection was not relevant. The Hearing Officer found in the present case that the average consumer was a member of the public who would pay an average degree of attention to the purchasing process, a process which was likely to be dominated by visual considerations but not to the extent that aural considerations could be ignored (paragraph 31 of the Decision). What the Hearing Officer found was that the concrete conceptual message conveyed by the Opponent's mark was such that it would have an effect on the recollection of the average consumer. It seems to me that this was a finding that he was entitled to make on the basis of his other findings noted in paragraph 32 above and was not in any way inconsistent with his finding with regard to the level of distinctive character possessed by the Opponent's mark (also noted in paragraph 32 above).

Conclusion

34. In the circumstances, it does not seem to me that the Opponent has identified any material error of principle in the Hearing Officer's analysis or that the Hearing Officer was plainly wrong. In the result I have decided that the Hearing Officer was entitled to make the findings that he did.
35. In the result the appeal fails.
36. Neither side has asked for any special order as to costs. Since the appeal has been dismissed, the Applicant is entitled to its costs of the Appeal. The Applicant has not taken any active steps during the pendency of the Appeal and therefore its costs would have been nominal. I will therefore make a modest award of £50 to the Applicant as a contribution to its costs of the appeal. I therefore order Peek & Cloppenburg KG to pay £50 to Jaxks Limited together with the sum of £400 awarded by the Hearing Officer below within 14 days of the date of this decision.

Emma Himsworth Q.C.

Appointed Person

5 September 2016