

**O-496-16**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 3119490  
BY STERLING SUITS LIMITED  
TO REGISTER THE TRADE MARK**



**IN CLASSES 25 & 40  
AND**

**IN THE MATTER OF OPPOSITION  
THERE TO UNDER No. 405259 BY  
LMSJ LIMITED**

## BACKGROUND


1) On 26 July 2015, Sterling Suits Ltd (hereinafter the applicant) applied to register the trade mark shown above in respect of the following goods and services:


In Class 25: Clothing for wear in judo practices; Clothing for wear in wrestling games; Clothing, footwear, headgear; Leather belts [clothing]; Paper hats for use as clothing items; Shoulder wraps [clothing]; Athletic clothing; Casual clothing; Thermally insulated clothing; Clothing for cycling; Clothing for fishermen; Clothing for horse-riding [other than riding hats]; Clothing for martial arts; Clothing for skiing; Clothing made of leather; Body warmers [clothing]; Anglers' shoes; Ballet shoes; Baseball shoes; Bowling shoes; Boxing shoes; Canvas shoes; Cycling shoes; Golf shoes; Handball shoes; Hockey shoes; insoles [for shoes and boots]; Leather shoes; Rubber shoes; Rugby shoes; Ski and snowboard shoes and parts thereof; Skiing shoes; Soccer shoes; Tennis shoes; Track and field shoes; Training shoes; Volleyball shoes; Women's shoes; Heel pieces for shoes; Athletics shoes; Basketball shoes; Bath shoes; Dance shoes; Dress shoes; Esparto shoes or sandals; Heels for shoes; Hiking shoes; Jogging shoes; Leisure shoes; Running shoes; Shoes for infants; Shoes for leisurewear; Slip-on shoes; Snowboard shoes; Stiffeners for shoes; Walking shoes; Sandals and beach shoes; High-heeled shoes; Riding shoes; Mountaineering shoes; shoes with hook and pile fastening tapes; tongues for shoes and boots; Pullstraps for shoes and boots; Work shoes; Sports shoes; Shoes ; Wooden shoes; Beach shoes; Esparto shoes or sandals; Dust coats; Fur coats and jackets; Morning coats; Trench coats; Wind coats; Fur coats; Car coats; Cotton coats; Duffel coats; Evening coats; House coats; Laboratory coats; Leather coats; Sheepskin coats; Tail coats; White coats for hospital use; Top coats; Rain coats; Light-reflecting coats; Men's and women's jackets, coats, trousers, vests; Coats (Top -); Coats; Coats made of cotton; Coats of denim; Pea coats; Open-necked shirts; Polo shirts; Shirts for suits; Short-sleeved shirts; Sport shirts; Sports shirts; Sports shirts with short sleeves; Sweat shirts; Golf shirts; Pique shirts; Casual shirts; Dress shirts; Football shirts; Rugby shirts; Tennis shirts; Under shirts; Knit shirts; Button down shirts; Collared shirts; Golf pants, shirts and skirts; Shirts and slippers; Shirts; Short-sleeve shirts; Ramie shirts; Snap crotch shirts for infants and toddlers; Bow ties; Silk ties; Ties; Footless tights; Woollen tights; Tights; Athletic tights; Hats; Socks; Dress suits; Ladies' suits; Skirt suits; Suits of leather; Evening suits; One-piece suits; Suits made of leather; Women's suits; Suits; Suits (Bathing -); Men's suits.

In Class 40: Tailoring or dressmaking; Tailoring services; Tailoring [custom manufacture]; Tailoring; Tailoring or dressmaking; Tailoring services; Tailoring [custom manufacture]; Tailoring.

2) The application was examined and accepted, and subsequently published for opposition purposes on 14 August 2015 in Trade Marks Journal No.2015/033.

3) On 14 October 2015 LMSJ Ltd (hereinafter the opponent) filed a notice of opposition. The opponent is the proprietor of the following trade marks:

Mark	Number	Dates of filing and registration	Class	Specification relied upon
STERLING LEATHERS	2300268	10.05.02 21.02.03	25	Leather clothing
	EU 011601861	25.02.13 23.07.13	18	Leather and imitations of leather and goods made of these materials and not included in other classes; animal skins; trunks and travelling bags, bags, umbrellas, parasols; bags made of leather; sports bags made of leather; tool bags of leather; travelling bags made of leather, wallets.
			25	Clothing footwear and headgear; men's clothing; women's clothing; clothing of leather or imitations of leather; jackets and coats; underwear for men; underwear for women; clothing accessories, including belts, scarves, headscarves, neckties, dress handkerchiefs, gloves; socks, stockings and pantyhose; caps.
			35	Retail services connected with the sale of clothing, clothing accessories, bags, wallets, purses and leather goods; mail order retail services connected with clothing, clothing accessories, bags, wallets, purses and leather goods; retail clothing shop services; online retail services relating to the sale of clothing,

				clothing accessories, bags, wallets, purses and leather goods; advertising services connected to the sale of clothing, clothing accessories, bags, wallets, purses and leather goods.
	EU 009911074	20.04.11 02.11.11	18	Leather and imitations of leather and goods made of these materials and not included in other classes; animal skins; trunks and travelling bags, bags, umbrellas, parasols and walking sticks; but not including whips, harness and saddlery; bags made of leather; sports bags made of leather; tool bags of leather; travelling bags made of leather, wallets.
			25	Clothing footwear and headgear; men's clothing; women's clothing; clothing of leather or imitations of leather; underwear for men; underwear for women; clothing accessories, including belts, scarves, headscarves, neckties, dress handkerchiefs, gloves; socks, stockings and pantyhose; headgear, caps.
			35	Retail services connected with the sale of clothing, clothing accessories and bags, wallets and purses; mail order retail services connected with clothing, clothing accessories and bags, wallets and purses; retail clothing shop services; online retail services relating to the sale of clothing, clothing accessories and bags, wallets and purses; advertising services connected to the sale of clothing, clothing accessories and bags, wallets and purses.
STERLING LEATHERS	EU 009906033	19.04.11 02.11.11	18	Leather and imitations of leather and goods made of these materials and not included in other classes; animal skins; trunks and travelling bags, bags, umbrellas, parasols and walking sticks; but not including whips, harness and saddlery; bags made of

				leather; sports bags made of leather; tool bags of leather; travelling bags made of leather, wallets.
			25	Clothing footwear and headgear; men's clothing; women's clothing; clothing of leather or imitations of leather; underwear for men; underwear for women; clothing accessories, including belts, scarves, headscarves, neckties, dress handkerchiefs, gloves; socks, stockings and pantyhose; headgear, caps.
			35	Retail services connected with the sale of clothing, clothing accessories and bags, wallets and purses; mail order retail services connected with clothing, clothing accessories and bags, wallets and purses; retail clothing shop services; online retail services relating to the sale of clothing, clothing accessories and bags, wallets and purses; advertising services connected to the sale of clothing, clothing accessories and bags, wallets and purses.

a) The opponent contends that the dominant and distinctive part of all its marks is the word “STERLING”, it contends that its marks and the mark applied for are very similar and that the goods applied for are identical or similar to its goods and services. It contends that the application offends against Section 5(2)(b) of the Act.

4) On 10 December 2015 the applicant filed a counterstatement, basically denying that the marks are similar, it also claims that the businesses of the two parties are dissimilar. It states that the word “STERLING” is descriptive, meaning (inter alia) “fine”, “quality” or “super”; and that it is used by a large number of companies both as part of their company name and in their trade marks. The applicant produces lists of companies registered at Companies House with the word “STERLING” as part of their registered company name and also lists of trade marks which are registered and which feature the word “STERLING”. The applicant also referred me to two decisions of the Registry (O-332-03 & O-082-09). The applicant did not request proof of use.

5) Both sides filed evidence. Both parties seek an award of costs in their favour. Neither side wished to be heard. Only the opponent provided written submissions which I shall refer to as and when necessary in my decision.

## **OPPONENT'S EVIDENCE**

6) The opponent filed two witness statements. The first, dated 12 April 2016, is by Steven Richard Ellis a Director of the opponent company and also a Director of Sterling Wholesale Ltd which commercially exploits the "STERLING" trade marks of LMSJ Ltd. He refers to these two companies collectively as "my company". He states that the company began trading in the 1960s and initially focussed on leather goods including leather clothing but soon expanded to offer a range of mainstream clothing, accessories and leather goods. He states that his company operates in the wholesale sector selling goods throughout the UK and internationally and includes amongst its customers fashion houses such as Burberry, Paul Smith and Gieves & Hawkes. He states that the company has used its trade marks upon a range of clothing for men and women including, coats, jackets, blazers, jumpers, shirts, knitwear, trousers and accessories like handkerchiefs, leather clothing (jackets and coats), bags belts, wallets, card holders, key holders and holdalls. He provides the following turnover figures but does not state if these are for the UK only:

Year	Sales £	Promotion £
2011	1,306,790	2,448
2012	1,676,976	2,318
2013	2,878,570	4,136
2014	2,623,091	2,285
2015	1,758,138	n/a

7) Mr Ellis states that the promotion figures includes an advertisement taken out in the April 2013 edition of the magazine FORMULA which is aimed at Formula 1 fans. The company produces promotional leaflets and booklets and attends trade fairs. He provides the following exhibits:

- SRE1: Pages from the opponent's website, which are undated and provided historic information about the company.
- SRE2: Pictures of various items of clothing which have the various trade marks of the company upon them on attached labels such as those inside a jacket, on the neck of jumpers, on swing

tags, suit covers, boxes, belt buckles, and buttons. None of these are dated. The word STERLING is prominent on all these goods.

- SRE3: A copy of the trade mark licence agreement between LMSJ Ltd and Sterling Wholesale Ltd giving the latter the right to use three of the opponent's trade marks shown above in paragraph 3 (UK 2300268, EU 9911074 and EU 9906033).
- SRE5: Copies of a selection of invoices. Twenty-four of which are prior to the relevant date and show use of a lion device and the name Sterling Wholesale Ltd. It is not clear what the goods are as most are listed in code such as STE311 etc.
- SRE8: Copies of leaflets and booklets. These show use of the trade mark STERLING LEATHERS only.

8) The second witness statement, dated 5 May 2016, is by Steven John Wake the opponent's Trade Mark Attorney. He attaches a copy of submissions previously filed with the Registry. He provides his views on a number of issues which I shall take into account as and when required in my decision. He provides a printout from Wikipedia which gives various meanings for the term "Sterling" as well as a list of places/businesses/schools/ people/music which include the term. He also includes copies of pages from sites which offer ready-made suits as well as bespoke tailoring as well as accessories.

## **APPLICANT'S EVIDENCE**

9) The applicant filed a witness statement, dated 3 July 2016, by Olufunso Ogunfuwa a Director of the applicant. It consists mostly of submissions which I shall take into account as and when required in my decision. The attachments include a list of companies from Companies House which have the word "Sterling" at the beginning of their name; a list of trade marks from the IPO Register which have the word "Sterling" as the initial element and registered for classes 25 & 40; a decision from the IPO dated March 2009; copies of Companies House form indicating that a "small" company has a turnover of less than £6.5 million; a list of "The Top 100 biggest UK Ad Spenders" which shows the company placed last spent over £20million on advertising in 2013; copies of pages from what appear to be the applicant's website dated July 2016; and various pages from Wikipedia referencing the use of lions in British Heraldry.

10) That concludes my summary of the evidence filed, insofar as I consider it necessary.

## DECISION

11) The only ground of opposition is under section 5(2)(b) which reads:

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

(a) .....

(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.”

12) An “earlier trade mark” is defined in section 6, the relevant part of 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 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.”

13) The opponent is relying upon its trade marks listed in paragraph 3 above which are clearly earlier trade marks. The applicant did not request proof of use.

14) When considering the issue under section 5(2)(b) I take into account the following principles which 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.

(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.

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

15) As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then determine the manner in which these goods and services 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.”

16) The applicant's goods and services are, broadly, clothing, footwear, headgear and tailoring services. Such goods and services will be sold in, inter alia, traditional retail outlets on the high street, through catalogues and on the Internet. The specifications of both parties are unlimited, and so I must keep all of these trade channels in mind. The average consumer of the goods and services at issue is a member of the general public (including businesses) who is likely, in my opinion, to select the goods and services mainly by visual means. I accept that more expensive items may be researched or discussed with a member of staff. In this respect I note that in *New Look Ltd v OHIM Cases- T-117/03 to T-119/03 and T-171/03*, the General Court (GC) said this about the selection of clothing:

“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.”

17) In the same case the Court also commented upon the degree of care the average consumer will take when selecting clothing. It said:

“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 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.”

18) Clearly, the average consumer’s level of attention will vary considerably depending on the cost and nature of the item at issue. However, to my mind even when selecting routine inexpensive items of clothing such as underwear, the average consumer will pay attention to considerations such as size, colour, fabric and cost. Overall the average consumer is likely to pay a medium degree of attention to the selection of such items of clothing. I believe that similar considerations will come into play when looking at the tailoring services sought to be registered by the applicant. If one is having a suit tailored then the cost can vary enormously depending on the fabric and the extent of the tailoring i.e. if it is truly bespoke or whether it involves merely a slight adaptation of a ready-made item.

**19) In summary, the average consumer will be a member of the public (including businesses); the visual aspect will be the most important element in selection although I must also take into account the possibility of word of mouth recommendations and so aural considerations must**

**be considered. In selecting clothing, footwear, headgear and tailoring services the average consumer would, in my opinion, take a medium degree of care.**

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

20) In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“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”.

21) The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- 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.

22) I also take into account the comments of Jacob J. in *Avnet Incorporated v. Isoact Ltd* [1998] FSR 16 where he said:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

23) In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criteria capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court 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”.

24) In *Sanco SA v OHIM*, Case T-249/11, the General Court indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....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.

25) The opponent stated that its strongest case was under marks 11601861 and 9911074 so I shall use the specifications for these marks in the comparison test. The goods and services of the two parties are:

Applicant's goods and services	Opponent's goods and services
<p>In Class 25: Clothing for wear in judo practices; Clothing for wear in wrestling games; Clothing, footwear, headgear; Leather belts [clothing]; Paper hats for use as clothing items; Shoulder wraps [clothing]; Athletic clothing; Casual clothing; Thermally insulated clothing; Clothing for cycling; Clothing for fishermen; Clothing for horse-riding [other than riding hats]; Clothing for martial arts; Clothing for skiing; Clothing made of leather; Body warmers [clothing]; Anglers' shoes; Ballet shoes; Baseball shoes; bowling shoes; Boxing shoes; Canvas shoes; Cycling shoes; Golf shoes; Handball shoes; Hockey shoes; insoles [for shoes and boots]; Leather shoes; Rubber shoes; Rugby shoes; Ski and snowboard shoes and parts thereof; Skiing shoes; Soccer shoes; Tennis shoes; Track and field shoes; Training shoes; Volleyball shoes; Women's shoes; Heel pieces for shoes; Athletics shoes; Basketball shoes; Bath shoes; Dance shoes; Dress shoes; Esparto shoes or sandals; Heels for shoes; Hiking shoes; Jogging shoes; Leisure shoes; Running shoes; Shoes for infants; Shoes for leisurewear; Slip-on shoes; Snowboard shoes; Stiffeners for shoes; Walking shoes; Sandals and beach shoes; High-heeled shoes; Riding shoes; Mountaineering shoes; shoes with hook and pile fastening tapes; tongues for shoes and boots; Pullstraps for shoes and boots; Work shoes; Sports shoes; Shoes ;Wooden shoes; Beach shoes; Esparto shoes or sandals; Dust coats; Fur coats and</p>	<p>991074: Clothing footwear and headgear; men's clothing; women's clothing; clothing of leather or imitations of leather; underwear for men; underwear for women; clothing accessories, including belts, scarves, headscarves, neckties, dress handkerchiefs, gloves; socks, stockings and pantyhose; headgear, caps.</p> <p>11601861: Clothing footwear and headgear; men's clothing; women's clothing; clothing of leather or imitations of leather; jackets and coats; underwear for men; underwear for women; clothing accessories, including belts, scarves, headscarves, neckties, dress handkerchiefs, gloves; socks, stockings and pantyhose; caps.</p>

jackets; Morning coats; Trench coats; Wind coats; Fur coats; Car coats; Cotton coats; Duffel coats; Evening coats; House coats; Laboratory coats; Leather coats; Sheepskin coats; Tail coats; White coats for hospital use; Top coats; Rain coats; Light-reflecting coats; Men's and women's jackets, coats, trousers, vests; Coats (Top -); Coats; Coats made of cotton; Coats of denim; Pea coats; Open-necked shirts; Polo shirts; Shirts for suits; Short-sleeved shirts; Sport shirts; Sports shirts; Sports shirts with short sleeves; Sweat shirts; Golf shirts; Pique shirts; Casual shirts; Dress shirts; Football shirts; Rugby shirts; Tennis shirts; Under shirts; Knit shirts; Button down shirts; Collared shirts; Golf pants, shirts and skirts; Shirts and slips; Shirts; Short-sleeve shirts; Ramie shirts; Snap crotch shirts for infants and toddlers; Bow ties; Silk ties; Ties; Footless tights; Woollen tights; Tights; Athletic tights; Hats; Socks; Dress suits; Ladies' suits; Skirt suits; Suits of leather; Evening suits; One-piece suits; Suits made of leather; Women's suits; Suits; Suits (Bathing -);Men's suits.

In Class 40: Tailoring or dressmaking; Tailoring services; Tailoring [custom manufacture]; Tailoring; Tailoring or dressmaking; Tailoring services; Tailoring [custom manufacture]; Tailoring.

11601861: Retail services connected with the sale of clothing, clothing accessories, bags, wallets, purses and leather goods; mail order retail services connected with clothing, clothing accessories, bags, wallets, purses and leather goods; retail clothing shop services; online retail services relating to the sale of clothing, clothing accessories, bags, wallets, purses and leather goods; advertising services connected to the sale of clothing, clothing accessories,

	<p>bags, wallets, purses and leather goods.</p> <p>9911074: Retail services connected with the sale of clothing, clothing accessories and bags, wallets and purses; mail order retail services connected with clothing, clothing accessories and bags, wallets and purses; retail clothing shop services; online retail services relating to the sale of clothing, clothing accessories and bags, wallets and purses; advertising services connected to the sale of clothing, clothing accessories and bags, wallets and purses.</p>
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26) In respect of the class 25 specifications of both parties whilst they contain detailed descriptions of various goods in class 25 they also contain the words “clothing, footwear and headgear” which encompass all of the items detailed. **Therefore the goods of the two parties in Class 25 are identical.**

27) I now turn to consider the class 40 services of the applicant. Neither of the opponent’s marks are registered for services in Class 40 but it contends that tailoring services are provided in order to produce an item of clothing. They state that the services and goods are complementary and point to the fact shown in the evidence that many companies which offer tailoring services also offer ready to wear items for sale, indeed the applicant’s own website shows that it offers ready-made items in addition to tailored clothing. Comparing the class 40 services to the opponent’s class 25 goods it is clear that the consumers will be the same, and that they share trade channels with tailoring providers also offering ready-made clothing, shoes and headgear. Tailoring services result in the provision of items of clothing and so there is a degree of complementarity, whilst they can also be said to be in competition. **To my mind, there is a low if not medium degree of similarity between the opponent’s class 25 goods and the applicant’s class 40 services.**



28) I next turn to compare the class 40 services of the applicant with the opponent's class 35 retail services in relation to clothing. Clearly the customers are identical, they also are part of the same trade channel with tailoring providers offering clothing for sale and vice versa, even if the tailoring amounts to little more than shortening trousers etc. They would also be in competition with each other. **To my mind, there is a low if not medium degree of similarity between the applicant's class 40 services and the opponent's class 35 services.**

**Comparison of trade marks**

29) 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:

“.....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.”

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

<b>Opponent's trade marks</b>	<b>Applicant's trade mark</b>
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11601861:



9911074:



31) I will first compare the applicant's mark to the opponent's mark 11601861. Both marks contain the word STERLING. This is a word which has many meanings in the UK. It can refer to the currency of the UK, it can be a word of laudatory significance and it can be both a forename and a surname. In the opponent's mark the only other features are a heraldic lion device and the words "Est. 1953". No

consumer would take the words “Est.1953” to have any trade mark significance, it merely provides an indication of when the company was established and perhaps provide a degree of confidence, perhaps misplaced, that the company cannot be too bad if it has survived for 63 years to date. The heraldic device also serves merely as a decorative item. Whilst neither the device nor the words “est. 1953” will be ignored, they will be accorded little weight in identifying the source of the goods or services. The applicant’s mark also contains the words “suits” and “London” as well as a device element of a letter “S” in a circle with an outer circle almost as though the inner circle was eclipsing the source of light. To my mind, the word “suits” when used on clothing or in respect of tailoring services will be seen as descriptive. The word “London” simply indicates the geographical location of the business or perhaps its headquarters. Again, to my mind, none of these additional elements will be seen as having great significance in terms of the origin of the goods or services. In both the opponent’s and the applicant’s marks the word “STERLING” will be seen as the dominant and distinctive element which provides an indication of origin. The marks are visually and aurally similar to a medium degree, whilst conceptually they will be seen as identical as whatever meaning is attributed by the consumer to the word “Sterling” would be the same in each case. **Overall the opponent’s mark 11601861 and the mark in suit are at least similar to a medium degree.**

32) I next compare the opponent’s mark 9911074 to the mark in suit. Both marks contain the word STERLING. This is a word which has many meanings in the UK. It can refer to the currency of the UK, it can be a word of laudatory significance and it can be both a forename and a surname. In the opponent’s mark the only other feature is a large heraldic lion device. Despite its size the heraldic device merely serves as a decorative item. It will not be ignored, but it will be accorded little weight in identifying the source of the goods or services. The word “STERLING” and the heraldic device are equally large, but it is accepted that “words speak louder than devices” particularly when the device is not particularly unusual or unique. I have described the mark in suit in the previous paragraph and I again come to the conclusion that the distinctive and dominant element in both marks is the word “STERLING”. The marks are visually and aurally similar to a medium degree, whilst conceptually they will be seen as identical as whatever meaning is attributed by the consumer to the word “Sterling” would be the same in each case. **Overall the opponent’s mark 9911074 and the mark in suit are at least similar to a medium degree.**

## Distinctive character of the earlier trade mark

33) 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-0000, paragraph 49).

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

34) In paragraphs 31 & 32 above I have set out my description of the opponent’s marks and what I view as their distinctive and dominant elements. In both cases this is the word “STERLING”. I accept that this has a laudatory meaning but can equally be seen as a name. **The mark is inherently distinctive to a medium to high degree. The opponent has provided evidence of use of the marks STERLING LEATHERS and STERLING WHOLESALE LTD and to my mind the use shown is such that it cannot benefit from enhanced distinctiveness.**

## Likelihood of confusion

35) 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 services and vice versa. As I mentioned above, it is also 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 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 trade marks and must instead rely upon the imperfect picture of them he has retained in his mind. Earlier in this decision, I concluded that:

- the average consumer is a member of the general public (including businesses), who will select the goods and services by predominantly visual means, although not discounting aural considerations and that they will, on average, pay a medium degree of attention to the selection of such items.
- the class 25 goods are identical. The class 35 services of the opponent are similar to the class 40 services of the applicant to at least a low to medium degree. The class 25 goods of the opponent are similar to the class 40 services of the applicant to at least a low to medium degree.
- the opponent's marks 11601861 and 9911074 are similar to the mark in suit to at least a medium degree.
- the opponent's mark has a medium to high degree of inherent distinctiveness but cannot benefit from an enhanced distinctiveness through use.

36) In view of all my conclusions, and allowing for the concept of imperfect recollection, there is a likelihood of consumers being confused into believing that the goods and services applied for under the mark in suit and provided by the applicant are those of the opponent or provided by some undertaking linked to it. **The opposition under Section 5(2)(b) therefore succeeds in full.**

## **CONCLUSION**

37) As the opposition has been completely successful the application will be refused.

## **COSTS**

38) As the opponent has been successful it is entitled to a contribution towards its costs.

Expenses	£100
Preparing a statement and considering the other side's statement	£300
Preparing evidence and considering the other side's evidence	£500
Preparing submissions	£300
<b>TOTAL</b>	<b>£1200</b>

39) I order Sterling Suits Ltd to pay LMSJ Ltd the sum of £1200. This sum 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 26th day of October 2016**

**George W Salthouse**  
**For the Registrar,**  
**the Comptroller-General**