

**O-631-17**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3182897**

**BY GLENA OYIADJO**

**TO REGISTER A TRADE MARK N CLASSES 18 AND 25**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 408146**

**BY FASHION IP B.V.**


## BACKGROUND

1. On 30 August 2016, Glenna Oyiadjo applied to register the trade mark 'Order My Steps shoe boutique' in respect of the following goods:

**Class 18:** Handbags, purses and wallets.

**Class 25:** Shoes; Children's footwear; Footwear for men; Footwear for women; Insoles [for shoes and boots].

2. The application was published for opposition purposes on 23 September 2016 and a notice of opposition was subsequently filed by Fashion IP B.V. ("the opponent"). The opposition is based upon Section 5(2)(b) of the Trade Marks Act 1994 ("the Act") and is directed against all of the goods in the application. The opponent relies on two earlier trade marks, the details of which are set out below:

Marks	Goods relied upon
<p>International Trade mark Registration (IR) No. 888394:</p> <p style="text-align: center;">STEPS</p> <p>Date of Designation of the EU: 21 April 2006</p> <p>Date protection granted in EU: 06 June 2007</p> <p>Seniority date: 01 June 2001 (UK)</p>	<p><b>Class 18:</b> 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; whips, harness and saddlery.</p> <p><b>Class 25:</b> Clothing, footwear, headgear.</p>
<p>European Union Trade Mark (EUTM) 6386941</p> <p style="text-align: center;"></p> <p>Colours Claimed: Red (PMS code 1795).</p> <p>Filing date: 23 October 2007</p> <p>Date of registration: 27 July 2013</p>	<p><b>Class 18:</b> 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; whips, harness and saddlery.</p> <p><b>Class 25:</b> Clothing, footwear, headgear.</p>

3. The opponent submits that the respective goods are identical or highly similar and that the marks are similar because the distinctive part of the application is the shared element 'Steps'.

4. Ms Oyiadjo filed a counterstatement in which she denies the basis of the opposition.

5. A hearing was neither requested nor considered necessary. The opponent filed written submissions during the evidence rounds. It also filed written submissions in lieu of attendance at a hearing. I will refer to these submissions, as necessary, below. Ms Oyiadjo filed nothing beyond the counterstatement. In these proceedings, the opponent has been represented by Maucher Jenkins. Ms Oyiadjo is not professionally represented.

## **DECISION**

6. Section 5(2)(b) of the Act reads:

“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.”

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

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

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question,

taking account (where appropriate) of the priorities claimed in respect of the trade marks.

8. In these proceedings, the opponent relies on its registrations Nos IR888394 and EUTM6386941. In my view, the opponent's strongest case lies in IR888394: if it cannot succeed in respect of this earlier registration, it will be in no better position as regards as its other mark. I proceed on that basis. IR888394 is an earlier mark within the meaning of section 6(1) of the Act. Though this mark had been granted protection in the EU for more than five years at the publication date of the opposed application, Ms Oyiadjo choose not to request proof of use from the opponent. The opponent can, as a consequence, rely upon all of the goods it has identified without having to prove use.

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

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

### **The principles**

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

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

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

## Comparison of goods

10. In the judgment of the Court of Justice of the European Union (“the CJEU”) in *Canon*, Case C-39/97, the Court stated that:

“23. 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”.

11. In *Gérard Meric v OHIM*, Case T- 133/05, the General Court (“the GC”) stated:

“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”.

12. 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.

13. I also bear in mind the decision in *Boston Scientific Ltd v OHIM*, Case T-325/06, where 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”.

14. The competing goods are as follows:

Applied for goods	Opponent’s goods
<p><b>Class 18:</b> Handbags, purses and wallets.</p> <p><b>Class 25:</b> Shoes; Children's footwear; Footwear for men; Footwear for women; Insoles [for shoes and boots].</p>	<p><b>Class 18:</b> 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; whips, harness and saddlery.</p> <p><b>Class 25:</b> Clothing, footwear, headgear.</p>

15. The contested *handbags, purses and wallets* fall within the broad term *leather and imitations of leather, and goods made of these materials and not included in other classes* in the opponent’s specification. These goods are identical on the principle outlined in *Meric*.

16. The contested *shoes, children's footwear, footwear for men and footwear for women*, are all types of footwear which are encompassed by the opponent’s term *footwear*. These goods are also identical on the *Meric* principle.

17. The contested *insoles [for shoes and boots]* are accessories for footwear which can be bought by the same end users to provide extra cushioning and support. There is therefore a degree of complementarity. Further, it is not unlikely that *insoles* would be produced by the same manufacturers and distributed through the same trade channels as of the opponent's *footwear*. In my view these goods are similar to a medium degree.

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

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

19. 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.”

20. The goods at issue are general consumer items and so the average consumer will be the general public. In my experience, the goods are most likely to be the subject of self-selection from traditional retail outlets on the high street, catalogues and websites; consequently, visual considerations are likely to dominate the selection process. That said, as the selection of the goods may, on occasion, involve the intervention of a sales assistant, aural considerations cannot be ignored. As to the degree of care that will be taken when selecting the goods at issue, consumers will be conscious of factors such as size, material, style, colour, cost and, where appropriate, compatibility with



existing items. As such, it is considered that they will pay, at least, an average level of attention when making their selection.

### **Comparison of marks**

21. 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.”

22. It would be wrong, therefore, artificially to dissect the 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 the marks.

23. The marks to be compared are:

<b>Applicant's mark</b>	<b>Opponent's mark</b>
Order My Steps shoe boutique	STEPS

## Overall impression

24. The opponent's mark consists of the word STEPS presented in upper case letters; the overall impression it conveys and the distinctiveness lying in the totality.

25. The applied for mark consists of the phrase 'Order My Steps shoe boutique' with the words 'Order', 'My' and 'Steps' in title case and the words 'shoe' and 'boutique' presented in lower case. The opponent submits that the distinctive element of the application is the word 'Steps' because, it states, the elements 'Order' 'My' and 'shoe boutique' are of low distinctive character. In this connection, the opponent submits that the words 'Order My' is "merely an indication of the means of procuring the goods covered by the [...] application". Given that the words 'Order My Steps shoe boutique' are presented in the same size and font and that the words 'Steps' is placed in the middle of the mark with no emphasis or impact stemming from it, I find that there is nothing that makes the component 'Steps' stand out. Rather, I consider that the words 'Order My Steps' form a unit and are more striking for the following reasons:

1. The first letters of the words 'Order My Steps' are capitalised, as opposed to the lower case letters used for the whole of the words 'shoe boutique'. Further, the words 'Order My Steps' are placed in a prominent position at the beginning of the mark;
2. The words 'shoe boutique' are purely descriptive in relation to the contested *shoes, children's footwear, footwear for men, footwear for women and insoles [for shoes and boots]* in class 25 as they indicate the place where the goods can be purchased. In relation to the contested *handbags, purses and wallets* in class 18 the words 'shoe boutique' still have descriptive connotations since these goods are likely to be sold in shoe shops/boutiques alongside shoes.

26. In my view, the distinctiveness of the mark 'Order My Steps shoe boutique' resides in the combination of the words and in the way in which they are combined though, for the reasons outlined above, the words 'Order My Steps' play the greater role in the overall impression conveyed by the mark.

27. As to the significance of the word 'Steps', this must be assessed taking into account the "overall blend of meaning" that the relevant public is likely to attribute to the composite mark 'Order My Steps shoe boutique' viewed as a whole. In BL-O-476/14, Professor Ruth Annand, sitting as the Appointed Person, said:

"24. To my mind the issue was not so much *Medion* but rather one of general principle: the overall impression the Applicant's mark would have on the pet-owning public in the particular circumstances of this opposition.

25. The Hearing Officer seems, however, to have determined that because in his view BARKERS BREW "hung together", and BREW was not purely descriptive of pet food, BARKERS had no independent significance in the Applicant's mark, and that was sufficient to preclude likelihood of confusion (or a link) with the Opponent's mark, even though BAKERS was highly distinctive and identical goods were involved.

26. On the contrary, the CJEU makes clear in *Bimbo* that "hanging together" is not the determinative criteria in assessing a composite mark: the decisive question being whether the composite mark forms a unit having a different meaning as compared to its components taken separately (*Bimbo*, para. 25).

27. Mr. Malynicz referred me to 2 earlier decisions of Mr. Geoffrey Hobbs Q.C. sitting as the Appointed Person in *CARDINAL PLACE Trade Mark*, BL O/339/04 and *CANTO Trade Mark*, BL O/021/06, as similarly expressing the same point that marks must be compared as wholes, considering the blend of meaning given by the composite mark against the single term.

28. In my judgment, the Opponent was justified in complaining that the Hearing Officer did not consider the overall blend of meaning and significance of BARKERS BREW to the pet-owning public in the context of pet food, and thus made an error of law."

And

“30. For the reasons I have given above, I do not consider that either the global assessment of likelihood of confusion for Section 5(2)(b), or the global assessment of the existence of a “link” for Section 5(3), was carried out by the Hearing Officer in an appropriately correct (viz overall blend of meaning and significance the pet-owning public would attribute to BARKERS BREW) or complete manner (viz taking account of evidence as to: (a) the state of the UK pet food market; and (b) the reputation of BAKERS on that market).”

28. In the present case, given the significance of the words ‘shoe boutique’ at the end of the mark, which is indicative of a place that specialises in selling shoes, the average consumer of *shoes, children's footwear, footwear for men, footwear for women, insoles [for shoes and boots]* is likely to take the mark ‘Order My Steps shoe boutique’ as referring to a trade in shoes under the name ‘Order My Steps’. Likewise, in relation to the contested *handbags, purses and wallets*, I find that although the nature of the goods is different, these goods are normally purchased alongside shoes in shoe shops/boutiques. Consequently, the mark ‘Order My Steps shoe boutique’ will still suggest to the average consumer of *handbags, purses and wallets* that ‘Order My Steps’ is the name of the trader selling the goods.

29. It is also important to remember here that the average consumer will not see the mark as applied to online retail services, in the context of which it would be more natural to see the single word ‘Order’ as meaning ‘placing an order’. When applied to the contested goods in classes 18 and 25, I find that the combination ‘Order My Steps shoe boutique’ has a degree of ingenuity: the average consumer will, most likely in my view, approach it as a phrase conveying a subtle message whose meaning is difficult to unpack.

30. Given that the mark places no emphasis on the word ‘Steps’ and that the word ‘Steps’ is a familiar word which is clearly allusive in the context of trading in shoes, it seems to me that, whatever is the meaning attributed to the combination ‘Order My Steps shoe boutique’, the phrase does not lead to the impression that the single word ‘Steps’ is a mark. It follows that the average consumer is unlikely to understand ‘Steps’ as an independent element within the overall mark ‘Order My Steps shoe boutique’.

## **Visual and aural similarity**

31. Visually there is some similarity between the marks in that the word 'Steps' in the applied for mark is the same as the word 'STEPS' in the earlier mark. However, I bear in mind that 'Order My Steps shoe boutique' is much longer than STEPS per se and that 'Steps' in the applied for mark is not represented as a standalone independent element. Overall the marks are visually similar to a low degree.

## **Aural similarity**

32. The opponent is correct to point out that the respective 'STEPS'/'Steps' aspects of the marks are aurally identical. However, as the contested mark will not be referred to solely by its 'Steps' element, the degree of aural similarity between 'STEPS' and 'Order My Steps shoe boutique' would be low overall.

## **Conceptual similarity**

33. The earlier mark consists of the single word 'STEPS'. The Oxford English dictionary contains the following definitions:

### **Step:**

1. an act or movement of putting one leg in front of the other in walking or running:
2. a flat surface, especially one in a series, on which to place one's foot when moving from one level to another
3. a measure or action, especially one of a series taken in order to deal with or achieve a particular thing

34. When applied to *footwear* in class 25, the single word 'STEPS' will immediately convey the idea of a person walking. In the absence of any other element in the earlier mark which may suggest a different connotation of the word 'STEPS', this is also the most obvious meaning of the word and the significance that, I believe, the average consumer is likely to give to the mark when applied to the remaining goods i.e. *clothing* and *headgear* in class 25 and *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; whips, harness and saddlery in class 18.*

35. Conceptually, therefore, the opponent's 'STEPS' mark will instantly convey the idea of a person walking. As for the contested mark, which I have concluded forms a unit, it will be seen as a phrase whose conceptual hook is of something unusual. The fact that both marks share a word element does not always result in the marks being regarded as conceptually similar: it is settled case-law that the marks must be compared without dismemberment or excision. In the present case, when used in the context of 'Order My Steps shoe boutique', the word 'Steps' derives its significance (whatever that might be) from the other components of the mark. Bearing in mind that it is only concepts that are capable of immediate grasps that are relevant<sup>1</sup>, I conclude that any conceptual similarity between the marks created by the presence of the word 'Steps' in the contested mark must be of a low degree.

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

36. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated at paragraphs 22 and 23 that:

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

In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not

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<sup>1</sup> *Ruiz Picasso v OHIM* [2006] e.c.r. –I-643; [2006] E.T.M.R. 29

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).”

37. As no evidence of use has been filed by the opponent, I have only the inherent distinctive character to consider. The earlier mark consists of the single word ‘STEPS’. The word ‘STEPS’ is clearly allusive in relation to *footwear* in class 25, in respect of which I find that it has a below average degree of distinctive character. In relation to the remaining goods, i.e. *clothing and headgear* in class 25 and *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; whips, harness and saddlery* in class 18, the word ‘STEPS’ is not allusive or descriptive and I find that it is possessed of an average degree of distinctive character.

### **Likelihood of confusion**

38. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective goods and vice versa. I must also keep 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 marks and must instead rely upon the imperfect picture of them he has retained in his mind.

39. I found that with the exception of *insoles [for shoes and boots]*, which are similar to a medium degree, all of the contested goods are identical to the goods covered by the earlier registration which, of course, represents a factor in favour of the opponent. However, this is counterbalanced by the fact that although the marks share the

common element 'STEPS'/'Steps', they are, as wholes, visually, aurally and conceptually similar only to a low degree. The purchasing process will be primarily visual with the average consumer deploying, at least, an average degree of attention and I have assessed the distinctive character the earlier mark as being, at best, average. In those circumstances, I find that the differences between the marks are such that there is **no likelihood of direct confusion** as the average consumer will not mistake the contested 'Order My Steps shoe boutique' with the STEPS mark.

40. That being the case, the question is whether the average consumer would believe from the identity (or similarity) of the goods and the presence of the word 'Steps' in the contested mark, that the goods come from economically connected undertakings. I am not convinced that s/he would. This is because the component 'Steps' in the contested mark does not retain an independent distinctive role and is unlikely to be seen as an independent element identifying the name of the trader from which the goods originate. **There is no likelihood of indirect confusion.**

## **CONCLUSION**

41. The opposition fails.

## **COSTS**

40. Ms Oyiadjo has been successful and is entitled to a contribution towards her costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 2 of 2016. As Ms Oyiadjo is unrepresented, at the conclusion of the evidence rounds the tribunal invited her to indicate whether she intended to make a request for an award of costs, and if so, to complete a pro-forma indicating a breakdown of her actual costs, including providing accurate estimates of the number of hours spent on a range of given activities relating to the prosecution of the opposition; it was made clear to Ms Oyiadjo that if the pro-forma was not completed "no costs will be awarded". As Ms Oyiadjo has not responded to that invitation, I will make no award of costs in her favour.



**Dated this 7<sup>th</sup> day of December 2017**

**Teresa Perks**

**For the Registrar**

**The Comptroller – General**