

**O-059-19**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF:**

**TRADE MARK APPLICATION No. 3246172  
BY RONAK HAJIYANI  
TO REGISTER THE FOLLOWING TRADE MARK  
IN CLASS 25**



**AND**

**OPPOSITION THERETO (NO. 410888)  
BY PUMA SE**

## Background and pleadings

1) Ronak Hajiyani ('the applicant') applied to register the following trade mark in the UK on 25 July 2017, claiming a date of priority of 24 July 2017 from its Indian trade mark registration no. 3598518.



2) The application includes the following disclaimer: "Registration of this mark shall not give right to the exclusive use of the word London". It was accepted and published in the Trade Marks Journal on 25 August 2017 in respect of the following class 25 goods:

*Class 25: Footwear [excluding orthopedic footwear]; Footwear for men; Footwear for women; Footwear.*

3) Puma SE ('the opponent') oppose the trade mark on the basis of Section 5(2)(b)<sup>1</sup> of the Trade Marks Act 1994 ('the Act'). This is on the basis of its earlier UK Trade Mark ("the earlier mark"). Pertinent details of the earlier mark are below:

UKTM No: 1223225



Mark:

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<sup>1</sup> The opposition initially also relied upon sections 5(3) and 5(4)(a) of the Act but since the opponent did not submit evidence in chief, the claims were dismissed (the official letter of 5 June 2018 refers).

Date of filing: 20 July 1984

Publication date: 5 February 1986

Date of entry in register: 20 July 1984

Goods:

*Class 18: Articles included in Class 18 made of leather or of imitation leather; trunks (luggage), travelling bags, carrying bags and cases included in Class 18*

*Class 24: Textile articles included in Class 24.*

*Class 25: Articles of clothing; parts and fittings included in Class 25 for footwear.*

*Class 28: Gymnastic and sporting articles (other than clothing)*

4) A hearing took place via video-link on 8 January 2019, with the opponent represented by Mr Alan Fiddes of Urquhart-Dykes & Lord LLP. The applicant did not attend.

5) The opponent argues that the respective goods are identical. It also argues that since the dominant and distinctive element of each mark is the “Leaping Cat”, the marks are similar. It is noted that in the statement of case attached to the TM7, it refers to European Union Trade Mark registration number 15108848 stating “that the specification of goods for the marks are identical in that the Applicant’s Goods are alcoholic beverage...”. At the hearing Mr Fiddes confirmed that the opponent is not relying upon this earlier registration.

6) The applicant filed a counterstatement denying the claims made. The opponent’s mark constitutes an earlier mark in accordance with section 6 of the Act and is old enough to be the subject of the proof of use conditions contained in section 6A of the Act, however the applicant stated that it did not require the opponent to provide evidence of such use.

7) The applicant filed evidence and the opponent filed evidence in reply. This will be summarised to the extent that it is considered appropriate/necessary.

## **Evidence**

### **Applicant's evidence**

8) This consists of a witness statement from the applicant, Mr Ronak Hajiyani. The witness statement essentially consists of submissions on whether a likelihood of confusion exists and makes reference to various case law. I shall not summarise the submissions made but I have read them and shall bear them in mind when reaching my decision.

### **Opponent's evidence**

9) The opponent did not file any evidence in chief, but did submit evidence in reply. This comprises of a witness statement of Mr Alan Fiddes, the opponent's professional representative. The witness statement includes the following factual statements about the opponent:

- It is a German company which was established in 1948. Since such date it has made extensive use of its 'leaping tiger'.
- It is the third largest sportswear brand in the world.
- Its global turnover for 2017 was in the region of €4.1billion.
- It operates in 120 countries and employs more than 13,000 people.

10) Mr Fiddes also lists judgments from the EUIPO, Boards of Appeal and CJEU which (he claims) the "Opponent has established its reputation to the satisfaction of the Tribunals in issue"<sup>2</sup>.

## **DECISION**

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

11) Section 5(2)(b) of the Act is as follows:

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<sup>2</sup> Copies of the judgments were attached to the witness statement as exhibit 4.

“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”.

## **Case law**

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

### *The principles*

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

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

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

## Comparison of goods and services

13) In the judgment of the Court of Justice of the European Union ('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”.

14) 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 uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) 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;
- (f) 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.

15) The respective goods are as follows:

<b>Applicant's goods</b>	<b>Opponent's goods</b>
<i>Class 25: Footwear [excluding orthopedic footwear]; Footwear for men; Footwear for women; Footwear.</i>	<i>Class 18: Articles included in Class 18 made of leather or of imitation leather; trunks (luggage), travelling bags, carrying bags and cases included in Class 18</i>  <i>Class 24: Textile articles included in Class 24.</i>  <i>Class 25: Articles of clothing; parts and fittings included in Class 25 for footwear.</i>  <i>Class 28: Gymnastic and sporting articles (other than clothing)</i>

16) During the hearing Mr Fiddes agreed that the opponent's best case lay with its earlier class 25 goods. I shall proceed by making the comparison based on the earlier class 25 goods. It follows that if the opponent is unsuccessful based on these goods it is in no better position relying upon the other goods and services and further analysis would not be necessary.

17) Mr Fiddes argued that if the respective class 25 goods are not identical then they are clearly highly similar. As I stated in the hearing, it is clear to me that they are not identical. Neither the earlier *clothing or parts and fittings included in Class 25 for footwear* are the same as the applied for goods (these generally being varying forms of *footwear*).

18) The earlier *parts and fittings included in Class 25 for footwear* are goods which form specific parts or fittings which are used to form the final footwear. These goods



are not finished articles and are not necessarily purchased by the same end user. In *Les Editions Albert Rene v OHIM*, Case T-336/03, the General Court found that:

“61... The mere fact that a particular good is used as a part, element or component of another does not suffice in itself to show that the finished goods containing those components are similar since, in particular, their nature, intended purpose and the customers for those goods may be completely different.”

19) The applicant’s goods essentially consist of footwear. These have a similar purpose to the earlier clothing in that they are used to cover and protect the body. The respective goods can share channels of trade and can be produced by the same manufacturers. Further they would be sold through the same or similar trade channels. I find them to be similar to a medium degree.

20) Mr Fiddes also argued that the average consumer of footwear will encounter parts and fittings for footwear (for example, soles), in the same retail outlets. Soles and inners for footwear, for example, are generally available from retailers specialising in footwear. Therefore, they are often provided in the same establishments that sell footwear. I also find that there is a degree of complementarity between the respective goods. Therefore, I find these goods to be similar to the opponent’s earlier goods, to a medium degree.



### **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 the 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.”

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

23) The respective trade marks are shown below:

Applicant's mark	Earlier mark
	

24) The earlier mark consists exclusively of a blacked out, or silhouette, “big cat” leaping to the left. The “big cat” or Panthera genus, would appear to be a puma but it is unlikely that the average consumer would be aware of the precise species. Since this is the only component of the earlier mark, it is the only thing that contributes to the overall impression of the trade mark.

25) The applicant's trade mark also contains a “big cat” leaping, though this time it is to the right. The “big cat” is not blacked out but contains various shaded stripes which have no obvious correlation. It is directly above the words NICO and LONDON which are placed to the right of another device which I do not consider to be particularly distinctive. I consider the figurative “big cat” to contribute roughly equal

weight in the overall impression of the mark as the words (in particular NICO), with the additional device being relatively negligible.

26) Visually, the fact that the respective marks both contain a leaping “big cat” indicates that there is a degree of similarity between the marks. However, the earlier mark is a silhouette, leaping to the left and at a 45-degree angle, whereas the applicant’s mark contains stripes, leaping to the right and is at a flatter angle. Further, the applicant’s mark contains the words NICO LONDON and a device which has no counterpart in the earlier mark. Many of the visual differences I have listed may be negligible or have little individual visual impact, however they all contribute to the overall visual differences between the marks. Having regard to the similarities and differences, together with the elements that contribute to the overall impression of the respective marks, I consider them to be visually similar to a low degree.

27) Aurally, Mr Fiddes argues that the earlier mark would be referred to as “Puma”. This is based on his assumption that given the opponent’s “reputation”, consumers will be aware of the earlier mark as originating from it and being the Puma brand. I am unable to make such an assumption and must assess both marks on a notional basis. The applicant’s mark will be read and spoken as “NICO” or “NICO LONDON”. The earlier mark has no verbal counterpart and even if they were to pronounce it as a “big cat”, “leaping cat” or, even, “puma”, they would not pronounce it as “NICO”, “NICO LONDON” or anything similar. Therefore, there is no aural similarity.

28) Conceptually, the marks are similar insofar as they both feature a “big cat” which is leaping. Whether the cat is leaping to the left or right does not alter this conceptual similarity. However, the applicant’s mark includes the words “NICO” may be viewed and remembered as a name. This concept is not present in the opponent’s mark. However, I find that there is a low level of conceptual similarity between the marks due to the existence of both marks containing a “big cat” leaping.

### **Average consumer and the purchasing act**

29) The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood

of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

30) 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.”

31) The average consumer of clothing and footwear will predominantly be the general public but could also be a professional public either buying on behalf of others or in respect of the parts and fittings for footwear, they could be professionals such as shoe smiths.

32) The selection of goods will largely be a visual process, as the average consumer (mostly the general public) will want to view the products prior to purchase. This will either be done in-store, on the internet or in catalogues. However, I do not discount aural recommendations following, for example, consultation with sales assistants. Professional consumers are also likely to purchase the goods following a visual inspection, though I do not discount aural recommendations.

33) As to the level of attention paid when purchasing the goods, I consider the average consumer's level of attention will be normal.

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

34) The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier marks, based either on inherent qualities or because of use made, the greater the likelihood of confusion (see *Sabel BV v Puma AG*, paragraph 24). 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).”

35) The opponent’s earlier mark is the device of a ‘big cat’ leaping. It has no obvious link or association with the goods at issue. However, the mark is not highly unusual or striking. I therefore find that it has an average degree of inherent distinctive character.

36) The opponent claims to have an enhanced degree of distinctive character by virtue of the use made of the mark. The opponent's evidence states that it is the third largest sportswear brand in the world with a global turnover in the region of €4.1billion. It also seeks to rely upon various judgments which recognise its reputation in sports clothing and footwear sector. In view of the use made of the earlier mark, I find that it is enhanced to an above average degree.

### **GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion**

37) Confusion can be direct (when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks/goods down to the responsible undertakings being the same or related). To determine whether there is a likelihood of confusion I now draw together my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the factors I set out in paragraph 12.

38) I have found that the respective goods are similar to a medium degree. I have found that the marks are visually and conceptually similar to a low degree. There is no aural similarity. The average consumer is the general public who will purchase the goods following a visual inspection, though I do not discount the professional public nor aural recommendations. The level of attention paid is normal. I have also found that the earlier mark has an above average degree of distinctive character by virtue of the use made of it.

39) I acknowledge that having an enhanced degree of distinctive character does increase the likelihood of confusion. However, given the low degree of visual similarity, even when taking imperfect recollection into account, I do not consider there to be a likelihood of direct confusion, i.e. I find that consumers will not mistake one mark for the other.

40) With regard to indirect confusion, I take into account the comments made in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, by Mr Iain Purvis Q.C., as the Appointed Person:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognised that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

41) Taking all of the relevant factors into account, I find that there is no likelihood of indirect confusion. The presence of the words “NICO LONDON” in the application and the differences between the respective “big cats” are sufficient for me to conclude that the average consumer would not assume that goods come from the same economic undertakings. The opposition fails.

## **Conclusion**

**42) Subject to appeal, the opposition is rejected and the application shall proceed to registration for all of the applied for goods.**

## **COSTS**

43) The applicant has been successful and is entitled to a contribution towards its costs. In the circumstances I award the applicant the sum of £300 as a contribution towards the cost of the proceedings. The sum is calculated as follows and takes into account that the applicant’s ‘evidence’ was essentially made up of submissions and the opponent’s evidence was light and would have therefore taken little time to consider:

Considering the opponent’s statement of grounds

and preparing a counterstatement	£200
Preparing evidence and considering the other side's evidence	£100
<b>Total</b>	<b>£300</b>

44) I therefore order Puma SE to pay Ronak Hajiyani the sum of £300. The above sum should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

**Dated this 28th day of January 2019**

**Mark King**  
**For the Registrar,**  
**The Comptroller-General**