

**O-284-19**

**TRADE MARKS ACT 1994  
IN THE MATTER OF APPLICATION No. 3294889  
BY IBRAHIM SESAY  
TO REGISTER THE TRADE MARK**



**IN CLASS 25**


**AND  
IN THE MATTER OF OPPOSITION  
THERE TO UNDER No. 413523 BY  
W-D APPAREL COMPANY LLC**

## BACKGROUND

1) On 7 March 2018, Ibrahim Sesay (hereinafter the applicant) applied to register the trade mark shown on the front page of this decision in respect of the following goods in Class 25: Athletic clothing; Athletic footwear; Baseball caps; Baseball caps and hats; Baseball hats; Baselayer bottoms; Baselayer tops; Bath robes; Bathrobes; Beach hats; Beanie hats; Beanies; Belts [clothing]; Belts for clothing; Bikinis; Bomber jackets; Bottoms [clothing]; Boys' clothing; Bucket caps; Camouflage jackets; Camouflage pants; Caps; Caps being headwear; Caps [headwear]; Casual clothing; Casual footwear; Casual jackets; Casual shirts; Casual trousers; Casual wear; Casualwear; Children's clothing; Childrens' clothing; Children's footwear; Children's headwear; Children's outerclothing; Children's wear; Clothes; Clothes for sport; Clothes for sports; Clothing; Clothing for babies; Clothing for children; Clothing for infants; Clothing for men, women and children; Clothing for sports; Clothing made of leather; Coats; Coats for men; Denim coats; Denim jackets; Denim jeans; Denim pants; Denims [clothing]; Fleece shorts; Fleece tops; Fleeces; Football shirts; Fur coats; Fur coats and jackets; Fur jackets; Gilets; Hats; Headwear; Hooded sweat shirts; Hooded sweatshirts; Hooded tops; Hoodies; Jackets; Jeans; Jogging bottoms; Jogging bottoms [clothing]; Jogging pants; Jogging sets [clothing]; Jumpers; Jumpers [sweaters]; Ladies' clothing; Men's clothing; Menswear; Parkas; Shorts; Shorts [clothing]; Short-sleeve shirts; Short-sleeved shirts; Short-sleeved T-shirts; Swim shorts; Swim trunks.

2) The application was examined and accepted, and subsequently published for opposition purposes on 25 May 2018 in Trade Marks Journal No.2018/021.

3) On 24 August 2018 W-D Apparel Company LLC (hereinafter the opponent) filed a notice of opposition. The opponent is the proprietor of the following trade mark:

Mark	Number	Dates of filing and registration	Class	Specification
	EU 509992	11.04.97 14.12.98	25	Footwear, clothing and headgear.

4) The ground of opposition is in summary:

- a) The opponent contends that the mark applied for and its mark are similar and that the goods applied for are identical or highly similar to those for which its mark is registered. As such it contends that the application offends against Section 5(2)(b) of the Act.

5) On 30 October 2018 the applicant filed a counterstatement which denies that marks are similar.

6) Neither side filed evidence; both parties seek an award of costs in their favour. Neither side wished to be heard, although the opponent filed written submissions which will be referred to as and when necessary.

## **DECISION**

7) The sole 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.”

8) 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.”

9) The mark relied upon by the opponent is clearly an earlier trade mark.

10) 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

11) As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

12) The goods at issue in these proceedings are, broadly speaking, clothing footwear and headgear. The average consumer for such goods will be the public at large (including businesses). Such goods will typically be offered for sale in retail outlets, in brochures and catalogues as well as on the internet. The initial selection is therefore primarily visual. I accept that more expensive items of clothing, footwear and headgear etc may, for example, be researched or discussed with a member of staff or be made to measure. The latter, along with personal recommendations, bring aural considerations into play. 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.”

13) 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.”

14) 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 for personal use such as socks/slippers/caps the average consumer will pay attention to considerations such as size, colour, fabric and cost. **Overall the average consumer for these types of goods is likely to pay a medium degree of attention to the selection of items of clothing, footwear and headgear.**

15) Items of clothing, footwear and headgear are also purchased by businesses (uniforms, corporate image etc). It is normal to assume that businesses take slightly more care in making decisions regarding the purchase of goods as their survival may depend upon making the correct choice both economically and for the image of the business. **To my mind, the average business consumer for these types of goods is likely to pay at least a medium degree of attention to the selection of items of clothing, footwear and headgear.**

## Comparison of goods

16) 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”.

17) In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the GC stated that:

“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 für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

18) It is clear that the opponent’s specification of “clothing, footwear and headgear” encompasses the whole of the applicant’s specification. **The goods are therefore identical.**



## Comparison of trade marks

19) 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.”

20) It would be wrong, therefore, to artificially 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:

Applicant's trade mark	Opponent's trade mark
	

21) The applicant contends:

“the two logos are NOT the same. Kodiak (opposition logo) has a claw in the logo, it's black and white, it's a grizzly (aggressive bear), also has 2 downward arrows pointing down and the background seems to be a semi-circle and a line. If you check my logo (RespetarAlNiño Defendant logo) I have no claw or hands showing in the logo, my logo

has colours in it Grey, Red, Brown & White, the writing is in Spanish and it is more detailed than Kodiak (opposition logo). According to Kodiak (opposition logo) customers will be confused that the two logos are the same if that was the case what about Kenzo?? Because I really don't understand how two logos with different writings and detailed can be the same with all due respect to Kodiak (opposition logo) there are not the same bears and also have different meanings.”

22) The opponent contends

“20. The Applicant's sign is a design mark depicting the head of a bear with a Spanish word element in a small font, namely *"Respetar Al Niño"*.

21. The Opponent submits that the dominant element of the Applicant's sign is the BEAR design element. This element is much larger and more prominent than the word element which is displayed in a small font and situated underneath and to the right of the BEAR design.

22. The Opponent also submits that the secondary element word element is written in cursive font and therefore is not clear to the public. In addition, consumers in the United Kingdom who are predominantly English speaking are not likely to recognise or understand the meaning of the Spanish words and so will overlook this element and will be more likely to remember the BEAR design element than the secondary word element of the sign.

*WDAC's BEAR (Design) mark*

23. WDAC's BEAR (Design) mark is a figurative mark consisting of the design image of a head of a bear in conjunction with a word element in plain, minimally stylised font and situated below the main BEAR design element.

24. The Opponent submits that the dominant and distinctive element of the earlier BEAR

(Design) mark is the image of the bear. This BEAR design element is the focal point of the mark in comparison to the word element and has no meaning in relation to the relevant goods covered by the earlier BEAR (Design) mark from the perspective of the relevant consumer. It is therefore highly distinctive in relation to those goods, namely footwear, clothing and headgear.

25. Visually, the Applicant's BEAR (Design) sign is closely similar to the Opponent's BEAR (Design) mark. Both marks use the image of a bear head, facing forward with an open, snarling mouth. This structure and stylisation renders the marks visually similar overall: given the distinctiveness of the Opponent's bear head design and the dominance of the bear head design as used in the marks to be compared, the word elements of the marks do not have a strong impact on the consumer and do little to distinguish the marks.

26. The Applicant's counterstatement that *"the background [of the Opponent's mark] seems to be a semi circle and a line"* is not understood: these elements form part of the shape of the Bear element only. Nor are there two *"downward arrows pointing down"* in the Opponent's mark as asserted by the Applicant.

27. A phonetic comparison is only possible where both trade marks can be pronounced or have a sound. As set out at paragraph 22 above, consumers in the United Kingdom (who are predominantly English speaking) are not likely to recognise or understand the meaning of the Spanish word element which will, as a result, be overlooked by consumers. The Opponent therefore submits that no phonetic comparison of the Applicant's BEAR (Design) sign and the Opponent's BEAR (Design) mark is possible.

28. Signs are conceptually similar when they are perceived as having the same or analogous semantic content (C-251/95, *Sabel*). As set out above, the dominant element of both the Applicant's BEAR (Design) sign and the Opponent's BEAR (Design) mark are the BEAR design elements. Conceptually therefore, both images share a link and evoke the same meaning: that of an aggressive bear.

29. The Opponent submits that, taking into account the above visual and conceptual

coincidences, the Applicant's BEAR (Design) sign is closely similar to the Opponent's BEAR (Design) mark.”

23) The applicant contends that his mark is in colour whilst the opponent's mark is in black and white. However, neither has any colour limitation and so normal and fair use of each mark would allow the applicant to use a black and white version of its mark and for the opponent to use a colour version of its mark. I accept that the opponent's mark is showing a claw and the curve of the bear's body also appears. However, to my mind the dominant and distinctive element of both marks is a bear's snarling head, showing its teeth in an aggressive manner. The opponent's mark has the word “Kodiak” underneath it in large print, but given that this is the name of the Alaskan brown bear it would be seen as merely reinforcing the “bear” motif. The words on the applicant's mark are in a small cursive font, which is not easily read. It would appear to be in Spanish but no translation has been provided. Given the lack of linguistic ability amongst the general population of the UK it is doubtful if many would have any idea of what the phrase means. None of the images or words have, as far as I am aware, any meaning in relation to the goods under consideration. There are obvious visual differences but far more visual similarities. Phonetically, the marks are completely different. Conceptually, the absence of understanding of the wording in the applicant's mark would lead consumers to regard it as simply an aggressive bear mark, similarly, the opponent's mark with its naming the type of bear (Kodiak) will reinforce that it is an aggressive bear mark. Conceptually the marks are identical. **Overall the marks have at least a medium degree of similarity.**

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

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).”

25) The opponent has not provided any evidence of sales for its goods in the UK, as such the opponent’s mark **cannot benefit from enhanced distinctiveness through use**. The opponent’s mark consists of the word KODIAK and the device of a snarling Kodiak bear. It is not descriptive of the goods (clothing, footwear and headgear. **To my mind, the earlier mark has an average inherent distinctiveness.**

### **Likelihood of confusion**

26) In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent’s trade mark as the more distinctive the trade mark is, the greater the likelihood of confusion. 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 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 for the goods is a member of the general public including businesses who will select the goods by predominantly visual means, although I do not discount aural considerations and that they are likely to pay at least a medium degree of attention to the selection of said goods.
- the marks of the two parties have at least a medium degree of similarity.
- The opponent's mark has an average level of inherent distinctiveness and cannot benefit from an enhanced distinctiveness through use.
- the goods of the two parties are identical.

27) It is necessary to consider the likelihood of both direct and indirect confusion. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, Mr Iain Purvis Q.C. as the Appointed Person, explained that:

“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 recognized 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.

28) I also note that in *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he

pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

29) Given that the goods of the two parties are identical it is entirely possible that a consumer (even if they noticed the differences between the opponent's mark that they had seen previously and the applicant's mark) would simply believe that the mark had been updated. In view of all of the above and allowing for the concept of imperfect recollection there is a likelihood of consumers being confused, directly or indirectly, into believing that the goods applied for and provided by the applicant are those of the opponent or provided by an undertaking linked to it. **The opposition under Section 5(2) (b) therefore succeeds in respect of all the goods applied for by the applicant**

## **CONCLUSION**

30) The opponent was successful in its opposition to the application and as such is entitled to a contribution towards its costs.

Preparing a statement and considering the other side's statement	£300
Expenses	£200
Providing submissions	£800
<b>TOTAL</b>	<b>£1,300</b>

31) I order Ibrahim Sesay to pay W-D Apparel Company LLC the sum of £1,300. 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 23<sup>rd</sup> day of May 2019**

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