

BL O-416-19

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATIONS NO. 3319950 & 3320535
BY MORRIS JONES & ASSOCIATES LTD TO REGISTER:**



AS A TRADE MARK IN CLASSES 9 & 25

&

bon

AS A TRADE MARK IN CLASS 25

AND

**IN THE MATTER OF CONSOLIDATED OPPOSITIONS THERETO UNDER NOS.
413187 & 413188 BY FAISAL PATEL**

BACKGROUND & PLEADINGS

1. On 22 June and 26 June 2018, Morris Jones & Associates Ltd (“the applicant”) applied to register the trade marks shown on the cover page of this decision. Trade mark application no. 3319950 was applied for in relation to:

Class 9 - Earphones; Headphones; Headsets for mobile telephones; Headsets for telephones.

Class 25 - Athletic clothing; Athletics vests; Baseball caps and hats; Bathrobes; Headgear; Hoodies; Gymwear; Tracksuits; Babies' clothing; Beanie hats; Body warmers; Padded jackets; Vest tops; V-neck sweaters; Track jackets; Track suits.

Trade mark no. 3320535 was applied for in relation to:

Class 25 - Gymwear; Caps; Casualwear; Childrens' clothing; Clothes for sports; Hoodies.

Both applications were published for opposition purposes on 6 July 2018.

2. Both applications have been opposed by Faisal Patel (“the opponent”) under sections 3(6) and 5(2)(b) of the Trade Marks Act 1994 (“the Act”). Although both applications were originally opposed in full, in a letter dated 20 December 2018, the opponent indicated that he was no longer pursuing his objection to the goods in class 9 of no. 3319950. In relation to the objection based upon section 5(2)(b) of the Act, the opponent relies upon the following trade mark registration:

UK no. 3197765 for a series of two trade marks consisting of the word **DON** and the trade mark shown below:



which were applied for on 21 November 2016 and registered on 17 February 2017. The opponent indicates he relies upon all the goods and services for which his trade mark is registered i.e.

Class 3 - Soaps; Perfumery, essential oils, cosmetics, hair lotions; Dentifrices; Aftershave; After-shave lotions; Perfume; Perfumed body lotions; Musk (Perfumery).

Class 14 - Precious metals and their alloys; Jewellery, precious stones; Horological and chronometric instruments; Jewellery articles; Jewellery boxes; Jewellery cases; Jewellery, including imitation jewellery and plastic jewellery; Jewellery watches.

Class 25 - Clothing, footwear, headgear; Articles of sports clothing; Baseball caps; Beach clothes; Belts [clothing]; Belts for clothing.

Class 35 - Advertising; Business management; Business administration; Office functions; Retail and online retail services connected with the sale of perfumery, cosmetics, clothing, footwear, headgear and accessories therefor, spectacles, leatherware, namely leather clothing, footwear, headgear, leather bags, cases, suitcases, travelling bags, boxes, purses, wallets, credit card cases, belts and keycases, clocks and watches, jewellery, stationery.

3. In relation to no. 3319950, the opponent's objection under section 3(6) is expressed as follows:

"4. Prior to the filing of the Subject Application on 27 February 2018, the Applicant had filed United Kingdom Trade Mark Application No. 3292856 to

register the trade mark "DON and device" in classes 9 and 25 ("the First Application")

5. The Opponent filed a Fast Track opposition against the Applicant's Earlier Mark on 15 June 2018 under Section 5(2)(b) based on his United Kingdom Registration No. 3197765 that features the word DON...

6. The text of the Applicant's Mark was altered in the IPO on-line Register on 27 June 2018 from "Don" to "bon" and on 26 June 2018 the Opponent (sic) filed United Kingdom Trade Mark Application No. 3320535 to register the word mark "bon" for goods in Class 25 ("the Third Application").

7. The Opponent submitted a Notices of Threatened Opposition on 06 July 2018 against the Subject Application and the Third Application and shortly after the Subject Application had been filed the Opponent's solicitor wrote to the Applicant in a letter dated 25 June 2018.

8. The Opponent bases this opposition on the Earlier Trade Mark and also on the Applicant's actions and behaviour generally as detailed above.

12. The Opponent submits that the Subject Application was filed in bad faith. The sequence of events set out...show that after the Opponent had opposed the Applicant's First Application it filed the Subject Application for an identical mark for virtually identical goods in Classes 9 and 25. The Applicant then had the Registry alter the text of the Subject Application, presumably to prevent notification of the Subject Application to the Opponent under Rule 14(b)(2). The Opponent submits that this behavior of the Applicant, in full knowledge of the opposition filed against the Applicant's First Application, is an abuse of process. The Opponent further submits that this behaviour of the Applicant is dishonest judged by ordinary standards of honest people and falls short of the standards of acceptable commercial behavior."

4. In relation to no. 3320535, the opponent relies upon the same underlying facts, adding:

“14. The Opponent submits that it is likely that the goods of the Subject Application will be marketed and sold under the device trade mark that is the subject of the Second Application, which is virtually identical to the mark of the First Application, and that the behavior of the Applicant, in full knowledge of the opposition filed against its First Application, is an abuse of process. The Opponent further submits that this behaviour of the Applicant is dishonest judged by ordinary standards of honest people and falls short of the standards of acceptable commercial behaviour.”

5. The applicant filed counterstatements in which the basis of the oppositions is denied.

6. In these proceedings, the opponent is represented by L.J. Bray & Co; the applicant represents itself. Although only the opponent filed evidence, the applicant filed written submissions during the evidence rounds. While neither party requested a hearing, the opponent filed written submissions in lieu of attendance.

The opponent’s evidence

7. This consists of a witness statement from Faisal Patel, who explains he is the sole director and majority shareholder of Response Clothing Limited (“Response”) which is based in Blackburn and operates in the fields of design and wholesale of clothing. Mr Patel states that Response has been licensed by him to use the trade mark upon which he relies and “has spent considerable time and monies in creating a new range of clothing to be sold under the earlier trade mark”. He adds that a designer has been employed to work solely on the design and branding for this range and that a website is “also being prepared for the online sale of goods under the earlier trade mark”.

8. Exhibit FP1 consists of what Mr Patel describes as:

“4...a set of drawings and photographs of some of the designs for the DON clothing range produced by the designer. This range will include hoodies,

sportswear, gym wear and headgear, for example caps and beanies. Some of my designs also use the device of a crown...”

As far as I can tell, none of the pages provided in the exhibit are dated.

9. Having recounted the procedural history of the applicant’s first application, no. 3292856, to which I will return later in this decision and the filing of no. 3319950, Mr Patel provides as exhibits FP2 and FP3, copies of the Certificate of Filing issued by the IPO and the IPO’s “Event History” in relation to no. 3319950. Of these exhibits, Mr Patel states:

FP2:

“9...I note that when filing this Second Application online the Applicant chose not to enter the "word element" of the mark, which is requested when filing applications on-line via the IPO website.”

FP3:

“10...This shows that the text of the Second Application was updated on 27 June 2018 and the "word element" of the mark was input to read "bon". I believe that as a result of this text, the Earlier Trade Mark was not cited against the Second Application by its examiner and I received no official notification that this Second Application had been published.”

10. Exhibit FP4 consists of a copy of the examination report issued by the IPO on 2 July 2018 in relation to no. 3319950. Of this exhibit, Mr Patel states:

“11...This Examination Report confirms that my Earlier Trade Mark was not cited against the Second Application and on the same date as this Report the Applicant withdrew the Class 25 goods from the First Application, which is now registered in respect of "Headsets for mobile telephones" in class 9.”

11. Mr Patel further states:

“12. It is my belief that after I had opposed the First Application the Applicant purposely filed the Second Application for a virtually identical mark for virtually identical goods without detailing the word element of the mark purely to avoid my being officially notified of the Second Application. Why otherwise would the Applicant claim that the word element of the mark is "bon" and not "Don", as in the First Application? I believe that after the Examination Report of the Second Application was received, the Applicant thought it could secure a registration of the same mark for clothing in class 25 without my being notified and could avoid opposition proceedings by withdrawing the Class 25 goods from the first application.

15. The mark "bon" is only one letter different from my Earlier Trade Mark and easy to confuse with it aurally and visually. It is also my belief that the Applicant will use this trade mark in figurative forms wherein it will be perceived by the public as the mark "Don". I believe this is all the more likely because the Applicant has secured a registration of its "Don" mark via the First Application for goods in Class 9 and will want to use the same mark for its goods in class 25.”

12. That concludes my summary of the opponent's evidence to the extent I consider it necessary.

DECISION

13. The oppositions are based upon sections 3(6) and 5(2)(b) of the Act which read as follows:

“3(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.

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.”

14. 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), 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,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

15. The trade mark relied upon by the opponent qualifies as an earlier trade mark under the above provisions. Given the interplay between the dates on which the opponent’s trade mark was registered and the publication date of the applications for registration, this earlier trade mark is not subject to the proof of use provisions.

The objection based upon section 5(2)(b) of the Act

16. I shall deal first with the above objection.

Case law

17. The following principles are gleaned from the decisions of the courts of the European Union 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 greater 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.

Comparison of goods

18. Although in his Notices of opposition the opponent relies upon all the goods and services in his registration, when comparing the goods and services in his written submissions, the opponent only refers to his goods in class 25 and to his “Retail and online retail services connected with the sale of...clothing, footwear, headgear...” in class 35. For present purposes it is only necessary for me to consider the opponent’s goods in class 25. Proceeding on that basis, the competing goods are as follows:

The opponent’s goods in class 25	The applicant’s goods in class 25
Clothing, footwear, headgear; Articles of sports clothing; Baseball caps; Beach	950:

<p>clothes; Belts [clothing]; Belts for clothing.</p>	<p>Athletic clothing; Athletics vests; Baseball caps and hats; Bathrobes; Headgear; Hoodies; Gymwear; Tracksuits; Babies' clothing; Beanie hats; Body warmers; Padded jackets; Vest tops; V-neck sweaters; Track jackets; Track suits.</p> <p>535:</p> <p>Class 25 - Gymwear; Caps; Casualwear; Childrens' clothing; Clothes for sports; Hoodies.</p>
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19. In its submissions, the applicant states:

“The applicant will solely be involved in gym clothing only i.e. leggings, tops, tracksuits used for gym related activities.”

20. In *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P, the Court of Justice of the European Union (“CJEU”) stated:

“59. As regards the fact that the particular circumstances in which the goods in question were marketed were not taken into account, the Court of First Instance was fully entitled to hold that, since these may vary in time and depending on the wishes of the proprietors of the opposing marks, it is inappropriate to take those circumstances into account in the prospective analysis of the likelihood of confusion between those marks.”

21. Even if paragraph 19 reflects the applicant’s current intentions for the type of goods upon which it intends to use its trade marks, it does not assist it for the reasons explained in *Devinlec*. However, even if its specifications had been limited to reflect the intended purpose of its goods i.e. items of gym clothing, as the opponent’s specification includes the term “articles of sports clothing”, it would not have assisted

the applicant in any case. Regardless, what I must do is compare the words in the competing specifications as they appear on the Trade Marks Register.

22. In reaching a conclusion, I remind myself of the comments of the General Court (“GC”) in *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05, in which it 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 the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

23. A number of terms in the applicant’s specifications find exact counterparts in the opponent’s specification, for example, “headgear” and “baseball caps”; these goods are literally identical. The opponent’s specification also includes, inter alia, the terms “clothing”, “footwear” and “headgear”. As cumulatively these terms would include all of the goods in the applicant’s specifications, the competing goods are to be regarded as identical on the principles outlined in *Meric*.

The average consumer and the nature of the purchasing act

24. 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 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.”

25. The average consumer of the goods at issue is a member of the general public. As a member of the general public will, for the most part, self-select such goods from the shelves of a bricks-and-mortar retail outlet or from the equivalent pages of a website or catalogue, visual considerations are likely to dominate the selection process. That said, as such goods may also be the subject of, for example, word-of-mouth recommendations or oral requests to sales assistants (both in person and by telephone), aural considerations must not be forgotten.


26. As to the degree of care the average consumer will display when selecting the goods at issue, the cost of such goods can vary considerably. However, as the average consumer will be alive to factors such as cost, size, colour, material and compatibility with other items, the average consumer can, in my view, be expected to pay at least an average degree of attention to their selection. As the cost and/or importance of the item increases, so too is likely to be the degree of care paid to its selection.

Comparison of trade marks

27. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade 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.”

28. 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 they create. The trade marks to be compared are:

Opponent’s trade marks	Applicant’s trade marks
 <p>And:</p> <p>DON</p>	<p>950:</p>  <p>And:</p> <p>535:</p> <p>bon</p>

29. Although the opponent still relies upon his series of two trade marks shown above, in his submissions, he only refers to the word “DON” presented in block capital letters. I take that approach as an indication that he considers that trade mark

to represent his best case. As the other trade mark in the series contains a device element, the words "REDEFINING REFINEMENT" and a three character combination in which the final two characters are clearly the letters "O" and "N" but in which the identity of the first character is ambiguous, the opponent's approach appears sensible and it is on that basis I intend to proceed.

The opponent's trade mark

30. The opponent's trade mark consists of the word "DON" presented in block capital letters. The word "DON" will be well-known to the average consumer. As no part of this word is highlighted or emphasised in any way, the overall impression it conveys and its distinctiveness lies in the single word of which it is composed.

Application no. 3319950

31. This trade mark consists of a number of components. The first is a black square. Although this component will contribute to the overall impression conveyed, as it acts as a background upon which the other components in the trade mark are presented, it has very little, if any, distinctive character. The second component is a stylised device of a crown presented in gold. While its size and positioning within the context of the trade mark as a whole ensures it will make a significant contribution to the overall impression conveyed, as the use of crown devices are, in my experience, ubiquitous in all areas of trade, any distinctiveness it may possess will, in my view, be modest at best. I should add that I am satisfied that the average consumer's experience of such devices is likely to be much like my own. The final component appears below the crown device and is integrated into it. It consists of three conjoined upper case characters presented in gold in a slightly stylised but unremarkable script. Despite their slight stylisation, they will, in my view, be readily understood by the average consumer as the letters "D", "O" and "N". Although clearly subordinate to the crown device they will, nonetheless, make an important distinctive contribution to the overall impression the trade mark conveys.

Application no. 3320535

32. This consists of the word “bon” presented in standard lower case letters. Like the opponent’s trade mark, as no part of this word is highlighted or emphasised in any way, the overall impression it conveys and its distinctiveness lies in the single word of which it is composed

33. Having reached the above conclusions, I will now conduct a separate visual, aural and conceptual comparison in relation to each of the applicant’s trade marks.

The comparison with application no. 3319950

The visual comparison

34. The only point of similarity between the competing trade marks is in respect of the word “DON”. Despite the presence of, inter alia, the gold crown device in the applicant’s trade mark, the fact that the word “DON” is the only component in the opponent’s trade mark and, despite being presented in gold and integrated into the crown device, an identifiable component in the applicant’s trade mark, it results in what I regard as a higher than medium degree of visual similarity between the competing trade marks.

The aural comparison

35. As “DON” is a word that will be well-known to the average consumer, the pronunciation of the opponent’s trade mark is entirely predictable. As for the applicant’s trade mark, it is well established that when a trade mark consists of a combination of words and figurative components, it is by the word components that the trade mark is most likely to be referred to. As the applicant’s trade mark is most likely to be referred to by the word “DON”, the competing trade marks are to be regarded as aurally identical.

The conceptual comparison

36. As I mentioned earlier, the word “DON” will be well-known to the average consumer. It may convey a number of meanings, for example, a shortening of the forename DONALD, a university lecturer or a mafia figure. The crown device in the applicant’s trade mark is likely to evoke the concept of royalty. Although the concept of royalty is alien to the opponent’s trade mark, whatever meaning the average consumer attributes to the word “DON”, it is likely to attribute the same meaning to that component of both party’s trade marks, resulting in what I consider to be a fairly high degree of conceptual similarity.

The comparison with application no. 3320535

The visual comparison

37. The competing trade marks consist of the words “DON” and “bon” respectively. Although the applicant’s trade mark is presented in lower case, as normal and fair use would include its use in upper case i.e. “BON”, that difference does not assist the applicant. As both trade marks consist of three letters in which the last two letters are the same but in which the first letters differ, it results in at least a medium degree of visual similarity between them.

The aural comparison

38. In its submissions, the opponent states:

“7...and readily confusable aurally given the similarity in the way a soft “b” and soft “d” are pronounced when followed by the vowel “o”.”

Both trade marks consist of single syllable words with the same endings. Although the articulation of the first letter differs, the competing trade marks are aurally similar to at least a medium degree.

The conceptual comparison

39. I have already outlined above the various conceptual messages likely to be conveyed to the average consumer by the word “DON”. As the word “bon” appears in the French phrase “bon appétite” (the meaning of which is, in my view, likely to be well-known to some average consumers in the UK), the word “bon” alone may be understood by such consumers as meaning “good”. However, for many average consumers the word is unlikely to convey any concrete conceptual message. Whilst the word “DON” is likely to convey the various conceptual messages mentioned, the word “bon” will either convey a different conceptual message or no concrete conceptual message at all.

Distinctive character of the earlier trade mark

40. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

41. At exhibit FP1, the opponent has provided evidence of various items of clothing bearing what appears to be elements of the stylised version of his trade mark (I say appears because the images provided are of poor quality). However, as no evidence has been provided of, for example: when the trade marks were first used, where they have been used, what if any turnover has been generated under the trade marks or sums spent on bringing the trade marks to the average consumer’s attention, the evidence filed does not assist him. I have, as a consequence, only the inherent characteristics of his “DON” trade mark to consider. Although a well-known word with a range of well-known meanings, as far as I am aware (and there is no evidence or

submissions to the contrary), the word “DON” is neither descriptive of or non-distinctive for the goods upon which the opponent relies. As a consequence, it is, in my view, a trade mark possessed of at least an average degree of inherent distinctive character.

Likelihood of confusion

42. 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 it 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.

43. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods down to the responsible undertakings being the same or related.

44. Earlier in this decision I reached the following general conclusions which apply to both oppositions:

- The competing goods are to be regarded as identical;
- The average consumer is a member of the general public who, whilst not ignoring aural considerations, is likely to select such goods by predominantly visual means whilst paying at least an average degree of attention during that process;

- The overall impression conveyed by the opponent's "DON" trade mark and its distinctiveness lies in the single word of which it is composed;
- The opponent's DON trade mark is possessed of at least an average degree of inherent distinctive character.

The comparison with application no. 3319950

- Notwithstanding the presence of a stylised device of a crown, the letters "DON" make an important distinctive contribution to the overall impression conveyed;
- The competing trade marks are visually similar to a higher than medium degree, aurally identical and conceptually similar to a fairly high degree.

The comparison with application no. 3320535

- The overall impression conveyed by the trade mark and its distinctiveness lies in the single word of which it is composed;
- The competing trade marks are visually and aurally similar to at least a medium degree and are either conceptually different or, if not conceptually different, the applicant's trade mark will convey no concrete conceptual message.

Likelihood of confusion with application no. 3319950

45. I begin by reminding myself that identical goods are involved and that such goods will be predominantly selected by visual means. When considered in the context of an average consumer paying an average degree of attention during the selection process and allowing for imperfect recollection, the various visual differences between the competing trade marks are, in my view, sufficient to avoid direct confusion. That leaves indirect confusion to be considered. 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 the difference between direct and indirect confusion stating:

“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.”

46. 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 trade marks share a common element. In this connection, he pointed out that it is not sufficient that a trade mark merely calls to mind another trade mark. This is mere association not indirect confusion.

47. Whilst realising that the competing trade marks are different, the average consumer will notice that the applicant’s trade mark also includes the word “DON”. Having done so and as identical goods are involved, it is, in my view, highly likely that the average consumer will simply assume that the applicant’s trade mark is a variant brand being used by the opponent or by an undertaking commercially linked to the opponent. As that is sufficient for a finding of indirect confusion, the opposition succeeds in relation to class 25.

Likelihood of confusion with application no. 3320535

48. My comments above in relation to identical goods and the traits of the average consumer also apply here. While I have concluded that the competing trade marks are

visually and aurally similar to at least a medium degree, I found that while the opponent's trade mark is likely to convey a number of conceptual messages to the average consumer, the applicant's trade mark is likely to send either a different conceptual message or no conceptual message at all.

49. In *The Picasso Estate v OHIM*, Case C-361/04 P, the CJEU found:

“20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law.”

50. However, in *Nokia Oyj v OHIM*, Case T-460/07, the GC stated:

“Furthermore, it must be recalled that, in this case, although there is a real conceptual difference between the signs, it cannot be regarded as making it possible to neutralise the visual and aural similarities previously established (see, to that effect, Case C-16/06 P *Éditions Albert René* [2008] ECR I-0000, paragraph 98).”

51. Although the competing trade marks are only three letters long and have the same second and third letters, it is well established that the start of trade marks are likely to have more visual and aural impact on the average consumer than the endings (the decision of the GC in *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02 refers). In my view, that principle is even more apposite in short trade marks when, as here, the first letter differs. That, together with what is likely to be the various conceptual messages conveyed by the opponent's trade mark and, at worst, the lack of any conceptual message conveyed by the applicant's trade mark is, in my view, likely to militate against both direct and indirect confusion and, as a consequence, the opposition based upon section 5(2)(b) fails.

Conclusion under section 5(2)(b) of the Act

52. The opposition against class 25 of no. 3319950 succeeds, whereas the opposition against no. 3320535, fails.

The opposition based upon section 3(6) of the Act

53. Having found in the opponent's favour under section 5(2)(b) of the Act in relation to no. 3319950, it is not strictly necessary for me to also consider his alternative case based upon section 3(6). However, as I must consider this ground in relation to no. 3320535 (in relation to which the opposition based upon section 5(2)(b) has failed), I will deal with this ground as it relates to both applications.

54. The law in relation to section 3(6) of the Act ("bad faith") was summarised by Arnold J. in *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch), as follows:

"130. A number of general principles concerning bad faith for the purposes of section 3(6) of the 1994 Act/Article 3(2)(d) of the Directive/Article 52(1)(b) of the Regulation are now fairly well established. (For a helpful discussion of many of these points, see N.M. Dawson, "Bad faith in European trade mark law" [2011] IPQ 229.)

131. First, the relevant date for assessing whether an application to register a trade mark was made in bad faith is the application date: see *Case C- 529/07 Chocladenfabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH* [2009] ECR I-4893 at [35].

132. Secondly, although the relevant date is the application date, later evidence is relevant if it casts light backwards on the position as at the application date: see *Hotel Cipriani Srl v Cipriani (Grosvenor Street) Ltd* [2008] EWHC 3032 (Ch), [2009] RPC 9 at [167] and cf. *Case C-259/02 La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 at [31] and *Case C-192/03 Alcon Inc v OHIM* [2004] ECR I-8993 at [41].

133. Thirdly, a person is presumed to have acted in good faith unless the contrary is proved. An allegation of bad faith is a serious allegation which must be distinctly proved. The standard of proof is on the balance of probabilities but cogent evidence is required due to the seriousness of the allegation. It is not enough to prove facts which are also consistent with good faith: see *BRUTT Trade Marks* [2007] RPC 19 at [29], *von Rossum v Heinrich Mack Nachf. GmbH & Co KG* (Case R 336/207-2, OHIM Second Board of Appeal, 13 November 2007) at [22] and *Funke Kunststoffe GmbH v Astral Property Pty Ltd* (Case R 1621/2006-4, OHIM Fourth Board of Appeal, 21 December 2009) at [22].

134. Fourthly, bad faith includes not only dishonesty, but also "some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined": see *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367 at 379 and *DAAWAT Trade Mark* (Case C000659037/1, OHIM Cancellation Division, 28 June 2004) at [8].

135. Fifthly, section 3(6) of the 1994 Act, Article 3(2)(d) of the Directive and Article 52(1)(b) of the Regulation are intended to prevent abuse of the trade mark system: see *Melly's Trade Mark Application* [2008] RPC 20 at [51] and *CHOOSI Trade Mark* (Case R 633/2007-2, OHIM Second Board of Appeal, 29 February 2008) at [21]. As the case law makes clear, there are two main classes of abuse. The first concerns abuse vis-à-vis the relevant office, for example where the applicant knowingly supplies untrue or misleading information in support of his application; and the second concerns abuse vis-à-vis third parties: see *Cipriani* at [185].

136. Sixthly, in order to determine whether the applicant acted in bad faith, the tribunal must make an overall assessment, taking into account all the factors relevant to the particular case: see *Lindt v Hauswirth* at [37].

137. Seventhly, the tribunal must first ascertain what the defendant knew about the matters in question and then decide whether, in the light of that

knowledge, the defendant's conduct is dishonest (or otherwise falls short of the standards of acceptable commercial behaviour) judged by ordinary standards of honest people. The applicant's own standards of honesty (or acceptable commercial behaviour) are irrelevant to the enquiry: see *AJIT WEEKLY Trade Mark* [2006] RPC 25 at [35]-[41], *GERSON Trade Mark* (Case R 916/2004-1, OHIM First Board of Appeal, 4 June 2009) at [53] and *Campbell v Hughes* [2011] RPC 21 at [36].

138. Eighthly, consideration must be given to the applicant's intention. As the CJEU stated in *Lindt v Hauswirth*:

"41. ... in order to determine whether there was bad faith, consideration must also be given to the applicant's intention at the time when he files the application for registration.

42. It must be observed in that regard that, as the Advocate General states in point 58 of her Opinion, the applicant's intention at the relevant time is a subjective factor which must be determined by reference to the objective circumstances of the particular case.

43. Accordingly, the intention to prevent a third party from marketing a product may, in certain circumstances, be an element of bad faith on the part of the applicant.

44. That is in particular the case when it becomes apparent, subsequently, that the applicant applied for registration of a sign as a Community trade mark without intending to use it, his sole objective being to prevent a third party from entering the market.

45. In such a case, the mark does not fulfil its essential function, namely that of ensuring that the consumer or end-user can identify the origin of the product or service concerned by allowing him to distinguish that product or service from those of different origin, without

any confusion (see, inter alia, Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 48)."

55. I begin by reminding myself of, inter alia: (i) the relevant date for assessing a claim to bad faith is the date the applications were filed i.e. 22 and 26 June 2018, (ii) the applicant is assumed to have acted in good faith unless the contrary is proven, (iii) bad faith is a serious allegation which must be distinctly proved, and (iv) it is not enough for the opponent to prove facts which are also consistent with good faith.

56. In reaching a conclusion, I must assess all the relevant factors, including what the applicant knew about the matters in question at the relevant dates (whilst reminding myself that evidence from after those dates is relevant if it casts light backwards on the position at the relevant dates) and whether, in the light of that knowledge, its conduct is dishonest or falls short of the standards of acceptable commercial behaviour judged by the ordinary standards of honest people. To assist me in this respect, I have prepared a chronology of events using a combination of the official record and the evidence provided. The key events appear to me to be as follows:

- 27 February 2018 – the first application (trade mark no. 3292856) is filed for goods in classes 9 and 25. In its application, the applicant identifies the word element of its trade mark as “DON”. The trade mark is identical to the trade mark the subject of the second application (no. 3319950);
- 16 March 2018 – the first application is published for opposition purposes;
- 21 March 2018 – the opponent files a Form TM7A to extend the opposition period for the first application;
- 15 June 2018 – the opponent files a Fast Track opposition (no. 600000887) against the first application. It opposes all the goods in the application on the basis of the same earlier trade mark relied upon in these consolidated proceedings;

- 22 June 2018 – the second application (trade mark no. 3319950) is filed for goods in classes 9 and 25. In the application, the applicant does not indicate its trade mark contains a word element (exhibit FP2 refers);
- 25 June 2018 – a review of official records in relation to the second application indicates that the applicant contacted the registry to explain “they had forgotten to include mark text within mark”;
- 25 June 2018 – the opponent’s solicitor writes to the applicant;
- 26 June 2018 - the third application (trade mark no. 3320535) is filed for goods in class 25. Although originally filed as a series of two i.e. the word “bon” and the trade mark shown below, following an objection by the registry, the applicant elected to proceed for the word only trade mark:



- 27 June 2018 – a review of official records in relation to the second application indicates that following a conversation with the examiner in which the applicant “confirmed that the mark text should be “bon”, this text was added to the application (exhibit FP3 refers);
- 28 June 2018 – the applicant files Form TM21B to delete class 25 from the first application;
- 2 July 2018 - the examination reports for the trade marks the subject of these consolidated proceedings are issued;
- 6 July 2018 – the trade marks the subject of these consolidated proceedings are published for opposition purposes;

- 11 July 2018 – the opponent maintains its opposition against class 9 of the first application;
- 24 July 2018 – the opponent files oppositions against the trade marks the subject of these proceedings;
- 15 October 2018 – a substantive decision (BL O/650/18) is issued in relation to the first application. The opposition failed and the decision was not appealed.

57. In its submissions, the opponent states:

“9...Despite the protestations of the Applicant that the text of the First Mark was not altered from "Don" to "bon", it is clear from the online Register that an amendment was made to the application on 27 June 2018 for which no word element had been indicated when the First Mark was filed. In any event the Applicant has failed to explain why having filed its '856 Registration with the word element "Don" it then chose to use a different word element, namely "bon" for the First Mark despite it being identical to the '856 Registration. The Applicant has also failed to explain why this was then followed up with an application for the Second Mark that started off life as a series with a figurative element but which was then altered to the word mark "bon" alone. The only reason can be that the Applicant hoped by using the word element "bon" to avoid the Opponent being notified of the applications for the First and Second Marks and therefore to secure one or both registrations unbeknown to the Opponent. It is submitted that this is at the least sharp practice but would be judged by most honest people as dishonest. The Applicant has submitted no reasons for its actions and must, therefore, be judged by ordinary standards of honest people; the Applicant's own standards of honesty (or acceptable commercial behaviour) are irrelevant. It is clear that the Applicant tried to mislead the Opponent and the Registry as to the nature of the First Mark and has subsequently been unable to justify the reasons for its actions without incriminating itself...”

What did the applicant know when it filed the applications?

58. By the dates on which the applications to these consolidated proceedings were filed, the applicant would have been aware that its first application (in which it identified the word element as “DON”) was the subject of a Fast Track opposition filed by the opponent. In that opposition, the opponent relied upon a series of trade marks which included the word “DON” for, inter alia, goods in class 25. Having been sent a letter by the opponent’s solicitors on 25 June 2018 (a copy of which is not in evidence), by the date on which the third application was filed, it would also have been aware that on 25 June 2018 it contacted the registry indicating that it had forgotten to include “mark text” in its second application.

59. Later events indicate that on 27 June 2018 it had a conversation with the trade mark examiner following which the word “bon” was added to its second application and that on 28 June 2018, it filed a Form TM21B to remove class 25 from its first application. In its submissions the applicant states in relation to the amendment of the second application:

“...This is misleading information...no text was altered but a full application was made for the name (logo) “bon.”

60. The applicant’s state-of-knowledge in relation to its first application is as described above. Armed with that knowledge, the applicant filed the identical trade mark for substantially the same goods under no. 3319950. Although that second application was originally purely figurative in nature, at the applicant’s request, the word “bon” was added to the application to correct an oversight said to have occurred when the application was filed. The applicant then filed the third application for a series of two trade marks one of which consisted of the plain word “bon”; it is that trade mark which ultimately proceeded to publication.

61. Having originally identified the word element of its first application as “DON”, it is surprising that the applicant elected to identify the identical element in its identical second application as the word “bon”. It then filed the third application which consisted of a series of two trade marks i.e. the word “bon” and a figurative trade

mark which included a component highly similar to a component it had previously identified as the word “DON”.

62. As the registry had informed the applicant that it would notify the opponent of the applicant’s later trade mark when its first application was examined, the opponent suggests that the applicant adopted the approach it did to avoid the opponent being notified of its second and third applications.

63. Although the burden to prove bad faith is on the opponent, as it points out, the applicant has provided no evidence or submissions which provides any explanation as to why a component which it specifically identified as “DON” in its first application should now be construed as “bon.” In its Notice of opposition, the opponent said of the third application:

“14. The Opponent submits that it is likely that the goods of the Subject Application will be marketed and sold under the device trade mark that is the subject of the Second Application...”

There is, of course, no evidence in support of such an assertion.

64. Notwithstanding the above, in my view, the opponent’s submissions have merit. Having specifically identified the word “DON” as an element of its first application, the applicant was advised by the registry that, when published, the opponent would be notified of its first application. Having had its first application opposed by the opponent on the basis of its trade mark registration which included the word “DON” for goods in class 25, on 22 June 2018, the applicant filed a second application for the identical trade mark for goods in classes 9 and 25 but in which no word element was identified. Having filed its third application on 26 June 2018 and having advised the registry on 27 June 2018 that as a result of an oversight on its part the word element in its second application should have been identified as “bon”, the following day the applicant deleted class 25 from its first application.

65. Based on that factual matrix, it is, in my view, an irresistible inference that the approach adopted by the applicant in relation to its second and third applications

was a calculated attempt on its part to try and avoid the opponent being notified by the registry of the existence of those applications. If successful, such an approach may have led to it obtaining for itself registrations in class 25 which it may not otherwise have been able to secure had the opponent been notified by the registry of the existence of the second and third applications during the examination phase.

66. By the time the second and third applications were filed, the applicant was fully aware of the opponent's rights in, inter alia, the word "DON" in relation to goods in class 25 and that the opponent was intent on enforcing his rights. In those circumstances, in my view, honest people would consider the approach adopted by the applicant to fall short of ordinary standards of acceptable commercial behaviour and, as a consequence, the oppositions based upon section 3(6) of the Act succeed in relation to both applications.

67. In reaching the above conclusions, I have not overlooked the fact that earlier in this decision when considering the opposition based upon section 5(2)(b) of the Act against the third application i.e. the word "bon", I concluded there was no likelihood of confusion. However, in my view that does not matter if, as I have found, the applicant's filing of the application was in pursuit of an aim which I regard as being in bad faith.

Conclusion under section 3(6) of the Act

68. Both oppositions succeed.

Overall conclusion

69. The opposition based upon section 5(2)(b) of the Act has succeeded in relation to application no. 3319950 and failed in relation to application no. 3320535. However, as the opposition to the class 9 element of no. 3319950 has been withdrawn, the application may proceed to registration in respect of the goods in this class.

70. As the oppositions based upon section 3(6) of the Act have also succeeded in relation to the class 25 element of no. 3319950 and the totality of application no. 3320535, subject to any successful appeals, no. 3319950 may proceed to registration on the basis indicated above and no. 3320535 will be refused.

Costs

71. As the opponent has been successful, he is entitled to a contribution towards his costs. Awards of costs in proceedings are governed by Annex A of Tribunal Practice Notice ("TPN") 2 of 2016. Applying the above guidance but reminding myself that these proceedings have been consolidated and the economies of scale such an approach brings, I award costs to the opponent on the following basis:

Filing the Notices of opposition and reviewing the counterstatements:	£400
Preparing evidence:	£500
Written submissions:	£300
Official fees:	£400 (i.e. 2 x £200)
Total:	£1600

72. I order Morris Jones & Associates Ltd to pay to Faisal Patel the sum of **£1600**. This sum is 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 18th day of July 2019

C J BOWEN
For the Registrar