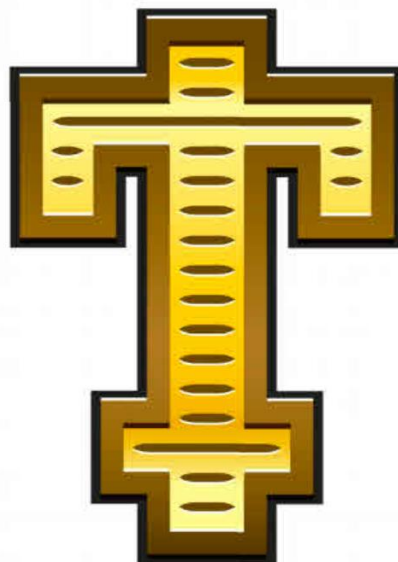


O-430-19

**TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK APPLICATION NO 3308322
BY RAJINDER SHARMA
TO REGISTER**



THE TRILLIONAIRE CLUB

**AS A TRADE MARK
IN CLASS 25
AND OPPOSITION THERETO (UNDER NO. 413113)
BY
BILLIONAIRE TRADEMARKS B.V.**

Background & Pleadings

1. Rajinder Sharma ('the applicant') applied to register the trade mark set out on the title page on 3 May 2018 in class 25. The application was published on 25 May 2018 for the following specification of goods: *Clothing*.

2. Billionaire Trademarks B.V. ('the opponent') opposes the applied-for mark under section 5(2)(b) of the Trade Marks Act 1994 ('the Act') on the basis of its earlier UK and EU trade marks set out below. The opponent claims that its earlier marks are similar to the applicant's mark and there exists a likelihood of confusion.

Earlier marks	Goods and services relied on
<p data-bbox="204 840 502 873">UK TM No. 3040166</p> <p data-bbox="204 996 582 1052">BILLIONAIRE</p> <p data-bbox="204 1153 614 1187">Filing date: 31 January 2014</p> <p data-bbox="204 1205 638 1238">Registration date: 9 May 2014</p>	<p data-bbox="805 840 1380 1366">Class 25: Clothing; leather and imitation leather clothing; coats; bathrobes; shoes, boots and slippers; short sleeved shirts, shirts; headgear; overcoats; bathing suits; neckties, gloves (clothing), scarves; jackets; skirts; waterproof clothing; ready-made clothing; knitwear (clothing); underwear; hosiery; sweaters, trousers, pullovers; dresses; belts (clothing).</p> <p data-bbox="805 1444 1380 1915">Class 35: Retail services connected with the sale of clothing, leather and imitation leather clothing, coats, bathrobes, shoes, boots and slippers, short sleeved shirts, shirts, headgear, overcoats, bathing suits, neckties, gloves (clothing), scarves, jackets, skirts, waterproof clothing, ready -made clothing, knitwear (clothing), underwear,</p>

	hosiery, sweaters, trousers, pullovers, dresses, belts (clothing).
EU TM No. 12203031 BILLIONAIRE Filing date: 8 October 2013 Registration date: 6 March 2014	Class 35: Sales, including online, relating to the following goods: clothing, footwear, headgear.

3. The opponent's trade marks are earlier marks, in accordance with section 6 of the Act, but have not been registered for five years or more at the publication date of the applicant's mark, so neither are subject to the proof of use requirements, as per section 6A of the Act.

4. The applicant filed a counterstatement in which he denied the marks were confusingly similar. In the written submissions dated 25 April 2019, the applicant conceded that his goods were identical to the opponent's goods in class 25.

5. Both parties have been professionally represented throughout, the applicant by Carpmaels & Ransford LLP and the opponent by Stevens Hewlett & Perkins.

6. The applicant filed submissions in lieu of a hearing and the opponent filed evidence. I make this decision based on the material before me.

Opponent's evidence

7. The opponent submitted two witness statements. The first made by Peter Cornford of Stevens Hewlett & Perkins, the opponent's legal representative, appended three exhibits. The second witness statement was made by Philipp Plein, the opponent's CEO, who appended seven exhibits.

8. Taking Mr Cornford's evidence first, his witness statement contained a number of submissions relating to the definitions of a billionaire and a trillionaire and the visual,

aural and conceptual similarity of those two terms. Exhibits PWC1 and 2 contain definitions taken from collinsdictionary.com for billionaire and trillionaire. Exhibit PWC3 is a copy of a previous tribunal decision, namely O-335-15, concerning another of the opponent’s opposition proceedings involving billionaire and trillionaire word marks which Mr Cornford describes as a ‘useful precedent’. However, I would point out the applied-for mark in this case is a figurative mark and I must make my decision based on the marks before me on the case’s own merits.

9. Mr Plein’s witness statement sets out the following key points:

- The earlier mark was first used in the UK in 2009
- The goods are sold from one physical location in the UK, namely Harrods in London and can be also be purchased online.

10. The opponent’s UK turnover is stated as:

2009	Over £2.5m
2010	Over 3.5m
2011	Over £4m
2012	Over £4.5m
2013	Over £4.5m
2017	Over £160,000
2018	Over £330,000

11. Exhibit 1 consists of case details for the earlier mark 3040166.

12. Exhibit 2 is an undated screenshot from the opponent’s website showing the locations of the applicant’s retail premises in Europe, Asia and the Middle East.

13. Exhibit 3 consists of a number of undated screenshots of garments available from the opponent’s website. The prices are given in £ sterling. Several variants of the mark are apparent either as tags or emblazoning on the garments themselves. Two typical examples are given below by way of illustration.



14. Exhibit 4 consists of a number of undated screenshots from the opponent's FaceBook and Instagram social media sites.

15. Exhibit 5 consists of an undated screenshot regarding the opponent's brand from the Harrod's website.

16. Exhibit 6 consists of several magazine advertisements and press articles dated between 2017-2018 for the opponent's goods. The publications listed are Harrods magazine, GQ, Ritz magazine, Esquire, City AM newspaper, Hello magazine and Mayfair.

17. Exhibit 7 consists of an advertising expenditure schedule dated between October 2016 – October 2018 for the Billionaire Couture brand in the UK. The final figure given at the end of the schedule is 681. 227, 64 but it is unclear if this figure denotes £ sterling or Euros.

18. That concludes my summary of the evidence.

Decision

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

“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.”

20. The leading authorities which guide me are from the Court of Justice of the European Union ('CJEU'): *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 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

21. As previously stated above, the applicant conceded that his goods were identical and similar to the opponent's goods in class 25 in the written submissions dated 25 April 2019.

22. With regard to the opponent's retail of clothing services, in *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criteria

capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court (GC) stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

23. In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the GC held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

24. In *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services v goods. He said (at paragraph 9 of his judgment) that:

“9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent’s earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are ‘similar’ to goods are not clear cut.”

25. However, on the basis of the European courts' judgments in *Sanco SA v OHIM*¹, and *Assembled Investments (Proprietary) Ltd v. OHIM*², upheld on appeal in *Waterford Wedgwood Plc v. Assembled Investments (Proprietary) Ltd*³, Mr Hobbs concluded that:

- i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer's point of view, they are unlikely to be offered by one and the same undertaking;
- ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent's goods and then to compare the opponent's goods with the retail services covered by the applicant's trade mark;
- iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;
- iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

26. Taking account of the guidance outlined above, I note that retail services for particular goods may be considered complementary to those goods and that such goods would be distributed via the services.

27. The applicant's specification for *clothing* is identical to the goods in the opponent's *Retail services connected with the sale of clothing*. I find that there is a

¹ Case C-411/13P

² Case T-105/05, at paragraphs [30] to [35] of the judgment

³ Case C-398/07P

relevant complementary relationship between the applicant's goods and the opponent's services resulting in at least a low degree of similarity between them.

Average Consumer and the purchasing process

28. It is necessary to consider the role of the average consumer and how the goods are purchased. 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*.

29. 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.”

30. The guidance given in *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03 is also appropriate here as the goods in that case were also clothing. The GC stated that:

“49. However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (*BUDMEN*, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or

the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumer choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs.”

And

“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.”

31. The average consumer for the contested goods in this case is a member of the general public. The goods can be sold in traditional bricks and mortar retail clothing stores as well as online or through mail order. As set out above in *New Look*, the act of purchasing clothing will be a primarily visual process and factors such as aesthetics, functionality and fit in addition to the cost will come into play. In traditional bricks and mortar retail premises, the average consumer will be viewing and handling the clothing on racks and possibly trying garments on. In an online website or mail order catalogue, a consumer will be viewing images of the goods before selection. Given that clothing prices can vary from garment to garment, I conclude that an average consumer will be paying a normal degree of attention during the purchasing process. Although I have found the purchasing process to be primarily visual, I do not discount any aural consideration such as word of mouth recommendations.

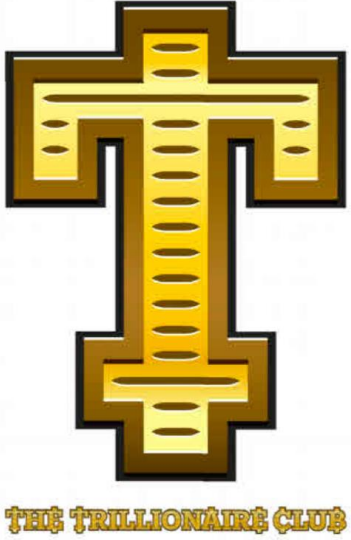
Comparison of the marks

32. 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.”

33. 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.

34. The marks to be compared are:

Opponent's marks	Applicant's mark
BILLIONAIRE	

35. The opponent's trade marks consists of a single word **BILLIONAIRE** in upper case. It has no other elements to it. The overall impression of the marks and their distinctiveness rests solely in that word.

36. The applicant's mark is a composite arrangement of a device and words consisting of a heavily stylised cross device resembling a letter 'T' positioned above the words **THE TRILLIONAIRE CLUB**. Those words are presented in a non-standard, very stylised font with the first and last letters of each word along with the letter **A** in 'trillionaire' having additional embellishments such as serifs to more closely resemble the shape of the device above. The mark as a whole is presented in shades of yellow and gold although the mark is not limited to colour. In terms of its size, stylisation and visual impact, I find the device element to be the dominant and distinctive element of the mark. Whilst the presentation of the words and the words themselves are not without distinctiveness, their relative size and positioning mean they carry less weight in the overall visual impression of the mark.

37. In a visual comparison, the only commonality between the marks are the letters

I-L-L-I-O-N-A-I-R-E. The opponent's marks have an additional letter B to form Billionaire and the applicant have the additional letters TR to form the word Trillionaire. The opponent's mark additionally lacks the visually impactful device element present in the applied-for mark as well as the stylisation and the two other words THE and CLUB. In short, visually the marks look quite different. As such I find there is a low degree of visual similarity based on the shared letters.

38. In aural terms, the device element of the applicant's mark will not be verbalised, which leaves only the words to be considered. The opponent's marks will be pronounced in the usual way and I see no reason why the applicant's mark will not be pronounced in full as three words. In my view the initial letters, B in the opponent's marks and TR in the applicant's will make an aural difference. Indeed in *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, the General Court noted that the beginnings of word tend to have more visual and aural impact than the ends. However, it is clear that the spoken sound made by the shared letters I-L-L-I-O-N-A-I-R-E, which is a long element of some 10 letters, are the same for all marks. I find there is some aural similarity, albeit relating to one word out of the applicant's three-word mark, to a medium degree

39. Finally in relation to the conceptual similarity, I note the opponent's dictionary definitions for the words BILLIONAIRE and TRILLIONAIRE, namely an individual whose financial wealth amounts to either a billion or trillion units of a particular currency. Clearly both words share a basic concept of individuals having extreme wealth. However, the applicant's mark is not simply the word 'trillionaire' alone. The applicant submits that the words THE TRILLIONAIRE CLUB "will imply an exclusive group or society". I agree with that submission. In my view the applicant's mark consists of an elaborate device and words implying a group of very wealthy individuals. I find this is a step removed from the opponent's mark meaning a single very wealthy individual. As such I find although there is some conceptual similarity between the marks it is to a low degree.

Distinctive character of the earlier marks

40. The distinctive character of the earlier marks must be considered. The more distinctive they are, either inherently or through use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). 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).”

41. In these proceedings the opponent has provided evidence of use of its earlier marks in the UK.

42. I note from the evidence that the marks were first used in the UK in 2009 and the goods are currently sold at one retail outlet in London, namely Harrods. I further note that whilst UK turnover is stated to be between £2.5m and £4.5m p.a. between 2009 and 2013, there are no annual figures stated for the three years between 2014

- 2016 and the turnover figures that stated for 2017 and 2018 have considerably decreased to £160k and £330k respectively in comparison to previously given figures. All of which suggests that use has not been continuous for at least the five years prior to the publication of the applied-for mark. Even if there has been continuous use, it is clear that it has been in decline in recent years resulting in much lower turnover. I accept that the opponent's garments are expensive individual purchases, as outlined in the evidence, however I still do not find that the turnover is significant in a clothing market which by any reckoning is a multibillion-pound sector in the UK.

43. In the light of the evidence, I do not find that the distinctiveness of the opponent's marks has been materially enhanced through use.

44. From an inherent perspective the marks consist of an ordinary dictionary word which do not describe the goods and services for which they registered. I find that the earlier marks are inherent distinctive to a medium degree.

Likelihood of confusion

45. I now draw together my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors and those outlined in paragraph 20:

- a) The interdependency principle, whereby a lesser degree of similarity between the goods may be offset by a greater similarity between the marks, and vice versa (*Canon*).
- b) The principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*).
- c) Imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer*).

46. 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). In terms of indirect confusion, this was dealt with by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10 where he noted 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”.

47. Whereas in *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., also sitting 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.

48. So far, I have found that the goods at issue are identical and the services complementary. In addition, the average consumer is a member of the general public who will be paying a reasonable degree of attention in a primarily visual purchasing process. Further I have found that the earlier mark is inherently distinctive to a medium degree but that the marks in this case are visually similar only to a low degree, aurally similar to a medium degree and conceptually similar to a low degree.

49. Taking all this into account, I find that a lack of visual similarity is a key factor in my decision especially as the goods are primarily purchased visually. In my view the visual, aural and conceptual differences between the marks are sufficient to offset

the similarities, namely a shared number of letters in one of three words, in the mind of the average consumer purchasing the goods. Even allowing for imperfect recollection, where the average consumer does not have the chance to make a direct comparison of the marks, but instead relies on the imperfect picture of them that they have kept in their mind I find there is no likelihood of direct confusion given the presence of the visually impactful device in the applicant's mark which has no counterpart in the opponent's marks.

50. As I have found no direct confusion between the marks at issue, I now consider if there is a likelihood of indirect confusion. I find that the *Duebros* guidance is applicable here, namely that although an average consumer may see the letters the marks have in common, namely I-L-L-I-O-N-A-I-R-E, they would merely associate these with a grammatical suffix that is commonly used for individuals of extreme wealth. Even if one mark brought the other mark to mind, it would not be sufficient to indirectly confuse the marks.

Conclusion

51. The opposition fails under section 5(2)(b). The application can proceed to registration subject to any appeal.

Costs

52. As the applicant has been successful, he is entitled to a contribution towards the costs incurred in these proceedings. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 2/2016. Using the guidance in the TPN I make the following award:

Considering the Notice of Opposition and preparing a counterstatement	£400
Preparing written submissions and considering the evidence	£500
Total	£900

53. I order Billionaire Trademarks B.V. to pay Rajinder Sharma the sum of £900. This sum is to be paid within 14 days of the expiry of the appeal period or within 14

days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated 25 July 2019

**June Ralph
For the Registrar,
The Comptroller General**