

O-672-19

**TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK APPLICATION NO. UK00003311462
BY NFL PROPERTIES (UK) LIMITED
TO REGISTER**



**AS A TRADE MARK
IN CLASSES 24 & 25
AND OPPOSITION THERETO (UNDER NO. 600001130)
BY
DUF LTD**

Background & Pleadings

1. NFL Properties (UK) Limited ('the applicant') applied for the trade mark set out on the title page on 17 May 2018. The application was examined and published in the Trade Marks Journal on 1 March 2019 in classes 24 and 25. Only class 25 forms part of these proceedings and those goods will be set out later in this decision.

2. Duf Ltd ('the opponent') filed a notice of opposition on 28 May 2019 under section 5(2)(b) of the Trade Marks Act 1994 ('the Act') using the Fast Track procedure based on its UK trade mark below. The goods will be set out later in this decision.



3. The applicant filed a counterstatement denying the grounds of opposition.

4. The opponent's above mentioned trade mark is an earlier mark, in accordance with Section 6 of the Act, but is not subject to proof of use requirements as it had not been registered for five years or more before the filing date of the applicant's mark, as per section 6A of the Act.

5. Rules 20(1)-(3) of the Trade marks Rules ("TMR") (the provisions which provide for the filing of evidence) do not apply to fast track oppositions but Rule 20(4) does. It reads:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit”.

6. The effect of the above is to require parties to seek leave in order to file evidence (other than the proof of use evidence which is filed with the notice of opposition) in fast track oppositions. No leave was sought in respect of these proceedings.

7. Rules 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the Registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost. Otherwise, written arguments will be taken. A hearing was not requested nor considered necessary in this case. Neither party provided submissions. This decision is taken following a careful reading of all the papers.

8. The opponent represents itself in these proceedings whilst the applicant is represented by White & Case LLP.

Section 5(2)(b)

9. 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”.

10. 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

11. In the judgment of the Court of Justice of the European Union 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”.

12. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

13. The following case law is also applicable in these proceedings. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court 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 fur Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

14. The goods to be compared are:

Opponent's goods	Applicant's goods
Men's clothing, headgear; parts for the aforesaid goods, included in class 25	Clothing, Fleece tops and bottoms, T-shirts, Shirts, Turtlenecks, Sweatshirts, Shorts, Tank tops, Sweaters, Trousers, Jackets, Golf shirts, Jerseys, Gloves, Sleepwear, Bathrobes, Pyjamas,

	Swimwear, Underwear, Socks; none of the aforementioned goods being womenswear; Headgear; Caps; Knitted hats; Wristbands; Scarves; Ties; Cloth bibs
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15. The applicant has *clothing* in its specification and the limitation *none of the aforementioned goods being womenswear*. The goods listed in the opponent's specification are *Men's clothing* and as such are considered as identical under the *Meric* principle.

16. Both parties have *headgear* in their specifications which is self-evidently identical. The remaining individual headgear items listed in the applicant's specification, namely *caps, knitted hats* are caught by the broader term *headgear* in the opponent's specification in any case and as such are considered as identical under the *Meric* principle.

17. The remaining terms in the applicant's specification which are not limited, namely *Wristbands; Scarves; Ties; Cloth bibs* if worn by men would be considered identical under the *Meric* principle to the term *Men's clothing* in the opponent's specification. Insofar as *Wristbands; Scarves; Ties; Cloth bibs* could be worn by women, I still consider these goods to be highly similar as per the *Treat* factors set out above as the goods share the same uses, users in terms of the general public and physical nature and will reach the market through the same trade channels.

Average consumer and the purchasing process

18. 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*.

19. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

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

20. The average consumer for the contested goods is the general public. The goods will be sold in physical retail clothing stores as well as online and through mail order. The act of purchasing clothing will be a primarily visual process. Moreover, factors such as aesthetics, functionality and fit will come into play. In traditional retail premises, the average consumer will be viewing and handling garments. 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 medium 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 seeking advice from sales staff or from word of mouth recommendations.

Comparison of the marks

21. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Case C-591/12P, Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

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

23. The marks to be compared are:

Opponent's mark	Applicant's mark
	

24. The opponent's mark is a composite arrangement of the number 12 enclosed in a single line black border, positioned above the word TWELVE. This word is the same width as the bordered number above it but is smaller in scale. However, the word element makes an equal contribution with the number element to the overall impression of the mark.

25. The applicant's mark consists of the number 12 in a non-standard typeface which is depicted in white, outlined in black and placed on a blue background. The stylisation, whilst noticeable, is not especially striking. I find the relative weight of the stylisation to be fairly minimal, meaning that the number itself strongly dominates the mark. The applicant states in its counterstatement that the “mark includes the colour

blue which differentiates it significantly from the opponent's mark". I do not consider this to be as important a factor as the applicant's mark is not limited to colour so notionally could be used in any colour.

26. Visually, the similarity clearly resides in the shared number 12 which in the opponent's mark is contained within a single lined border and in the opponent's mark is placed on a contrasting background. These features will be noticed but are not especially remarkable. The difference in the opponent's mark is the presence of the word TWELVE which has no equivalent in the contested mark. Taking this into account, I find there is a medium degree of similarity.

27. In the aural comparison, the stylisation of borders or backgrounds will not play a part. As such the focus is on the number and word elements. The number 12 in both marks will be pronounced identically. The opponent's mark has the additional word TWELVE which self-evidently will also be pronounced identically to the numbers. It is possible that an average consumer would verbalise both the number and the word in the opponent's mark, which would obviously make the opponent's mark longer by repetition and adding an element of difference with the applicant's mark, but even taking that in to account I find there to be aural similarity to a high degree.

28. Conceptually, the shared element of both marks will bring to mind the identical notion of a number 12. The opponent's mark also has the word equivalent TWELVE which clearly brings to mind the same notion as the number. I think the repetition of the number and word in the opponent's mark will reinforce one another as the concept of a single number 12. In which case the marks are conceptually identical. I draw this conclusion as the mark contains a number and a word combination, rather than a repetition of a number format or of a word equivalent which often serves to change a concept, eg 2020 or fifty fifty. Even if that were not the case and the opponent's mark brought to mind the notion of 'twelve twelve', I still find the degree of conceptual similarity to be at least high.

Distinctive character of the earlier mark

29. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, based either on inherent qualities or

because of use made, the greater the likelihood of confusion. 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).”

30. There is no evidence of distinctiveness having been enhanced through use before me in these proceedings, so I have only the inherent character of the earlier mark to consider. The earlier mark, consisting of a number and word element, does not directly describe the goods or any characteristics of the goods for which it is registered. However, the mark does not contain any invented elements so cannot be considered as inherently distinctive to the highest degree, but I find the earlier mark to have a medium degree of distinctive character.

Likelihood of confusion

31. Drawing together my earlier findings on the global assessment of the likelihood of confusion, I keep in mind the following factors and those set out in paragraph 10:

- 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 Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc*).
- b) The principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*).
- c) The factor of 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 & Co. GmbH v Klijsen Handel BV*).

32. So far in this decision, I have found the parties' goods to be identical (and where they were not identical, at least highly similar) and that they will be primarily purchased visually, although I did not rule out any aural considerations by the general public who pay a medium degree of attention during the purchasing process. In addition, I have found the earlier mark is distinctive to a medium degree. In terms of the visual similarity, I found this to be of a medium degree. Aurally I found the similarity to be high and I found the conceptual similarity to be identical for a single number 12, or in the alternative at least highly similar for the concept of a repeated number 12.

33. Taking all of this into account, I find in particular that the conceptual identity of both marks sharing the common element of a number 12 is a key factor in my decision. I have identified some visual, aural and conceptual differences between the marks but these are based on the presence of the word TWELVE in the opponent's mark which I have already found to reinforce the number 12 element. Therefore in my view the whole forms a composite unit that has the same meaning as the separate components. Moreover I must consider that the average consumer rarely has the chance to make a direct comparison of the marks, instead relying on the imperfect picture of them that they have kept in their mind, and bearing in mind the fact that both parties' marks contain the identical number 12 and that the

opponent's mark contains the word equivalent of the same number, I find there is a likelihood of direct confusion.

Conclusion

34. The opposition succeeds under section 5(2)(b) and, subject to any successful appeal against my decision, the application is refused for class 25 only. Class 24 did not form any part of these proceedings, so the application can proceed to registration for this remaining class.

Costs

35. As the opponent has been successful, it is entitled to a contribution towards the costs incurred in these proceedings. As the opponent is unrepresented, at the conclusion of the evidence rounds the tribunal invited it, in a letter dated 12 August 2019, to indicate whether it wished to make a request for an award of costs, and if so, to complete a pro-forma including a breakdown of actual costs, including providing accurate estimates of the number of hours spent on a range of given activities relating to the opposition. The tribunal letter also set out that the Litigants in Person (Costs and Expenses) Act 1975 (as amended) sets the minimum level of compensation for litigants in person in court proceedings at £19 per hour. The opponent returned the costs pro-forma on 5 September 2019 and estimated a total of 3 hours and 20 minutes spent on preparation of the opposition. Bearing that in mind I award costs as follows:

£100 official fee for Notice of Opposition

£63.33 (comprising £19 x 3hrs 20mins) for Filing Notice of Opposition

36. I order NFL Properties (UK) Limited to pay Duf Ltd the sum of £163.33. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 5th day of November 2019

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