

**O-722-19**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3375875 BY  
ALBION LIMITED**

**TO REGISTER:**

**ALBION**

**&**

**Albion**

**AS A SERIES OF TWO TRADE MARKS IN CLASS 25**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 600001157 BY  
ALBIONE POLAND KATARZYNA JANOWSKA PUDLO**

## Background & pleadings

1. On 15 February 2019, Albion Limited (“the applicant”) applied to register **ALBION** and **Albion** as a series of two trade marks for the goods shown in paragraph 13 below. The application was published for opposition purposes on 12 April 2019.

2. On 27 June 2019, the application was opposed in full under the fast track opposition procedure by Albione Poland Katarzyna Janowska Pudlo (“the opponent”). The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), with the opponent relying upon an International Registration designating the United Kingdom (“IRUK”) no. 1174570, for the trade mark shown below, which has a designation date of 11 October 2013 and for which protection was granted in the UK on 5 June 2014. The opponent relies upon all the goods in its designation (also shown in paragraph 13 below):

ALBIONE

3. The opponent states:

“There exists a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected. The public may treat goods marked with [the applicant’s trade marks] as part of the goods originated in opponent’s undertaking. [The applicant’s trade marks] may mislead the public, as it may suggest that clothing marked with this trade mark is another product line of opponent’s products which are generally clothing. There is no doubt that [the applicant’s trade marks] are modeled on the [opponent’s trade mark] both verbally and graphically.”

4. The applicant filed a counterstatement in which the basis of the opposition is denied.

5. In these proceedings, the opponent represents itself. The applicant is represented by Groom Wilkes & Wright LLP.

6. Rule 6 of the Trade Marks (Fast Track Opposition)(Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

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

7. The net effect of these changes is to require parties to seek leave in order to file evidence in fast track oppositions. Rule 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.

8. In an official letter dated 5 September 2019, the parties were allowed until 19 September 2019 to seek leave to file evidence or request a hearing and until 3 October 2019 to provide written submissions. A hearing was neither requested nor considered necessary. Neither party elected to file written submissions.

## **DECISION**

9. The opposition is based upon section 5(2)(b) of the Act, which reads 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.

5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

10. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6.- (1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK) a European Union 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.”

11. The designation upon which the opponent relies qualifies as an earlier trade mark under the above provisions. As this earlier trade mark had not been protected for more than five years at the date the application was filed, it is not subject to the proof of use provisions contained in section 6A of the Act. The opponent is, as a consequence, entitled to rely upon it in relation to all of the goods indicated without having to prove that genuine use has been made of it.

### **Section 5(2)(b) – case law**

12. 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

13. The competing goods are as follows:

<b>The opponent's goods</b>	<b>The applicant's goods</b>
<b>Class 3 – Cosmetics</b>  <b>Class 25 - Clothing</b>	<b>Class 25 - Articles of clothing, footwear and headgear; shirts; T-shirts; tops; jumpers; fleeces; hooded tops; body warmers; jackets; suits; blazers; waistcoats; coats; tunics; trousers; shorts; thermal clothing; waterproof clothing; casualwear; leisurewear; beachwear; sleepwear; dressing gowns; bath robes; bath wraps; bathing suits; bathing trunks; socks; boots; shoes;</b>

	sandals; slippers; hats; caps; visors; gloves; ties; scarves; snoods; belts.
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14. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the Court stated at paragraph 23 of its judgment:

“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”.

15. 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.

16. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion 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”.

17. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the GC 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 trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

18. Although the opponent relies upon its goods in classes 3 and 25, it is only necessary for me to comment upon its goods in class 25. The opponent’s specification in class 25 consists solely of the word “Clothing”, which is identical to “Articles of clothing” in the application.

19. “Clothing” is a broad term which includes a very wide range of goods including both under and outer clothing. It would include at least the following goods in the application: “shirts; T-shirts; tops; jumpers; fleeces; hooded tops; body warmers; jackets; suits; blazers; waistcoats; coats; tunics; trousers; shorts; thermal clothing; waterproof clothing; casualwear; leisurewear; beachwear; sleepwear; dressing gowns; bath robes; bath wraps; bathing suits; bathing trunks; gloves; ties; scarves; snoods; belts”. These goods are, as a consequence, to be regarded as identical to the opponent’s “Clothing” on the inclusion principle outlined in *Meric*.



20. That leaves the following goods in the application to be considered: “footwear and headgear; socks; boots; shoes; sandals; slippers; hats; caps; visors.”. In relation to such goods, I begin by noting that collinsdictionary.com defines “clothing” as: “things people wear”. That definition accords with my own understanding of the word and, more importantly will, I am satisfied, accord with that of the average consumer. As all of the remaining goods are to be worn, they too are to be regarded as identical on the *Meric* principle. However even if that were not the case, given the obvious similarities in, at least, the users, nature, intended purpose, method of use and trade channels, if not identical, these goods are similar to the opponent’s “Clothing” to a high degree.

### **The average consumer and the nature of the purchasing process**

21. 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 such 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.”

22. 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.


23. 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**

24. 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*:

“.....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.”

25. 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 competing trade marks are as follows:

The opponent's trade mark	The applicant's trade marks
	ALBION  Albion

26. The applicant has applied for the series of two trade marks shown above. As their differing presentations i.e. in upper and title case respectively have no bearing on the matter, I will conduct the comparison on the basis of the trade mark presented in upper case. The overall impression conveyed by the trade mark resides in the single word of which it is composed.

27. The opponent's trade mark consists of the letters "A-L-B" and "O-N-E" presented in upper case in a slightly stylised but unremarkable bold font. Also present is an enlarged upper case letter "I" presented in the same bold font. Although the enlarged letter "I" is placed between the combinations of letters mentioned above, I think it highly likely that despite its size, the average consumer will, nonetheless, view the letters as forming a word in its own right i.e. "ALBIONE". Above and below this word there appear horizontal lines presented in bold which act as a border for the word. Given the size and positioning of the component that will be construed as the word "ALBIONE" and the non-distinctive nature of the horizontal lines, it is the word "ALBIONE" that will dominate the overall impression the opponent's trade mark conveys. I will bear these conclusions in mind in the comparison that follows.

### **Visual comparison**

28. The competing trade marks consist of six letters i.e. "ALBION" and seven letters i.e. "ALBIONE", respectively. Despite the enlarged letter "I" in the opponent's trade mark, the first six letters are identical. Even if the horizontal lines are noticed by the average consumer, the visual similarity between the applicant's trade mark and the dominant component in the opponent's trade mark, results in what I regard as a fairly high degree of visual similarity.

### **Aural similarity**

29. As the horizontal lines will not be mentioned when the opponent's trade mark is referred to orally, it is only the word components in the competing trade marks that matter. In line with my comments above, the opponent's trade mark is most likely to be treated as a word by the average consumer and pronounced "AL-BEE-O-KNEE", whereas the applicant's trade mark is most likely to be pronounced as "AL-BEE-UN". Considered on that basis, the competing trade marks are aurally similar to a fairly high degree.

### **Conceptual similarity**

30. Turning first to the applicant's trade mark, I think the average consumer is likely to be familiar with the word "ALBION", appearing as it does in the names of various famous football teams such as Brighton & Hove Albion and West Bromwich Albion. I have, however, no evidence or submissions to assist me in determining how the average consumer may treat this word. While I am aware that "ALBION" is an old-fashioned word for Britain, I am not in a position to judge to what extent my own experience may be representative of the average consumer. In those circumstances, while some average consumers may be familiar with the word "ALBION" and its meaning, I think there is likely to be a significant number of average consumers who, while familiar with the word, will not be familiar with its meaning. For that group, the word is unlikely to convey any concrete conceptual message.

31. As to the opponent's trade mark, given its obvious visual and aural similarity to the word "ALBION", some average consumers may assume it is, for example, an alternative/foreign language spelling of the word "ALBION" and, if they are familiar with the meaning of that word, accord it the same meaning. However, for a significant number of average consumers it is unlikely to convey any concrete message.

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

32. 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.

33. As the opponent has filed no evidence of any use it may have made of the trade mark upon which it relies, I have only its inherent characteristics to consider. Even if the opponent's trade mark were "ALBION", given its archaic nature, it would still be deserving of a medium degree of inherent distinctive character. Although the presentation with the enlarged letter "l" and the additional letter "E" improves the position still further, I shall proceed on the basis that the earlier trade mark enjoys at least a medium degree of inherent distinctiveness.

### **Likelihood of confusion**

34. 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.

35. 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. Earlier in this decision I concluded:

- The competing goods are either identical or, if not identical, similar to a high degree;
- The average consumer is a member of the general public who, whilst not forgetting aural considerations, is most likely to select the goods by visual means whilst paying at least an average degree of attention during that process;
- The competing trade marks are visually and aurally similar to a fairly high degree;
- Given the average consumer's state of knowledge, the competing trade marks may be either conceptually identical or conceptually neutral;
- The earlier trade mark is possessed of at least a medium degree of inherent distinctive character.

36. I shall consider the matter from the perspective of a consumer for whom the conceptual position is neutral and who while paying at least an average degree of attention during the selection process, remains prone to the effects of imperfect recollection. Even proceeding on that basis, inter alia, the fairly high degree of visual and aural similarity between the competing trade marks combined with the identity/high degree of similarity in the goods is, in my view, likely to result in a consumer mistaking one trade mark for the other i.e. there will be direct confusion. The opponent's position is, of course, even stronger if the average consumer also conceptualises the trade marks at issue in the same way. As a consequence of those conclusions, the opposition succeeds.

37. However, even if I am wrong and the various differences between the competing trade marks is considered sufficient to avoid direct confusion, there is still, in my view, a likelihood of indirect confusion. Given the goods at issue and the manner in which they are marketed, together with, at least, the fairly high degree of visual and aural similarity between the competing trade marks, I agree with the opponent that the consumer is likely to assume that the applicant's trade mark is, to use the opponent's own words, "another product line" originating from it.

## **Conclusion**

**38. The opposition has succeeded and, subject to any successful appeal, the application will be refused.**

## **Costs**

39. As the opponent has been successful, it is entitled to an award of costs. Awards of costs in fast track opposition proceedings are governed by Tribunal Practice Notice ("TPN") 2 of 2015. In an official letter to the opponent dated 5 September 2019, the tribunal stated:

"If you intend to make a request for an award of costs you must complete and return the attached pro-forma within 28 days of the date of this letter, that is on or before **3 October 2019**, and send a copy to the other party.

If the pro-forma is not completed and returned, costs, other than official fees arising from the action (excluding extensions of time), may not be awarded..."

40. As the opponent did not respond to that invitation either by the deadline set or by the date of the issuing of this decision, the only costs it is entitled to is in respect of the official fee for filing its opposition. **I therefore order Albion Limited to pay to Albione Poland Katarzyna Janowska Pudlo the sum of £100.** This sum is to be

paid within twenty one days of the expiry of the appeal period or within twenty one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 27<sup>th</sup> day of November 2019

**C J BOWEN**  
**For the Registrar**