

O-047-21

TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK APPLICATION NO 3438977
BY DKH RETAIL LIMITED
TO REGISTER

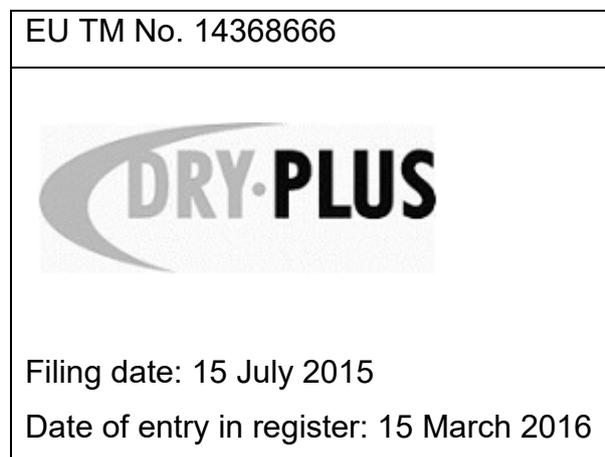
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AS A TRADE MARK
IN CLASSES 9, 18, 24, 25 & 35
AND OPPOSITION THERETO (UNDER NO. 419035)
BY
IIC-INTERSPORT INTERNATIONAL CORPORATION GMBH

Background and pleadings

1. DKH Retail Limited (“the applicant”) applied for the trade mark set out on the title page on 24 October 2019. The mark was published in the Trade Marks Journal on 8 November 2019 in classes 9, 18, 24, 25 and 35. I will refer to the goods and services later in this decision.

2. IIC-INTERSPORT International Corporation GmbH (“the opponent”) opposed the application on 8 January 2020 under section 5(2)(b) of the Trade Marks Act (“the Act”). The opponent relies on its earlier EU trade mark no. 14368666 in classes 18, 24, 25 and 28. The earlier registration details are set out below. I will refer to the goods later in this decision.



3. The opponent’s registration is an earlier mark, in accordance with section 6 of the Act, but as the mark has not been registered for five years or more before the filing date of the application, it is not subject to the proof of use requirements, as per section 6A of the Act.

4. The applicant filed a counterstatement denying the claims made.

5. Only the opponent filed evidence in these proceedings. The applicant filed written submissions which I will refer to as necessary. A hearing took place on 2 November 2020 with the opponent represented by Julius Stobbs of Stobbs IP Limited and the applicant by Aaron Wood of Blaser Mills LLP. Skeleton arguments were sent in advance of the hearing.

Opponent's evidence

6. The opponent filed evidence, namely a witness statement dated 18 May 2020 in the name of Fiona Cumming of Stobbs IP Limited, the opponent's legal representative. Ms Cumming annexed 5 exhibits. I do not propose to summarise all the evidence here other than to say Ms Cumming sought to provide information on the number of people in the UK who could read or understand Japanese according to the Office for National Statistics 2011 census data. However I have taken the evidence into consideration as part of this decision.

Decision

7. 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.

8. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

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 & services

9. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

10. 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.

11. The following case law is also applicable to these proceedings.

12. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court (“GC”) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

13. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

14. In *Sky v Skykick* [2020] EWHC 990 (Ch), Lord Justice Arnold considered the validity of trade marks registered for, amongst many other things, the general term ‘computer software’. In the course of his judgment he set out the following summary of the correct approach to interpreting broad and/or vague terms:

“...the applicable principles of interpretation are as follows:

(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.

(2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.

(3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.

(4) A term which cannot be interpreted is to be disregarded.”

15. The goods and services to be compared are:

| Opponent's goods & services | Applicant's goods & services |
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| | 9: Optical apparatus and instruments; sunglasses; sports goggles; spectacles; ski goggles; cases, cords and chains for sunglasses, spectacles, ski goggles and sports goggles; containers for contact lenses; laptop bags; bags and cases for personal digital assistants, electronic organisers, tablet computers and e-book devices; computer hardware; mats for use with a computer mouse; computer game programs; computer software; apparatus for recording, transmission or reproduction of sound or images; photographic apparatus and instruments; telecommunications apparatus and instruments; telephones; mobile telephones; smart phones; MP3 and other digital format audio and video players; fascias, cases, covers, carry |

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| | <p>bags and holders for telephones, smart phones, mobile telephones, satellite navigational devices, MP3 and other digital format audio and video players, cameras and video cameras; parts and accessories for telephones, smart phones, mobile telephones, satellite navigational devices, MP3 and other digital format audio and video players, cameras and video cameras; hands free kits for telephones; wireless headsets; headphones; loudspeakers; microphones; radios; chargers; apparatus for connecting and charging portable and handheld digital electronic devices; magnetic data carriers, recording discs; CDs, DVDs; memory cards; encoded cards, magnetic; life jackets; diving suits; diving equipment and apparatus; protective helmets for use in sports; helmets; swimming goggles; downloadable musical sound recordings; motion pictures and video recordings featuring music, adventure and/or animation; project screens; pocket calculators; parts and fittings for all the aforesaid goods.</p> |
| <p>18: Universal sports bags; Backpacks; Climbing packs</p> | <p>18: Bags; handbags; shoulder bags; toiletry bags; make-up bags; kit bags; rucksacks; sports bags; gym bags; beach bags; swing bags; hip bags; cross body bags; travel bags; luggage; wallets; purses; key cases (leather</p> |

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| | <p>ware); umbrellas; parasols; leather and imitations of leather; leather and imitation leather bags; leather and imitation leather wallets; leather and imitation leather purses; leather and imitation leather laces; leather and imitation leather cords, twists and straps; leather and imitation leather cases; leather and imitation leather pouches; leather and imitation leather handbags; leather and imitation leather credit card wallets; leather and imitation leather belts; leather and imitation leather credit card cases; leather and imitation leather luggage tags; leather and imitation leather card holders; leather and imitation leather belts; leather and imitation leather garment bags; leather and imitation leather make up bags; leather and imitation leather travelling sets; suit bags; brief cases and attaché cases; beauty cases; vanity cases; golf umbrellas; diaper bags; nappy bags; baby carriers; backpacks for carrying babies</p> |
| <p>24: Textiles; Semi-permeable textiles allowing evaporation while being waterproof</p> | <p>24: Textiles and substitutes for textiles; Household linen; Curtains of textile or plastic.</p> |
| <p>25: Clothing, footwear, headgear, in particular clothing, footwear, headgear comprising semi-permeable membranes allowing evaporation while being waterproof</p> | <p>25: Clothing; casual clothing; formal clothing; sportswear; leisurewear; activewear; hooded sweatshirts; sweatshirts; printed t-shirts; t-shirts; polo shirts; short sleeved and long</p> |

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| | <p>sleeved shirts; shirts; blouses; shorts; baggy shorts; long sleeved T-shirts; rugby tops; printed and embroidered sweatshirts; cardigans; sweaters; zip tops; joggers; trousers; jeans; knitwear; jumpers; fleece pullovers; dresses; skirts; tops; lined and unlined jackets; jackets; coats; trench coats; leather and imitation leather clothing; leather jackets; flatiron jackets; wax jackets; military blazers; macs; gilets; hunting jackets; flax jackets; stormbreaker jackets; army jackets; bomber jackets; cagoules; suits; waistcoats; ties; leggings; socks; scarves; gloves; swimwear; wetsuits; belts; underwear; camisoles; bras; knickers; boxer shorts; underpants; slippers [undergarments]; nightwear; pyjamas; bathrobes; dressing gowns; footwear; sandals; beach shoes; flip flops; canvas shoes; boots; shoes; leather shoes; trainers; running shoes; plimsoles; sports shoes; slippers; headgear; hats; caps; peaked caps; baseball caps; sports hats; sports caps; bandanas; beanies; berets; running tights; leggings; sports bras; gym clothing; yoga clothing; running shoes; bags for ski boots; ski gloves; belts made of leather or artificial leather.</p> |
| <p>28: Sporting articles included in this class; Sports bags adapted for carrying sporting articles</p> | |

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| | <p>35: Advertising and promotion services provided online from a computer database or the Internet; Retail services in connection with the sale of non-medicated cosmetics and toiletry preparations, non-medicated dentifrices, perfumery, essential oils, bleaching preparations and other substances for laundry use, cleaning, polishing, scouring and abrasive preparations, scientific, research, navigation, surveying, photographic, cinematographic, audiovisual, optical, weighing, measuring, signalling, detecting, testing, inspecting, life-saving and teaching apparatus and instruments, apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling the distribution or use of electricity, apparatus and instruments for recording, transmitting, reproducing or processing sound, images or data, recorded and downloadable media, computer software, blank digital or analogue recording and storage media, mechanisms for coin-operated apparatus, cash registers, calculating devices, computers and computer peripheral devices, diving suits, divers' masks, ear plugs for divers, nose clips for divers and swimmers, gloves for divers, breathing apparatus for</p> |
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| | <p>underwater swimming, fire-extinguishing apparatus, precious metals and their alloys, jewellery, precious and semi-precious stones, horological and chronometric instruments, leather and imitations of leather, animal skins and hides, luggage and carrying bags, umbrellas and parasols, walking sticks, whips, harness and saddlery, collars, leashes and clothing for animals, textiles and substitutes for textiles, household linen, curtains of textile or plastic, clothing, footwear, headwear, enabling customers to conveniently view and purchase these goods from retail stores, general merchandise catalogues by mail order, telephone, or other means of telecommunication, or from a general merchandise website; Wholesale services in connection with the sale of non-medicated cosmetics and toiletry preparations, non-medicated dentifrices, perfumery, essential oils, bleaching preparations and other substances for laundry use, cleaning, polishing, scouring and abrasive preparations, scientific, research, navigation, surveying, photographic, cinematographic, audiovisual, optical, weighing, measuring, signalling, detecting, testing, inspecting, life-saving and teaching apparatus and instruments, apparatus</p> |
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| | <p>and instruments for conducting, switching, transforming, accumulating, regulating or controlling the distribution or use of electricity, apparatus and instruments for recording, transmitting, reproducing or processing sound, images or data, recorded and downloadable media, computer software, blank digital or analogue recording and storage media, mechanisms for coin-operated apparatus, cash registers, calculating devices, computers and computer peripheral devices, diving suits, divers' masks, ear plugs for divers, nose clips for divers and swimmers, gloves for divers, breathing apparatus for underwater swimming, fire-extinguishing apparatus, precious metals and their alloys, jewellery, precious and semi-precious stones, horological and chronometric instruments, leather and imitations of leather, animal skins and hides, luggage and carrying bags, umbrellas and parasols, walking sticks, whips, harness and saddlery, collars, leashes and clothing for animals, textiles and substitutes for textiles, household linen, curtains of textile or plastic, clothing, footwear, headwear; The provision of advice and information to customers and potential customers in the selection of non-medicated</p> |
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| | <p>cosmetics and toiletry preparations, non-medicated dentifrices, perfumery, essential oils, bleaching preparations and other substances for laundry use, cleaning, polishing, scouring and abrasive preparations, scientific, research, navigation, surveying, photographic, cinematographic, audiovisual, optical, weighing, measuring, signalling, detecting, testing, inspecting, life-saving and teaching apparatus and instruments, apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling the distribution or use of electricity, apparatus and instruments for recording, transmitting, reproducing or processing sound, images or data, recorded and downloadable media, computer software, blank digital or analogue recording and storage media, mechanisms for coin-operated apparatus, cash registers, calculating devices, computers and computer peripheral devices, diving suits, divers' masks, ear plugs for divers, nose clips for divers and swimmers, gloves for divers, breathing apparatus for underwater swimming, fire-extinguishing apparatus, precious metals and their alloys, jewellery, precious and semi-precious stones, horological and</p> |
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| | <p>chronometric instruments, leather and imitations of leather, animal skins and hides, luggage and carrying bags, umbrellas and parasols, walking sticks, whips, harness and saddlery, collars, leashes and clothing for animals, textiles and substitutes for textiles, household linen, curtains of textile or plastic, clothing, footwear, headwear; Organisation, operation and supervision of loyalty card, incentive and promotional schemes, loyalty, incentive and bonus program services; fashion shows for promotional and commercial purposes.</p> |
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16. The opponent has no direct equivalent class 9 in its registration. It submitted in the hearing many of the goods in the applicant's class 9, are similar to goods in its own classes 18, 25 and 28 to varying degrees. I will take each of those submissions in turn. However, before proceeding further I need to address the point raised by the applicant in its skeleton argument about the meaning of the term *universal sports bags* in the opponent's class 18 specification. In the hearing, the opponent explained that it was likely to have been a translation from an original French specification and in its view should be regarded as akin to multi-purpose or all-purpose sports bags. This seems a reasonable interpretation and the applicant did not disagree. Therefore, for the purposes of this decision I will regard the term *universal sports bags* as meaning all-purpose sports bags.

17. In its skeleton argument¹ the applicant conceded that the following goods in its class 9, namely *optical apparatus and instruments; sunglasses; sports goggles; spectacles; ski goggles; cases, cords and chains for sunglasses, spectacles, ski*

¹ Paragraph 4

goggles and sports goggles; containers for contact lenses; life jackets; diving suits; diving equipment and apparatus; protective helmets for use in sports; helmets; swimming goggles "had a level of cross over" with the opponent's class 28 goods being *Sporting articles included in this class*. I take the words "a level of cross over" to mean that the applicant concedes that the goods are similar. The applicant did not state a degree of similarity but for my part I find these goods to be similar to a medium degree.

18. The opponent has also submitted that *computer hardware and computer software* in the applicant's class 9 would cover such goods as fitness and activity trackers and as such were also similar to its *Sporting articles* in class 28. I find there is similarity but not greater than a medium degree. The nature and purpose of fitness and activity trackers and sporting articles can be the same, in that they assist individuals with sporting activities. The users are likely to be the same. The goods can also share some of the same retail channels, i.e. they can both be purchased from sporting goods manufacturers.

19. The opponent submitted that its class 18 goods are similar to *laptop bags; bags and cases for personal digital assistants, electronic organisers, tablets, computers and e-book devices* in the applicant's class 9. I find there is similarity at least to a medium degree with the opponent's term *backpacks*. Such goods are frequently designed, shaped and marketed to carry electronic equipment so they do share the share nature and purpose and they are also likely to share the same users. They will also share the same distribution channels. I do not find there to be a similarity between *universal sports bags* or *climbing packs* in the opponent's class 18 specification with the applicant's goods given they both have a clearly specified nature and purpose for sport and climbing respectively which in my view does not coincide with specifically purposed bags for carrying electronic equipment,

20. With regard to the opponent's *backpacks* and the applicant's *carry bags and holders for telephones, smart phones, mobile telephones, satellite navigational devices, MP3 and other digital format audio and video players, cameras and video cameras*, I find these are similar only to a low degree. The respective goods coincide in their nature and purpose at a general level to carry items and may share

the same users. However I do not find that the applicants goods namely *fascias, cases, covers for telephones, smart phones, mobile telephones, satellite navigational devices, MP3 and other digital format audio and video players, cameras and video cameras* are similar to *backpacks*, as I find their primary purpose is to protect a device's screen, keys or lenses rather than for carrying items.

21. As to the remaining items in the applicant's class 9 specification namely *mats for use with a computer mouse; computer game programs; apparatus for recording, transmission or reproduction of sound or images; photographic apparatus and instruments; telecommunications apparatus and instruments; telephones; mobile telephones; smart phones; MP3 and other digital format audio and video players; parts and accessories for telephones, smart phones, mobile telephones, satellite navigational devices, MP3 and other digital format audio and video players, cameras and video cameras; hands free kits for telephones; wireless headsets; headphones; loudspeakers; microphones; radios; chargers; apparatus for connecting and charging portable and handheld digital electronic devices; magnetic data carriers, recording discs; CDs, DVDs; memory cards; encoded cards, magnetic; downloadable musical sound recordings; motion pictures and video recordings featuring music, adventure and/or animation; project screens; pocket calculators*, I have considered the opponent's submissions regarding these goods and their subject matter as well as the fitness and activity tracker functionality. However I do not find these goods to be similar to the opponent's *sporting articles* in class 28. Whilst some of the goods may have the capacity for fitness or activity tracking functionality, that is not their primary purpose. The broad reading of the goods as per *Skykick* is "to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms".

22. Turning now to class 18, clearly the applicants have the term *bags* at large which will encompass the opponent's goods and is therefore considered identical under the *Meric* principle. Furthermore I find that applicant's goods namely *kit bags; sports bags* and *gym bags* are identical to the opponent's *universal sports bags*. In addition, I find that the applicant's *rucksacks* can be considered as identical to the opponent's *backpacks* as they are synonyms for the same goods.

23. I find the opponent's *backpacks* at large will encompass *backpacks for carrying babies* and are therefore considered identical under the *Meric* principle. The applicant's term *baby carriers* is broader but will still encompass carriers taking the form of backpacks so should be considered as *Meric* identical.

24. With regard to the applicant's goods *handbags; shoulder bags; toiletry bags; make-up bags; beach bags; swing bags; hip bags; cross body bags; travel bags; luggage; leather and imitation leather bags; leather and imitation leather cases; leather and imitation leather pouches; leather and imitation leather handbags; leather and imitation leather garment bags; leather and imitation leather make up bags; leather and imitation leather travelling sets; suit bags; brief cases and attaché cases; beauty cases; vanity cases; diaper bags; nappy bags, wallets; purses; key cases (leather ware); leather and imitation leather wallets; leather and imitation leather purses; leather and imitation leather credit card wallets; leather and imitation leather credit card cases; leather and imitation leather card holders*, I find these are all bags or containers for carrying, storing or holding things so I find them similar to a medium degree to *backpacks* as there is a shared nature, purpose and user. In addition such goods will likely share the same distribution channels.

25. In terms of the applicant's remaining goods in class 18 namely *umbrellas; parasols; leather and imitations of leather; leather and imitation leather laces; leather and imitation leather cords, twists and straps; leather and imitation leather belts; leather and imitation leather luggage tags; leather and imitation leather belts; golf umbrellas*, I do not consider them to be similar to the opponent's class 18 goods. Their nature and purpose is different.

26. Turning now to class 24, both the respective specifications in this class contain the term *Textiles* so are clearly identical. Regarding *substitutes for textiles* in the applicant's specification, I find these to be highly similar to textiles as they will be used to make up the same products as textile equivalents. As such they not only serve the same purpose and will share the same users, they will be in competition with the opponent's *textiles*.

27. I find the opponent's term *textiles* is the name given to the raw material to make up into finished goods as well as the finished goods themselves. As such I find the applicant's remaining goods namely *Household linen; Curtains of textile* to be similar to at least a medium degree. In addition, I find the applicant's term *Curtains of plastic* to be similar to a medium degree with the opponent's *textiles* as plastic is a material which can be used to manufacture the same type of goods as textile materials like curtains. Therefore, these goods have the same purpose, method of use, the same users and be distributed through the same channels. There is also an element of competition between them.

28. Regarding class 25, both parties have accepted the identity of the goods.

29. The opponent has no class 35 equivalent. The applicant conceded in its skeleton argument² that there was a level of similarity between the sale of items and the items themselves. As such I find that *retail services in connection with the sale of carrying bags; textiles, clothing, footwear and headgear enabling customers to conveniently view and purchase these goods from retail stores, general merchandise catalogues by mail order, telephone, or other means of telecommunication, or from a general merchandise website; Wholesale services in connection with the sale of carrying bags, textiles, clothing, footwear and headgear* to be similar to a low degree to the equivalent goods in the opponent's classes 18, 24 and 25. This is consistent with the GC findings in *Oakley, Inc v OHIM*, Case T-116/06, amongst others.

Average consumer & the purchasing process

30. I next consider the role of the average consumer and how the goods and services 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*.

² Paragraph 11

31. 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.”

32. The contested goods and services cover a broad range of terms. The average consumers will predominately be the general public, although there would also be potential for some business consumers. The opponent submitted at the hearing that there was “a real range of price points” for the goods and services. I agree with the opponent, as even within each class there will be a price variation. I conclude though, that the average consumer will be paying at least a medium degree of attention as they will still need to consider factors such as the aesthetics, fit, suitability for purpose and functionality of the goods.

33. It is settled case law³ that where goods are available in self-select retail premises, then the purchasing process is primarily visual. The same is true of the purchasing process for the services which will likely come about from reviewing printed material such as advertisements, catalogues or from a website. The opponent at the hearing also drew my attention to the nature of using language to search for goods online which I bear in mind as both a visual and an aural consideration.

Comparison of the trade marks

34. 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

³ *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03

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.”

35. 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.

36. The marks to be compared are:

| Opponent's mark | Applicant's mark |
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37. The opponent's registration is a composite mark consisting of a crescent device positioned in front of the words DRY PLUS which themselves are separated by a single dot. In addition, the word DRY is depicted in grey and the word PLUS in black. Notwithstanding the device, it is the words which have the greater impact in the overall impression and will be how the mark is referred to.

38. The applicant's mark is also a composite arrangement. The mark comprises the word DRY presented vertically alongside four additional characters. In the applicant's counterstatement, it clarifies that the four characters are Japanese Kanji

characters which transliterate as “Jyunin Toiro”. I do not find the word DRY to be especially distinctive. But I do find that both the vertically presented word DRY and the four characters make an equal contribution to the overall impression of the mark.

39. In a visual comparison the respective marks share the word DRY. It is the first verbal element reading from left to right in both marks, however in the opponent’s registration it is presented horizontally and in the applicant’s mark it appears vertically but will still be seen as the word DRY. In terms of other differences, the opponent has the crescent device, the word PLUS and the applicant has the four additional characters. However, much was made at the hearing about the nature of

the 十 element of the applicant’s mark. The opponent submitted in its evidence that less than 0.5% of UK residents can speak or understand Japanese⁴. As a result, it submits, when seeing these particular characters, an average consumer is more likely to regard them as plus signs given their resemblance to the mathematical symbol rather than as Japanese characters. Thus, a consumer may see the applicant’s mark as DRY PLUS or DRY PLUS PLUS and only see the remaining two characters as being Japanese or at least non-English. The applicant for its part contends in its skeleton argument⁵ that whilst the English word DRY will be seen, a consumer would regard the remainder of the mark as they would regard a device. I agree it is possible that some consumers may see a mathematical plus sign.

However, I take all factors into account and bear in mind the point made in *Sabel* that the average consumer does not analyse a mark’s various components. As such the similarity rests solely with the word DRY. The vertical and horizontal presentations of the shared word DRY will have a visual impact as will the other verbal and non-verbal elements. As such I find the level of visual similarity as low.

40. Taking the aural comparison next, I find that the shared word DRY will be pronounced identically in each case. The opponent’s mark will be verbalised as DRY PLUS. If as the opponent submits, consumers verbalise the 十 element as the word PLUS making the whole pronunciation as DRY PLUS or DRY PLUS PLUS,

⁴ Witness Statement of Fionna Cumming, paragraph 12.

⁵ Paragraph 16

then there is a high degree of aural similarity. If on the other hand consumers verbalise only the word DRY, then the level of aural similarity is only medium.

41. In a conceptual comparison, the message brought to mind by the shared word DRY will be its usual dictionary definition. The opponent's registration may bring to mind that something is dryer than usual or has some extra dry component. The opponent's device is an abstract shape so will neither add to nor detract from the concept of the verbal element. As far as the applicant's mark is concerned the average consumer is likely to recognise that it contains non-English elements. Furthermore they may recognise an element which resembles a mathematical plus sign but that is not a certainty. Nor is it clear that even if they did see that particular element as mathematical plus signs, they would necessarily associate the concept of the word PLUS, meaning something additional, to that element. Whilst I find there is conceptual identity for the shared word DRY, there are conceptual differences. Overall I find the level of conceptual similarity to be medium.

Distinctiveness of the earlier registration

42. The degree of distinctiveness of the earlier registration must be assessed. This is because the more distinctive the earlier registration, based either on inherent qualities or because of the use made of it, 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).”

43. There is no evidence of enhanced distinctiveness before me in these proceedings. As such I have only to consider the inherent distinctiveness of the earlier registration. The registration consists of a device and word combination. I find the words DRY PLUS to be low (at very best) in distinctiveness given that in classes 24 and 25 the dryness properties of those goods are specifically referenced, and that dryness or moisture repellence would also be a desirable quality for class 18 and 28 goods. The registration is raised slightly higher in distinctiveness terms given the additional device. Taking this into account I find the degree of inherent distinctive character is slightly higher than low.

Likelihood of confusion

44. There is no scientific formula to apply in determining whether there is a likelihood of confusion. It is a global assessment where 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 services and vice versa. It is necessary for me to keep in mind the distinctive character of the opponent’s mark, the average consumer and the nature of the purchasing process for the contested goods and services. In doing so, I must be aware that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

45. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that

exists between the marks and the goods and services down to the responsible undertakings being the same or related.

46. The comments of Kitchin L.J. in *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation*⁶, are also appropriate in this matter as he considered the relationship between the average consumer and the likelihood of confusion. He concluded that:

“if, having regard to the perceptions and expectations of the average consumer, the court concludes that a significant proportion of the relevant public is likely to be confused such as to warrant the intervention of the court then it may properly find infringement.”

47. Although this was in the context of infringement, the same approach is appropriate under section 5(2) of the Act. It is not therefore necessary to find that the majority of average consumers will be confused. However, if the most that can be said is that occasional confusion amongst a few average consumers cannot be ruled out, then this is not sufficient. Rather the question is whether there is a likelihood of confusion amongst a significant proportion of the relevant public being the average consumers of these services.

48. In this decision I have found:

- Some of the goods and services to be identical and similar to varying degrees and some goods and services to be dissimilar.
- Average consumers will be paying at least a medium degree of attention during a primarily visual purchasing process.
- The inherent distinctiveness of the registration is slightly higher than a low degree.
- The respective marks are visually similar to a low degree.
- They are aurally similar to a medium degree, rising to a high degree if the ⁺ element is verbalised as the word PLUS.

⁶ See *Soulcycle Inc v Matalan Ltd*, [2017] EWHC 496 (Ch), Mann J

- They are overall conceptually similar to a medium degree, as there is a conceptually identical element.

49. Having considered these factors, I find that the visual differences between the marks is sufficient to rule out the likelihood of direct confusion in a primarily visual purchasing process even allowing for the notion of 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. Furthermore, I do not believe that a significant proportion of the public will see the  element as the words PLUS or PLUS PLUS, given the complex stylisation, which includes non-English characters, in the applicant's mark. Whilst I accept that there may be some consumers who do perceive the mark in that way, my view is that those consumers are likely to represent a very small proportion and insufficient numbers to warrant intervention. Occasional confusion by a small minority is not sufficient to find a likelihood of confusion. As I do not consider that a significant proportion of consumers will perceive the application as containing the verbal element DRY PLUS, I can see no reason why it would result in indirect confusion either. I accept both marks contain the identical element DRY but in my view this element is too low in distinctiveness to make consumers believe that the marks come from the same undertakings and will instead impart a message that the goods have some dryness properties.

Conclusion

50. The opposition fails under section 5(2)(b). Subject to appeal, the application can proceed to registration.

Costs

51. The applicant has been successful and is entitled to a contribution to its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 2/2016. Neither side identified any off-scale considerations at the hearing and the applicant submitted a costs pro-forma with its skeleton argument. However, there are two additional matters. Firstly, the opponent filed some evidence on Japanese language understanding in the UK and secondly, the applicant sought to have additional

documents relating to the examination of the earlier mark at EUIPO admitted late to the proceedings. I did not allow the admission of the documents but nonetheless they had to be considered by the other side. Equally the applicant had to consider the evidence submitted by the opponents. I find that these considerations cancel each other out and I decline to award costs on these matters. Bearing in mind the guidance given in TPN 2/2016, I award costs to the applicant as follows:

| | |
|--------------|--|
| £500 | Preparing a defence and considering the other side's statement |
| £1000 | Preparation for and attending the hearing |
| £1500 | Total |

52. I order IIC-INTERSPORT International Corporation GmbH to pay DKH Retail Limited the sum of £1500. 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 18th day of January 2021

June Ralph
For the Registrar
The Comptroller-General