

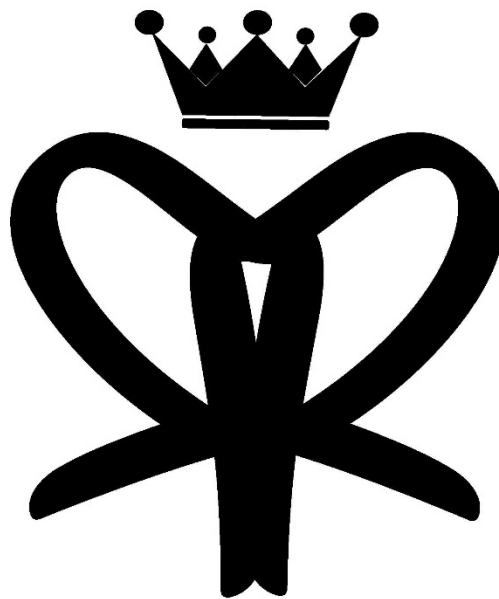
BL O/0377/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003475209

BY RECOGNYZ LTD

TO REGISTER THE TRADE MARK:



IN CLASS 25

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 421062

BY BONAMARK LIMITED

BACKGROUND AND PLEADINGS

1. On 15 March 2020, Recognyz Limited (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on the 1 May 2020. The applicant seeks registration for the following goods:

Class 25 Clothing for leisure wear.

2. The application was opposed by Bonamark Limited (“the opponent”) on 30 July 2020. The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon the following trade mark:



UK registration no. UK003449518

Filing date 5 December 2019; Registration date 6 March 2020.

Relying upon some of the goods for which the mark is registered, namely:

Class 25 Bandanas [neckerchiefs]; bathing caps; bathing suits ; swimsuits; bathing drawers; bath robes; beach shoes; boxer shorts; braces for clothing [suspenders] ; clothing*; clothing containing slimming substances; clothing for gymnastics; clothing of imitations of leather; clothing of leather; coats; collars [clothing]; combinations [clothing]; corselets; corsets [underclothing]; cuffs ; wristbands [clothing]; cyclists' clothing; detachable collars; dresses; dressing gowns; dress shields; ear muffs [clothing]; footwear*; hoods [clothing]; hosiery; inner soles; jackets [clothing]; jerseys [clothing]; judo uniforms; jumper dresses ; pinafore

dresses; karate uniforms; kimonos; knitwear [clothing]; lace boots; layettes [clothing]; outerclothing; overalls ; smocks; overcoats ; topcoats; pajamas ; pyjamas; panties ; knickers; paper clothing; paper hats [clothing]; parkas; scarfs ; scarves; shawls; shirt fronts; shirts; shirt yokes; shoes*; short-sleeve shirts; shower caps; ski boots; ski gloves; skirts; skorts; skull caps; sleep masks; socks; jumpers [pullovers]; teddies [underclothing] ; bodies [underclothing]; tee-shirts; tights; uniforms; waterproof clothing.

3. The opponent claims that there is a likelihood of confusion because the goods and the marks are similar.

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

5. Both parties' are unrepresented. A hearing was neither requested nor considered necessary.

6. The applicant filed evidence in chief, however, on 6 September 2022, the Registry sent out an official letter stating that the evidence was not admissible as the statement was not headed as a "witness statement", the evidence was not cross referenced with the statement and the evidence was not identified by an exhibit header sheet. As the applicant did not re-file its evidence accordingly, the Registry notified the applicant on 28 October 2022 that "the Registry may deem the applicant to have not filed evidence". In an official letter dated 15 January 2023, the Registry confirmed that as the applicant had not filed the amended evidence or sought additional time within which to file it, the evidence rounds were concluded, and that "neither party has filed any evidence or submissions in these proceedings".

7. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

DECISION

8. Section 5(2)(b) reads as follows:

“5(2) A trade mark shall not be registered if because –

(a)...

(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.”

9. The earlier mark had not completed its registration process more than five years before the relevant date (the registration date of the mark in issue). Accordingly, the use provisions at s.6A of the Act do not apply. The opponent may rely on all of the goods it has identified without demonstrating that it has used the mark.

Section 5(2)(b) case law

10. 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:

(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 might 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. The competing goods are as follows:

Opponent's goods	Applicant's goods
<p><u>Class 25</u> Bandanas [neckerchiefs]; bathing caps; bathing suits ; swimsuits; bathing drawers; bath robes; beach shoes; boxer shorts; braces for clothing [suspenders] ; clothing*; clothing containing slimming substances; clothing for gymnastics; clothing of imitations of leather; clothing of leather; coats; collars [clothing]; combinations [clothing]; corselets; corsets [underclothing]; cuffs ; wristbands [clothing]; cyclists' clothing; detachable collars; dresses; dressing gowns; dress shields; ear muffs [clothing]; footwear*; hoods [clothing]; hosiery; inner soles; jackets [clothing]; jerseys [clothing]; judo uniforms; jumper dresses ; pinafore dresses; karate uniforms; kimonos; knitwear [clothing]; lace boots; layettes [clothing]; outerclothing; overalls ; smocks;</p>	<p><u>Class 25</u> Clothing for leisure wear.</p>

overcoats ; topcoats; pajamas ; pyjamas; panties ; knickers; paper clothing; paper hats [clothing]; parkas; scarfs ; scarves; shawls; shirt fronts; shirts; shirt yokes; shoes*; short-sleeve shirts; shower caps; ski boots; ski gloves; skirts; skorts; skull caps; sleep masks; socks; jumpers [pullovers]; teddies [underclothing] ; bodies [underclothing]; tee-shirts; tights; uniforms; waterproof clothing.	
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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. The applicant’s “clothing for leisure wear” falls within the broader category of “clothing*” in the opponent’s specification. I consider them identical on the principle outlined in *Merici*.

The average consumer and the nature of the purchasing act

14. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. 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.”

15. The average consumer for the goods will be members of the general public. The cost of purchase is likely to vary, and the goods will be purchased relatively frequently. However, various factors are still likely to be taken into consideration during the purchasing process, such as materials used, cut, aesthetic appearance and durability. Consequently, I consider that a medium degree of attention will be paid by the average consumer when selecting the goods.

16. The goods are likely to be obtained by self-selection from the shelves of a clothing retail outlet, online or catalogue equivalent. This means that the mark will be seen and so the visual element of the mark will be the most significant: see *New Look Limited v OHIM*, Joined cases T-117/03 to T-119/03 and T-171/03, paragraph 50. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount that there will also be an aural component to the purchase, as advice may be sought from a sales assistant or representative.


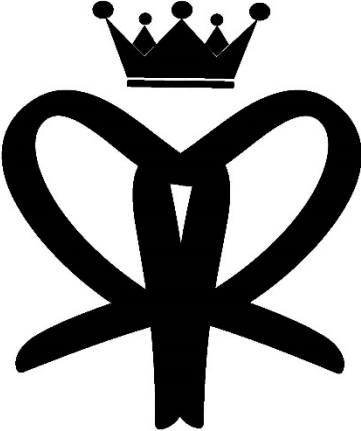
Comparison of the trade marks

17. 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 the trade 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.”

18. 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.

19. The respective trade marks are shown below:

Opponent's trade mark	Applicant's trade mark
	

20. The opponent's mark clearly consists of two letter R's, presented in a standard typeface, positioned back to back, with space in between them. Placed above, and centrally on the space between these letters, is a crown device, which looks as if it has been hand-drawn. I consider that given the size and positioning of the letter R's positioned back to back, I consider that they play a greater role in the overall impression, with the crown device playing a slightly lesser role.

21. The opponent submits that the applicant's mark also consists of two letter R's positioned back to back, with a crown on top of them. The applicant also submits that its mark consists of the "double R" element. However, albeit the applicant may have intended for its mark to consist of a "double R", due to the heavy stylisation and positioning of the letters so close together, I consider that the applicant's mark looks like a decorative device, which isn't an identifiable shape or image, and therefore, I do not consider that the average consumer would attribute any meaning to this device. However, I also consider that a significant proportion of average consumers may recognise the decorative device as consisting of a heart shape with 2 draped lines down the middle. I note that the device is presented with a crown on top. I therefore do not consider that, as the opponent submits, the average consumer would recognise the letter R's. I consider that if the opponent was correct, and a proportion of average consumers did recognise these letters within the mark, it would be so few in number that it wouldn't amount to a significant proportion. I consider that given the size and positioning of the decorative device, I consider that it plays a greater role in the overall impression of the mark, with the crown device playing a slightly lesser role.

22. Visually, the marks coincide in the presence of the crown devices. This acts as a visual point of similarity. However, I note that the crown in the opponent's mark is presented as if it has been hand-drawn. The opponent's mark also consists of two letter R's positioned back to back. The applicant's mark consists of the decorative (heart) device. These all act as visual points of difference. Therefore, I consider that the marks are visually similar to a low degree.

23. Aurally, the opponent's mark will be pronounced as R-R. The applicant's mark is composed of the decorative (heart) and crown device. I note that in *Dosenbach-Ochsner AG Schuhe und Sport v OHIM*, T- 424/10, the GC stated:

"46. A figurative mark without word elements cannot, by definition, be pronounced. At the very most, its visual or conceptual content can be described orally. Such a description, however, necessarily coincides with either the visual perception or the conceptual perception of the mark in question. Consequently, it is not necessary to examine separately the phonetic perception of a figurative

mark lacking word elements and to compare it with the phonetic perception of other marks.”

24. Therefore as the applicant’s mark cannot be articulated, the marks are aurally dissimilar.

25. Conceptually, I have not been provided with submissions from either party as to what concepts would be assigned to the opponent’s and applicant’s marks. I consider that two letter R’s positioned back to back in the opponent’s mark will not be assigned any conceptual meaning, since the letters may stand for any number of word combinations. I also note that letters on their own don’t convey a particular concept over and above their existence as letters in the English alphabet. The opponent’s mark also evokes the concept of a crown.

26. The applicant’s mark either evokes the concept of a crown and a decorative device which isn’t an identifiable shape or image, which wouldn’t be attributed any meaning, or the concept of a crown and heart.

27. I consider that the crown element in both marks could evoke the concept that both the opponent’s and applicant’s goods are “crowned as the best” and is therefore mildly laudatory of the quality of the goods. Therefore, as both marks share the crown concept, I consider that they are conceptually similar to a medium degree.

Distinctive character of the earlier trade mark

28. 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

C108/97 and C-109/97 Windsurfing Chiemsee v Huber and Attenberger [1999] ECR 1-2779, 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 promotion of 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).”

29. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

30. As highlighted above, the opponent’s mark consists of two letter R’s positioned back to back, with a hand-drawn crown device above them. The letter R’s have no immediate conceptual meaning, since they may stand for any number of word combinations. The crown device, however, is mildly laudatory of the opponent’s goods being “crowned as the best”. Therefore, I consider that the opponent’s mark is inherently distinctive to a medium degree.

Likelihood of confusion

31. 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 down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether

there is a likelihood of confusion; rather, 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 vice versa. It is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to 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 that he has retained in his mind.

32. The following factors must be considered to determine if a likelihood of confusion can be established:

- The opponent's mark clearly consists of 2 letter R's positioned back to back, presented in a standard typeface, with a hand-drawn crown device above them. I consider that the letter R's play a greater role in the overall impression, with the crown device playing a slightly lesser role.
- The opponent's mark consists of the decorative (heart) device, which is presented below a crown device. I consider that the decorative device/heart device plays a greater role in the overall impression, with the crown device playing a slightly lesser role.
- I have found the marks to be visually similar to a low degree.
- I have found the marks to be aurally dissimilar.
- I have found the marks to be conceptually similar to a medium degree.
- I have found the opponent's mark to be inherently distinctive to a medium degree.
- I have identified the average consumer to be members of the general public who will select the goods primarily by visual means, although I do not discount an aural component.
- I have concluded that a medium degree of attention will be paid during the purchasing process for the goods.
- I have found the parties' goods to be identical.

33. I note that both the opponent and applicant submit that the applicant's mark consists of the "double R" element. However, as noted above, I do not consider that the average consumer would recognise these letters within the mark due to its heavy stylisation and positioning. I also note that the average consumer rarely has the opportunity to compare the marks side-by-side, and therefore, the applicant's mark in isolation, will not be directly compared with the opponent's mark which consists of the letter R's positioned back to back. Furthermore, and as highlighted by the case law above, the consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The average consumer is therefore not going to artificially dissect the applicant's mark to find the "double R element" to directly compare it with the opponent's mark. Instead, the average consumer will view the applicant's mark, as a whole, and will see either see it a decorative device, which isn't an identifiable shape or image, or a decorative heart device, which a crown above it.

34. Consequently, even though the goods are identical, there are significant visual differences between the marks. Therefore, even bearing in mind the principle of imperfect recollection, I am satisfied that the marks are unlikely to be mistakenly recalled or misremembered as each other. This is particularly the case given the relatively low visual similarity between the marks and the predominantly visual purchasing process.

35. I note that the only common element between the marks is the presence of the crown device, which, as highlighted above, evokes the concept that the opponent's and applicant's goods are "crowned as the best", which is mildly laudatory of the quality of the parties' clothing goods. Therefore, I do not consider that the average consumer would overlook the two letter R's positioned back to back in the opponent's mark, nor do I consider that the average consumer would overlook the decorative (heart) device in the applicant's mark, especially considering the size of these elements, which play a greater role in the overall impression of the marks. Taking all of the above into account, I do not consider there to be a likelihood of direct confusion.

36. It now falls to me to consider the likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”

37. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

38. I consider that having noticed that the competing trade marks are different, I see no reason why the average consumer would assume that they came from the same or economically linked undertakings.

39. I do not consider that the average consumer would think that the applicant’s trade mark was connected with the opponent and vice versa on the basis that they both contain the crown device element, which is also presented in different styles. It is more likely to be viewed as coincidence, especially as the crown device is mildly laudatory of the quality of the parties’ clothing goods. The marks are clearly not natural variants or brand extensions of each other (the two letter R’s positioned back to back vs decorative (heart) device). Consequently, I consider there is no likelihood of indirect confusion.

CONCLUSION

40. The opposition is unsuccessful, and the application may proceed to registration.

COSTS

41. Award of costs are governed by Tribunal Practice Notice (“TPN”) 2/2016. The applicant has been successful and would normally be entitled to a contribution towards its costs.

42. However, as the applicant is unrepresented, at the conclusion of the evidence rounds the tribunal wrote to the applicant and invited them to indicate whether they intended to make a request for an award of costs. The applicant was informed that, if so, they should complete a Pro Forma, providing details of their actual costs and accurate estimates of the amount of time spent on various activities associated with the proceedings. They were informed that “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”.

43. The applicant did not file a completed Pro Forma and paid no official fees. That being the case, I make no award of costs in this matter.

Dated this 20th day of April 2023

L FAYTER

For the Registrar