

O-056-08

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 2412887 BY BASIC ELEMENTS
LTD TO REGISTER THE TRADE MARK**

basicelements

IN CLASS 25

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER NO 94407 BY
ANTONIO RIERA FARRE**

TRADE MARKS ACT 1994

**IN THE MATTER OF application No. 2412887
by Basic Elements Ltd to register a Trade Mark
in Class 25**

AND

**IN THE MATTER OF Opposition No. 94407
By Antonio Riera Farre**

Background

1. On 3 February 2006 Basic Elements Ltd (hereinafter referred to as BEL) applied to register the following trade mark:



2. The application was published in Trade Marks Journal No 6628 on 7 April 2006 in respect of the following Class 25 goods:

Clothing, footwear, headgear.

3. The colours black, white and grey are a feature of the mark.

4. On 12 June 2006 Antonio Riera Farre (hereinafter referred to as ARF) filed notice of opposition to this application citing a single ground under Section 5(2)(b) of the Act. ARF is the proprietor of Community Trade Mark No 1144252 which is registered in respect of the following mark and goods:



ELEMENTS

Class 25: Sportswear; football boots, studs for football boots; footwear for sports; shirts, jumpers, blouses, windcheaters, parkas, jackets, trousers, gloves, socks, stockings, underwear, pyjamas, night-dresses, waistcoats, cloaks, shawls, coats, scarves, jerseys, skirts, suits, neckties, belts, suspenders, swimsuits; caps (headwear),

waterproof clothing, anoraks, gymnastics and sports clothing included in this class; dressing gowns; stoles, headscarves; suits; overalls; footwear and headgear; knitwear.

Class 28: Games and playthings; gymnastic and sporting articles not included in other classes; gloves included in this class; balls for games, bladders of balls for games.

5. This mark has a filing date of 19 April 1999 and achieved registration on 23 June 2000. It is thus both an earlier trade mark for the purposes of Section 6(1)(a) of the Act and subject to the Trade Marks (Proof of Use, etc.) Regulations 2004. In relation to the latter the notice of opposition indicated that the mark had been used on all the goods for which it is registered in Classes 25 and 28.

6. ARF bases its claim on its rights in Class 25 only and claims that the trade mark applied for is similar to its trade mark and the goods are said to be identical or similar.

7. BEL filed a counterstatement. They accept the statement of use made by ARF, but deny that the respective marks are similar or that the respective goods are similar.

8. Both sides filed evidence. The parties were invited to say whether they wished to be heard or to file written submissions. Neither party requested a hearing or filed written submissions. After a careful study of the papers I give this decision.

EVIDENCE

ARF's evidence

9. This evidence consists of a witness statement, dated 22 January 2007, from Caitriona Mary Desmond, a Trade Mark Attorney Assistant in the firm of Murgitroyd & Company. She states that she is prosecuting the opposition filed by ARF and that she is familiar with all matters relating thereto. She confirms that she is authorised to make the witness statement on behalf of ARF and does so from matters within her own knowledge.

Ms Desmond states:

‘I carried out a trade mark search of the UK, Community and International Registrations designating the UK for any registrations containing the word BASIC on the Marquesa website on 19th January 2007. The search revealed 136 results, 50 of which confirm that numerous companies utilise the word BASIC to denote a simple or unsophisticated part of their product range. Other results utilised the word in a descriptive manner in sentences or as a description of the computer language BASIC in relation to computer products. Other uses were not in a descriptive way, but the marks contained other distinctive material. The exhibit ‘CMD1’ provides full details of the 50 relevant trade mark registrations located by the search. These results confirm that the meaning of the word BASIC to the average consumer is that it is non-distinctive usually used in conjunction with other distinctive words in relation to articles of clothing and other similar goods.’

10. Despite Ms Desmond's claims as to the reasons why companies may use the word 'basic' the evidence does not deal with the extent to which (if any) all or any of these marks have been brought into use in the UK market or what the effect of such use has been on consumer perception. It was said in *British Sugar Plc v James Robertson & Son Ltd (Treat)* [1996] R.P.C. 281 and has been referred to many times since that:

“Both sides invited me to have regard to the state of the Register. Some traders have registered marks consisting of or incorporating the word “treat”. I do not think this assists the factual inquiry one way or the other, save perhaps to confirm that this is the sort of word in which traders would like a monopoly. In particular the state of the Register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led the Registrar to put the marks concerned on the Register.”

11. This evidence does not assist.

Ms Desmond continues:

‘I also enclose a dictionary definition (Collins 2006 6th Edition) of the word BASIC which indicates BASIC means ‘elementary or simple’. The exhibit ‘CMD2’ provides a copy of the dictionary definition’.

12. Exhibit CMD2 consists of a copy of page 126 of Collins Dictionary, which Ms Desmond says is from the 2006 6th edition. Two references for the word BASIC are given. The first is: adj 1. of, relating to, or forming a base or basis; fundamental; 2. elementary or simple: *a few basic facts*. 3. excluding additions or extras; *basic pay*. 4. *Chem*) of, denoting, or containing a base; alkaline. 5. *Metallurgy* of, or made by a process in which the furnace or converter is made of a basic material, such as magnesium oxide. 6. (of such igneous rocks as basalt) containing between 52 and 45 per cent silica. 7. n (*usually plural*) a fundamental principle, fact, etc.

13. The second reference relates to the computer programming language.

14. In addition to the Collins reference she provides numerous other references for the word BASIC, which have been obtained from a variety of online sources. I consider that the meaning of the word basic is well known and the Collins reference is sufficient to define the meaning. I therefore do not consider it necessary to comment upon the credibility or otherwise of the additional references that have been provided.

15. To conclude she states:

‘It is my opinion that the above facts illustrate that the word BASIC would be taken by the average consumer as being a purely descriptive element of the Mark and would therefore not be considered as an important element of the Mark, meaning the comparison between the Marks would come down to the shared term ELEMENTS.’

BEL's evidence

16. This consists of a Witness Statement, dated 9 July 2007, from Louise Roberts, a Company Director of Basic Elements Ltd. Ms Roberts states that:

“The business name is ‘Basic Elements’ and the trademark clearly shows these words used side by side, of equal importance and without even a gap between the two words. The two words are never use separately in the brand name of the business.

It is true that the word ‘basic’ on its own is a commonly used word and appears in many business names, as shown in evidence already given in the prosecution (Exhibit CMD1).

It is equally true that the word ‘elements’ is used in many business names, a small sample of which can be found in my attached evidence. This evidence can be seen in exhibit BE1. Antonio Riere [sic] Farre’s company clearly has no monopoly on the use of such a common word in a company name.

The crucial fact, however, is that in my company’s name the words ‘basic’ and ‘elements’ are used together, with equal weight and indivisibly. This company name and trademark does not conflict with that of Antonio Riere [sic] Farre’s company and is not currently used by any other business in the same category’

17. Exhibit BE1 contains a photograph showing BEL’s mark. Underneath the mark it states ‘Log on to this exclusive new website selling a capsule wardrobe of women’s classic clothes and accessories in black and white. Perfect for your ‘Back to Work’ wardrobe’. Beneath this are three pictures two of which show a female wearing a suit and one showing a briefcase. Underneath those pictures is the website address and the statement ‘It all becomes clear in black and white...’. A business card of Louise Roberts bearing a representation of BEL’s mark is also exhibited. Also included in this exhibit are a selection of examples showing the word ELEMENTS being used as, or part of, a trade mark. The examples range from use on a bath soak to use as the name of a rock band. I note that none of the examples, apart from BEL’s own use, are within the field of clothing.

18. Although the Statement amounts to submissions rather than evidence, given it forms the totality of BEL’s evidence, and in the absence of any other written submissions, I include it here and it will be taken into account when reaching my decision.

Proof of use

19. The Trade Marks (Proof of Use, etc) Regulations 2004 apply in this case. The earlier trade mark relied on by ARS had been on the register for more than five years at the date of publication of the applied for mark (7 April 2006). ARF was, therefore, required to make a statement of use. It claimed use in relation to all of the goods for which its mark is registered. BEL accepted this statement [Box 5 of the Form TM8 refers]. As a consequence of this I must proceed

on the basis of assumed notional use of ARF's mark across the full range of goods for which it is registered.

Section 5(2)(b)

20. "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."

An earlier trade mark is defined in Section 6 of the Act as follows:

"6.- (1) In this Act an "earlier trade mark" means

(a) a registered trade mark, international trade mark (UK), Community 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,"

21. I take into account the well established guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723. It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v. Puma AG*, paragraph 22;

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, paragraph 23, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* paragraph 27;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*, paragraph 23;

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*, paragraph 23;

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17;

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*, paragraph 24;

(g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*, paragraph 26;

(h) further, 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; *Marca Mode CV v. Adidas AG & Adidas Benelux BV*, paragraph 41;

(i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.

Comparison of goods

22. The respective sets of goods are as follows:

ARF's goods	BEL's goods
<p>Class 25:</p> <p>Sportswear; football boots, studs for football boots; footwear for sports; shirts, jumpers, blouses, windcheaters, parkas, jackets, trousers, gloves, socks, stockings, underwear, pyjamas, night-dresses, waistcoats, cloaks, shawls, coats, scarves, jerseys, skirts, suits, neckties, belts, suspenders, swimsuits; caps (headwear), waterproof clothing, anoraks, gymnastics and sports clothing included in this class; dressing gowns; stoles, headscarves; suits; overalls; footwear and headgear; knitwear.</p>	<p>Class 25:</p> <p>Clothing, footwear, headgear.</p>

23. In her counterstatement Ms Roberts states that the goods sold under her trade mark are exclusive women's 3 piece suits, shirts, tops and accessories for the busy working woman. She deduces that ARF sell a broad range of clothing which varies from football boots.... to pyjamas and stockings. She goes on to say that 'there is no way that two different merchandise mixes could be conceptually similar and confuse customers'.

24. BEL did not request ARF to demonstrate use of its mark. I must therefore consider the notional scope of its registration. The goods covered by ARF's registration are articles of clothing of various forms, including footwear and headgear. The general term 'clothing' included in BEL's application would include the specific items of clothing included in ARF's registration. It is clear therefore that based on the notional scope of the respective specifications, identical goods are in play.

The Relevant Consumer and the nature of the purchasing decision

25. The issues are to be considered from the perspective of the relevant consumer who is deemed to be reasonably well informed and reasonably circumspect and observant. That relevant consumer will range from the general public to the wholesaler/ merchandising distributor. Purchases of clothing are likely to be made with some degree of care not least because issues of size, style, colour, price etc must be considered. Nevertheless, the consumer may not exercise the very highest level of attention, particularly if the item is a relatively low cost or utilitarian item, such as a pair of socks. The contrary may of course be the case if very expensive items are involved, such as designer dresses and the like. Notionally the marks could be used on low cost utilitarian items of clothing or expensive designer garments. I therefore take into account the fact that the levels of attention may vary depending on the goods.

Comparison of Marks

26. The marks for comparison are:

ARF's Mark

basicelements

BEL's Mark


ELEMENTS

27. In his decision sitting as the Appointed Person in the *React* trade mark case [2000] R.P.C. 285, Mr Simon Thorley stated:

“There is no evidence to support Ms Clark's submission that, in the absence of any particular reputation, consumers select clothes by eye rather than by placing orders by word of mouth. Nevertheless, my own experience tells me it is true of most casual shopping. I have not overlooked the fact that catalogues and telephone orders play a significant role in this trade, but in my experience the initial selection of goods is still made by eye and subsequent order usually placed primarily by reference to a catalogue number. I am therefore prepared to accept that a majority of the public rely primarily on visual means to

identify the trade origin of clothing, although I would not go so far as to say that aural means of identification are not relied upon.”

28. The decisions in *Claudia Oberhauser v OHIM (Fifties)* [2003] E.T.M.R. 58, and *Criminal Clothing Ltd v Aytan’s Manufacturing (UK) Ltd*, [2005] EWHC 1303 also indicate that the circumstances in which the relevant goods and trade marks are encountered by the consumer, particularly at the point at which the purchase is made is an important consideration, but the matter must be assessed by applying an assessment of all relevant factors. So although the selection of clothes is a visual act, that places most importance on the appearance of marks, this does not negate the need to consider and balance the aural and conceptual similarities.

29. With that background in mind I go on to assess the visual, aural and conceptual similarities of the marks, having regard to the overall impressions created by them bearing in mind their distinctive and dominant components.

Visual consideration

30. It is self-evident that ARF’s mark and BEL’s mark are not identical. However, there are points of similarity between the marks, notably the presence in both of the word ELEMENTS. That the respective marks are presented in either upper case or lower case is not a material consideration; use of the respective marks notionally extends to use in any normal font and case. The word ELEMENTS is an ordinary English word which I consider will be known to most persons familiar with the language, it is a word commonly used to denote something that is a part or component of some whole. Neither side has commented specifically on the distinctive character *per se* of this word, although I note that Ms Desmond opines that the important component in both marks is the word ELEMENTS (para 4 of her witness statement). In relation to goods that usually come in various parts, such as suits composed of jackets, skirts or trousers, this word may well be regarded as having some descriptive reference. It may be also be taken by some as an indirect reference to atmospheric conditions and thus obliquely alluding to clothing designed to withstand rain, wind etc. Notwithstanding this I do not consider that the word ELEMENTS should be taken as being directly descriptive.

31. In any event the respective marks are not composed solely of the word ELEMENTS; each has other matter. In the case of ARF’s mark this is a stylised device of a letter ‘E’ with an ‘arrow’ shape contained within its open jaws. It is centrally positioned above the word ELEMENTS, and is proportionally slightly larger. To my mind the stylisation is such that it must undoubtedly be a distinctive part of the mark. BEL’s mark has the word BASIC as a prefix to the word ELEMENTS, the first word placed on a dark background and the second on a lighter background. This serves to emphasise that the mark is composed of two separate words. BASIC is another ordinary English word with a meaning that I would say is even more likely than the word ELEMENTS to be understood by the consumer. It is widely understood as denoting something that is “no frills”, and as such it has a more obvious reference to the some characteristic of the goods. Even so, I would say that in itself it is not directly descriptive. It also hangs together with the word ELEMENTS so I do not see that it will be disregarded by the consumer’s eye.

32. I consider that to the extent both marks contain the word ELEMENTS there is a degree of visual similarity, but not to the extent that I consider the marks visually similar as a whole.

Aural consideration

33. In a composite mark it is most unlikely that the consumer will embark upon a description of the graphical features, it will be the word(s) that are the point of reference. Insofar as the respective marks each contain the word ELEMENTS, there must be some phonetic similarity. The word 'basic', at the beginning of BEL's mark is a prominent component that will have an impact on how the mark sounds when spoken. Despite the fact that the words 'basic' and 'elements' are conjoined, due to the contrasting backgrounds upon which they are presented, I consider that they will be verbalised as two separate words.

34. In my view to the extent that both marks contain the word ELEMENTS there is a degree of aural similarity, but the marks overall are not aurally similar to a significant extent.

Conceptual consideration

35. As I have stated previously the word ELEMENTS is a well known word. In the context of clothing it is my view that any one of its meanings may be fixed in the mind of the consumer. When encountering ARF's mark the figurative component is likely to be perceived as a letter E with significant stylisation. ARF's mark will be remembered as a figurative and word mark.

36. BEL's mark consists of the words 'basic' and 'elements' conjoined, the words are presented on black and grey backgrounds respectively. In her evidence Ms Desmond provides a definition of the word BASIC; one of the meanings is given as 'elementary or simple'. In her view this is the meaning that would be attributed to the word when encountered within BEL's mark. From my experience as a consumer I know that the word BASIC is commonly used in the clothing field to denote items that are considered to be essential in any wardrobe, that is to say the wardrobe staples; items such as a white t-shirt, a pair of blue jeans, a black skirt etc. are referred to as 'basic'. Because, in Ms Desmond's view, this word is non-distinctive she goes on to say it is therefore the word ELEMENTS in BEL's mark that should be compared with ARF's mark. Although I do not disagree with her analysis to a point, I think that her assessment is based upon a dissection of BEL's mark. It is my view that the presence of the word BASIC in BEL's mark gives that mark as a whole a conceptual meaning which is distinct from that of ARF's mark. In the context of the goods I consider that the relevant consumer would take the meaning of BEL's mark to be basic items of clothing. This concept is not, in my view, present in ARF's mark.

37. I do not consider that the marks are conceptually identical or similar.

Likelihood of confusion

38. This is a matter of global appreciation taking all relevant facts into account. Central to the determination is the interdependency principle whereby a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] R.P.C 117). The distinctive character of the mark must also be taken into account as must the nature of the average consumer and the circumstances in which the goods are supplied/purchased.

39. ARF has made no claim to enhanced distinctive character through use of its mark, and no evidence of use has been filed. The assessment of distinctive character therefore rests with its inherent qualities. I consider that when assessed as a whole the mark is inherently highly distinctive.

40. I consider that the respective goods are identical, but the marks are only similar to a minimal degree. Overall the visual, aural, and conceptual differences outweigh the similarities and I consider that there is no likelihood of either direct or indirect confusion, even allowing for imperfect recollection and even where identical goods are concerned.

Conclusion

41. The likelihood of confusion must be appreciated globally, taking into account all factors relevant to the circumstances of the case. Having done this I find that there is no likelihood of confusion and the opposition fails.

Costs

42. BEL has been successful and is entitled to a contribution towards its costs. I award costs on the following basis:

Considering the Notice of opposition	£200
Filing the counterstatement	£300
Considering and responding to ARF's evidence	£200

TOTAL £700

43. I order ARF to pay BEL the sum of £700. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 26th of February 2008

**Lynda Adams
For the Registrar
the Comptroller-General**