

**O-081-10**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2359115  
BY  
NEXT RETAIL LIMITED**

**TO REGISTER THE TRADE MARK:**

**ANGEL**

**IN CLASS 25**

**AND**

**THE OPPOSITION THERETO  
UNDER NO 95980  
BY  
MAJOR LEAGUE BASEBALL PROPERTIES, INC**

## **Trade Marks Act 1994**

**In the matter of application no 2359115  
by Next Retail Limited  
to register the trade mark:  
ANGEL  
in class 25  
and the opposition thereto  
under no 95980  
by Major League Baseball Properties, Inc**

1) The application to register the trade mark **ANGEL** was made by Next Retail Limited (Next) on 23 February 2004. The application was published for opposition purposes on 26 October 2007 with the following specification:

*clothing, footwear, headgear.*

The above goods are in class 25 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

2) On 28 January 2008 Major League Baseball Properties, Inc (Major) filed an opposition to the registration of the trade mark. Major bases its opposition on section 5(2)(b) of the Trade Marks Act 1994 (the Act). According to section 5(2)(b) of the Act a trade mark shall not be registered if because:

“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.”

The earlier trade mark upon which Major relies is:



It is the subject of Community trade mark registration no 3437308. The application for registration was made on 31 October 2003 and the registration process was completed on 18 April 2005. Consequently, Major's trade mark is

an earlier trade mark and is not subject to proof of use. The trade mark is registered in three classes but, in this case, Major only relies upon the class 25 goods, to wit:

*clothing (excluding jeans and denim clothing), footwear, headgear.*

Major considers that the trade marks are similar and that the respective goods are identical.

3) Next filed a counterstatement. In its counterstatement it denies that the respective trade marks are similar or that the respective goods are similar. In written submissions Next modified the latter position, where it accepted that the footwear and headgear of its application are identical to the same goods of the earlier registration. It maintained that the remaining goods were not similar. Next denies that there is a likelihood of confusion.

4) Neither side requested a hearing, they both furnished written submissions.

***Average consumer, nature of purchasing decision and standard for likelihood of confusion***

5) The goods are bought by the public at large. They can be of low cost and high cost. The clothing trade is very much concerned with brand and brand image, hence, the common practice for trade marks to be placed on the exterior of garments. The consumer will look at garments for colour and style, will often try them on; consequently, there will be a reasonably long exposure to the trade mark in most circumstances prior to purchase. These factors mean that the effects of imperfect recollection are likely to be limited. However, the purchasing of clothes will not involve the sort of educated and careful decision that the purchasing of a product such as a computer would entail. The average consumer "is deemed to be reasonably well informed and reasonably circumspect and observant"<sup>i</sup>. In relation to clothing it is the visual impression of the trade mark that is most important<sup>ii</sup>. The goods are likely to be primarily purchased by reference to labels rather than by oral communication.

### ***Comparison of trade marks***

6) The trade marks to be compared are:

The word "ANGELS" is written in a bold, black, serif font. The letter 'A' is significantly larger than the other letters and features a white halo above it. The entire word is slightly arched.The word "ANGEL" is written in a bold, black, sans-serif font.

7) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details<sup>iii</sup>. 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<sup>iv</sup>. Consequently, I must not indulge in an artificial dissection of the trade marks, although I need to take into account any distinctive and dominant components. The average consumer rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he/she has kept in his/her mind and he/she is deemed to be reasonably well informed and reasonably circumspect and observant<sup>v</sup>. The assessment of the similarity of the trade marks must be made by reference to the perception of the relevant public<sup>vi</sup>.

8) Next claims that Major's trade mark is in a distinctive and stylised typeface and includes a prominent halo over the letter A. It claims that the letter A is "significantly" larger than the other letters in the word and that the trade mark forms an arc. The letter A is not significantly larger than the other letters. The stylisation of Major's trade mark is limited. The trade mark is clearly the word ANGELS. The dominant and distinctive element of Major's trade mark is the word ANGELS. There is only one element of Next's trade mark, the word ANGEL, and so distinctiveness and dominance must rest in this word.

9) Next claims that the respective trade marks are visually, phonetically and conceptually different. Both trade marks refer to a messenger of a god, to a very kind or loving person, a well-behaved child or a backer of a theatrical production. One is the plural form of the other. ANGEL is a commonly used word. The trade marks are conceptually similar to a high degree. There is one letter difference between the trade marks, a letter at the end. In oral use, taking into account the use of the plural and the possessive forms, there is very little difference between the trade marks. The respective trade marks are phonetically similar to a high

degree. The main visual impact of Major's trade mark is not the particular font in which it is written but of the word in itself. There is no great stylisation of Major's trade mark. The respective trade marks are visually similar to a high degree. **The respective trade marks are similar to a very high degree.**

### ***Comparison of goods***

10) Next states that as the registration of Major's trade mark includes an exclusion of *jeans and denim clothing* the provisions of section 13(1) of the Act must be taken into account. Major's registration is for a Community trade mark and so not subject to section 13(1) of the Act. All of the clothing of the application will be included in the clothing of the earlier registration with the exception of jeans and denim clothing. Consequently, with the exception of the excluded goods the respective goods are identical. In assessing the similarity of goods it is necessary to take into account, inter alia, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary<sup>vii</sup>. In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, Jacob J also gave guidance as to how similarity should be assessed<sup>viii</sup>. If Next's application had been limited to *jeans and denim clothing*, this would leave both specifications encompassing goods that clothe the body, and so be for the same purpose and the same end user, the goods of the earlier registration could be bought as alternative to *jeans and denim clothing* and so be in competition, they are likely to be follow the same trade channels. *Jeans and denim clothing* are highly similar to other items of clothing which are not these particular goods. **The respective goods are identical or highly similar.**

### ***Likelihood of confusion***

11) In considering whether there is a likelihood of confusion various factors have to be taken into account. There is the interdependency principle – a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods, and vice versa<sup>ix</sup>. In this case the respective trade marks are similar to a high degree and the respective goods are identical or highly similar.

12) It is necessary to consider the distinctive character of the earlier trade mark; the more distinctive the earlier trade mark the greater the likelihood of confusion<sup>x</sup>. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public<sup>xi</sup>. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the mark to identify the goods for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods from those of other undertakings<sup>xii</sup>. In its submissions Next states that ANGEL is not descriptive nor allusive to the goods. It is the distinctiveness of the earlier trade mark that has to be considered. However, as the distinctive and dominant

element of that trade mark is the word ANGELS, the same logic must be applied and so Next's submission must be considered to be an admission against interest in relation to the likelihood of confusion. In this case even if Major's trade mark were to be considered to only having a limited degree of distinctiveness, owing to the proximity of the trade marks and the goods, likelihood of confusion is inevitable. As the European Court of Justice (ECJ) stated in *L'Oréal SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case C-235/05 P:

"45 The applicant's approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders."

The proximity of the trade marks and the respective goods is such that even if purchasing involved a highly educated process this would not mitigate against there being a likelihood of confusion. Especially taking into account the use of Next's trade mark in the possessive or plural form.

**13) There is a likelihood of confusion and the application is to be refused in its entirety.**

### **Costs**

14) Major having been successful is entitled to a contribution towards its costs. In its written submissions Major requests an award at the top of the scale. It commented upon the preliminary indication and Next's decision to continue with the application after the issuing of the indication. As far as reaching a conclusion in these proceedings I have not, and could not, take any cognisance of the preliminary indication<sup>xiii</sup>. In this case the statement of grounds and counterstatement were not extensive. Next did not file any evidence. Consequently, Major was put to no great trouble in supporting its opposition. It may complain of the delay but this in itself is not something which put it to additional cost. I note that Major put in written submissions during the

proceedings and at the end of the proceedings. I award costs on the following basis:

Opposition fee:	£200
Preparing a statement and considering the counterstatement of Next:	£300
Written submissions:	£300
Total:	£800

**I order Next Retail Limited to pay Major League Baseball Properties, Inc the sum of £800. 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 09 day of March 2010**

**David Landau  
For the Registrar  
the Comptroller-General**

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<sup>i</sup> *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [2000] FSR 77.

<sup>ii</sup> See *Société provençale d'achat and de gestion (SPAG) SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-57/03 and React Trade Mark* [2000] RPC 285.

<sup>iii</sup> *Sabel BV v Puma AG* [1998] RPC 199.

<sup>iv</sup> *Sabel BV v Puma AG* [1998] RPC 199.

<sup>v</sup> *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* [2000] FSR 77.

<sup>vi</sup> *Succession Picasso v OHIM - DaimlerChrysler (PICARO)* Case T-185/02.

<sup>vii</sup> *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117.

<sup>viii</sup> He considered that the following should be taken into account when assessing the similarity of goods and/or services:

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“(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.”

<sup>ix</sup> *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117.

<sup>x</sup> *Sabel BV v Puma AG* [1998] RPC 199.

<sup>xi</sup> *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

<sup>xii</sup> *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

<sup>xiii</sup> Lindsay J in *esure Insurance Limited v Direct Line Insurance plc* [2007] EWHC 1557 (Ch):

“As a subsidiary argument, esure argues before me that the Hearing Officer was wrong to reject the Registrar's preliminary view in the way that he did. Mr Hobbs, drawing attention to the Rules to which I have referred and also to Article 6 ECHR, argues that the Hearing Officer was right in doing as he did. I have no doubt but that the Hearing Officer was right to do as he did. The Registrar's view was arrived at before there was any evidence on either side, before there was any argument on either side and in a context in which it could not be regarded as a decision against the interests of either side without the prospective loser being given an opportunity to be heard, an opportunity which was not given. So far from it being an error of principle to fail to take the Registrar's preliminary view into account, it would, in my judgment, have been a serious error of principle for it to have been taken into account.”