

O-108-18

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3202361
BY OU DAHAN TO REGISTER THE FOLLOWING TRADE MARK**

TOMMY HERITAGE

IN CLASS 25

**AND IN THE MATTER OF OPPOSITION THERETO UNDER NO. 408852
BY TOMMY HILFIGER LICENSING B.V.**

Background and pleadings

1) Ou Dahan (“the applicant”) applied to register the mark ^{TOMMY HERITAGE} in the UK on 15 December 2016. It was accepted and published in the Trade Marks Journal on 23 December 2016 in respect of the following goods in Class 25:

Clothing; Trousers; Outerclotthing; Underwear; shoes; Headgear for wear; Hosiery; Neckties; Scarfs; Leather belts [clothing].

2) Tommy Hilfiger Licensing B.V. (“the opponent”) opposed the mark on the basis of section 5(2)(b), section 5(3) and section 5(4)(a) of the Trade Marks Act 1994 (“the Act”). For the purposes of section 5(2)(b) and section 5(3) the opponent relies upon three earlier marks, one of which is:

Mark details and relevant dates	List of goods
UK No. 2292693 TOMMY Filing date: 14 February 2002 Registration date: 29 July 2005	Class 25: <i>Clothing, footwear, headgear; clothing for men, women and children; shirts, golf shirts, T-shirts, sweatshirts, tank tops, sweaters, jerseys, turtle-necks; shorts, sweatpants, warm-up suits, pants, trousers, jeans, skirts, suits, overalls; blazers, sport coats, vests, waistcoats, jackets, coats, parkas, ponchos; swimwear, bikinis, swim trunks; overcoats, rain wear, wind resistant jackets; sleepwear, pyjamas, robes, bathrobes; underwear, lingerie, hosiery, boxer shorts, socks; hats, wool hats, caps, visors, scarves, head bands, ear muffs; wristbands; shoes, boots, sneakers, beach shoes, sandals, slippers; gloves; cloth bibs; ties; belts; suspenders (braces).</i>

3) This mark has an earlier filing date than that of the contested mark and is registered and therefore qualifies as an earlier mark under section 6 of the Act. The

registration date of the earlier mark is more than five years before the date of publication of the contested mark and, consequently, it is caught by the genuine use provisions at section 6A of the Act and the applicant is entitled to put the opponent to proof of use of its mark.

4) The opponent submits that the respective marks and goods are identical or highly similar and there exists a likelihood of confusion on the part of the average consumer.

5) The opponent also claims that the application offends under section 5(3) and section 5(4)(a) of the Act on the basis that its reputation and goodwill respectively in its earlier marks is such that use of the applicant's mark will lead to unfair advantage, detriment to repute and distinctive character and also to misrepresentation and damage.

6) The applicant filed a counterstatement denying the claims made. It did not exercise its right to put the opponent to proof of use. The consequence of this is that the opponent is entitled to rely upon the full list of goods attached to its earlier mark.

7) The opponent filed evidence and written submissions but the applicant chose to provide neither. Neither party requested a hearing and I make my decision after careful consideration of the papers.

Evidence

8) The opponent has provided evidence in the form of a witness statement by Yu Lian De Bakker, Vice President Legal affairs at PVH Europe B.V., the parent company of the opponent, but for reasons of procedural economy, I do not summarise them.

DECISION

Section 5(2)(b)

9) The opponent relies upon three earlier marks, but for the purposes of my considerations and for procedural economy, I intend to limit my assessment to the likelihood of confusion with the opponents' earlier UK mark no. 229263 TOMMY.

10) 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”.

Comparison of goods

11) In the judgment of the Court of Justice of the European Union (“the CJEU”) in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, 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”.

12) 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 users of the respective goods or services;

- b) The physical nature of the goods or acts of services
- c) The respective trade channels through which the goods or services reach the market
- d) 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;
- e) 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.

13) I also keep in mind the following guidance of the General Court (“the GC”) in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05 (“*MERIC*”):

“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”.

14) The relevant respective goods are:

Applicant's goods	Opponent's goods include:
Class 25: <i>Clothing; Trousers; Outerclothing; Underwear; shoes; Headgear for wear; Hosiery; Neckties; Scarfs; Leather belts [clothing].</i>	Class 25: <i>Clothing, footwear, headgear;</i>

15) The respective specifications contain the identical term *clothing*. Further, the applicant's *shoes* is covered by the opponent's broad term *footwear*. In addition, the applicant's term *headgear for wear* covers identical goods to the opponent's *headgear*. The remaining goods of the application, namely *Trousers; Outerclothing; Underwear; Hosiery; Neckties; Scarfs; Leather belts [clothing]* are all covered by the opponent's broad term *clothing*. In summary, the respective goods are either self-evidently identical or that, when applying the guidance of the GC in *MERIC*, the applicant's specific goods are covered by the opponent's broad terms.

Comparison of marks

16) It is clear from *Sabel BV v Puma AG*, Case C-251/95 (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 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.”

17) 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.

18) The respective marks are shown below:

Earlier mark	Contested mark
TOMMY	TOMMY HERITAGE

19) The earlier mark consists of the single word TOMMY, being self-evidently the dominant and distinctive part of the mark. The applicant's mark consists of the two words TOMMY and HERITAGE presented in a pale blue/grey coloured font. The average consumer is likely to perceive the mark as either the forename TOMMY plus a descriptive (or allusive) term indicating the nature of the range of products sold under the brand TOMMY or, alternatively, a family name consisting of a forename and surname. Where the former meaning is perceived, the first element TOMMY will be dominant and distinctive. Where the mark is seen as a full name, the distinctiveness lies in the totality, with neither element dominating.

20) Visually, the respective marks share the element TOMMY, being the only element of the opponent's mark and the first element of the applicant's mark. They differ in that the applicant's mark contains the additional element HERITAGE and is presented in a thin, pale blue coloured font that differs little from the ordinary typeface of the opponent's mark. When comparing the marks as a whole, this results in a medium level of visual similarity. Aurally, the considerations are similar with the opponents' mark consisting of the two syllables TOM-MEE and the applicant's mark consisting of the same two syllables plus the additional three syllables HEIR-AT-EDGE. They also share a medium level of aural similarity.

21) Conceptually, the opponent mark consists of the male forename TOMMY. The applicant's mark consists of the same forename plus the word HERITAGE. As I referred to earlier (para no. 19) this word will be perceived in one of two ways.

Firstly, because the HERITAGE appears directly after a forename, it may be perceived by some average consumers as a surname. However, there is nothing before me to suggest that it is a common surname, or that it will be readily perceived as a surname. Secondly, the word HERITAGE is also an ordinary and commonly understood dictionary word meaning valued objects passed down from previous generations and is used in a number of ways, including to indicate “a traditional brand or product regarded as emblematic of fine craftsmanship”¹. It is at least equally likely that the average consumer will perceive this meaning and, where this is so, the concept attached to the mark will be that of a heritage range of clothes originating from somebody or a company identified by TOMMY. Where the former meaning is perceived, the applicant’s mark will be seen as a particular individual named TOMMY HERITAGE and there will be a medium level of conceptual similarity. Where the second meaning is perceived, the applicant’s mark will be seen as designating a “heritage” range of goods where the provider is identified as TOMMY and consequently shares a higher level of similarity with the opponent’s mark.

Average consumer and the purchasing act

22) 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*.

23) 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

¹ <https://en.oxforddictionaries.com/definition/heritage>

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.”

24) The average consumer of the goods concerned is the ordinary clothes and footwear purchasing public and there is no reason why I should assume that s/he is any different to that identified by Birss J. above. The GC has continued to identify the importance of visual comparison when considering the purchasing act in respect of clothing (see for example Joined Cases T-117/03 to T-119/03 and T-171/03 *New Look Ltd v OHIM (NLSPORT et al)* [2004] ECR II-3471 at [49]-[50] and Case T-414/05 *NHL Enterprises BV v OHIM (LA KINGS)* [2009] ECR II.). I conclude that the purchasing process is primarily a visual one, however, I do not ignore that aural considerations may be involved.

25) The purchasing act will, generally involve a reasonable degree of care and attention but not the highest degree of attention.

Distinctive character of the earlier trade mark

26) 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).”

27) In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. sitting as the Appointed Person pointed out that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. This is the case here where the single element of the opponents’ mark is reproduced at the start of the applicant’s mark.

28) The opponent’s mark consists of the male forename TOMMY. It is not uncommon in the fashion industry for the whole name, surname only or first name only to be used to identify goods produced by a particular fashion designer. Therefore, a single forename when used in respect of the goods of the opponent, is not endowed with a particularly high level of inherent distinctive character, however, neither is it very low. I conclude that it has a low to medium level of inherent distinctive character.

29) I make no finding regarding enhanced distinctive character, but observe that any such enhancement would increase the likelihood of confusion.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.

30) The following principles are gleaned from the decisions of the CJEU 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.

31) The opponent makes a broad submission that the applicant's mark is highly similar to its earlier mark with both marks sharing the forename TOMMY that it claims is the dominant and distinctive element of the applicant's mark. I have found that:

- The respective goods are identical;
- The respective marks share a medium level of both visual and aural similarity;
- Where the applicant's mark is perceived as a full name, the respective marks share a medium level of conceptual similarity but where it is perceived as a forename and a descriptor then the level of conceptual similarity is higher;
- The word TOMMY is the dominant and distinctive element of the applicant's mark and is virtually identical to the opponent's mark;
- The average consumer is reasonably well informed and reasonably circumspect and the purchasing process is primarily visual, but I do not ignore that aural considerations may also be relevant. The purchasing process will generally involve a reasonable degree of care and attention;
- The opponents' mark is endowed with a low to medium level of inherent distinctive character.

32) I have found that the average consumer is likely to see one of two concepts when encountering the applicant's mark. Some may see it as a full name of a person, but others will see it as indicating the "heritage" range of "Tommy" branded clothing. Whilst I consider both perceptions are equally likely, I note that in his counterstatement, the applicant concedes that "Heritage" is low in distinctive character as it describes a range of clothing reminiscent of the past. When such a meaning is perceived, I have found that the word "Tommy" will have a low to medium level of inherent distinctive character, however, this does not necessarily create a barrier to a finding of a likelihood of confusion (see *L'Oréal SA v OHIM*, Case C-235/05 P, paragraph 45). I keep this in mind when making my finding. I also keep in mind that descriptive or non-distinctive matter is to be given less weight when comparing the marks (see *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, paras 22 and 23).

33) Taking this guidance into account together with my other findings, whilst not all average consumers will perceive the applicant's mark as a forename and a descriptor of clothing reminiscent of the past, a good proportion will, and at least as many as those who see it as a full name. Where this is so, the word "Heritage" carries less weight than the "Tommy" element that is almost identical to the opponent's mark. Consequently, there is a real likelihood of confusion where average consumers will merely perceive the applicant's mark as indicating a heritage range of clothes that originate from the same or linked undertaking as goods provided under the opponent's mark.

34) In light of this, the opposition is successful against the whole of the application which is, therefore, refused.

Section 5(3) and section 5(4)(a)

35) In light of my findings under section 5(2)(b) it is not necessary that I consider these further grounds.

Summary

36) The opposition succeeds in its entirety and the application is refused.

Costs

37) Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 2 of 2016. The opponent filed evidence, but I did not to rely upon this and I make no award for this. It also provided written submissions in lieu of a hearing. Taking account of all of this, I award costs as follows:

Preparing statement and considering counterstatement (including official fee of £200)	£400
Preparing written submissions	£400
Total:	£800

38) I order Ou Dahan to pay Tommy Hilfiger Licensing B.V. the sum of £800 which, in the absence of an appeal, should be paid within 14 days of the expiry of the appeal period.

Dated this 16th day of February 2018

Mark Bryant
For the Registrar,