BL O/1146/23

IN THE MATTER OF THE TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NUMBERS 3,696,697 and 3,723,689 IN THE NAME OF HUMA IRFAN LIMITED

AND IN THE MATTER OF THE OPPOSITIONS UNDER NUMBERS 429,924 AND 431,605 IN THE NAME OF PUMA SE

AND IN THE MATTER OF AN APPEAL FROM THE DECISION OF AARON COOPER (O/507/23) DATED 1 JUNE 2023

DECISION

Introduction

1. This is an appeal from the decision of Mr Aaron Cooper, for the Registrar, dated 23 June 2023 (O/507/23). Puma SE opposed the application of Huma Irfan Limited to register two trade marks (Nos 3,696,697 and 3,723,689). The opposition by Puma was made under sections 5(2), 5(3) and 5(4)(a), but it was unsuccessful on all grounds. Puma appeals.

2. Huma Irfan Limited applied to register the word mark HUMA (No 3,696,697) in classes 14, 18 and 25 on 17 September 2021; and the word mark HUMA LONDON (3,723,689) in classes 3, 9, 14, 18, 25 on 19 November 2021.

3. Puma opposed these applications based on eight registrations. Four of those registrations are for the word mark PUMA (Nos 1,147,681, 779,443, 874,725 and 1,037,791) covering respectively classes 14, 25, 25 and 18. These have all been registered for many years with the most recent date of filing being in 1981. The other four registrations are for the following figurative mark:

4. The four figurative registrations cover the following, respectively: first, classes 9 and 14 (No 801,459,903); second, classes 18, 25 and 28 (No 912,579,728); third, class 3 (No 1,264,076); and fourth, classes 8, 21 and 26 (No 801,470,520). All eight marks are earlier trade marks within the meaning of section 6 of the Trade Marks Act 1994. Furthermore, the opponent was not required to prove use of any of the marks and so the opposition extends across the whole of each of the specifications. In relation to the

opposition under section 5(4)(a), the claim is based on goodwill having developed in the mark PUMA.

Standard of appeal

5. The standard of appeal is by way of review. Neither surprise at a Hearing Officer's conclusion nor a belief that he or she has reached the wrong decision will suffice to justify interference in this sort of appeal. Before that is warranted, it is necessary for me to be satisfied that there was a distinct and material error of principle in the decision in question or that the Hearing Officer was wrong. The principles to be applied were summarised by Joanna Smith J in *Axogen Corporation v Aviv Scientific Ltd* [2022] EWHC 95 (Ch) at [24]. When considering this appeal, and applying these principles, it is important to remember the high bar set.

Grounds of appeal

6. The Appellant challenges the Hearing Officer's decision on two grounds. First, the Hearing Officer erred by failing to treat the evidence filed which showed use of the PUMA mark in the marketplace as representing a notional use of the registered mark. Secondly, the Hearing Officer was wrong to find that the conceptual dissimilarity of the marks was sufficient to negate the visual and aural similarity between the marks in light of the finding that the mark PUMA enjoyed an enhanced distinctive character.

Ground 1: Notional use

7. It has long been established that where a trader has used a mark in a particular way then this is likely to represent *a* notional and fair use of the mark, but it will not necessarily be the only notional and fair use (see *Open Country Trade Mark* [2000] RPC 477 at 482). However, this is subject to a qualification, namely the actual use must represent something that can *objectively* amount to use of the registered mark: *BUILDXACT* (O/934/23), [34].

8. The evidence filed by PUMA included various photographs of clothing where the mark was partially obscured (examples are reproduced in Decision, [70]). There was, for instance, a T-Shirt with "UMA" visible (the P being on the side of the T-Shirt) and a jacket covering a T-Shirt where only the "MA" from the PUMA is visible. Mr Hoole, for the Appellant, submits that because evidence has been presented showing that in the marketplace part of the mark PUMA might be obscured this should have been taken into account when considering the likelihood of confusion.

9. I entirely accept that the images filed in evidence by PUMA represent real examples of how consumers might come across the mark and, furthermore, that when consumers see a trade mark it might sometimes be partially obscured. This occlusion might arise by reason of the actions of the trade mark proprietor (releasing promotional material where the mark is partially obscured) or by the retailer (the way the goods are presented in the shop: folded clothes, for example). But, in my judgment, it would be quite wrong

to take this into account when comparing marks or assessing the likelihood of confusion in opposition proceedings.

10. I take this view for three reasons. First, it offends the rule that consumers normally perceive a mark as a whole. Secondly, it could lead to a host of permutations being considered to amount to notional use of a mark (both of the earlier mark and the mark being applied for). In this case, as explained above, there was evidence that the mark was encountered partially obscured, such that it appears as (P)UMA or (PU)MA. It would be very odd to suggest that promotional images showing only the letters MA amount to a notional use of the mark PUMA and so the comparison should be between the applicant's mark and merely the letters MA. Thirdly, allowing for partial obscurity would lead to perverse incentives for trade mark owners to promote the mark with parts of it obscured to broaden the scope of protection.

11. I therefore dismiss this ground of appeal.

Ground 2: Conceptual similarity

12. The Hearing Officer concluded that the PUMA marks and the mark HUMA were visually similar to a higher than medium (but not high) degree (Decision, [74]), they were aurally similar to between a medium and high degree (Decision, [77]), and they were conceptually dissimilar (Decision, [79]). The Appellant did not challenge any of these findings (or the findings in relation to HUMA LONDON).

13. The Hearing Officer also concluded that the visual component of the mark will dominate the selection process of the goods at issue, but the aural component may play a role where advice is received from a sales assistant (Decision, [59]). The Appellant supports this finding.

14. The Hearing Officer also found that the PUMA '903 mark enjoyed enhanced distinctiveness in relation to Sunglasses (Class 9); the '728 mark enjoyed it in relation to Apparel, footwear, headgear (Class 25); the '443 mark in relation to Articles of clothing, none being made of fur (Class 25); and the '725 mark in relation to Shoes and parts therefor included in Class 25, all for the use in sports and athletics (Decision, [93]). Once more, none of these findings was challenged by the Appellant.

15. The Appellant's case was that in light of these findings of fact the Hearing Officer should inevitably have found that the HUMA mark was confusingly similar to the PUMA mark for the purposes of section 5(2), that there would be a link between the marks for the purposes of section 5(3), and that the use of the HUMA mark would lead to a misrepresentation for the purposes of section 5(4)(a). The arguments presented were largely the same in relation to each ground.

16. Whereas, beginning with the section 5(2) ground, the Hearing Officer concluded otherwise at Decision, [96] (footnote omitted):

> Taking all of the above into account and bearing in mind the principle of imperfect recollection, I am not convinced that any of the parties' marks would be mistakenly recalled or misremembered for one another. While I appreciate the level of visual and aural similarity between the marks, I consider that the conceptual distinction between a well-known dictionary word and a seemingly made-up or foreign language word with no obvious meaning would clearly be noticed. This conceptual difference will, in view, counteract any visual and aural similarities. This is particularly the case given that the marks have a different first letter and, as I have set out above, this is where the average consumer tends to focus. Even taking into account the high degree of distinctive character of 'PUMA', I see no reason why their different beginnings and concepts would be overlooked or misremembered. Consequently, I do not consider there to be any likelihood of direct confusion. For the avoidance of doubt, this finding applies even where the parties' marks are viewed on identical goods and in situations where the average consumers pays a lower degree of attention.

17. The Hearing Officer went on to find that there would be no indirect confusion because "the alteration of the well-known and distinctive element, 'PUMA', to a different and seemingly made-up or foreign language word, 'HUMA', is completely illogical and it is my view that the average consumer would reach the same conclusion." (Decision, [100]).

18. Mr Hoole puts forward a number of reasons why the Hearing Officer was incorrect in his conclusions. First, he submits that, because the Hearing Officer found the purchasing decision was largely visual (and some aural involvement), the conceptual meaning of a mark is less important. I do not think this finding assists the Appellant's case. It is difficult to imagine many cases where the conceptual meaning of a mark is relevant to a purchasing decision. This is because a mark is a signifier, and the concept of a mark is what is signified (whether a simple denotative meaning or a connotative meaning or both). But the finding about the purchasing decision relates to how the consumer comes into contact with the signifier in the marketplace (ie whether the mark is seen, or heard, or is possibly involves one of the other senses, such as touch). What the mark signifies is therefore immaterial to this finding and so I reject Mr Hoole's submission.

19. Secondly, Mr Hoole relies on a decision of the EUIPO Opposition division (B 2 744 186 *Puma v Yuma*) where it was held that the conceptual differences between Puma and Yuma could be overcome by reason of the highly distinctive character of the Puma mark. This finding is treated as opinion evidence and is inadmissible in these proceedings under the rule from *Hollingworth v Hethorn* [1943] KB 587 (also see BANDIT (O/197/23), [13] to [20]). This equally applies to other cases cited by the Appellant where the visual and aural similarity could not be overcome by the conceptual dissimilarity. Accordingly, I will not consider these cases further.

20. Thirdly, Mr Hoole refers to *Aveda Corp v Dabur India* [2013] EWHC 589 (Ch), [48] and a comment by Arnold J that "The human eye has a well-known tendency to see what it expects to see and the human ear to hear what it expects to hear." I entirely accept this observation, but it was made in relation to a mark where the changed letter was in the middle of a mark not at the beginning (DABUR UVEDA and AVEDA). It was also supported by the fact the Hearing Officer had wrongly written AVEDA instead

of UVEDA in the decision and the Intellectual Property Office database had the decision wrongly recorded as DABUR AVEDA (not DABUR UVEDA).

21. In short, a difference of a letter in the middle of a word is quite different from a different first letter (even where the earlier mark has independent distinctive character). Indeed, it is a widely adopted principle that the beginning of a word mark is given greater attention: T 109/07 *L'Oréal*, EU:T:2009:81, [30]; T-412/08 *Trubion*, EU:T:2009:507, [40]; T-41/19 *MSI Svetovanje, marketing*, EU:T:2019:764, [68]). Accordingly, I am not sure Arnold J's observation assists the Appellant.

22. It is clear that the conceptual differences between two marks may counteract any visual or aural similarity and this can apply even where the earlier mark has enhanced distinctiveness (see C-361/04P *Picasso v OHIM* [2006] ECR I-660, [20] to [28]; cited by the Hearing Officer in Decision, [96] footnote 30). The assessment of whether the conceptual difference between HUMA and PUMA was sufficient to counteract the other similarities is a pure value judgment and the conclusion reached by the Hearing Officer was not one which falls outside the bounds within which reasonable disagreement is possible. Accordingly, it would be improper for me to disturb it on appeal.

23. The Hearing Officer likewise concluded there would be no link between the two marks in the mind of the relevant public (Decision, [114]). His reasons for this finding were largely the same as those for section 5(2) and, accordingly, I also see no reason why the finding should be disturbed on appeal. It was a finding he was entitled to make. The same applies to his finding in relation to section 5(4)(a).

24. Accordingly, I dismiss the second ground of appeal.

Conclusion

25. I have dismissed the appeal in its entirety and upheld the Hearing Officer's decision to dismiss the opposition.

26. The Respondent, Huma Irfan, was a litigant-in-person. She indicated that she spent about 10-15 hours preparing for the case. Litigants in person are usually awarded costs before the Appointed Person on the same basis as before the High Court, namely at a rate of £19 per hour. Accordingly, in light of the range of time indicated by the Respondent, I will work on the basis she spent a little over ten hours preparing for the Hearing and award her £200 in costs. This is to be paid by the Appellant to the Respondent within 14 days of the date of this decision.

PHILLIP JOHNSON
2 December 2023

Representation

Chris Hoole (of Appleyard Lees IP LLP) for the Appellant

Huma Irfan (litigant-in-person) for the Respondent