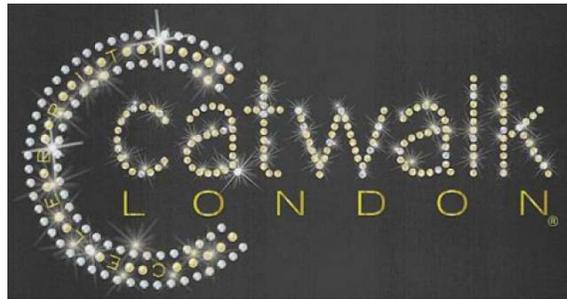


O/137/12

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2554490
BY
CONTINENTAL SHELF 128 LIMITED
TO REGISTER A SERIES OF TWO TRADE MARKS**



IN CLASS 25

AND

**THE OPPOSITION THERETO
UNDER NO 101215
BY
DOSENBACH-OCHSNER AG SCHUHE UND SPORT**

Background

1. Continental Shelf 128 Limited (“the applicant”) applied to register the above trade mark on 30 July 2010 for the following goods in class 25:

Clothing; outer clothing; under clothing; underwear, lingerie; sleep wear, pyjamas, night dresses, dressing gowns, robes; sports clothing; water proof clothing; swimsuits, swimwear; footwear; shoes, boots, sandals, slippers; socks; headgear; hats, caps; scarves, gloves, mittens; neckties.

2. The application is for a series of two marks, one of which includes yellow lettering and the other which is shown on the application form in black and white. The application was published on 20 August 2010 in the *Trade Marks Journal*, following which an opposition was filed by Dosenbach-Ochsner AG Schuhe und Sport (“the opponent”). The opponent claims that the application offends section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). This section states:

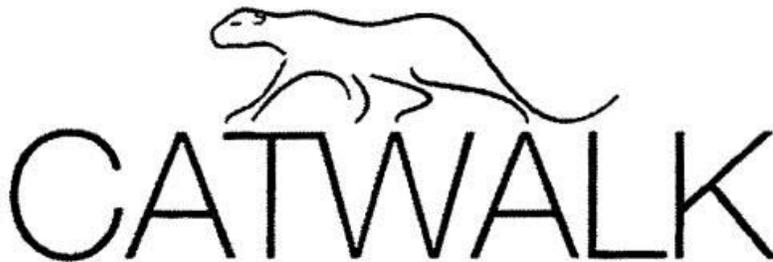
“5. (2) A trade mark shall not be registered if because –

(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.”

3. The opponent relies upon the following goods of its International Registration designating the European Community, number 0938207:



Class 18: *Goods made of leather and leather imitations (included in this class) namely bags and other containers not adapted to their content as well as small leather articles, especially purses, wallets, key cases, trunks and travelling bags, umbrellas, parasols.*

Class 25: *Clothing, footwear, headgear.*

4. Protection for the opponent's international registration designating the European Community was requested on 22 August 2007, claiming a priority date of 22 June 2007 from the German Office of Origin. The database of the Office for Harmonisation in the Internal Market ("OHIM") records that it was "accepted for international registration", i.e. protected, on 22 August 2008. Consequently, this is an earlier trade mark which is not subject to proof of use¹ because at the date of publication of the opposed application (20 August 2010) it had been protected for less than five years. The significance of this is that the opponent's mark can be taken into account across the full breadth of the goods relied upon on the basis of notional and fair use of the terms in its specification. The opponent claims that it is a well-established retail chain for shoes, apparel, accessories, sporting and leather goods. It also claims that the applied-for mark includes the opponent's mark for goods which are either identical or very similar and so there will be a likelihood of confusion. The opponent also claims that the average consumer will assume that there is a connection between the opponent and the applicant as a result of CATWALK being included in the application.

5. The applicant filed a counterstatement in which it denies that there is a likelihood of confusion. Both sides filed written submissions; neither side filed evidence. Both sides were content for a decision to be made from the papers on file rather than attend a hearing and both sides filed written submissions in lieu of a hearing.

Decision

6. The leading authorities which guide me in this ground are from the Court of Justice of the European Union ("CJEU"): *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P (LIMONCELLO)*. 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*,

(b) the matter must be judged through the eyes of the average consumer for the goods/services in question; *Sabel BV v Puma AG*, 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.*,

¹ See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations) 2004 (SI 2004/946) which came into force on 5th May 2004.

(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*,

(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*,

e) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

f) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*.

(g) 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*,

(h) 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*,

(i) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(j) 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*,

(k) 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 and Adidas Benelux BV*,

(l) 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*.

Comparison of goods

7. Both parties' class 25 specifications include the terms clothing, footwear, and headgear. The applicant's specification also lists various items of clothing, footwear and headgear. The opponent's *clothing, footwear and headgear* encompass all the specific items listed in the applicant's specification. The goods of both parties are identical as a result of identical terms (clothing, footwear and headgear) appearing in both specifications and also because the specific items listed in the applicant's specification fall within the ambit of the wider terms *clothing, footwear, headgear* in the opponent's specification².

Average consumer and the purchasing process

8. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect, but his/her level of attention is likely to vary according to the category of goods. The average consumer for clothing is the general public. Clothing may be tried on for size and comfort and varies considerably in price. A reasonable level of attention will be paid to its purchase, but not the highest level of attention. The purchase of clothing will be primarily visual, but I do not discount the potential for oral use of the mark³.

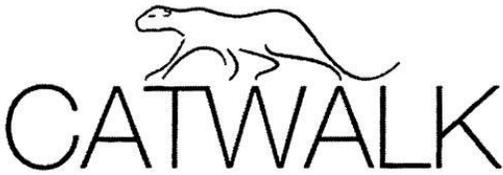
Comparison of trade marks

9. The above authorities direct that, in making a comparison between the marks, I must have regard to each mark's visual, aural and conceptual characteristics. I have to decide which, if any, of their components I consider to be distinctive and dominant, without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details. Although the application is for a series of two marks, I will, for convenience, refer to the mark in the singular because the colour element in the first mark in the series makes no difference to the comparison of marks, the opponent's mark being protected without reference to colour.

² General Court in *Gérard Meric v OHIM*, case T-133/05.

³ *New Look Ltd v Office for the Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Joined cases T-117/03 to T-119/03 and T-171/03 the General Court (GC) said: "50. The applicant has not mentioned any particular conditions under which the goods are marketed. Generally in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly the visual aspect plays a greater role in the global assessment of the likelihood of confusion."

10. The marks to be compared are:

Opponent's mark	Application
	

11. The word CATWALK in the opponent's mark is larger than the device of a cat. CATWALK is clearly the dominant element of the mark in terms of proportion, although the device has a good deal of impact and is more distinctive than the word CATWALK in the context of the goods (I will say more about this below). However, overall, the word element is the dominant distinctive component of the opponent's mark. The applicant's mark is made up of three components: the words CATWALK and LONDON and the "C" device, which is made up of three bands of dots made to sparkle like jewels. Running through the C device, but really only discernable upon close analysis, is the word CELEBRITY. 'LONDON' is written in plain lettering and CATWALK is comprised of sparkling dots, in the manner which appear in the C device. The C device takes up a large proportion of the mark. LONDON plays considerably less of a part in the mark than CATWALK and the C device. Overall, considering its length and positioning the CATWALK is the dominant distinctive element of the applicant's mark.

12. CATWALK is the only element which both marks share. The differences are the cat device, the large sparkling C device, the CATWALK sparkles, the word LONDON and the word CELEBRITY, although the latter is negligible in terms of impact. There are more points of visual difference than similarity. Bearing in mind the relative size of the word CATWALK in both marks, I conclude that the marks are, visually, similar to a reasonable degree. Aurally, I think it unlikely that the C device and the word CELEBRITY will be articulated, the latter being almost indiscernible. The cat device does not form part of the aural comparison⁴;

⁴ See the decision of the General Court in T-424/10, *Dosenbach-Ochsner AG Schuhe und Sport v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-424/10: "45 The fact none the less remains that, contrary to what the applicant submits, a phonetic comparison is not relevant in the examination of the similarity of a figurative mark without word elements with another mark (see, to that effect, Joined Cases T-5/08 to

consequently, the comparison is between CATWALK and CATWALK LONDON. There is a good deal of phonetic similarity.

13. Turning to the conceptual impression of the respective marks, the opponent's mark clearly contains a device of a cat and it will immediately be recognised as such by the average consumer. The word CATWALK also has a meaning capable of immediate grasp; although it is made up of CAT and WALK, and so one could say there is a tongue in cheek reference to the walking cat device above it, CATWALK is a word in its own right. It means, to quote from the online Collins English Dictionary in the opponent's submissions:

- “1. a narrow pathway over the stage of a theatre or a along a bridge
2. a narrow platform where models display clothes in a fashion show.”

14. In the context of the goods, clothing, the second of these is the meaning which is most relevant for consideration. This is the opponent's position in its submissions. I think it unlikely that the average consumer will make a connection between the walking cat device and CATWALK, unless they give the mark an abnormally high level of attention; therefore, there are two concepts at play in the opponent's mark. These are (i) the cat and (ii) the catwalk meaning identified above.

15. The catwalk meaning is also the main concept of the applicant's mark. CELEBRITY is so hard to read that it is negligible; if I am wrong in that and it would be noticed, then I consider that it forms part of the CATWALK concept; i.e. a catwalk for or relating to celebrity fashion. LONDON is simply a geographical anchor for the CATWALK concept (a London catwalk). The sparkling letters are an embellishment and add to the impression of glamour, fashion and modelling. The C device has no concept beyond that it is the letter C, albeit dressed in sparkles.

16. In summary, the opponent's mark has two concepts, the cat and the catwalk, while the concept of the applicant's mark is that of a catwalk. The marks share a good degree of conceptual similarity, a moderate to low degree of visual similarity and a good deal of phonetic similarity. I will bring forward these points when I consider whether there is a likelihood of confusion.

T-7/08 Nestlé v OHMI – *Master Beverage Industries (Golden Eagle and Golden Eagle Deluxe)* [2010] ECR II-1177, paragraph 67).

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.”

Distinctiveness of the earlier mark

17. It is important that I consider the distinctive character of the earlier mark because the more distinctive it is, either by inherent nature or by use (nurture) the greater the likelihood of confusion⁵. The distinctive character of the earlier trade mark must be assessed by reference to the goods for which it is registered and by reference to the way it is perceived by the relevant public⁶. The opponent has not filed any evidence of use so I have only the inherent distinctive position to consider. The cat device is distinctive. Used in relation to clothing, footwear and headgear, CATWALK is suggestive of clothing which has been modelled or is part of a designer collection of clothing, e.g. “hot off the catwalks of Paris/London/Milan” etc. Although CATWALK for these goods has a tangential relationship with clothing, it is not descriptive. Overall, the combination of the cat device and the word CATWALK means that the opponent’s mark has a reasonably high degree of inherent distinctive character.

Likelihood of confusion

18. In deciding whether there is a likelihood of confusion between the marks, I must weigh the various factors I have identified and also bear in mind the principle of interdependency, whereby a lesser degree of similarity between the goods may be offset by a greater degree of similarity between the trade marks, and vice versa (*Canon*). I have found identity between the respective goods.

19. I bear in mind the whole mark comparison and the dominant and distinctive elements within the marks. I should guard against dissecting the marks so as to distort the average consumer’s perception of them; the average consumer perceives trade marks as wholes and rarely has the opportunity to compare marks side by side, relying instead upon the imperfect picture he has of them in his mind. The opponent has submitted that its cat device is a ‘weak’ element, although it does not explain why it makes this submission, beyond stating that it is subordinate in size to the CATWALK element of its mark. This, by itself does not mean it is weak; it may not be dominant, but it is not proportionally insignificant and it is a distinctive element in the mark. The opponent’s pleadings also state that the application includes the opponent’s mark; this plainly is not the case in view of the differences which I have identified above. The opponent also submits that the opponent’s mark is known as CATWALK and it is identified as CATWALK on the website of the Intellectual Property Office. Firstly, there is no evidence to show that the mark is known as CATWALK. Secondly, it is of no relevance that the Intellectual Property Office has catalogued it as CATWALK:

⁵ *Sabel BV v Puma AG* [1998] RPC 199.

⁶ *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

the Office captures and identifies all word elements in marks. In point of fact, the opponent has said that CELEBRITY in the applicant's mark is negligible, but this is also captured on the Office's website for the applicant's mark. The capturing of trade mark details by the Office has no bearing on the impression of marks on the average consumer.

20. The opponent also refers to an action between the parties before OHIM in which it was successful. In the action, the marks were CATWALK STOCKHOLM and CATWALK LONDON. The issues were clearly different to those which I have to consider in this case in view of the other elements in the marks; consequently, the OHIM decision does not assist the opponent. Nor does the applicant's argument that it has registered prior marks, CATWALK and CATWALK LONDON, a state of affairs upon which both sides have concentrated much of their submissions. As stated in Tribunal Practice Notice 4/2009:

“Defences including a claim that the applicant for registration/registered proprietor has a registered trade mark that predates the trade mark upon which the attacker relies for grounds under sections 5(1) and 5(2) of the Act.

1. A number of counterstatements in opposition and invalidation actions have sought to introduce as a defence that the applicant for registration/registered proprietor has a registered trade mark (or trade mark application) for the same or a highly similar trade mark to that which is the subject of the proceedings that predates the earlier mark upon which the attacker relies.

2. Sections 5(1) and 5(2) of the Act turn upon whether the attacker has an earlier trade mark compared to the mark under attack, as defined by section 6 of the Act. Whether the applicant for registration/registered proprietor has another registered trade mark (or trade mark application) that predates the earlier mark upon which the attacker relies cannot affect the outcome of the case in relation to these grounds.”

21. One of the factors to consider in the global appreciation is the weight which I should attach to the type of purchasing process. The relevance of this point is that sometimes the characteristics of the purchasing process for some goods and services are more aural than visual. However, in the instant case, the average consumer's selection and contact with the parties' marks will be overwhelmingly visual, so the level of visual similarity is more important. I have found the marks to be visually similar to a reasonable level and that CATWALK is the dominant distinctive element of both the opponent's mark and the applicant's mark. The General Court said in *Ontex NV v OHIM* Case T- 353/04:

“68 It must be pointed out that although, strictly speaking, the visual impression of a sign consists of the overall impression it produces, the fact

that some of its constituents produce a greater or lesser visual impact cannot be ruled out. That is also true in a case such as the present, in which the sign consists of a single word. The sequence 'e-u-r-o' of the earlier mark immediately attracts the visual attention of consumers. That is due to the multiple repetition, in consumers' everyday life, of situations in which they are led to perceive various words constituted by that sequence of letters, including, in particular, the word 'euro', relating to the single currency, or even the words 'Europe' and 'European'. The visual attraction of the sequence in question is instinctive. It does not, therefore, depend on a conceptual analysis of the earlier mark by consumers or on the fact that they attribute a specific meaning to it."

In the instant case, the presence of CATWALK in both marks also leads to the finding of a good level of conceptual similarity. Assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark,⁷ but that the overall impression conveyed to the relevant public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components. I consider that CATWALK is the element which will dominate both marks and that this is the constituent which will produce the greatest impact in the average consumer's overall impression of each mark.

22. In *New Look Ltd v OHIM*⁸, the General Court said:

"51 Nevertheless it is common in the clothing sector for the same mark to be configured in various ways according to the type of product which it designates. It is also common for a single clothing manufacturer to use sub-brands (signs that derive from a principal mark and which share with it a common dominant element) in order to distinguish its various lines from one another (*Fifties*, paragraph 49, and *BUDMEN*, paragraph 57). In the present case the conceptual content of the marks applied for may reinforce the consumer's perception of them as sub-brands of a mark NL. Even if the consumer were faced with only one of the signs in question, the separate perception of 'NL' in bold type, first, and then of the following word, which may evoke the idea of a certain style of clothing, might lead the consumer to identify it as a sub-brand of the mark NL. Moreover, the different written form of the letter combination 'NL' in the signs applied for as compared with that of the earlier trade mark NL could be perceived as a particular configuration of that mark. Accordingly, the conclusion of the Board of Appeal that the consumer may perceive the marks applied for as special lines originating from the undertaking which is the proprietor of the earlier trade mark must be upheld."

⁷ *Shaker di Laudato & C. Sas v OHIM*.

⁸ Joined cases T-117/03 to T-119/03 and T-171/03.

In this case, I do not think that there will be direct confusion, in the sense that the marks will be mistaken for each other. However, I do think that the average consumer will believe there to be an economic connection between the undertakings responsible for the marks. They will see CATWALK marks configured in different ways in order to signify different product lines or sub-brands, sharing the common dominant element CATWALK. There will be a likelihood of confusion in the indirect sense.

23. The opposition succeeds.

Costs

24. The opponent has been successful and is entitled to an award of costs⁹. The cost award breakdown is:

Preparing a statement and considering the applicant's statement	£200
Opposition fee	£200
Preparing written submissions and considering the applicant's written submissions	£500
Preparing submissions in lieu of a hearing	£200
Total:	£1100

25. I order Continental Shelf 128 Limited to pay Dosenbach-Ochsner AG Schuhe und Sport the sum of £1100. 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 day of March 2012

Judi Pike
For the Registrar,
the Comptroller-General

⁹ As per the scale in Tribunal Practice Notice 4/2007.