

O-152-08

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2423905
BY GLYN BERRINGTON TO REGISTER A
TRADE MARK IN CLASSES 18, 25 AND 35**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 94928 BY RICHARD CHARLES ARCHER-PERKINS**

BACKGROUND

1) On 8 June 2006, Glyn Berrington, applied to register the trade mark:



for the following goods and services in classes 18, 25 and 35:

Class 18: Articles made of leather or made of imitation leather and goods made of these materials; bags, tote bags, shoulder bags, shopping bags, luggage, holdalls, trunks and travelling bags, flight bags, sling bags, rucksacks, backpacks, wallets, purses, credit card holders; (included in Class 18).

Class 25: Articles of clothing, headwear, neckwear, underwear, footwear, nightwear, shoes, boots, trainers, socks, gloves, mittens, scarves, hats, caps, hosiery, socks, sportswear, rainwear, ponchos, capes, bandanas and belts for wear; headgear, hats and caps; sports bags shaped to contain clothing used in sports and athletics.

Class 35: Advertising, promotion, marketing and publicity services; endorsement services; dissemination of advertising, promotion, marketing and publicity materials; retail services connected with clothing, headwear, neckwear, underwear, footwear, nightwear, shoes, boots, trainers, socks, gloves, mittens, scarves, hats, caps, hosiery, sportswear, rainwear, ponchos, capes, bandanas and belts for wear, headgear, hats and caps, sports bags shaped to contain clothing used in sports and athletics, articles made of leather or of imitation leather and goods made of these materials, bags, tote bags, shoulder bags, shopping bags, luggage, holdalls, trunks and travelling bags, flight bags, sling bags, rucksacks, backpacks, wallets and purses, credit card holders; the bringing together, for the benefit of others, of a variety of clothing, headwear, neckwear, underwear, footwear, nightwear, shoes, boots, trainers, socks, gloves, mittens, scarves, hats, caps, hosiery, sportswear, rainwear, ponchos, capes, bandanas and belts for wear, headgear, hats and caps, sports bags shaped to contain clothing used in sports and athletics, articles made of leather or of imitation leather and goods made of these materials, bags, tote bags, shoulder bags, shopping bags, luggage, holdalls, trunks and travelling bags, flight bags, sling bags, rucksacks, backpacks, wallets

and purses, credit card holders, enabling customers to conveniently view and purchase those goods in a retail shop, via mail order catalogues, and Internet websites.

2) Following examination, the application was accepted and published for Opposition purposes in Trade Marks Journal No.6658 on 10 November 2006.

3) On 26 January 2007, Richard Charles Archer-Perkins (hereafter the opponent), filed a notice of opposition. This consists of a single ground based upon section 5(2)(b) of the Act, under which the opponent relies on the following trade mark:

Trade Mark	Number	Application Date	Registration Date	Goods
URBAN SHOCK	2347111	28.10.2003	22.10.2004	<p>14 - Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, costume jewellery, precious stones; horological and chronometric instruments.</p> <p>18 - Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; handbags, rucksacks and purses; umbrellas, parasols and walking sticks; belts of leather and imitations of leather.</p> <p>25 - Clothing, headgear and footwear; scarves, socks, bras, pants and belts.</p>

4) I note that the opposition is directed at all the goods and services save for “Advertising, promotion, marketing and publicity services; endorsement services; dissemination of advertising, promotion, marketing and publicity materials” in Class 35.

5) On 9 March 2007, the applicant filed a counterstatement which stated:

“We do not agree with the grounds for opposition. Even though there is a similarity in the goods under both marks, the marks themselves are sufficiently different to be distinguishable by the consumer. In both marks it is only the word “URBAN” that is identical. Further, [the application] is for device mark. The device in question is particularly distinctive to be easily differentiated from the opponent’s mark. Based on the above contention, we therefore do not accept the grounds of this application.”

6) Both sides filed evidence and seek an award of costs in their favour. The matter came to be heard on 30 April 2008 when the opponent was represented by Mr Murch of Mastrovito &

Associates; the applicant was represented by Mr Ward of Counsel instructed by Silverman Sherliker LLP.

OPPONENT'S EVIDENCE

7) This consists of a witness statement, dated 19 July 2007, from Alice Mastrovito, the opponent's Trade Mark Attorney. Ms Mastrovito confirms that she is authorised to speak on the opponent's behalf. The majority of Ms Mastrovito's witness statement consists of submissions on the law to be applied and her conclusions on the likelihood of confusion between the respective parties' trade marks. This is not evidence, and as such, it is neither necessary or appropriate for me to summarise it here; I will of course bear it in mind when reaching my decision. That said, Ms Mastrovito then goes on to explain that the opponent and his company, ET2C International Inc, trade as URBAN SHOCK with, she explains, ET2C using the trade mark URBAN SHOCK with the opponent's consent. Exhibit 1 consists of prints taken from the website www.urban-shock.com on 19 July 2007 together with a print taken from the website www.et2cint.com (also dated 19 July 2007) and a press release dated 3 April 2007, all of which I note are after 8 June 2006 which is the material date in these proceedings. I note that on the urban-shock website under the heading Company History the following text appears:

“INTRODUCTION TO URBAN SHOCK

Urban Shock is a British run company specializing in women's clothing for the Chinese market. The company is directed by Richard Archer-Perkins, a British chartered accountant now based in Shanghai.

The idea of Urban Shock was founded in September 2003, with the vision of targeting the Chinese women's fashion market. Urban shock was registered on 28 October 2003 in the UK and registered in China on 15 October 2003. Urban Shock's parent company operates as an FICE.”

8) Exhibit AMM2 consists of a BBC News online article dated 14 May 2007, again after the material date, in which Ms Mastrovito notes the following text:

“ET2C International itself decided to move up the value chain by launching a fashion brand Urban Shock, for young women.”

APPLICANT'S EVIDENCE

9) This consists of a witness statement, dated 22 October 2007, by Glyn Berrington. Mr Berrington explains that he is the applicant for the trade mark in suit, and the sole owner of the business trading as The Urban Shop, a position he has held since 2002. He adds that the business of The Urban Shop is primarily online retailing, specialising in the sale of clothing, footwear, headgear, bags and other similar items with a hip hop, street and urban theme which are marketed exclusively to young men. He adds that he has given consent to the business to use the trade mark in suit.

10) Mr Berrington states that the trade mark is used extensively by the business in all its marketing and advertising materials, including on their online retail website at www.theurbanshop.co.uk which he explains has been registered in his name since early 2006. A print taken from the website and dated 23 October 2007 (again after the material date) is shown as exhibit GB1. He continues that since the business started trading in 2006, its has been growing steadily, adding that The Urban Shop now has “an extensive exposure”. He comments that over the past few months (i.e after the material date), “...the Business, the brand and the Mark..” have been featured in national press articles and write-ups in the following publications: *The Sunday Mail*, *Hip-Hop Connection Magazine*, *Pimp Magazine*, *DJ Magazine*, *the Metro* and *One Week to Live Magazine*, although none of these articles are provided.

11) The business and the trade mark have also, says Mr Berrington, been featured as sponsors in a series of advertisements placed on Channel U TV, which he explains is a satellite television channel available on SKY television which features mainly “Grime, Urban and hip hop music”. The advertisement ran from November 2006 to January 2007 (again after the material date) and a copy of the invoice relating to this sponsorship is provided as exhibit GB2.

12) Mr Berrington comments that the business has recently sponsored the Urban Music Awards 2008, which he explains is the leading music accolade for artistes, producers, DJs, broadcasters and labels in the urban music scene. He provides a list of the previous winners and, at exhibit GB3, screenshot extracts from the event’s homepage featuring the trade mark in suit in the top banner together with a hyperlink, and on the sponsor’s page. I note that the pages provided appear to refer to the Urban Music Awards 2007. Whether 2007 or 2008, all of this sponsorship activity appears to relate to periods after the material date.

13) Other than references to state-of-the-register evidence, the remainder of Mr Berrington’s witness statement consists of submissions rather than evidence. Like Ms Mastrovito’s evidence in this regard, I do not intend to summarise these submissions here; I will of course bear them in mind when making my decision.

14) That concludes my summary of the evidence filed, insofar as I consider it necessary.

DECISION

15) The sole ground of opposition is based upon section 5(2)(b) of the Act. This reads:

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

(a)

(b) it is similar to an earlier 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.”

16) An earlier right is defined in section 6 of the Act, the relevant parts of which state:

“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,”

17) In these proceedings, the opponent is relying on one earlier trade mark, registration No. 2347111 which has an application date of 28 October 2003 and qualifies as an earlier trade mark under the above provisions; I note that it achieved registration on 22 October 2004. Given that the application in suit was published for opposition purposes on 10 November 2006, the opponent’s registration is not subject to The Trade Marks (Proof of Use, etc) Regulations 2004.

18) In determining the question under section 5(2)(b), I take into account the following cases: *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabusiki Kaisha v Metro-Goldwyn-Mayer Inc.* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Kilsen Handel BV* [2000] 45 FSR 77, *Marca Mode CV v Adidas AG & Adidias Benelux* [2000] ETMR 723, Case C 120/04 *Medion* [2005] ECR I-8551 and Case C 421/04 *Metratzen Concord v OHIM* [2002].

19) In essence the test under section 5(2)(b) is whether there are similarities in marks and goods and services which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion I am guided by the judgments mentioned above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity in the goods and services, the category of goods and services in question and how they are marketed. Furthermore, I must compare the applicant’s mark and the mark relied upon by the opponent on the basis of their inherent characteristics assuming normal and fair use of the marks on a full range of the goods and services covered within the respective specifications.

20) It was accepted by both parties at the hearing that neither side had used their mark prior to the relevant date. Therefore, neither side can rely upon reputation.

21) I have to consider whether the opponent’s mark has a particularly distinctive character arising from the inherent characteristics of the mark. In my opinion, the opponent’s mark URBAN SHOCK is inherently distinctive for clothing and the other goods for which it is registered.

22) I have to determine the average consumer of the goods in question. It was accepted by both parties that the average consumer will be the average citizen in the UK, despite some suggestions at the hearing that the clothing, in particular, was aimed at women or “young people”. I rejected such contentions as there is no limitation upon the goods of either party that could lead me to accept such a premise.

23) I shall first consider the marks of the two parties. For ease of reference these are reproduced below:

Applicant's Mark	Opponent's Mark
	<p>URBAN SHOCK</p>

24) The opponent seeks to rely upon notional and fair use of the marks. I was referred to Practice amendment notice 9/06 which states:

“7.7 "Notional and fair use" and section 3(1)

The concept "Notional and fair use" refers to how a trade mark may be used in the market-
place and, consequently, will have a bearing on how distinctive the mark will be in its
various modes of use. This will include use on business papers, on packaging and in
advertising, ie. not just on more conventional means for carrying brands, such as swing
tags and sew-in labels etc. A mark may lose trade mark significance when encountered in a
promotional context rather than physically used on the goods. Care must be taken when
examining a mark which "reads" into the goods or services. "Notional and fair use" of a
mark registered in block capitals will also include use in differing typefaces and in upper
and lower case letters.”

25) I was also referred to Practice Amendment Notice 8/07 which states:

“49.9 Notional and fair use

This refers to use across the range of goods/services claimed in any way that would be
considered to be normal use of the trade mark in relation to the goods or services in
question. Notifications should not be waived on the basis that the goods/services will only
be sold in a certain environment, or in a specific price range, or that the mark will only
appear in a certain way in connection with the goods/services. Trade Mark proprietors are
free to change the way they market goods/services and they can assign marks which may
then be used however the new proprietor sees fit.”

26) The opponent contended that:

“This makes it clear that notional and fair use of a mark registered in block capitals includes use in a differing type face or upper and lower case letters. The opponent will contend that the doctrine of notional and fair use extends to use of a mark registered in block letters in any combination of colours, with one word at a 90 degree angle to the other or even in the form of a cube. There is no limitation entered on the Register against No 2347111 [the opponent’s mark]”.

27) I agree with parts of the above such as that which relates to upper and lower case, however, the contention that notional and fair use of the opponent’s mark could include a get up similar to that of the applicant is totally spurious.

28) The opponent also sought relief by instancing how the marks would be used on the internet. It contended that in this context the applicant’s mark would have to be used as URBAN SHOP against its own use of URBAN SHOCK. It was suggested that a search using URBAN SH or URBAN SHO would retrieve both parties marks. Whilst I accept that internet sites are likely to be used by both parties there is no limitation on either side restricting use only to the internet. I must consider how the marks would be used in the wider context of the marketplace.

29) The opponent sought to compare the marks in their simplest form with the applicant’s mark being reduced to “The Urban Shop.co.uk” and then compared to the opponent’s mark. In this test the opponent dismissed the words “The” and “.co.uk” as non-distinctive. They therefore contended that the first words of the two marks, “Urban”, were identical and that there were only minor differences between the second words “shop” and “shock”. They also contend that the word “shop” is not distinctive, and quote the Registry Practice Guide with regard to the use of “shop”.

30) If the applicant’s mark had been presented as simply the words “The Urban Shop” I would have agreed with most of the above comments. However, the design element of the applicant’s mark is not something which can so easily be dismissed. Similarly, words parts cannot be treated as though they were not present.

31) Visually the marks are very different from each other. Whilst the words “Urban” and “Shop” can be found in the applicant’s mark they require a small amount of effort to realise. I accept that phonetically the marks have similarities. I do not believe that the average consumer would pay much attention to the words “The” or “.co.uk” when verbalising the mark. They are, in my opinion, far more likely to refer to the applicant’s mark as “Urban Shop”. Phonetically the marks share the first word but differ in their second. Conceptually, the applicant’s mark conjures up the image of a building, emphasised by the overall shape and design, whereas the opponent’s mark is fanciful. Can one shock a city?

32) In considering the issues I also take into account the views of Mr S Thorley sitting as the Appointed Person in the *REACT* case [2000] RPC 285 where he said:

“[*Counsel*] ...drew my attention to the fact that in relation to clothing of the type for which the mark is to be registered, anybody using the mark aurally would be informed to some extent of the nature of the goods they were proposing to purchase; they will therefore know of a mark; and they will know what they want. I think there is force in this in the context of purchasing clothes. The Hearing Officer was prepared of his own experience to hold that the initial selection of goods would be made by eye, and I believe this is correct. I must therefore, in taking into account the likelihood of aural confusion, bear in mind the fact that the primary use of the trade marks in the purchasing of clothes is a visual act.”

33) The average consumer for the goods and services of the two parties are the average UK citizen. Items of clothing etc such as those covered by the specifications of both parties are not purchased without some consideration as to the material, cut, design, quality etc. Given all the above it is my view that the differences between the marks far outweigh any slight similarities, particularly given the visual importance of the visual image on clothing.

34) I now turn to consider the specifications of both parties, which are as follows:

Applicant's specification	Opponent's specification
Class 18: Articles made of leather or made of imitation leather and goods made of these materials; bags, tote bags, shoulder bags, shopping bags, luggage, holdalls, trunks and travelling bags, flight bags, sling bags, rucksacks, backpacks, wallets, purses, credit card holders; (included in Class 18).	Class 14: Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, costume jewellery, precious stones; horological and chronometric instruments.
Class 25: Articles of clothing, headwear, neckwear, underwear, footwear, nightwear, shoes, boots, trainers, socks, gloves, mittens, scarves, hats, caps, hosiery, socks, sportswear, rainwear, ponchos, capes, bandanas and belts for wear; headgear, hats and caps; sports bags shaped to contain clothing used in sports and athletics.	Class 18: Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; handbags, rucksacks and purses; umbrellas, parasols and walking sticks; belts of leather and imitations of leather.
Class 35: Retail services connected with clothing, headwear, neckwear, underwear, footwear, nightwear, shoes, boots, trainers, socks, gloves, mittens, scarves, hats, caps, hosiery, sportswear, rainwear, ponchos, capes, bandanas and belts for wear, headgear, hats and caps, sports bags shaped to contain clothing used in sports and athletics, articles made of leather or of imitation leather and goods made of these materials, bags, tote bags, shoulder bags, shopping bags, luggage, holdalls, trunks and travelling bags, flight bags, sling bags, rucksacks, backpacks, wallets and purses, credit card holders; the bringing together, for the benefit of others, of a	Class 25: Clothing, headgear and footwear; scarves, socks, bras, pants and belts.

variety of clothing, headwear, neckwear, underwear, footwear, nightwear, shoes, boots, trainers, socks, gloves, mittens, scarves, hats, caps, hosiery, sportswear, rainwear, ponchos, capes, bandanas and belts for wear, headgear, hats and caps, sports bags shaped to contain clothing used in sports and athletics, articles made of leather or of imitation leather and goods made of these materials, bags, tote bags, shoulder bags, shopping bags, luggage, holdalls, trunks and travelling bags, flight bags, sling bags, rucksacks, backpacks, wallets and purses, credit card holders, enabling customers to conveniently view and purchase those goods in a retail shop, via mail order catalogues, and Internet websites.	
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35) At the hearing it was accepted that there was complete overlap between the class 18 & 25 goods of both parties and as such these must be regarded as identical goods. The only issue on this point is in relation to the Class 35 services. Broadly these relate to the sale of goods in Classes 18 & 25. The contention put forward by the opponent is that the sale of goods identical to those for which the opponent has a registration equates to the services being identical or similar to the goods of the opponent. I was referred to case C 418/02 *Praktiker Bau und Heimwerkermärkte AG* where it was stated that “the risk of confusion between [retail] services and the products, if it cannot be excluded, is nevertheless improbable except in particular circumstances, for example when the respective marks are identical or almost identical and well established on the market”.

36) Earlier in this decision I came to the conclusion that the marks were not identical, indeed overall they are not even similar. The applicant’s services in Class 35 are therefore not similar to the opponent’s goods.

37) Taking account of all of the above when considering the marks globally, notwithstanding the fact that the goods in Classes 18 & 25 are identical, I believe that there is not a likelihood of consumers being confused into believing that the goods and services provided by the applicant are those of the opponent or provided by some undertaking linked to them. The opposition under Section 5(2)(b) therefore fails.

38) As the opponent was unsuccessful the applicant is entitled to a contribution towards its costs. I order the opponent to pay the applicant the sum of £2,000. This sum 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 4th day of June 2007

**George W Salthouse
For the Registrar,
the Comptroller-General**