

O-223-13

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NO 2 616 841
IN THE NAME OF UNIVERSAL GARMENTS INTERNATIONAL TO REGISTER IN CLASS**



25 THE TRADE MARK:

AND

**OPPOSITION THERETO UNDER NO 103 683
BY MATALAN LIMITED**

TRADE MARKS ACT 1994

In the matter of trade mark application 2 616 841 in the name of Universal Garments



International, to register in class 25 the trade mark:

and

Opposition thereto under No 103 683 by Matalan Limited

THE BACKGROUND, PLEADINGS AND ARGUMENTS

1. Universal Garments International (the applicant) applied to register the trade mark



on 05/04/2012. The application was published in the Trade Marks Journal on 25/05/2011 in respect of “clothing, footwear and headgear, socks” in Class 25.

2. Matalan Limited opposes the registration of the mark, based on Section 5(2) (b) and 5(3) of the Trade Marks Act 1994. These grounds of opposition are on the basis of the following earlier trade marks:

Earlier trade mark	Application date	Registration date	Goods and services
CTM 1 018 1881 EASY	8/8/2011	1/3/2013	<p>Class 3 Non-medicated toilet preparations; soaps for personal use, toiletries, cosmetics, hair care products; skin care products; bath lotions; shower preparations; anti-perspirants and deodorants; perfume; eau de toilette; aftershave; shaving preparations; preshaving and aftershave lotions.</p> <p>Class 18 Bags, luggage, travelling bags and cases; toilet bags; wallets and purses; leather belts; umbrellas, parasols and walking sticks; trunks, pannier bags, travel bags, haversacks, back packs, briefcases, rucksacks; shopping bags, holdalls; belts, keycases, key fobs made of leather incorporating key rings;</p>

			school bags and school satchels; beach bags; sports bags; parts, fittings and components for all the aforesaid goods. Class 25 Articles of clothing; footwear; headgear; jeans; t-shirts; sweatshirts; jumpers; sports clothing; sports footwear; jackets and coats; belts; swimwear; lingerie; underwear.
UK 1 125 121 EASY	5/12/1979	5/12/1979	Class 25 Jeans being articles of clothing.
UK 2 024 591 EASY	20/6/1995	1/11/1996	Class 25 Articles of outer clothing; jeans, trousers, jackets, shirts, t-shirts, sweatshirts, waistcoats, cardigans.

3. The opponent argues that the application should be refused under Section 5(2) (b) of the Act as the respective trade marks are similar and the goods applied for are identical and/or similar to those of the earlier trade marks. Further, the application should be refused under Section 5(3) of the Act as the earlier trade marks have a significant reputation in respect of all types of clothing, footwear and headgear and use of the later mark would take unfair advantage of or be detrimental to the distinctive character or the repute of the earlier trade marks.
4. In its counterstatement, the applicant denies the claim made. Specifically, it argues that the trade marks are not competing with one another as the earlier trade marks are in respect of general clothing items and its mark is solely associated with the elastic of socks. Further, it would not benefit from any association with "Easy".
5. Only the opponent filed evidence which will be summarised and considered below. Written submissions were also received from the opponent. Neither party requested a Hearing and so this decision is taken following a thorough review of the papers.

Opponent's evidence

6. This is a witness statement, from Mr William George Lodder, a Solicitor and Head of Legal at Matalan. The following relevant points are contained therein:

- EASY has been used as a clothing brand since 2003 and has been in continuous use since then;
- It has been used on a wide range of clothing items and exhibit WL1 is an example of how it is used;
- Turnover figures relating specifically to EASY branded goods are: 2007 - £154.2m; 2008 – £151.9m; 2009 - £105.5m; 2010 - £110.4m and 2011 - £130m;
- The opponent does not advertise EASY branded goods separately from other brands owned by it and advertising/promotion of the brand is done via mailers, examples of which are attached in exhibit WL2. The opponent dispatches around 9 or 10 different mailers each year which are sent to between 2.5 million and 3 million customers who have a Matalan Reward Card. In addition, approximately 100,000 copies of each mailer are sent to the opponent's stores;
- Exhibit WL3 is extracts from the opponent's website where use of EASY can be seen. This is dated 13 November 2012 (and so, after the filing date of the application under attack in these proceedings).

7. The remainder of the witness statement is comprised of submissions which I will not summarise here. Rather, I will refer to them if appropriate, during this decision.

Conclusions on Opponent's Evidence

8. The above mentioned evidence indicates that the earlier trade mark has been used for a fairly significant period of time. There are sales figures provided. However, no details of market share are included and so these figures cannot be placed into any context within the clothing market as a whole. Further, the advertising activities described make clear that they are directed at only Matalan reward customers or customers visiting a Matalan store. The use is effectively behind the closed wall of Matalan customers, non Matalan customers will not see over the wall. The evidence shows that unlike with certain instore trade marks of other undertakings, the trade mark is not advertised to the public at large. These flaws mean it is impossible to gauge the level of recognition among the relevant public, which in the case of these goods will be the public at large. As such, it is considered that the evidence is unpersuasive as regards any reputation enjoyed by the earlier trade marks.

DECISION

The proof of use provisions

9. I note that in its TM8 and Counterstatement, the applicant, when asked whether or not it wished the opponent to provide proof of use of its earlier trade marks, replied "no". I must therefore make a notional assessment based on the earlier specification of goods and services as they are registered.

Likelihood of confusion – Section 5(2) (b)

10. The relevant parts of section 5 of the Act read as follows:

“(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”.

11. 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.*,

(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*.

Preliminary remarks

12. In response to the arguments of the applicant as regards the nature of the respective businesses in the marketplace, the current, or past, marketing undertaken by the parties is not relevant to the issues to be determined, as the General Court (GC) stated in *NHL Enterprises BV v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-414/05:

“71 The Court considers, first, that that assessment by the Board of Appeal is not called in question by the particular conditions in which the applicant’s goods are marketed, since only the objective marketing conditions of the goods in question are to be taken into account when determining the respective importance to be given to visual, phonetic or conceptual aspects of the marks at issue. Since the particular circumstances in which the goods covered by the marks at issue are marketed may vary in time and depending on the wishes of the proprietors of those marks, the prospective analysis of the likelihood of confusion between two marks, which pursues an aim in the general interest, namely that the relevant public may not be exposed to the risk of being misled as to the commercial origin of the goods in question, cannot be dependent on the commercial intentions of the trade mark proprietors – whether carried out or not – which are naturally subjective (see,

to that effect, *NLSPORT*, *NLJEANS*, *NLACTIVE* and *NLCollection*, cited at paragraph 61 above, paragraph 49, and Case T-147/03 *Devinlec v OHIM – TIME ART (QUANTUM)* [2006] ECR II-11, paragraphs 103 to 105, upheld on appeal by the Court by judgment of 15 March 2007 in Case C-171/06 P *TIME ART v OHIM*, not published in the ECR, paragraph 59).”

13. That the applicant is only currently interested in the elastic of socks is therefore not relevant. The correct comparison to be made is between the respective specifications as they appear on the Register.

Comparison of the goods

14. When making the comparison, all relevant factors relating to the goods and services in the respective specifications should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at paragraph 23 of its judgment:

“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.”

15. Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

“(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.”

16. I also bear in mind how complementary is defined; in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-325/06 the GC explained when goods are complementary:

“82 It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005]

ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P *Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).”

17. The earlier specification contains “articles of clothing, footwear and headgear”. The contested specification is “clothing, footwear and headgear, socks”. They are all self-evidently identical and in the case of the contested socks, these are clearly an item of clothing and so are also identical. For the sake of completeness, earlier community trade mark 1 018 1881 includes “bags” in class 18 which will include handbags. These goods are related to articles of clothing, footwear and headgear in class 25, in the sense that they are likely to be considered by consumers as complementary accessories to articles of clothing, headgear and even to footwear because they are closely co-ordinated with these articles and they may well be distributed by the same or linked manufacturers. It is also not unusual for clothing manufacturers to directly produce and market them. Moreover, these goods can be found in the same retail outlets. Therefore these products are considered to be similar to the contested goods.

Comparison of the marks

18. It is clear from *Sabel BV v. Puma AG* (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. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account any distinctive and dominant components.

19. The respective trade marks are:

EASY	
Earlier trade marks	Contested trade mark

20. The respective trade marks each contain the letters “eay”. They differ in respect of the letters “s” and “z” and also the additional elements in the contested sign, namely “grip” and “socks”, together with a swirl device. Visually they are similar, only to a very low degree.

21. Aurally, “easy” and “eazy” would be pronounced identically. The additional elements in the contested sign have a lengthening effect which does have an aural impact. Aurally, it is considered they are similar to a low degree.
22. Conceptually, I note that there are a variety of meanings of the word “easy”, including “not requiring much labour or effort; not difficult” and “comfortable” (Collins Dictionary). It is considered that this is how the earlier trade mark will be understood. The contested trade mark will be understood in the same manner albeit with the added context of socks which grip without much effort or which have a comfortable grip. In this regard, the misspelling, namely “eazy” has no impact as it will be understood as “easy”. The additional elements in the contested trade mark do not have the effect of creating a clear conceptual gap. There is merely context added to the element eazy. They are conceptually similar.

Distinctive and dominant components

23. As regards the earlier trade mark, the answer is straightforward as there is only one component.
24. In the contested trade mark, the element eazy appears in bold typeface as does the element grip, albeit in a relatively lighter bold typeface, which appears at the same level. The element socks appears in a smaller typeface underneath. Though there is a hint of separation of eazy and grip as a result of the position of the swirled device, this is minimal and overall it is considered that “eazy grip” catches the eye first upon visual inspection and so is the overall dominant and distinctive element. However, the remaining elements are also not negligible and so the correct assessment to be made is between the trade marks as a whole.
25. Taking into account all of the aforesaid, I consider that the respective trade marks are similar, to the extent that each include easy/eazy. However, the overall degree of similarity is not particularly high.

Degree of distinctiveness of the earlier trade mark

26. Though the opponent claims that the earlier trade marks have a reputation, the evidence has not demonstrated this. As such, it has no impact on distinctiveness.
27. 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 (*Rewe Zentral AG v OHIM (LITE) Case T-79/00*). The word easy has a number of meanings, including in respect of fit in that it can be used to describe a fit that is loose or comfortable (Collins Dictionary). Bearing in mind that some of the the earlier goods relied upon are clothing, footwear and headgear, it is considered that the earlier trade marks are not particularly distinctive in respect of these goods, per se, as it may describe a characteristic of the goods in that they have a loose, comfortable fit.
28. In respect of the goods relied upon in class 18, it is considered that the earlier trade marks have no meaning and so are at least averagely distinctive.

The average consumer

29. The case-law informs me that the average consumer is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). The degree of care and attention the average consumer uses when selecting goods or service providers can, however, vary depending on what is involved (see, for example, the judgment of the GC in *Inter-Ikea Systems BV v OHIM* (Case T-112/06)).
30. In relation to general items of clothing, the case law¹ informs me that it is the visual impression of the marks that is the most important bearing in mind the manner in which such goods will normally be purchased. This would normally be from a clothes rail, a catalogue or a web site rather than by oral request. The average consumer will be the public at large, who in my view will display a medium degree of attention during the purchasing process and is said to be reasonably well informed and reasonably observant and circumspect.

Global Assessment – Conclusions on Section 5(2) (b)

31. It is clear that the factors assessed have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17) and that a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.
32. The goods have been found to be identical and it is considered that the trade marks are similar to a degree. It is true that identity of goods can counteract a lesser degree of similarity between the respective trade marks. However, there is only a very low degree of visual similarity and the case law informs that in respect of clothing, visual considerations are the most important. In addition, the level of attention of the average consumer of these goods will at least be reasonable during the purchasing process. It is considered that these factors negate against the impact of the identity of the goods. That the earlier trade mark is not particularly distinctive in respect of the class 25 goods relied upon is also borne in mind. Further, the following guidance is taken into account: Case C-120/04 Medion it was stated:

“28 The global appreciation of the likelihood of confusion, in relation to the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. The perception of the marks by the average consumer of the goods or services in question plays a decisive role in the global appreciation of that likelihood of confusion. In

¹ ² See, for example, *Société provençale d'achat and de gestion (SPAG) SA v OHIM* Case T-57/03 and *React Trade Mark* [2000] RPC 285.

this regard, the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (see, in particular, *SABEL*, paragraph 23, *Lloyd Schuhfabrik Meyer*, paragraph 25, and *Matratzen Concord*, paragraph 29).

29 In the context of consideration of the likelihood of confusion, 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. On the contrary, 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 (see *Matratzen Concord*, paragraph 32).

30 However, beyond the usual case where the average consumer perceives a mark as a whole, and notwithstanding that the overall impression may be dominated by one or more components of a composite mark, it is quite possible that in a particular case an earlier mark used by a third party in a composite sign including the name of the company of the third party still has an independent distinctive role in the composite sign, without necessarily constituting the dominant element.”

33. Bearing in mind the above, it is considered that the earlier trade mark does not play an independent and distinctive role within the contested trade mark. The element “eazy” is unlikely to be singled out and focussed upon within the contested trade mark and is more likely to be seen in combination with “grip” as “eazy grip”. Further, it will be seen in the context of the mark as a whole. In considering all of the foregoing, it is considered that despite the fact that the respective trade marks share similarity centred around the coincidental element easy/eazy, when considering the trade marks as a whole, the differences between them are marked and are considered to be more than sufficient to enable the relevant public to accurately distinguish between them. Finally, the differences are such that the relevant public is unlikely to consider them to be economically linked.
34. The position in respect of the earlier class 18 goods relied upon must be considered separately as the earlier trade mark is at least averagely distinctive and weight must be given to this factor in considering the overall likelihood of confusion. It is considered that the earlier trade mark having an average degree of distinctiveness rather than a lower than average does not materially affect the matter of confusion as the differences between the trade marks remain. Further, the goods are only similar in this scenario. Taking all these matters in the round, it is considered that overall, there is no likelihood of confusion here either.
35. It is noted that the opponent also relies upon Section 5(3) of the Act. However, it has failed to demonstrate that it has a reputation. As such, this ground, which requires a reputation to operate, also fails.

COSTS

36. The opposition has failed in its entirety. As such the applicant is entitled to a contribution towards its costs. Neither party sought costs off the normal scale and I am of course mindful that neither sought a hearing. In the circumstances I award the applicant the sum of £850 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

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Considering notice of opposition and accompanying statement - £200

Statement of case in reply- £300

Considering evidence - £350

Total - £850

37. The above sum should 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 28th day of May 2013

Louise White

**For the Registrar,
The Comptroller-General**