

O-227-18

**TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK APPLICATION NO 3196800
BY BO FOOTWEAR & APPAREL LIMITED
TO REGISTER**

JULIA BO

**AS A TRADE MARK
IN CLASS 25
AND OPPOSITION THERETO (UNDER NO. 408713)
BY
CKL HOLDINGS N.V.**

Background & Pleadings

1. Bo Footwear & Apparel Limited (hereafter 'the applicant') applied for the trade mark **Julia Bo** on 15 November 2016 in class 25 for **footwear**. The mark was published on 9 December 2016.

2. CKL Holdings N.V. (hereafter 'the opponent') opposes the trade mark under Section 5(2)(b) of the Trade Marks Act 1994 ('the Act') against all goods in the application. This is on the basis of its earlier European Trade Mark set out below. The earlier mark was registered in classes 18, 25 and 42 but only class 25 forms the basis of this opposition:

EU TM 14743272 Julia Filing date: 29 October 2015 Date of entry in register: 17 March 2016	Class 25: Clothing; footwear; swimwear; sportswear and leisurewear
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3. The applicant filed a counterstatement in which it denied that the marks were similar but admitted its goods are identical to the opponent's goods.

4. The opponent's trade mark is an earlier mark, in accordance with section 6 of the Act and, as it had not been registered for five years or more before the publication date of the applicant's mark, it is not subject to the proof of use requirements, as per section 6A of the Act.

5. The applicant is represented in these proceedings by Michael Harrison and the opponent by Trademarkers Merkenbureau C.V.

6. Both parties filed written submissions and the applicant filed evidence. No hearing was requested and so this decision is taken from the material before me.

Applicant's evidence

7. The applicant filed a witness statement and appended four exhibits. These exhibits comprise confirmation that the applicant owns two JULIA BO related domain names, a list of forename marks registered by the opponent, a screenshot of the footwear produced by the applicant and a list of third party trade marks containing the female forename 'Julia' in class 25.

8. Having considered this evidence, I do not consider it to be of assistance to me. The use of domain names has no bearing on these trade mark proceedings. The opponent's other registrations are not relevant as I must focus on the mark they have relied on in this case. With regard to the screenshot of the applicant's goods, this is unnecessary as it has already conceded the goods at issue are identical and other third party trade marks containing 'Julia' are not relevant to this case

Decision

9. 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.

10. The leading authorities which guide me are from the Court of Justice of the European Union ('CJEU'): *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.

The principles

(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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

11. As previously stated the applicant has conceded that the respective goods are identical.

Average consumer and the purchasing act

12. It is necessary to consider the role of the average consumer and how the goods are purchased. 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*.

13. 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 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.”

14. The average consumer for the contested goods is a member of the general public. The goods can be sold in traditional bricks and mortar shoe shops or in the footwear section of a general clothing retailer as well as online and through mail order. Whilst I do not discount word of mouth recommendations, the act of purchasing footwear will be a primarily visual process and will include factors such as aesthetics, functionality and fit in addition to the cost. In a physical retail premises, the average consumer will be viewing a range of footwear, handling the physical goods and trying them on. In an online website or mail order catalogue, a consumer will be viewing images of the goods before selection. Given that an average consumer will be looking for footwear of a particular size in addition to style, I conclude that they will be paying a normal degree of attention during the purchasing process.

Comparison of the marks

15. The marks to be compared are:

Opponent's mark	Applicant's mark
Julia	Julia Bo

16. 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. The Court of Justice of the European Union 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 opponent's trade mark consists of a single word **Julia** in title case. The overall impression of the mark and its distinctiveness rests solely on that word.

19. The applicant's trade mark consists of two words **Julia Bo** in title case. The two words form a unit, namely a forename plus surname. The unit has a different meaning to the separate words of which the mark is composed. In my view, the overall impression of the applicant's trade mark and its distinctiveness rests on the unit, i.e. in the combination of the two words.

20. With regard to the visual and aural similarity comparison, the applicant submits that,

“Although there exist some visual and aural similarity between the conflicting signs, they do not play a great role in the global assessment of the likelihood of confusion between the trade marks in dispute... Attaching a particular importance to the phonetic similarity between the trade marks at issue may also be inappropriate because [the] goods at issue are not ordered orally or at sales point with an increased noise factor.

21. The applicant has accepted that the marks both share a visual and aural similarity because of the word **Julia**. It is present in both marks and is pronounced in the same way. However the applicant's mark has the additional element **Bo** which is absent from the opponent's mark. This element will be seen and verbalised. Overall I would categorise the degree of visual and aural similarity as medium.

22. In a conceptual comparison, the opponent's trademark will be understood as a female forename whereas the applicant's trade mark will be understood as the same female forename followed by a surname, albeit an uncommon one. In my view the applicant's mark refers to a specific individual whereas the opponent's mark does not. Overall, I find the marks are conceptually dissimilar.

Distinctive character of the earlier mark

23. It is necessary to consider the distinctive character of the earlier mark. 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).”

24. There is no evidence before me in these proceedings of enhanced distinctiveness through use so I can only consider the inherent distinctiveness of the earlier mark.

25. The earlier mark consists of a single female forename, **Julia**, which does not describe or allude to the goods or any characteristic of the goods. Nonetheless personal names are commonly used as trade marks and the forename **Julia** is common one in the UK; as such I find that the earlier mark is lower than average in distinctiveness.

Likelihood of confusion

26. I now draw together my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors, those outlined in paragraph 10 and the relevant case law:

- a) The interdependency principle, whereby a lesser degree of similarity between the goods may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc*).
- b) The principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*).
- c) The factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*).

27. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. considered the impact of the CJEU’s judgment in *Bimbo*, Case C-591/12P, on the court’s earlier judgment in *Medion v Thomson*. The judge said:

“18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

28. So far I have found that the contested goods are identical and that the average consumer is a member of the general public who will select the goods by primarily

visual means whilst paying a normal degree of attention during the purchasing process. I also found that the overall impression and distinctiveness of the opponent's mark lies in the single word, **Julia**, whereas the overall impression and distinctiveness of the applicant's mark lies in the unit created by the combination of the words **Julia Bo**.

29. In terms of the comparison of the marks, I found that they are visually and aurally similar to a medium degree. However, the concept of the opponent's trade mark is of a single female forename and the applicant's mark is of a female forename plus surname denoting a specific individual creating conceptual dissimilarity between the marks overall. In terms of the distinctiveness of the earlier mark, and because personal names are commonly used as trade marks, I concluded this to be lower than average.

30. As per the guidance given in the *Whyte and Mackay* extract above, I find that the average consumer would perceive the mark **Julia Bo**, it being a familiar construction of a forename plus surname combination, as a unit and as such would accord it 'a different meaning to the meanings of the separate components'. In other words, the **Julia** element in the applicant's mark does not have a distinctive significance independent of the whole. Its presence in the unit **Julia Bo** would not lead to a likelihood of either direct or indirect confusion with the opponent's mark. Therefore the opposition fails.

Conclusion

31. The opposition has failed. Subject to any successful appeal, the application will proceed to registration.

Costs

32. As the applicant has been successful, it is entitled to a contribution toward its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 2/2016. Bearing in mind the guidance given in TPN 2/2016, but making no award to

the applicant in respect of its evidence as it did not assist me in these proceedings, I award costs to the applicant as follows:

£300 Considering the Notice of Opposition and filing a defence.

£200 Filing written submissions and considering the other side's written submissions.

£500 Total

33. I order CKL Holdings N.V. to pay Bo Footwear & Apparel Limited the sum of £500. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 10th day of April 2018

June Ralph

For the Registrar

The Comptroller-General