

O-267-19

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3315286
BY WAVE AGAIN LLC
TO REGISTER THE TRADE MARK**



AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 413590 BY C & A AG**

Background and pleadings

1. On 4 June 2018, Wave Again LLC (“the applicant”) applied to register the trade mark shown below under number 3315286:

GEN | M

2. The application claims a priority date of 19 December 2017, from European Union trade mark (“EUTM”) 17620352. It was published on 22 June 2018 in respect of a range of goods in class 25. Following an amendment during proceedings, the specification now reads:

Class 25 Men's clothing, footwear, and headgear, namely, shirts, t-shirts, sweatshirts, pants, shorts, tank tops, sweaters, pullovers, scarves, jackets and coats, raincoats, hats, sleepwear, socks, gloves.

3. The application is opposed by C & A AG (“the opponent”). The opposition, which is based upon s. 5(2)(b) of the Trade Marks Act 1994 (“the Act”), is directed against all of the goods in the application. The opponent relies upon the following trade marks:

(i) EUTM number 16848384 **GEN C**

Filing date: 12 June 2017

Applied for in classes 25, 35 and 40.

Goods relied upon: Class 25: Clothing, footwear, headgear

(ii) International (UK) trade mark (“IR”) number 1385830

GEN C

International registration date/designation date: 13 November 2017

Priority date: 12 June 2017 (Swiss trade mark number 708970)

Date of protection in the UK: 17 April 2018

Registered in classes 25, 35 and 40

Goods relied upon: Class 25: Clothing, footwear, headgear.

4. The opponent claims that the marks are similar and that the goods are similar or identical, which will give rise to a likelihood of confusion, including the likelihood of association.

5. Given their dates of filing, the opponent's marks qualify as earlier marks in accordance with section 6 of the Act. As neither mark had completed its registration process more than 5 years before the publication date of the application in suit, they are not subject to the proof of use provisions contained in s. 6A of the Act. The opponent may rely upon all of the goods it has identified, without showing that it has used the marks.

6. The applicant filed a counterstatement denying the grounds of opposition.

7. Neither party filed evidence. Neither party requested a hearing. The applicant filed written submissions during the evidence rounds, as well as submissions in lieu of a hearing. The opponent only filed submissions in lieu. I will take all of these into account. Both parties have been professionally represented throughout, the opponent by Bird & Bird LLP and the applicant by Cooley (UK) LLP. This decision is taken following a careful reading of all of the papers.

My approach

8. Whilst I note the opponent's comments regarding the status of the appeal against the EUTM, as the opponent's IR is a protected trade mark and its EUTM is not, I will consider the position in relation to that mark first, returning only if necessary to the other mark. In any event, given that there is no material difference between the opponent's trade marks or the goods upon which it relies, the opponent's position would not be stronger under the EUTM than it is under the IR.

Section 5(2)(b)

9. Section 5(2)(b) of the Act reads 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 following principles are gleaned from the decisions of the EU courts in *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:

(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. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut fur Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

12. Registration is sought for “men's clothing, footwear, and headgear, namely, shirts, t-shirts, sweatshirts, pants, shorts, tank tops, sweaters, pullovers, scarves, jackets and coats, raincoats, hats, sleepwear, socks, gloves”. I note the applicant's submissions regarding the limitation of the specification to men's clothing but the assessment under s. 5(2)(b) is a notional assessment, which must take into account all of the circumstances in which the marks might be used.¹ The earlier mark is protected unreservedly for “clothing, footwear, headgear”. All of the goods within the applied-for specification fall within the broader categories in the earlier specification. These goods are identical on the principle outlined in *Merica*.

¹ See *Compass Publishing BV v Compass Logistics Ltd* ([2004] RPC 41) at [22]; *Roger Maier v ASOS* ([2015] EWCA Civ 220 at [78] and [84]; and *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited* (Case C-533/06).

The average consumer and the nature of the purchasing act

13. It is necessary for me to determine who the average consumer is for the respective parties' goods. I must then decide the manner in which these goods are likely to be selected by the average consumer in the course of trade. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purposes 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 in question: *Lloyd Schuhfabrik*.

14. 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”.

15. The average consumer of the goods at issue is a member of the general public. The average consumer will wish to ensure that the goods are, for example, the desired fit, colour or style. Consequently, an average degree of attention will be paid to their selection. The goods at issue are generally sold through bricks and mortar retail premises (such as shops on the high street or in supermarkets) and online. The goods will normally be chosen via self-selection from a shelf or a website, or perhaps from a catalogue. In *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03, the GC stated that:

“50. [...] 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”.

16. Whilst I do not rule out that there may be an aural component, when considered overall the selection process will be mainly visual.

Comparison of trade marks

17. It is clear from *Sabel* (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 (“CJEU”) stated at paragraph 34 of its judgment in *Bimbo*, 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”.

18. It would be wrong, therefore, artificially to dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks. Due weight must be given to any other features which are not negligible and therefore

contribute to the overall impressions created by the marks. The marks to be compared are:

Earlier mark	Application
 The earlier mark consists of the word "GEN" followed by a space and the letter "C", both in a bold, sans-serif typeface.	 The application mark consists of the word "GEN" followed by a vertical bar and the letter "M", all in a bold, sans-serif typeface.

19. The opponent claims that the marks have a high level of visual and aural similarity, as both begin with the identical word element, have a similar structure and the figurative element of the later mark has no distinctive character. It submits that neither mark has a conceptual meaning. The applicant submits that the marks are visually and aurally dissimilar because, despite the common element “GEN”, the marks feature a “C” and an “M”, respectively. It also claims that the marks are conceptually dissimilar.

20. The earlier mark consists of the word “GEN” along with the letter “C”, presented in capital letters in an unremarkable typeface.² There are no other elements which might contribute to the overall impression. The word “GEN”, due to its position and comparative length, is marginally more dominant than the letter “C”.

21. The later mark consists of the word “GEN”, with the letter “M” separated from the word by a bold vertical line. The letters are presented in capitals, in a bold typeface. The mark is dominated by the verbal element “GEN M”, again with “GEN” marginally more dominant than the single letter. The vertical line is likely to be perceived as decorative and will play only a weak role.

² Although the appearance of this mark on the UK register suggests a particular typeface, the opponent confirmed when it applied for the mark that it wished the mark to be considered as a mark in standard characters.

22. There is an obvious visual similarity because of the presence of the word “GEN” at the beginning of both marks. There is also a difference because of the different letters “C” and “M”, which do not resemble one another, in the marks and because of the vertical line in the later mark. Bearing in mind my assessment of the overall impression, the marks are visually similar to a reasonably high degree.

23. The earlier mark will be pronounced entirely predictably, as “JEN SEE”. The figurative element in the later mark will not be articulated, resulting in the later mark being verbalised as “JEN EM”. The marks are aurally similar to a medium degree.

24. The applicant contends that the earlier mark will be perceived by the average consumer as an abbreviation of “GENERATION C”. It is said that “Generation C / Gen C is a term used to describe people who care deeply about content” and is defined by the “three Cs: consume, create and curate”.³ The applicant includes three web links in its submissions but has filed no evidence to support the claim. It is, therefore, no more than assertion. I do not consider that it is a fact so notorious it would be appropriate for me to take judicial notice of it; quite the reverse. In my view, neither “GEN C” nor “GEN M” will immediately be perceived by the consumer as references to a particular generation or generational phenomenon. There is potential for the average consumer to perceive “GEN” as an abbreviation of “generation”. For those consumers who do perceive “GEN” in this way, there is a reasonable degree of conceptual similarity between the marks. However, it is also possible that the consumer will not interpret “GEN” as an abbreviation for generation, given that “gen” has various potential meanings, depending on whether it is an entire word or an abbreviation, and that no meaning obviously lends itself to either mark in the particular context of “GEN” plus letter. In that case, neither mark has any conceptual meaning and the conceptual position is neutral.

³ Written submissions filed 25 February 2019, §13.

Distinctive character of the earlier trade mark

25. 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)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. In *Lloyd Schuhfabrik*, 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-2779, 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)".

26. As there is no evidence to show that the earlier mark has enhanced its distinctiveness through the use which has been made of it, I have only the inherent position to consider. The earlier mark is not allusive of the goods for which it is registered. It will be perceived as an abbreviation of an ordinary dictionary word, albeit possibly with no specific meaning in the context, combined with a single letter of the alphabet, itself not particularly distinctive. As a whole, the mark has a medium degree of inherent distinctive character.

Likelihood of confusion

27. In deciding whether there is a likelihood of confusion, the factors considered above have a degree of interdependency and must be weighed against one another in a global assessment (*Canon* at [17]; *Sabel* at [22]). The various factors must be considered from the perspective of the average consumer, and a determination made as to whether the average consumer is likely to be confused. In making my assessment, I must keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

28. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. Indirect confusion is where the consumer notices the differences between the marks but concludes that the later mark is another brand of the owner of the earlier mark or a related undertaking. In *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

"16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning

– it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark”.

29. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

30. The goods are identical and the marks are visually similar to a reasonably high degree. They have a medium degree of aural similarity and the earlier mark has a medium level of distinctive character. The position most favourable to the applicant is where the marks are conceptually neutral, which is where I will begin. Given the similarity of the word “GEN” in each mark, and the similar structure, I am satisfied that there is a likelihood of confusion. I bear in mind that there is a figurative element in the later mark but the weakness of this component in the overall impression will not, in my view, assist the consumer in distinguishing between the marks: if it is noticed at all, it will be seen as no more than a presentational difference, not one which indicates a different trade origin. I acknowledge, of course, that the second part of the marks is different, one being the letter “C”, the other the letter “M”. However, single letters in general have only modest distinctiveness and in the marks at issue these components have lesser impact overall. It is likely, given the effects of imperfect recollection, that a consumer will directly confuse these marks, misremembering the different element and having no real means of otherwise distinguishing them. Indirect confusion is also likely

in this case. Where a consumer does recognise the differences, s/he will assume that the later mark is a brand extension of the earlier mark and that the goods derive from the same, or an economically connected, source. It also follows that, where there is conceptual similarity between the marks, confusion is more likely. There is a likelihood of confusion.

Conclusion

31. The opposition has been successful. The application will, subject to appeal, be refused.

Costs

32. The opponent has been successful and is entitled to an award of costs. The relevant Tribunal Practice Notice (“TPN”) is TPN 2/2016. I bear in mind that the submissions filed by the applicant during the evidence rounds were very brief. I award costs to the opponent as follows:

Official fee:	£100
Preparing the notice of opposition and considering the counterstatement:	£200
Considering the other party’s submissions and filing written submissions:	£400
Total:	£700

33. I order Wave Again LLC to pay C & A AG the sum of **£700**. 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 20 May 2019

**Heather Harrison
For the Registrar
The Comptroller-General**