

O-268-14

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3031091 BY  
USMAN DAWOOD**

**TO REGISTER:**



A P P L E R I B B O N



A P P L E R I B B O N

**AS A SERIES OF 2 TRADE MARKS:**

**IN CLASSES 14, 18, 24 & 25**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 60000084 BY  
BANK FASHION LIMITED**

## BACKGROUND

1. On 18 November 2013, Usman Dawood applied to register the series of two trade marks shown on the cover page of this decision. The application was published for opposition purposes on 13 December 2013, for the following goods:

**Class 14** - Watches; Women's jewelry; Women's watches.

**Class 18** - Evening handbags; Handbags for men; Leather handbags; Gentlemen's handbags; Ladies handbags; Travelling handbags; Handbags, purses and wallets; Handbags; Ladies handbags.

**Class 24** - Labels (textile-) for identifying clothing; Labels (textile-) for marking clothing; Labels of textile for identifying clothing.

**Class 25** - Clothing ;Clothing, footwear, headgear; Clothing for children; Footwear for women; Gloves; Handwarmers [clothing];Head scarves; Head wear; Headscarfs; Headscarves; Headwear; Neck scarves; Neckwear; Scarfs; Scarves; Shawls; Shoulder scarves; Silk scarves; Women's shoes.

2. The application is opposed by Bank Fashion Limited (“the opponent”) under the fast track opposition procedure. The opposition, which is directed against all of the goods in the application, is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), for which the opponent relies upon all of the goods in the following Community Trade Mark (“CTM”) registration:

CTM no. 7062052 for the mark: **RIBBON** which was applied for on 16 July 2008 and for which the registration process was completed on 3 December 2009:

**Class 18** - Holdalls, back packs and rucksacks; wallets, key cases, key fobs, purses and pouches; credit card cases, jewellery rolls; attaché cases and briefcases; umbrellas, parasols and walking sticks; parts and fittings for all the aforesaid goods.

**Class 24** - Textiles and textile goods nor included in other classes; household textile goods; covers for hot water bottles; fabrics for textile use; bed, furniture and table covers; curtains and rugs (lap-robés); bed linen, household linen, table linen, bath linen; upholstery fabrics; sheets, blankets, quilts and duvets; covers or cases for pillows, cushions or duvets; towels, tea-towels, napkins.

**Class 25** - Clothing, belts for wear, headgear, footwear, aprons.

3. Mr Dawood filed a counterstatement in which he denies the basis of the opposition. Mr Dawood states:

“We deny that the trademark is similar to the opposer.

It is not similar. The logo/mark is different.

The “Appleribbon” cannot be deemed as similar.

If the opposer is claiming “ribbon” is used, then how many other names, which include “ribbon” can be ruled out.”

4. Rule 6 of the Trade Marks (Fast Track Opposition)(Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

5. The net effect of these changes is to require parties to seek leave in order to file evidence in fast track oppositions. No leave was sought in respect of these proceedings.

6. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (1) the Office requests it or (2) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost. Otherwise written arguments will be taken. A hearing was neither requested nor considered necessary. The opponent filed written submissions which I will refer to, as necessary, below.

## **DECISION**

7. The opposition is based upon section 5(2)(b) of the Act, which 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.”

8. An earlier trade mark 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) or 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,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

9. In these proceedings, the opponent is relying upon the trade mark shown in paragraph 2 above, which qualifies as an earlier trade mark under the above provisions. Given the interplay between the date on which the application was published and the date on which the opponent’s earlier trade mark completed its

registration process, the earlier trade mark is not subject to proof of use, as per The Trade Marks (Proof of Use, etc) Regulations 2004.

### **Section 5(2)(b) – case law**

10. In his decision in *La Chemise Lacoste SA v Baker Street Clothing Ltd* - BL O/330/10 (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), the Appointed Person, Mr Geoffrey Hobbs QC, expressed the test under this section (by reference to the CJEU cases mentioned) on the basis indicated below:

#### **The CJEU cases**

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; Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), Case T-6/01; Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH C-120/04; Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P.

#### **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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 greater 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 causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.”

### **The average consumer and the nature of the purchasing process**

11. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods; I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. The goods at issue in these proceedings are, broadly speaking, watches and jewellery in class 14, bags and related items in class 18, textile goods in class 24 and articles of clothing, footwear and headgear in class 25. The average consumer for all of these goods is the public at large. In *New Look Ltd v Office for the Harmonization in the Internal Market (Trade Marks and Designs)* Joined cases T-117/03 to T-119/03 and T-171/03 the General Court (GC) commented on how articles of clothing are selected. It said:

“50. The applicant has not mentioned any particular conditions under which the goods are marketed. Generally in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly the visual aspect plays a greater role in the global assessment of the likelihood of confusion.”

12. As all of the goods at issue in these proceedings are, like clothing, in my experience, most likely to be the subject of self selection from traditional retail outlets on the high street, catalogues and websites, visual considerations are likely to dominate the selection process. That said, as the selection of the goods may, on occasion, and in particular in relation to the goods in class 14, involve the intervention of a sales assistant, aural considerations cannot be ignored. As to the degree of care that will be taken when selecting the goods at issue, it is self evident that, save for Mr Dawood's goods in class 24 (which are always, in my experience,

likely to be inexpensive), the cost of the remainder of the goods at issue can vary considerably. In *New Look* the GC also considered the level of attention taken purchasing goods in the clothing sector. It stated:

“43 It should be noted in this regard that the average consumer’s level of attention may vary according to the category of goods or services in question (see, by analogy, Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 26). As OHIM rightly pointed out, an applicant cannot simply assert that in a particular sector the consumer is particularly attentive to trade marks without supporting that claim with facts or evidence. As regards the clothing sector, the Court finds that it comprises goods which vary widely in quality and price. Whilst it is possible that the consumer is more attentive to the choice of mark where he or she buys a particularly expensive item of clothing, such an approach on the part of the consumer cannot be presumed without evidence with regard to all goods in that sector. It follows that that argument must be rejected.”

13. In my experience, the average consumer is likely to pay a much higher level of attention when selecting, for example, the designer equivalent of goods such as jewellery, watches, handbags, textiles for the home or articles of clothing, than when selecting their non-designer equivalents (which are likely to cost significantly less). However, even when selecting a routine equivalent, as many of the goods at issue will be used on or about the person, the average consumer will, when making a selection, be conscious of factors such as size, material, style, colour, cost and, where appropriate, compatibility with existing items, all of which, in my experience, suggests that they will pay at least a reasonable level of attention when making their selection, a level of attention which is likely to increase as the cost and importance of the item increases.

### Comparison of goods

14. The competing goods are as follows:

Opponent’s goods	Mr Dawood’s goods
<p><b>Class 18</b> - Holdalls, back packs and rucksacks; wallets, key cases, key fobs, purses and pouches; credit card cases, jewellery rolls; attaché cases and briefcases; umbrellas, parasols and walking sticks; parts and fittings for all the aforesaid goods.</p> <p><b>Class 24</b> - Textiles and textile goods not included in other classes; household textile goods; covers for hot water bottles; fabrics for textile use; bed, furniture and table covers; curtains and rugs (lap-robés); bed linen, household linen, table linen, bath linen; upholstery fabrics; sheets, blankets, quilts and</p>	<p><b>Class 14</b> - Watches; Women’s jewelry; Women’s watches.</p> <p><b>Class 18</b> - Evening handbags; Handbags for men; Leather handbags; Gentlemen’s handbags; Ladies handbags; Travelling handbags; Handbags, purses and wallets; Handbags; Ladies handbags.</p> <p><b>Class 24</b> - Labels (textile-) for identifying clothing; Labels (textile-) for marking clothing; Labels of textile for identifying clothing.</p> <p><b>Class 25</b> - Clothing; Clothing, footwear, headgear; Clothing for children;</p>

duvets; covers or cases for pillows, cushions or duvets; towels, tea-towels, napkins.	Footwear for women; Gloves; Handwarmers [clothing]; Head scarves; Head wear; Headscarfs; Headscarves; Headwear; Neck scarves; Neckwear; Scarfs; Scarves; Shawls; Shoulder scarves; Silk scarves; Women's shoes.
<b>Class 25</b> - Clothing, belts for wear, headgear, footwear, aprons.	

15. The leading authorities on how to determine similarity between goods and services are considered to be *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117 and *British Sugar Plc v James Robertson & Sons Ltd (Treat)* [1996] R.P.C. 281. In the first of these cases the CJEU accepted that all relevant factors should be taken into account including the nature of the goods/services, their intended purpose, their method of use and whether they are in competition with each other or are complementary. The criteria identified in the *Treat* case were:

- (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. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) at [12] Floyd J stated:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. *Treat* was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

17. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05, in which the GC stated:

“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 the trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 Oberhauser v OHIM – Petit Liberto (Fifties) [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 Vedial v OHIM – France Distribution (HUBERT) [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03 Koubi v OHIM – Flabesa (CONFORFLEX) [2004] ECR II-719, paragraphs 41 and 42).”

18. In relation to complementary goods and services, the comments of the Court of First Instance (now the General Court) in *Boston Scientific Ltd v OHIM* case T-325/06 are relevant:

“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).”

19. In relation to complementarity, I also bear in mind the recent guidance given by Mr Daniel Alexander QC, sitting as the Appointed Person, in case BL O/255/13 *LOVE* where he warned against applying too rigid a test:

“20. In my judgment, the reference to “legal definition” suggests almost that the guidance in *Boston* is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to *Boston*.”

20. In its notice of opposition, the opponent stated:

“The application has been filed in relation to goods identical or similar to those for which the earlier trade mark is registered...”

21. The totality of Mr Dawood’s defence to the application is reproduced in para. 3 above. In its submission, the opponent stated:

“4.1 The Form TM8 submitted by the applicant simply states that the marks in issue are not similar. We would point out that the applicant has not commented on the issue of the goods covered by the application and those of the opponent’s earlier trade mark, therefore this should be considered to be an admission that the goods are identical or similar.”

22. Whilst I understand the opponent’s submission in this regard, and would have agreed with it had Mr Dawood been professionally represented, as he is not, and as the consequences of not specifically denying a particular claim are likely to be unfamiliar to him, it remains, in my view, appropriate for me to consider the opponent’s claims on their merits.

### **Class 18**

23. “Purses” and “wallets” appear in both parties’ specification in this class and are identical. All of the remaining goods in Mr Dawood’s specification are handbags of one sort or another. Given the obvious similarities in the nature, intended purpose, method of use and trade channels through which the goods are likely to reach the average consumer, these goods are, if not identical, in my view, highly similar to the “holdalls”, “back packs”, “rucksacks”, “attaché cases” and “briefcases” appearing in the opponent’s specification in this class.

### **Class 24**

24. As the “textile labels” in Mr Dawood’s specification in this class would be encompassed by (at least) the phrase “Textiles and textile goods not included in other classes” included in the opponent’s specification in this class, the competing goods are, on the principles outlined in *Meric*, identical.

### **Class 25**

25. The opponent’s specification in this class includes clothing, footwear and headgear at large. As Mr Dawood’s specification in this class includes either identically worded terms or refers to goods which would be encompassed by the goods in the opponent’s specification in this class, the competing goods are either literally identical or identical on the principles outlined in *Meric*.

### **Class 14**

26. That leaves Mr Dawood’s specification in this class for me to consider. It consists of watches (with women’s watches specifically mentioned) and jewellery for women. The opponent’s mark is not registered in this class and it provides no explanation of why it considers these goods to be similar to its goods in classes 18, 24 and 25. While the users of the competing goods may be the same and whilst they may be sold in, for example, the same retail outlets, that tells one little. Insofar as the latter is concerned, they would, perhaps with the exception of “jewellery rolls” in the opponent’s specification in class 18 (see below), be sold in different areas of, for example, a department store. In addition, again with the exception of “jewellery rolls”, I can see no meaningful similarity in terms of the nature, intended purpose, or method of use nor are the goods at issue in competition with or complementary to

the opponent's goods in classes 18 or 24. As to "jewellery rolls", these are, as I understand it, goods in the nature of (not surprisingly) a roll for storing items of jewellery both in the home and when travelling. Whilst the nature, intended purpose and method of use of such goods is clearly different to jewellery for women, and whilst the respective goods are clearly not in competition with one another, it is not, in my view, unreasonable for me to infer that as the goods may be used together, the users will be the same and the goods may be sold through the same trade channels. Considered overall and without any evidence or submissions to assist me, I think there is likely to be a degree of complementarity between jewellery for women and jewellery rolls, and, as a consequence, a degree of similarity, albeit a low degree. That leaves the clash between Mr Dawood's goods and the opponent's goods in class 25 to consider. I am prepared to accept that as women's' jewellery may be chosen to contribute to a coordinated look and may be sold through the same channels of trade and in proximity to articles of clothing, there is a degree of similarity (albeit low) between women's jewellery in Mr Dawood's application and the opponent's clothing in class 25. As to watches, these are first and foremost functional items. Whilst I accept they are also, albeit in my view to a lesser extent, selected for aesthetic reasons, I am, absent evidence or submissions to assist me, unable to conclude they are selected as part of a coordinated look and are therefore on a par with women's jewellery. In those circumstances, there is, in my view, no similarity between "watches" and "women's watches" in Mr Dawood's application and the opponent's clothing. However, even if I am wrong in that regard, any similarity must, in my view, be at a very low level.

**Comparison of marks**

27. The competing marks are as follows:

Opponent's mark	Mr Dawood's marks
RIBBON	

28. It is well established that the average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as wholes and does not pause to analyse their various details. In addition, he rarely has the chance to make direct comparisons between trade marks and must instead rely upon the

imperfect picture of them he has kept in his mind. In reaching a conclusion on similarity, I must identify what I consider to be the distinctive and dominant elements of the respective trade marks and, with that conclusion in mind, I must then go on and compare the respective trade marks from the visual, aural and conceptual perspectives.

29. The opponent's mark consists exclusively of the well known English language word RIBBON presented in upper case. When used as a noun, the word RIBBON means, inter alia, "a narrow strip of fine material, esp silk, used for trimming, tying, etc" and when used as a verb, as, inter alia, "to adorn with a ribbon or ribbons" (collinsdictionary.com). As no part of the mark is highlighted or emphasised in any way, there are no dominant elements, the distinctiveness lying in the mark as a whole.

30. Although Mr Dawood's application consists of a series of two marks, the second mark of which contains a device element presented in green, as the opponent's mark is presented in black and white, the comments of Mann J in *Specsavers International Healthcare Limited & Others v Asda Stores Limited* [2010] EWHC 2035 (Ch) are relevant. As the earlier mark is not limited to colour, the colour in which the second mark in the series is presented is not relevant. I will, as a consequence, use the first mark in the series which is presented in black and white for the purposes of comparison.

31. Mr Dawood's mark consists of a number of elements. The first is a device of what I take to be a ribbon presented in a manner reminiscent of the shape of an apple. Given its size and positioning, it will obviously not go unnoticed. Considered in the context of the goods for which registration is sought, the device element is, in my view, clearly distinctive. The second element consists of the words APPLE and RIBBON conjoined presented in upper case lettering in an unremarkable typeface. Although the words are conjoined, as both are well known English language words with which the average consumer will be very familiar, I have no doubt that this is how the average consumer will see and understand this part of Mr Dawood's mark. Although the words are presented below the device element, they start before and extend beyond the confines of the device. Whilst it could be argued that the word APPLE may describe a colour that, in my view, is far too imprecise. Similarly, it could be argued, given the definitions mentioned above, that the word RIBBON may have descriptive connotations when considered in the context of, for example, articles of clothing adorned with a ribbon or ribbons; that again, in my view, is highly debatable. Regardless, as the combination APPLERIBBON describes the device which accompanies it i.e. a ribbon in the shape of an apple, that, in my view, is how it will be perceived by the average consumer i.e. as a unified whole. As the combination APPLERIBBON is, in my view, neither descriptive of nor non-distinctive for any of the goods for which Mr Dawood seeks registration, it too is a distinctive element of his mark. Considered overall, I think the two elements make roughly equal contributions to the overall distinctive character of Mr Dawood's mark.

### **The visual, aural and conceptual comparison**

32. The fact that the opponent's mark consists exclusively of, and Mr Dawood's mark contains the word RIBBON as an element, results in a degree of visual similarity

between them, albeit, in my view, given the other elements in Mr Dawood's mark, a relatively low degree. When considered from an aural perspective, as the device element in Mr Dawood's mark is unlikely to be articulated and as the pronunciation of both marks is entirely predictable, there is at least a reasonable degree of aural similarity between them. Finally, insofar as the conceptual position is concerned, as both marks are likely to create an image of a ribbon in the average consumer's mind, (albeit in Mr Dawood's mark one in the shape of an apple), there is, I think, a reasonably high degree of conceptual similarity between the competing marks.

### **Distinctive character of the opponent's earlier trade mark**

33. 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.

34. As these are fast track opposition proceedings in which neither party has sought leave to file evidence, I have only the inherent characteristics of the opponent's mark to consider. I have already commented upon the definition of the word RIBBON above. As a word which, in my view, neither describes nor is non-distinctive for the goods for which the earlier mark is registered, but bearing in mind it is a well known English language word, it is, in my view, possessed of an average i.e. a no higher or lower than normal level of inherent distinctive character.

### **Likelihood of confusion**

35. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's mark as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact 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. In reaching a conclusion, I will bear in mind that in its submissions, the opponent states:

“5...The application consists of the entirety of the opponent's earlier trade mark together with a device which is the visual representation of the opponent's earlier trade mark.”

36. Earlier in this decision I concluded that:

- The average consumer is a member of the general public who will select the goods at issue by predominantly visual means and who will pay a reasonable level of attention when doing so;
- The goods (i) in class 18 are identical, or if not identical, highly similar, (ii) in classes 24 and 25 are identical and (iii), there is a low degree of similarity between both the opponent's "jewellery rolls" in class 18 and its clothing in class 25 and "women's jewellery" in class 14 of the application and no (or at best a very low degree of) similarity between the opponent's goods in class 25 and watches/women's watches in class 14 of the application;
- The opponent's mark has no dominant elements, the distinctiveness lying in the mark as a whole;
- The device and word elements of Mr Dawood's mark are both distinctive and make a roughly equal contribution to the overall distinctive character of his mark;
- There is a relatively low degree of visual similarity, at least a reasonable degree of aural similarity and a reasonably high degree of conceptual similarity between the competing marks;
- The opponent's earlier mark is possessed of an average degree of inherent distinctive character.

37. Having revisited those findings, I have concluded that notwithstanding the degree of aural and conceptual similarity between the competing marks I have identified, that the significant visual differences between them is, given the nature of the purchasing act I have identified above, sufficient to avoid direct confusion i.e. where one trade mark is mistaken for the other. That leaves indirect confusion to be considered. In *L.A. Sugar Limited v By Back Beat Inc* (BL-O/375/10), the Appointed Person, Mr Iain Purvis Q.C, commented on the difference between direct and indirect confusion in the following terms:

"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.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

38. I will also bear in mind that in *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, in which the CJEU stated:

“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.

31. In such a case the overall impression produced by the composite sign may lead the public to believe that the goods or services at issue derive, at the very least, from companies which are linked economically, in which case the likelihood of confusion must be held to be established.

32. The finding that there is a likelihood of confusion should not be subject to the condition that the overall impression produced by the composite sign be dominated by the part of it which is represented by the earlier mark.

33. If such a condition were imposed, the owner of the earlier mark would be deprived of the exclusive right conferred by Article 5(1) of the directive even where the mark retained an independent distinctive role in the composite sign but that role was not dominant.

34. This would be the case where, for example, the owner of a widely-known mark makes use of a composite sign juxtaposing this mark and an earlier mark which is not itself widely known. It would also be the case if the composite sign was made up of the earlier mark and a widely-known commercial name. In fact, the overall impression would be, most often, dominated by the widely-known mark or commercial name included in the composite sign.

35. Thus, contrary to the intention of the Community legislator expressed in the 10th recital in the preamble to the directive, the guarantee of the earlier mark as an indication of origin would not be assured, even though it still had an independent distinctive role in the composite sign.”

39. Although the word RIBBON appears in Mr Dawood’s mark, it does not, in my view, play an independent distinctive role within it. Rather, when it is combined with the word APPLE, it creates, as I explained above, a unified whole which I have concluded will evoke in the average consumer’s mind the concept of an apple shaped ribbon. Given the degree of visual and aural similarity I have already identified (i.e. low and reasonable), is that sufficient to lead to a likelihood of indirect confusion? In my view, it is. The average consumer familiar with the opponent’s RIBBON mark is likely, given the very clear conceptual image it will create in their mind, on seeing Mr Dawood’s mark (which I have already found creates a very similar concept), in my view, to assume that Mr Dawood’s mark is, to use the words of the Appointed Person mentioned above, a “brand extension” of the opponent’s mark.

40. The consequence of that conclusion is that the opposition succeeds against all of the goods in class 18, 24 and 25 which I have found to be either identical or highly similar and, although I have only found a low degree of similarity, to “women’s jewelry” in class 14 of the application. However, I am, absent evidence or submissions to assist me, not satisfied that conclusion extends to “watches” and “women’s watches” in the application (which I have concluded have no or at best a very low level of similarity with the opponent’s goods in class 25); as a consequence, the opposition fails in relation to those goods.

### **Overall conclusion**

**41. The opposition based upon section 5(2)(b) of the Act succeeds in relation to all of the goods in class 18, 24 and 25 and to “women’s jewelry” in class 14 but fails in relation to “watches” and “women’s watches” in class 14. Subject to any successful appeal, the application will be refused in respect of those goods for the opponent has been successful and the application will be allowed to proceed to registration in respect of those goods for the opponent has failed.**

### **Costs**

42. Although both parties have achieved a measure of success, the scale of the opponent’s success far outweighs that of Mr Dawood. The opponent is, as a

consequence, entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide, I award costs to the opponent on the following basis:

Preparing a statement and considering Mr Dawood's statement:	£200
Opposition fee:	£100
Written submissions:	£100
<b>Total:</b>	<b>£400</b>

43. I order Usman Dawood to pay to Bank Fashion Limited the sum of **£400**. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 13th day of June 2014**

**C J BOWEN**  
**For the Registrar**  
**The Comptroller-General**