

O-278-10

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2498651
BY SIENA BLACK LIMITED TO REGISTER THE TRADE MARKS**



AND



IN CLASS 25

**AND IN THE MATTER OF OPPOSITION
THERE TO UNDER NO 98606
BY TAMASU BUTTERFLY EUROPA GMBH**

TRADE MARKS ACT 1994

**IN THE MATTER OF application No. 2498651
by Siena Black Limited to register the trade marks**



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**IN THE MATTER OF Opposition thereto under No. 98606
by Tamasu Butterfly Europa GmbH**

BACKGROUND

1) On 26 September 2008, Siena Black Limited (“the applicant”), of 29 Shaa Road, London, W3 7LW applied under the Trade Marks Act 1994 (“the Act”) for registration of the above shown series of two marks and in respect of the following goods in Class 25:

Clothing; footwear; headgear

2) The application was subsequently published in the Trade Marks Journal on 14 November 2008 and on 14 January 2009, Tamasu Butterfly Europa GmbH (“the opponent”) of Am Schurmannshutt 30 h, Moers 47441, Germany filed notice of opposition to the application. By the time of the hearing, the grounds of opposition had reduced to a single ground based upon Section 5(2)(b) of the Act. The ground is based upon the opponent’s earlier International registration M921807 as shown below:

Butterfly

3) This earlier mark is protected in the UK in respect of goods in classes 24, 25 and 28 but for the purposes of these proceedings the opponent relies only upon the following list of Class 25 goods:

Clothing, in particular outer clothing, winter jackets, wind-resistant jackets, fleece jackets, briefs, T-shirts, sportswear, casual wear, sports shirts, sports trousers, tracksuits, jogging suits, leotards, sweatbands, headbands; knitwear, in particular, sweaters, jerseys, jumpers, jersey clothing; hosiery goods (clothing), in particular, stockings, socks, sports socks; terry cloth clothing, namely bath robes; shoes, in particular sports shoes for tennis and table tennis; headgear, in particular caps.

4) The date of designation, in the UK, of this earlier mark was 16 January 2007 (and claimed a priority date of 24 October 2006). It therefore qualifies as an earlier mark in accordance with Section 6 of the Act. Furthermore, the registration procedure (or rather the procedure leading to the protection of an international mark) had not been completed *before* the period of five years ending with the publication of the application in suit and therefore, the proof of use provisions contained in Section 6A¹ of the Act do not apply.

5) The applicant subsequently filed a counterstatement denying the opponent's claims.

6) Neither side filed evidence in these proceedings. Both sides ask for an award of costs. The matter came to be heard on 28 July 2010 when the opponent was represented by Mr Alan Fiddes for Urquhart-Dykes & Lord LLP and the applicant represented by Mr Ian Wilkes for Groom Wilkes & Wright LLP.

DECISION

Section 5(2)(b)

7) Section 5(2)(b) reads:

“(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.”

8) In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the European Court of Justice

¹ Section 6A was added to the Act by virtue of the Trade Marks (Proof of Use, etc.) Regulations 2004 (SI 2004/946) which came into force on 5 May 2004.

(ECJ) in *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] FSR. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] ETMR 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 of 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) 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*,
- (f) 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*,
- (g) 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*,
- (h) 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*,

(i) 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*,

(j) 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.*

(k) 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*

(l) 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 (LIMONCELLO)*

Comparison of goods

9) The respective goods are reproduced below:

| The opponent's goods | The applicant's goods |
|---|--|
| <p><i>Clothing, in particular outer clothing, winter jackets, wind-resistant jackets, fleece jackets, briefs, T-shirts, sportswear, casual wear, sports shirts, sports trousers, tracksuits, jogging suits, leotards, sweatbands, headbands; knitwear, in particular, sweaters, jerseys, jumpers, jersey clothing; hosiery goods (clothing), in particular, stockings, socks, sports socks; terry cloth clothing, namely bath robes; shoes, in particular sports shoes for tennis and table tennis; headgear, in particular caps.</i></p> | <p><i>Clothing; footwear; headgear</i></p> |

10) I bear in mind the guidance provided by the General Court (GC) in *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) ("Meric")* Case T-133/05, where, at para 29, it is stated:

“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).”

11) With this guidance in mind, all the goods listed in the opponent’s specification are identical to the applicant’s *clothing* with the exception of *shoes, in particular sports shoes for tennis and table tennis; headgear, in particular caps*. Applying the same guidance, it is equally clear that these surviving goods are identical to the applicant’s *footwear* and *headgear* respectively.

12) In summary, all of the respective goods are identical.

The average consumer

13) As matters must be judged through the eyes of the average consumer (*Sabel BV v. Puma AG*, paragraph 23) it is important that I assess who the average consumer is for the goods at issue. As the respective goods are identical, it follows that the relevant consumer will be the same, namely the clothing, footwear and headgear buying members of the general public.

14) In respect of these goods, I am mindful of the comments of Mr Simon Thorley, sitting as the Appointed Person, in the *React* trade mark case [2000] R.P.C. 285:

“There is no evidence to support Ms Clark’s submission that, in the absence of any particular reputation, consumers select clothes by eye rather than by placing orders by word of mouth. Nevertheless, my own experience tells me it is true of most casual shopping. I have not overlooked the fact that catalogues and telephone orders play a significant role in this trade, but in my experience the initial selection of goods is still made by eye and subsequent order usually placed primarily by reference to a catalogue number. I am therefore prepared to accept that a majority of the public rely primarily on visual means to identify the trade origin of clothing, although I would not go so far as to say that aural means of identification are not relied upon.”

15) The General Court (GC) has continued to identify the importance of visual comparison when considering the purchasing act in respect of clothing (see for example Joined Cases T-117/03 to T-119/03 and T-171/03 *New Look Ltd v OHIM (NLSPOORT et al)* [2004] ECR II-3471 at [49]-[50] and Case T-414/05 *NHL Enterprises BV v OHIM (LA KINGS)* [2009] ECR II.). There is no evidence in the current case and therefore nothing that provides assistance in considering the nature of the purchasing act. In the absence of such evidence, it is reasonable that I apply Mr Thorley's comments here. The purchasing act will, generally be described as consumer items and will involve a reasonable degree of care and attention but not the highest degree of attention. As Mr Thorley noted, the purchasing process is primarily a visual one but I do not ignore the aural considerations that may be involved.

Comparison of marks

16) For ease of reference, the respective marks are:

| Opponent's mark | Applicant's marks |
|---|---|
|  |  |

17) When assessing the extent of similarity between the respective marks, I must do so with reference to their visual, aural and conceptual similarities bearing in mind their distinctive and dominant components (*Sabel BV v. Puma AG*, para 23). From a visual perspective, the applicant's mark consists of the words BUTTERFLY TWISTS in, what appears to be, a neat handwritten style. The letter B of the word BUTTERFLY is carefully constructed so that it forms one half of the device of a butterfly. The three elements, namely the device of a butterfly, the word BUTTERFLY and the word TWISTS are all distinctive elements within the mark. On the other hand, the opponent's mark consists of the single word BUTTERFLY in an unremarkable typeface. The sharing of the word BUTTERFLY is an obvious point of similarity. They are different in that the applicant's mark includes the additional elements of the device, the word TWISTS and the stylisation of the letters. A further point of difference is that the first mark in the series includes letters and device coloured gold and appearing upon a black background. Taking all of this into account, together with the prominence of the word BUTTERFLY in the applicant's mark, I conclude that the respective marks share a moderately high level of visual similarity.

18) From an aural perspective, the device element in the applicant's marks will not be referred to when a consumer says the mark. It will be pronounced as the four syllables BUT-TER-FLY-TWISTS. The opponent's mark will replicate these same first three syllables and is an obvious point of similarity. They differ in that the applicant's mark has the additional word TWISTS. Taking all of this into account, I find that the respective marks share a moderately high level of aural similarity.

19) Finally, from a conceptual perspective, the applicant's mark has a clear and unambiguous meaning as it consists of a word that describes "any of a large group of nectar-feeding lepidopterous insects with two pairs of large, typically colourful wings"². The applicant's marks contain the same element, namely the word BUTTERFLY and additionally the device of the same, conveying the identical meaning and also the addition word TWISTS. The word TWIST has various meanings and, significantly, including "a thing with a spiral shape"³. When comparing the marks, I am mindful of the guidance given by the ECJ in *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* that assessment of similarity means more than taking just one component of a composite trade mark and comparing it with another mark and also in *Shaker di L. Laudato & C. Sas v OHIM* that only if other components are negligible is it permissible to make the comparison on the basis of the dominant element. In this case, the dominant and only element in the earlier mark is the word BUTTERFLY and that the equally dominant elements of the applicant's marks are the words BUTTERFLY and TWISTS and the device of a butterfly coalesced with the letter "B". The device element reinforces the meaning of the word BUTTERFLY.

20) At the hearing, Mr Wilkes contended that the term BUTTERFLY TWISTS describes an action in martial arts, but there is no evidence supporting this contention. Even if this were so, there is no evidence establishing that the relevant association would be made by the consumer. Mr Fiddes enquired if I would take judicial notice of such an alleged association. In considering this point, I am mindful of the comments of Ms Anna Carboni (sitting as the Appointed Person) in *Chorkee*, BL O-048-08:

"36. ... While the Applicant contended in its Counterstatement that the earlier marks would be recognised to refer to the Cherokee tribe and that the tribe was well known to the general public, no evidence was submitted to support this. By accepting this as fact, without evidence, the Hearing Officer was effectively taking judicial notice of the position. Judicial notice may be taken of facts that are too notorious to be the subject of serious

² "butterfly n." The Concise Oxford English Dictionary, Twelfth edition . Ed. Catherine Soanes and Angus Stevenson. Oxford University Press, 2008. Oxford Reference Online. Oxford University Press. Intellectual Property Office. 28 July 2010 <<http://www.oxfordreference.com/views/ENTRY.html?subview=Main&entry=t23.e7636>>

³ "twist v." The Concise Oxford English Dictionary, Twelfth edition . Ed. Catherine Soanes and Angus Stevenson. Oxford University Press, 2008. Oxford Reference Online. Oxford University Press. Intellectual Property Office. 28 July 2010 <<http://www.oxfordreference.com/views/ENTRY.html?subview=Main&entry=t23.e60567>>

dispute. But care has to be taken not to assume that one's own personal experience, knowledge and assumptions are more widespread than they are.

37. I have no problem with the idea that judicial notice should be taken of the fact that the Cherokee Nation is a native American tribe. This is a matter that can easily be established from an encyclopaedia or internet reference sites to which it is proper to refer. But I do not think that it is right to take judicial notice of the fact that the average consumer of clothing in the United Kingdom would be aware of this. I am far from satisfied that this is the case. No doubt, some people are aware that CHEROKEE is the name of a native American tribe (the Hearing Officer and myself included), but that is not sufficient to impute such knowledge to the average consumer of clothing (or casual clothing in the case of UK TM no. 1270418). The Cherokee Nation is not a common subject of news items; it is not, as far as I am aware, a common topic of study in schools in the United Kingdom; and I would need evidence to convince me, contrary to my own experience, that films and television shows about native Americans (which would have to mention the Cherokee by name to be relevant) have been the staple diet of either children or adults during the last couple of decades."

20) Taking this guidance into account and the circumstances of this case, it is not appropriate for me to take judicial notice that the average consumer will understand the applicant's mark as referring to an action in martial arts. It follows that the average consumer will not identify this claimed conceptual dissimilarity between the respective marks. Rather, the applicant's mark will be understood as containing two, apparently unconnected concepts, namely that of a winged insect and that of something with a spiral shape. The second of these concepts is absent in the opponent's mark. Taking all these factors into account, the respective marks share a moderately high level of conceptual similarity.

21) In summary, I have found that the respective marks share a moderately high level of visual, aural and conceptual similarity and combine so that when the respective marks are considered taking account of the respective wholes, result in a moderately high level of similarity.

Distinctive character of the earlier trade mark

22) I have to consider whether the opponent's mark has a particularly distinctive character either arising from the inherent characteristics of the marks or because of the use made of them. It consists of the word BUTTERFLY. This has a clear meaning in English, as already identified above, but in respect of the relevant goods the word appears to have no connection. As such, the mark enjoys a reasonably high degree of inherent distinctive character but not the highest level as may be associated with, for example, an invented word.

23) I must also consider the effect of reputation on the global consideration of a likelihood of confusion under Section 5(2)(b) of the Act. However, no evidence has been provided regarding the scale of use of the opponent's mark and I must conclude that its distinctive character is not enhanced through use.

Likelihood of confusion

24) The decisions in *Claudia Oberhauser v OHIM (Fifties)* [2003] E.T.M.R. 58, and *Criminal Clothing Ltd v Aytan's Manufacturing (UK) Ltd*, [2005] EWHC 1303 indicate that the circumstances in which the relevant goods and the marks are encountered by the consumer, particularly at the point at which the purchase is made, is an important consideration. That said, the matter must be considered by applying an assessment of all relevant factors and take into account that marks are rarely recalled perfectly with the consumer relying instead on the imperfect picture of them he has in kept in his mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27).

25) I have established that the purchasing act is one based predominantly on visual aspects, but I also note that I must not ignore the aural and conceptual similarities and differences between the respective marks. I have concluded that the marks share a moderately high level of visual, aural and conceptual similarity, combining to result in an overall moderately high level of similarity and that the earlier mark has a reasonably high degree of inherent distinctive character that is not enhanced through use.

26) I take all of the above into account. The applicant's marks have two word elements, both with their own distinct conceptual identities that do not appear to be interrelated in any way. The concept of a winged insect is the first of these two concepts as conveyed by the word BUTTERFLY and this is reinforced by the device of the same appearing at the beginning of the mark. This is the same concept retained by the earlier mark. In respect of the relevant goods, the second concept, namely something with a spiral shape may merely be perceived as describing a characteristic of the goods. Taking these points together, when the applicant's mark is used in respect of clothing, footwear and headgear, the average consumer, familiar with the earlier mark, is likely to assume that it is merely an extension of the BUTTERFLY brand, possibly identifying goods that incorporate a spiral shape or is merely a variant of the BUTTERFLY mark. The addition of a butterfly device and a stylisation of the script is not sufficient to detract from such an assumption. As such, there is a likelihood of indirect confusion in that, whilst the marks may not be confused with one another, the average consumer will believe that the respective goods originate from the same or linked undertaking.

27) In light of this finding, the opposition, as based upon Section 5(2)(b) of the Act, is successful in its entirety.

COSTS

28) The opposition having been successful, Tamasu Butterfly Europa GmbH is entitled to a contribution towards its costs. I take account of the fact that no evidence has been filed by either party. I award costs on the following basis:

| | |
|--|-------------|
| Preparing Notice of Opposition and considering statement | £300 |
| Preparing and attending hearing | £500 |
| TOTAL | £800 |

29) I order Siena Black Limited to pay Tamasu Butterfly Europa GmbH the sum of £800. 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 5 day of August 2010

**Mark Bryant
For the Registrar,
the Comptroller-General**