

**O-286-18**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3244190 BY  
EBONY INTERNATIONAL LTD**

**TO REGISTER THE TRADE MARK:**

**Dylan**

**FOR GOODS CLASSES 18, 20 AND 25**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 60000744  
BY ABAKUS DIRECT LIMITED**

## **BACKGROUND**

1) On 17 July 2017 Ebony International Ltd. (“the Applicant”) applied to register the following trade mark:

**Dylan**

The application was published for opposition purposes on 29 September 2017. Registration is sought for goods in classes 18, 20 and 25, but only goods in Class 20 are opposed in these proceedings.

2) The application is opposed by Abakus Direct Ltd. (“the Opponent”). The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), for the purposes of which the Opponent relies upon UK registration No. 2654470 for the following mark (“the earlier mark”):

### **DYLAN CORNER SOFA**

3) The earlier mark is registered for the following goods in Class 20, which are relied on by the Opponent for the purposes of this opposition: *sofas, corner sofas*. The mark was applied for on 28 February 2013 and its registration process was completed on 14 June 2013. The significance of these dates is that (1) the Opponent’s mark constitutes an earlier mark in accordance with section 6 of the Act, and (2) it is not subject to the proof of use conditions contained in section 6A of the Act, its registration procedure having been completed less than five years before the publication of the Applicant’s mark.

4) The Opponent claims that the mark applied for is similar to the earlier mark and that the goods of the competing marks are identical or similar, so that there is a likelihood of confusion. The Applicant filed a counterstatement, denying the grounds of opposition. The Opponent is now represented in these proceedings by TR Intellectual Property Ltd but initially represented itself. The Applicant is not professionally represented.

5) Rules 20(1)-(3) of the Trade Marks Rules (“TMR” – the provisions which provide for the filing of evidence) do not apply to fast track oppositions, but Rule 20(4) does. It reads:

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

The net effect of these provisions is that parties are required to seek leave in order to file evidence (other than the proof of use evidence, which is filed with the notice of opposition) in fast track oppositions. Neither side sought leave to file evidence in these proceedings.

6) Rule 62(5) (as amended) of the Trade Marks Rules 2008 (as amended by the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013) (“the Rules”) provides 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. Neither side requested a hearing. The Applicant filed written submissions with its defence and counterstatement and both parties filed written submissions in lieu of a hearing. I therefore give this decision after a careful review of all the papers before me.

## **SECTION 5(2)(b)**

7) 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”.

8) The following principles are gleaned from the decisions of the Court of Justice of the European Union (the “CJEU”) 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**

9) In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

10) The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services
- c) The respective trade channels through which the goods or services reach the market
- d) 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;
- e) 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.

11) In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05 (“*Meric*”), the General Court (“the 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 the trade mark application (Case T-388/00 *Institut für 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 (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)”.

12) The position on the interpretation of terms used in specifications was explained as follows by Floyd J. (as he then was) In *YouView TV Ltd v Total Ltd* ,[2012] EWHC 3158 (Ch):

"... 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."

13) The goods in Class 20 for which the Applicant seeks protection are: *divans; sofas; armchairs; beds; ottomans; tables; chairs; chaises longues; furniture; mirrors; picture frames*. The Applicant submits:

"16. A sofa is defined as "*a long, comfortable seat with a back and usually with arms, which two or three people can sit on*" (<https://www.collinsdictionary.com/dictionary/English/sofa>). It is common knowledge that sofas are synonymous with upholstered furniture, and not, regular furniture.

17. Furniture is defined as "*the moveable articles, as tables chairs, desks or cabinets required for use or ornament in a house, office, or the like*" (<http://www.dictionary.com/browse/furniture?s=t>), and armchair is defined as "*a chair with sidepieces or arms to support a person's forearms or elbows*" (<http://www.dictionary.com/browse/armchair?s=t>). Analysing the specifications of the respective marks, it is clear that they are dissimilar."

14) In its notice of opposition, the Opponent indicates that its opposition is directed at “sofas, armchairs, furniture”. I do not consider that it intends its opposition to be limited to “furniture” as it appears as a standalone term in the Applicant’s specification, but rather I consider that it is opposing each of the goods within the applicant’s specification which are, in fact, furniture. I take this purposive approach for a number of reasons. At the time it filed its notice of opposition, the Opponent represented itself. In explaining why it considered there to be a likelihood of confusion, it stated: “The Applicant is clearly trying to use the name Dylan for the goods from the same class 20. We already use that name for sofas, armchairs and other products”. I also note that in its written submissions, filed by its professional representatives in lieu of a hearing, it states its opposition is directed against all goods in class 20 and the Applicant has not challenged this. Moreover, to do otherwise would lead to the rather absurd situation where the Opponent would be taken to be opposing, for example, armchairs but not chairs (which would include armchairs).

15) I consider that the ordinary and natural meaning of “furniture” includes divans, sofas, armchairs, beds, ottomans, tables, chairs and chaises longues. I do not consider that the term “furniture” in its ordinary and natural, or core, meaning is apt to cover mirrors and picture frames, which are more aptly described as furnishings. I therefore do not consider the Applicant’s *mirrors* and *picture frames* to be included in the goods opposed.

16) The Opponent’s *sofas* and *corner sofas* clearly fall within the ambit of the Applicant’s *furniture*, and are thus identical under the guidance in *Meric*. The Applicant’s *divans, sofas, armchairs, beds, ottomans, tables, chairs and chaises longues* all share with the Opponent’s *sofas* and *corner sofas* the basic nature and purpose of furniture, their users will be the same, there will be a degree of complementarity between them (furniture is often sold as a set or suite composed of matching or complementary items), and they will be sold through the same channels of trade. There is a high degree of similarity between them.

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

17) 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*. 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.”

18) The average consumer for the relevant goods will include both business and private consumers among the public at large. The goods will typically be offered for sale in retail outlets, in brochures and catalogues, and on the internet. The purchasing process will therefore be predominately visual, but I do not ignore the potential for aural use of the marks during the purchasing process, or by word of mouth recommendation, and aural considerations will not be ignored in my analysis. The cost of the goods may vary across a range, and items of furniture will not normally be very frequent purchases. The average consumer is likely to be concerned about a number of factors, such as style, cost, comfort and functionality, so the purchasing process is likely to be a considered one.

## **Comparison of the marks**

19) 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 CJEU 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.”

It would be wrong, therefore, to dissect the trade marks artificially, 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.

20) The marks to be compared are shown below:

<b>The opposed mark</b>	<b>The earlier mark</b>
<b>Dylan</b>	<b>DYLAN CORNER SOFA</b>

The Applicant’s mark consists of the word Dylan. The orthographical treatment does not play a role. The word itself, being the mark’s sole element, forms its distinctive component. The opponent’s mark consists of the three words DYLAN CORNER SOFA. The words CORNER SOFA, being descriptive of the goods of the earlier mark, would be accorded little distinctive weight by the consumer. The word DYLAN is manifestly the heavily dominant and distinctive element of the earlier mark.

21) Although not negligible in the overall visual impression of the mark, forming, as they do, a considerable part of its length, the words CORNER SOFA are descriptive of goods covered by the opponent's specification and will be immediately perceived as such. They will therefore receive limited attention from the average consumer when the mark is encountered visually, the focus lying heavily on the initial distinctive word DYLAN. Overall, there is a reasonably high degree of visual similarity between the marks.

22) Aurally, I think it unlikely that the words CORNER SOFA will normally be articulated in trade, because they will be perceived as descriptive and the mark can be referred to much more simply by its distinctive and dominant element DYLAN, making the marks aurally identical. Even if the words CORNER SOFA are included in oral use, however, I consider that there is still overall a reasonably high degree of aural similarity between the marks. Similarly, the words CORNER SOFA add a conceptual element not present in the earlier mark but, being descriptive, their impact on the attention of the consumer will be limited in comparison with the heavily dominant and distinctive word DYLAN, which is well known as being a name (whether forename or surname). Overall, there is a reasonably high degree of conceptual similarity between the marks.

### **The distinctive character of the earlier mark**

23) The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, on the basis either of inherent qualities or because of use made, the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). 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) I have no evidence of acquired distinctiveness to consider. This leaves the question of inherent distinctive character. The words "corner sofa", being descriptive of the goods, would be accorded little distinctive weight by the consumer. Dylan is well known as being a name (whether forename or surname), but it is in no way descriptive or allusive of the goods of the earlier mark. Overall, the mark has a normal degree of inherent distinctive character.

### **Likelihood of Confusion**

25) The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

26) I have found the goods of the respective marks to be identical or highly similar. I have found there to be a reasonably high degree of visual, aural and conceptual similarity overall between the competing marks. I have found the earlier mark to have a normal degree of inherent distinctive character. I have found that, though

both visual and aural aspects may have a role to play, the selection process is likely to be primarily a visual one, and the purchasing process is likely to be a considered one

27) Although the purchasing process will be a considered one, I consider that the words CORNER SOFA, being descriptive of the goods of the earlier mark, are less likely to be retained in the memory of the consumer. It is the initial distinctive DYLAN which will be remembered, and this will create a likelihood that the Applicant's and Opponent's marks will be directly confused. Even where the words CORNER SOFA are noticed and retained, however, the consumer will simply assume that words descriptive of the goods have been appended to the mark DYLAN. The marks will thus be seen as belonging to the same or economically-linked undertakings, and there will be indirect confusion.

28) In view of the broad nature of the term *furniture* in the Applicant's specification in class 25 I have considered whether an amendment of this specification could be made to avoid a likelihood of confusion, and concluded that this would not be feasible in this case. I have taken into account the very high degree of similarity between the marks and the penumbra of protection of the Opponent's earlier registration. I also note that in the letter issued by the Tribunal to the parties when the proceedings were ready for substantive determination the Applicant was invited to make clear whether it had a fall-back position in the form of a limited specification. No fall-back position was submitted.

### **Outcome**

29) **The opposition succeeds insofar as the application is refused in respect of:**

***divans; sofas; armchairs; beds; ottomans; tables; chairs; chaises  
longues; furniture.***

**The following goods in Class 20 of the Applicant's specification may proceed to registration:**

*mirrors; picture frames.*

**All the goods in Class 18 and Class 25 of the Applicant's specification, none of which were opposed, may proceed to registration.**

### **Costs**

30) The Opponent has been successful and is entitled to a contribution towards its costs. Awards of costs in fast track opposition proceedings filed after 1 October 2015 are governed by Tribunal Practice Notice ("TPN") 2 of 2015. I hereby order Ebony International Ltd. to pay Abakus Direct Ltd. the sum of £550. This sum is calculated as follows:

Opposition fee	£100
Preparing a statement and considering the other side's statement	£150
Preparing written submissions	£300

The above sum should 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 11<sup>th</sup> day of May 2018**

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