

0/294/12

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2571595
BY REEBOK INTERNATIONAL LIMITED TO REGISTER THE SERIES OF
TWO TRADE MARKS**

EASYTONE

EASYTONE

IN CLASS 25

**AND IN THE MATTER OF OPPOSITION
THERE TO UNDER NO 101960
BY MATALAN LIMITED**

BACKGROUND

1) On 9 February 2011, Reebok International Limited (“Reebok”) applied under the Trade Marks Act 1994 for registration of the following series of two marks:

EASYTONE

EASYTONE

2) The application is in respect of *Clothing, footwear, headgear* in Class 25.

3) The application was published in the Trade Marks Journal on 25 February 2011 and on 23 May 2011, Matalan Limited (“Matalan”) filed notice of opposition to the application. The grounds of opposition are that the marks offend under Section 5(2)(b) and Section 5(3) of the Trade Marks Act (“the Act”) because they are similar to six earlier marks in the name of Matalan and in respect of identical or similar goods. It claims that its marks enjoy a “significant reputation” in the UK. The relevant details of Matalan’s six earlier marks are provided below:

Mark details and relevant dates	Specification of goods
1125121 EASY Filing date: 5 December 1979	Class 25: <i>Jeans being articles of clothing.</i>
2024591 EASY Filing date: 20 June 1995 Registration date: 1 November 1996	Class 25: <i>Articles of outer clothing; jeans, trousers, jackets, shirts, t-shirts, sweatshirts, waistcoats, cardigans.</i>
2114728 EASY JEANS Filing date: 05 November 1996 Registration date: 23 May 1997	Class 25: <i>Footwear</i>
2321831 	Class 25: <i>Articles of clothing; belts included in Class 25; footwear; headgear.</i>

Filing date: 25 January 2003 Registration date: 8 August 2003	
2321854  Filing date: 25 January 2003 Registration date: 8 August 2003	Class 25: <i>Articles of clothing; belts included in Class 25; footwear; headgear.</i>
1052906  Filing date: 1 October 1975	Class 25: <i>Dresses, jeans being articles of clothing, jackets, skirts and shirts</i>

4) All six marks are registered and have filing dates that predate that of Reebok's mark. Consequently, all of Matalan's marks are "earlier marks" as defined by Section 6 of the Act.

5) The applicant subsequently filed a counterstatement denying the opponent's claims and putting it to proof of use of its marks in respect to all of the goods claimed.

6) Both sides filed evidence in these proceedings and both sides ask for an award of costs. The matter came to be heard on 10 July 2012 when Matalan was represented by Mr Ian Wilkes for Groom Wilkes & Wright LLP and Reebok was represented by Mr Simon Malynicz of Counsel, instructed by J A Kemp & Co..

Opponent's Evidence

7) This consists of two witness statements by Mr Wilkes and one by Mr William George Lodder, a solicitor in the legal department of Matalan. Mr Wilkes is a trade mark attorney and Partner with Groom Wilkes & Wright LLP, Matalan's representatives in these proceedings. He draws attention to Community Trade Mark ("CTM") proceedings between the same parties and in respect to Reebok's application to register the word mark EASYTONE in respect of an identical range of goods as in its current application. At Exhibit IW2, Mr Wilkes provides a copy of the ruling of OHIM's opposition division issued under number 1450883. The

OHIM rejected Reebok's application and also found that Matalan had made genuine use of its earlier marks.

8) Mr Wilkes provides a second witness statement in which he introduces Exhibit IW2 to that statement which consists of copies of evidence of use submitted to the OHIM in respect of the above mentioned CTM proceedings to support its claim of proof of use. This takes the form of promotional literature issued by Matalan between 2005 and 2008, delivery notices issued by Matalan in 2007 and copies of independent reviews showing use of the mark EASY in 2006 and 2007. For reasons that will become obvious, it is not necessary for me to provide further details.

9) At Exhibit IW3, Mr Wilkes provides further evidence of use of the marks EASY and "EASY in a roundel". Once again, it is not necessary for me to provide further details.

10) In his witness statement, Mr Lodder states that Matalan has used its EASY brand since 2003 and in respect of a wide range of clothing including casual shirts, jersey tops (including sweats), jeans, casual trousers, underwear, socks, footwear, knitwear, jogs, shorts, swimwear, nightwear, outerwear, scarves, gloves, hats and belts.

11) Mr Lodder states that turnover relating specifically to EASY branded goods was £154.2 million in 2007, £151.9 million in 2008 and £105.5 million in 2009. He explains that EASY products are not marketed separately to other brands. Ten pages selected from "mailers" are provided at Exhibit B. These appear to be the same pages exhibited by Mr Wilkes at Exhibit IW2 of his second witness statement. Mr Lodder explains that these mailers are sent to between 2.5 million and 3 million customers who have a Matalan Reward Card and a further 100,000 are distributed via its stores.

Applicant's Evidence

12) This takes the form of two witness statements, the first by Ms Rosalind Miller, trade mark attorney with J A Kemp & Co., Reebok's representatives in these proceedings, and the second by Mr Timothy George James Behean, Director of Reebok and General Counsel, Group IP of the adidas group of companies of which Reebok is a member.

13) Ms Miller, at Exhibit RSM1 to her witness statement, provides a definition for the word EASY that appears in the Collins English Dictionary. Meaning 6 of the 18 meanings listed is "*not tight or constricting; loose: an easy fit*". Ms Miller highlights the following marks

- 1006509 EASY RIDERS registered in respect of various items of clothing. She states that this is a brand available for sale in the UK from amazon.co.uk;
- 2543728 WALK EASY registered in respect of footwear. Ms Miller states that the brand is available for sale in the UK from ShoeZone's online store;
- 1408067 EASY STREET registered in respect of footwear. Ms Miller states that this brand is available from amazon.co.uk;
- 2149093 EASY SPIRIT (and device) registered in respect of various types of clothing, shoes and headgear. It is stated that this brand is also available from amazon.co.uk.

14) At Exhibit RSM4, Ms Miller provides examples of these marks in use as of 1 December 2011.

15) Ms Miller states that UK clothing stores commonly market clothing by reference to the word "EASY" as a descriptive term to denote their ease of wear. The following extracts from clothing retailer websites are provided at Exhibit RSM5 in support of this statement:

- Marks & Spencer: "Easy to Iron" and "Easy Iron" clothing and women's "Easy Grip" socks;
- *House of Fraser*: "Big Easy" T-shirts, an "easy fit" pair of jeans and an "easy up firm control body";
- *GAP* promoting a category of jeans as "Easy" and describing them as "easy fit jeans"
- *Asda* identifying its "East Fit Jean" by the word "EASY";
- *John Lewis*: *Jigsaw* branded "Easy T-Shirt" described as being an "easy-fitting top" and "Easy Fit Linen Shirt";
- *Littlewoods*: various items of "Easy Up" underwear and "Easy Hi" and "Easy Slip Hi" training shoes;
- *Fat Face* branded "Easy Light Vintage Denim" jeans being described as "Relaxed easy fit jeans...";
- *Paul Smith*: "Easy Fit, Antique Blue Wash Jeans" and "Formal Slim Fit White Easy Care Shirt";
- *Joe Browns*: "Crinkle Effortlessly Easy Shirt" and "Easy Livin Dress".

16) Ms Miller also provides definitions of the word TONE that appear in the Collins English Dictionary. The relevant extracts are provided at Exhibit RSM7 and the definitions shown include: "to give greater firmness or strength to (the body or a part of the body)".

17) In his statement, Mr Behean explains that the mark EASYTONE was first used in the UK in 2009 in respect of footwear which allows the wearer to tone their calf, hamstring and gluteus maximus muscles simply by walking and running. Reebok began marketing "complementary apparel" under the

EASYTONE mark in the UK in January 2010. For the year 2010, Mr Behean discloses “retail value” of over £21 million with over 31,000 items of EASYTONE footwear being sold that year. Example invoices are provided at Exhibit TGJB1. Catalogues, shown at Exhibit TGJB2, illustrate use of EASYTONE in respect of footwear and also in respect of women’s trousers, shorts and sports tops. Reebok’s EASYTONE goods are available through retailers such as *Debenhams, JD Sports, John Lewis, Next and JJB Sports*.

18) Mr Behean discloses advertising spend in the UK in respect of the EASYTONE mark and this is £3.2 million in 2010 and he provides examples of advertisements and features in “a large number of women’s magazines” and a wide range of newspapers and magazines as well as “advertorials”. Examples of such promotion are provided at Exhibits TGJB4, TGJB5, TGJB6 and TGJB8. EASYTONE goods have also been promoted through cinema and television advertising. Mr Behean also provides evidence (in the form of copies of presentations) illustrating that EASYTONE goods are also promoted through personal endorsements (the model and actress Kelly Brook is specifically identified) and at every home game of Bolton Wanderers football club.

Opponent’s Evidence in reply

19) This takes the form of a further witness statement by Mr Wilkes. This consists of submissions in the form of criticisms of the evidence provided on behalf of Reebok. I will not detail this here but I will bear it in mind. Mr Wilkes also highlights that Matalan has made continuous use of its mark since 2003 with sales averaging £130.5 million a year for the four years preceding the filing of Reebok’s application and, therefore, he submits this clearly demonstrates the reputation that resides in Matalan’s EASY mark.

DECISION

Proof of use

20) The Trade Marks (Proof of Use, etc) Regulations 2004 apply in this case. The provision reads as follows:

“6A Raising of relative grounds in opposition proceedings in case of non-use

(1) This section applies where –

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1),(2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes –

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, ...

...

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services...”

21) As all of Matalan’s earlier marks were registered more than five years before the publication of Reebok’s mark and because Reebok required it in its counterstatement, Matalan was required to provide proof of use of its marks in respect of the goods claimed. At the hearing, Mr Malynicz conceded that his client accepted that such evidence demonstrated genuine use in respect of *clothing* and both parties appeared to accept that in light of the similarity between *clothing* and *footwear*, it was not critical to the outcome of these proceedings whether or not Matalan had also shown use in respect of *footwear*. I will return to this point later in my decision, only if necessary.

Section 5(2)(b)

22) 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.”

23) In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the Court of Justice of the European Union (CJEU) 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 (MEDION)* 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. 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 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*;

(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*.

Comparison of goods

24) Following Mr Malynicz's concession at the hearing, it is common ground between the parties that both parties' marks include the identical goods covered by the term *clothing*. Whilst Reebok's mark also includes footwear and headgear, it was common ground that if the opposition cannot succeed against clothing, it will not do so against the other goods.

The average consumer

25) 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.

26) Mr Malynicz reminded me of the following comments of Mr Simon Thorley, sitting as the Appointed Person, in *React trade mark* [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.”

27) 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 (NLSPORT et al)* [2004] ECR II-3471 at [49]-[50] and Case T-414/05 *NHL Enterprises BV v OHIM (LA KINGS)* [2009] ECR II.). In the current case, there is no evidence specifically on this point. However, Matalan has provided catalogue pages that support the premise that the purchasing process is primarily a visual one. The purchasing act will involve an average degree of care and attention but not the highest and 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

28) I intend to focus my considerations to a comparison between Matalan’s word only mark (that is registered in respect of many items of clothing). At the hearing, the parties were in agreement that this represented Matalan’s best case. For ease of reference, the respective marks are:

Matalan’s marks	Reebok’s marks
EASY	EASYTONE EASYTONE

29) 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). At the hearing, Mr Malynicz submitted that the comparison of the marks is the critical and deciding factor in this case.

30) Firstly, I need to consider what are the dominant and distinctive elements of the respective marks. As Matalan's mark consists of a single word, it is self-evident that this is its dominant and distinctive part. I note Mr Malynicz's submission that the word EASY lacks distinctive character, but I will not discuss this further here, but I will do so later.

31) In respect of Reebok's marks, they both consist of the conjoined words EASY and TONE. The second of these two marks is presented in such a way as the word TONE is in a slightly bolder text. This has the effect of highlighting the fact that the mark is comprised of two distinct words and Mr Wilkes submitted that, as a consequence, the word EASY is more prominent. I do not agree with Mr Wilkes' conclusion. The first mark in the series is also naturally divided between these two recognisable words. The fact that the two words are represented in slightly different fonts in the second mark, merely reinforces this, but in essence, both marks will be perceived as the two distinct words EASY and TONE conjoined. The both words act together to create an allusive term and I am of the view that in both this mark and Reebok's un-stylised mark, the distinctive character resides in the combination of the two words rather than in any one of them.

32) Having identified the dominant and distinctive elements of the respective marks, I must now proceed to consider the comparison of the marks based upon their visual, aural and conceptual characteristics.

33) I shall begin by considering the level of visual similarity between Matalan's word mark and Reebok's marks. Matalan's mark consists of the single word EASY, whereas Reebok's word mark consists of the two words EASY and TONE conjoined. Clearly, the shared use of the word EASY is a point of similarity and the word TONE in Reebok's mark is a point of difference and double's the length of its mark. Taking all of this into account, I conclude that these respective marks share a moderate level of visual similarity. In respect to Reebok's second mark, the bold text used for the word TONE provides an additional point of dissimilarity. That said, and contrary to the assertion by Mr Wilkes, it is my view that this does not appreciably affect the level of visual similarity.

34) From an aural perspective, the respective marks are clearly similar by virtue of the shared EASY element that will be pronounced as E-ZEE. Reebok's marks also have the additional single syllable TONE, so that they are pronounced E-ZEE-T-OWN. Therefore, aurally Reebok's marks consist of three syllables compared to Matalan's marks that consist of two syllables. Taking all of the

above into account, I conclude that Reebok's marks share a moderate level of aural similarity with Matalan's marks.

35) I now turn to the conceptual comparison of the marks. All the marks include the word EASY and this has a normal, widely known meaning of "achieved without great effort"¹. Mr Malynicz argued at the hearing that Reebok's evidence also demonstrates that, in respect of clothing, the word will be understood as indicating that the clothes are "comfortable fit". There is some force in this. At Mr Hold's Exhibit RSM5 is a *Jigsaw* branded "Easy T-Shirt" described as being an "easy-fitting top"; *GAP* promoting a category of jeans as "Easy" and describing them as "easy fit jeans"; *Asda* identifying its "East Fit Jean" by the word "EASY" and; *Fat Face* branded "Easy Light Vintage Denim" jeans being described as "Relaxed easy fit jeans...". And, of course, as Ms Miller identified in her witness statement, it describes clothing that is not tight or constricting. This all lends support to Mr Malynicz's submission and illustrates that high street retailers promote easy fit tops and jeans by allusive reference to the word EASY.

36) On the other hand, Reebok's mark also includes the word TONE. As a result, the word EASY will be perceived as being an adjective applying to the word TONE so that the whole will be perceived as meaning "tone without any great effort". Consequently, the word EASY in the respective marks will be perceived by the consumer as conveying a different message, alluding to clothes that are not tight or constricting on the one hand and to the ability to tone without great effort, on the other. Mr Malynicz contended that the word TONE could relate to one of various meanings such as tone of voice or colour. Of course, it may also be understood as also meaning tone of the body or muscles, and this is how Reebok have actually used it. However, it is my view that the precise meaning of TONE that the consumer may perceive is not relevant. What is relevant is that the two words EASY and TONE conjoined create an allusive whole that will be perceived as a reference to tone, in whatever context, as being made easy. Matalan's mark will be as an allusion to clothing that is "easy-fit".

37) Taking all of this into account, I conclude that the respective marks create separate and unconnected allusions and that, therefore, there is no conceptual similarity.

38) I have concluded that the respective marks share a moderate level of visual and aural similarity and no conceptual similarity. These combine to result in the respective marks sharing a moderate level of similarity overall.

Distinctive character of the earlier trade mark

¹ "easy". Oxford Dictionaries. April 2010. Oxford Dictionaries. April 2010. Oxford University Press. 16 July 2012 <<http://oxforddictionaries.com/definition/english/easy>>.

39) I must consider the distinctive character of the earlier mark because the more distinctive it is, either by inherent nature or by use the greater the likelihood of confusion (*Sabel BV v Puma AG* [1998] RPC 199). The distinctive character of the earlier trade mark must be assessed by reference to the goods for which it is registered and by reference to the way it is perceived by the relevant public (*Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91). Matalan's mark consists of the word EASY. Ms Miller contended that this word is descriptive of loose fitting clothes and this view has been supported by a definition of the word EASY from the Collins English Dictionary and also a number of exhibits where easy-fitting clothes are identified as EASY. Consequently, I am not persuaded by Mr Wilkes argument that the contention is only made out when EASY is used with another word such as EASY-FIT or EASY-IRON. Nevertheless, whilst clearly highly allusive, I remain unconvinced that when the word EASY is used alone, that the consumer will attribute the meaning picked out by Ms Miller. Consequently, I conclude that the word EASY has at least the minimal level of inherent distinctive character for registration.

40) 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. This was considered by David Kitchen Q.C. sitting as the Appointed Person in *Steelco Trade Mark* (BL O/268/04). Mr Kitchen concluded at paragraph 17 of his decision:

“The global assessment of the likelihood of confusion must therefore be based on all the circumstances. These include an assessment of the distinctive character of the earlier mark. When the mark has been used on a significant scale that distinctiveness will depend upon a combination of its inherent nature and its factual distinctiveness. I do not detect in the principles established by the European Court of Justice any intention to limit the assessment of distinctiveness acquired through use to those marks which have become household names. Accordingly, I believe the observations of Mr. Thorley Q.C in *DUONEBS* should not be seen as of general application irrespective of the circumstances of the case. The recognition of the earlier trade mark in the market is one of the factors which must be taken into account in making the overall global assessment of the likelihood of confusion. As observed recently by Jacob L.J. in *Reed Executive & Ors v Reed Business Information Ltd & Ors*, EWCA Civ 159, this may be particularly important in the case of marks which contain an element descriptive of the goods or services for which they have been registered. In the case of marks which are descriptive, the average consumer will expect others to use similar descriptive marks and thus be alert for details which would differentiate one mark from another. Where a mark has become distinctive through use then this may cease to be such an important consideration. But all must depend upon the circumstances of each individual case.”

41) In his witness statement, Mr Lodder states that Matalan has continually used its EASY marks since 2003 with sales of £154.2 million in 2007, £151.9 million in 2008 and £105.5 million in 2009. It is clear from the evidence that such sales do not all relate to Matalan's word mark. That said, at Exhibit IW2 to Mr Wilkes' witness statement are a number of supporting exhibits showing Matalan's use of this mark in respect of various items of clothing in what Mr Lodder described as "mailers" distributed between 2.5 million and 3 million of Matalan's Reward Card holders. Taking all of this into account, I conclude that Matalan's word mark EASY does benefit from an enhanced distinctive character with such use raising its minimal inherent level to a moderate level.

Likelihood of confusion

42) I must adopt the global approach advocated by case law 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).

43) At the hearing Mr Malynicz submitted that there is a strong correlation between the current case and that of O-268-03 *EASYFLEX*, claiming that this earlier decision set out the correct approach. In this earlier decision the hearing officer found that, in respect of the services concerned, the word EASY lacked distinctive character. This is not the case here, where I have concluded that in respect of clothing, Matalan's EASY mark is endowed with a moderate level of distinctive character as a result of the use made of it. Consequently, I dismiss Mr Malynicz's reliance upon the findings in *EASYFLEX*. Mr Wilkes, unsurprisingly, takes a rather different view, submitting that because EASY is distinctive then allowing a registration of EASYTONE is akin to Matalan registering REEBOKTONE. Of course, every case must be considered on its facts, and whilst I note Mr Wilkes' analogy, I will consider this case based upon the facts and observe that the comparison of the marks is somewhat different to the example Mr Wilkes uses because of the difference in the level of distinctive character (and possibly repute) of the REEBOK and EASY marks.

44) Mr Malynicz also referred me to the High Court decision in *FIORELLI Trade Mark* [2007] RPC 18 where, at paragraph 38, Alan Steinfield QC sitting as a deputy judge stated:

"[...] If it is correct, as it seems to me to have been on the unchallenged evidence before the hearing officer, that there is essentially here a single market for designer clothes and accessories, and that the two marks had for many years been used in the market simultaneously, the fact that there was no evidence whatsoever of any actual confusion in the market place must be, as I see it, a relevant factor. [...] The relevance of the parallel trading is not whether there happens to have been parallel trading in the particular class of goods for which the application to register the trade

mark has been made. Rather, it is the fact that if in a market which consists of designer clothes and accessories there has been parallel trading for very many years without any actual evidence of confusion in that market, that is in itself a factor to be taken into account when considering the risk of confusion between the two marks.”

45) Mr Malynicz claims that this supports the view that the lack of actual instances of confusion is a relevant and important factor to take into account. I note this, but the circumstances in the current case differ from those in *FIORELLI*. Firstly, as explained by Mr Behean in his witness statement, Reebok has used its mark primarily in respect of footwear that allows the wearer to tone their muscles, and more recently in respect to a complimentary range of women’s sportswear. Matalan’s evidence illustrates that its mark has been used primarily in respect of casual clothing and jeans. Consequently, the respective markets of the parties’ goods have, as at the relevant date, been concentrated on clothing and footwear with a different purpose. This significantly limits the opportunity for confusion unlike the circumstances described in the *FIORELLI* case. Secondly, Reebok has used its mark for about two years (in respect to footwear) prior to the filing of its application (and one year in respect of sportswear). Consequently, neither has there been “parallel trading for very many years” as in the *FIORELLI* example. Therefore, I bear the guidance of the court in mind, but find that it is not a decisive factor in the current proceedings.

46) Mr Wilkes submitted that the first part of a mark is generally the part that catches the consumer’s attention and has a significant influence on the impression created by the mark. In support of this, he drew my attention to two decisions of the OHIM Boards of Appeal. These were regarding conflicts between the marks QUINTON/QUINTONINE and SHAPER/SHAPERITE respectively. I do not find these to be persuasive because the considerations involved were different to those in the current case. Both relate to the addition of three letters (that are not obviously perceived as an additional word) to six or seven letter words to make a longer, but still single word. The impact upon the additional three letters to these words is different to the impact of a recognised word being added to another four letter word, thereby creating a word that clearly consists of two words.

47) Mr Wilkes developed this theme by contending that the marks THOMSON and THOMSON LIFE that were the subject of the CJEU’s judgment in *Medion* were on “all-fours” with the considerations in the current case. In assessing the role of the word THOMSON in the mark THOMSON LIFE the court commented:

“36 It must therefore be accepted that, in order to establish the likelihood of confusion, it suffices that, because the earlier mark still has an independent distinctive role, the origin of the goods or services covered by the composite sign is attributed by the public also to the owner of that mark.

37 Accordingly, the reply to the question posed must be that Article 5(1)(b) of the directive is to be interpreted as meaning that where the goods or services are identical there may be a likelihood of confusion on the part of the public where the contested sign is composed by juxtaposing the company name of another party and a registered mark which has normal distinctiveness and which, without alone determining the overall impression conveyed by the composite sign, still has an independent distinctive role therein.”

48) Once again, I do not consider the circumstances being considered by the CJEU to be the same as in the current case. Critically, to my mind, is the fact that the dominant and distinctive element of the mark THOMSON LIFE is the name THOMSON and that the court observed this was “the company name of another party”. In the current case the contested mark includes the word EASY, being also the earlier mark relied upon. However, as I have already found, the word EASY functions to serve a different purpose in the two marks thereby negating the likelihood that the occurrence of the word in Reebok’s mark is a reference to Matalan or its goods.

49) Finally, Mr Wilkes contends that adding the word TONE to the word EASY does not create a distinctive whole unlike in the mark CARDINAL PLACE that was discussed in the Registry’s decision in BL O-339-04. It is clear from my earlier comments that I do not agree. The mark EASYTONE is a distinctive whole being allusive of goods that tone without any great effort.

50) In light of all of the above, I remain unpersuaded by Mr Wilkes submissions. Mr Malynicz submitted that there is no way that there can be direct confusion between the marks. I agree, the addition of the word TONE to Reebok’s mark removes any likelihood that the consumer will be confused into believing that one mark is the other, even where they fail to recall the marks perfectly. Mr Malynicz contended further that it is not, in itself, sufficient that the first element of Reebok’s mark is the same as Matalan’s mark because it all depends upon the distinctiveness of the shared element. Matalan’s mark is not non-distinctive (and therefore, this case is not on all-fours with the GC judgment T-434/05 in *Gateway, Inc. v OHIM*, as Mr Malynicz contended). I have found that the word EASY functions in each mark to indicate a different message to the consumer and it is this lack of conceptual similarity that predominates in my finding that there is also no likelihood of indirect confusion, even taking into account that identical goods are involved. Such a lack of conceptual similarity combines with the visual and aural differences to outweigh the similarities. In reaching this conclusion, I have also considered my findings that Matalan’s mark is endowed with a low level of distinctive character, that the relevant consumers are the same and that the purchasing process is primarily visual.

51) In summary, I have found that the grounds based upon Section 5(2)(b) of the Act fails in its entirety.

Section 5(3)

52) Both parties agreed that this ground of objection will stand and fall with the Section 5(2) grounds because the Section 5(3) argument advanced by Matalan essentially relied upon a finding of confusion.

COSTS

53) The opposition having failed, Reebok International Limited is entitled to a contribution towards its costs. I take account of the fact that a hearing has taken place and that both sides filed evidence. I award costs on the following basis:

Considering Notice of Opposition and preparing statement in reply	£300
Preparing and filing evidence and considering other side's evidence	£800
Preparing for, and attending hearing	£800
TOTAL	£1900

54) I order Matalan Limited to pay Reebok International Limited the sum of £1900. 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 1st of August 2012

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