

O-306-17

**TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK APPLICATION NO 3167570
BY GARY MILLER
TO REGISTER**

BEBE BONITO

**AS A TRADE MARK
IN CLASS 25
AND OPPOSITION THERETO (UNDER NO.407688)
BY
GLASGOW PRAM CENTRE (A SCOTS LAW PARTNERSHIP)**

BACKGROUND AND PLEADINGS

1. Gary Miller ('the applicant') applied to register the following mark on 2 June 2016:

BEBE BONITO

2. The mark was accepted and published on 15 July 2016 for the following goods in class 25: **Clothing, footwear and headgear for children and infants**

3. Glasgow Pram Centre (a Scots Law Partnership) ('the opponent') opposed the trade mark under section 5(2)(b) of the Trade Marks Act 1994 ('the Act') on the basis of the trade mark set out below:

Opponent's mark	Goods relied on
Trade mark No. 2609225 BONITO BEBÉ Filing date: 3 February 2012 Registration date: 3 August 2012	Goods in classes 5, 18 and 25.

4. The opponent's trade mark is an earlier mark, in accordance with section 6 of the Act and, as it had not been registered for five years or more at the publication date of the applicant's mark, it is not subject to the proof of use requirements, as per section 6A of the Act.

5. Neither party filed evidence or written submissions nor was a hearing requested. I now make this decision on the basis of the papers before me.

PRELIMINARY ISSUE

6. In his counterstatement, the applicant has submitted that he has used the mark at issue since 1999 and has owned a previously registered trade mark that expired in 2008. This is not relevant to the matter before me so I cannot take that information into consideration. I refer to Tribunal Practice Notice (TPN) 4/2009 in relation to defences including a claim that the applicant has a registered mark that predates the opponents mark which states:

“2. Sections 5(1) and 5(2) of the Act turn upon whether the attacker has an earlier trade mark compared to the mark under attack, as defined by section 6 of the Act. Whether the applicant for registration has another registered trade mark (or trade mark application) that predates the earlier mark upon which the attacker relies cannot affect the outcome of the case in relation to these grounds”.

7. TPN 4/2009 also set out the position on defences claiming use of a trade mark which precedes the date of use of the opponent’s mark. It states:

“4. The viability of such a defence was considered by Ms Anna Carboni, sitting as the appointed person, in *Ion Associates Ltd v Philip Stainton and Another*, BL O-211-09. Ms Carboni rejected the defence as being wrong in law.

5. Users of the Intellectual Property Office are therefore reminded that defences to section 5(1) or (2) grounds based on the applicant for registration/registered proprietor owning another mark which is earlier still compared to the attacker’s mark, or having used the trade mark before the attacker used or registered its mark are wrong in law. If the owner of the mark under attack has an earlier mark or right which could be used to oppose or invalidate the trade mark relied upon by the attacker, and the applicant for registration/registered proprietor wishes to invoke that earlier mark/right, the proper course is to oppose or apply to invalidate the attacker’s mark”.

DECISION

8. Section 5(2)(b) of the Act is 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.

9. The leading authorities which guide me are from the Court of Justice of the European Union ('CJEU'): *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.

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 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

10. The opponent has indicated that it relies on its earlier registration insofar as it is registered for goods in classes 5, 18 and 25. I intend to carry out the comparison only in respect of goods in class 25 as, if it does not succeed in relation to these goods, it will be in no stronger position in relation to its goods in the other classes. The goods to be compared are:

Opponent's goods	Applicant's goods
Clothing, headgear and footwear; babies diapers, napkins and nappies of textile materials; cotton nappies; wraps, liners and boosters for nappies; babies absorbent pants; articles of clothing for babies and infants; articles of knitwear for babies and infants; articles of underclothing for babies and infants; babies bibs [other than of paper]; babies bootees; babysuits; pramsuits; all-in-one stretch garments for babies; cardigans; jackets; romper suits; jumpers; sweaters; trousers; dungarees; skirts; dresses; socks; bonnets; mittens; maternity wear.	Clothing, footwear and headgear for children and infants

11. The opponent's specification of goods contains the term 'clothing, headgear and footwear'. This term covers all forms of clothing, headgear and footwear. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court ('GC') stated that:

"29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut 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”.

Therefore the term clothing, headgear and footwear will cover all of the applicant's goods for children and infants and are considered as identical goods.

AVERAGE CONSUMER AND THE PURCHASING PROCESS

12. 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*.

13. 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.”

14. The goods at issue in this case are clothing, headgear and footwear. 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 GC 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.

53. 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.”

15. The average consumer for the contested goods are the general public. As stated by the GC, items of clothing vary in price and quality. Ordinarily I would expect a normal level of attention to be paid by the consumer when selecting such goods. The purchasing act will be mainly visual and will likely be based on the aesthetic appeal of a garment and, where intended to be worn by young children, its suitability for that purpose. It is likely that goods will be selected after perusal of racks/shelves in retail establishments, or from photographs on Internet websites or in catalogues. However, I do not discount aural considerations which may also play a part.

COMPARISON OF THE MARKS

16. The marks to be compared are:

Opponent's mark	Applicant's mark
BONITO BEBÉ	BEBE BONITO

17. 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 them, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union 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.”

18. It would be wrong, therefore, artificially to dissect the trade marks, although, it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by them.

19. The opponent's trade mark consists of two words **BONITO BEBÉ** in plain block capitals. The overall impression rests solely on those two words. The applicant's mark consists of the same two words but transposed, that is **BEBE BONITO**, in plain

block capitals. The overall impression of the applicant's mark rests solely on those two words. In addition I note that there is an acute accent over the second letter 'e' in the word BEBE in the opponent's mark which is absent in the applicant's mark.

20. In terms of visual similarity, the eye will notice that both marks contain the words BEBE and BONITO. I do not think that the additional acute accent will have any material visual impact. The applicant submits in his counterstatement that the transposing of the words creates a difference, however even if this is the case, I find there to be at least a medium degree of visual similarity.

21. With regard to aural similarity, the two words will be pronounced in the same way in both marks, albeit in a different order, so again I find there to be at least a medium degree of aural similarity.

22. In considering the conceptual similarity, I note that both marks consist of the same non-English words. Neither mark has any immediately graspable concept¹. The average consumer will recognise that the marks are made up of non-English words. It may be that some average consumers will know the meaning of these words whereas others will not. Whether they know the meaning or not, given that both marks consist of the same words, whatever message is brought to mind is likely to be same in both cases. On that basis I find there to be at least a medium degree of conceptual similarity.

DISTINCTIVE CHARACTER OF THE EARLIER MARK

23. The distinctive character of the earlier mark must be considered. The more distinctive it is, either inherently or through use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

¹ It has been highlighted in numerous judgments such as *The Picasso Estate v OHIM*, Case C-361/04 that it is only concepts capable of immediate grasp by the consumer that are relevant.

“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. The opponent did not file any evidence showing use of the earlier mark for the goods relied on so I can only consider the inherent distinctiveness of the earlier mark.

25. The words BONITO BEBÉ do not describe the relevant goods. Some average consumers may recognise the meaning of the words and know that they have some connection with baby clothing but for a substantial number of consumers the mark is likely to be considered meaningless. Whether the meaning is known or not, I find that in this matter there is an average level of inherent distinctiveness.

LIKELIHOOD OF CONFUSION

26. I must now draw together my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors:

- a) The interdependency principle, whereby a lesser degree of similarity between the goods may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc*).
- b) The principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*).
- c) The factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*).

27. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, Mr Iain Purvis Q.C. as the Appointed Person noted that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

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).”

28. I have found that the marks are visually, aurally and conceptually similar to a medium degree. In addition I have found that the respective goods are identical and that the average consumer will be paying a normal level of attention during the purchasing process. With regard to the distinctiveness of the earlier mark, I have found there to be an average level of inherent distinctiveness. In considering the factors outlined in the paragraph above, the most pertinent is that of imperfect recollection. Both marks contain the same two non-English words albeit in a different order. It is unlikely that a consumer will see the two marks side by side but they will have those two words in mind. This significantly increases the likelihood of the applicant’s goods being considered by the average consumer, at the very least, to come from the same or linked undertakings.

CONCLUSION

29. The opposition succeeds under section 5(2)(b) of the Act for all the goods claimed.

COSTS

30. As the opponent has been successful, they are entitled to a contribution towards their costs incurred in these proceedings. Using the guidance in Tribunal Practice Notice 2/2016, I make the following award:

£100 Official fee for filing the Notice of Opposition

£200 Preparing the Notice of Opposition

£300 Total

31. I order Gary Miller to pay Glasgow Pram Centre (a Scots Law Partnership) the sum of £300. This sum is to be paid within 14 days of the expiry of the appeal period or within 14 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 4th day of July 2017

June Ralph

For the Registrar,

The Comptroller General