

O-347-17

**TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK APPLICATION NO 3136205
BY ABOUBEKR CHIKH
TO REGISTER**

CITIZEN

**AS A TRADE MARK
IN CLASS 35
AND OPPOSITION THERETO (UNDER NO. 406174)
BY
CITIZEN HOLDINGS KABUSHIKI KAISHA ALSO TRADING AS CITIZEN
HOLDINGS CO., LTD**

Background and Pleadings

1. On 15 November 2015, Aboubekr Chikh ('the applicant') applied to register the following mark for a wide number of retail services in class 35:

CITIZEN

2. The trade mark was published on 4 December 2015. Citizen Holdings Kabushiki Kaisha also trading as Citizen Holdings Co., Ltd ('the opponent') opposes part of the application (for retail services in relation to sporting articles; retail services connected with the sale of clothing accessories) under sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 ('the Act') on the basis of specified goods in the following earlier EU Trade Mark.

<p>EU013847389</p> <p>CITIZEN</p> <p>Filing date: 23 April 2014 Registration date: 17 March 2015</p>	<p>Class 14: jewelry; horological and chronometric instruments.</p> <p>Class 18: leather purses or wallets; trunks and travelling bags; whips, harness and saddlery.</p> <p>Class 25: Clothing, footwear, headgear.</p> <p>Class 28: Games and playthings; gymnastic and sporting articles not included in other classes.</p>
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3. The applicant filed a counterstatement denying the grounds of opposition.

4. The opponent's above mentioned trademark is an earlier mark, in accordance with Section 6 of the Act but is not subject to proof of use requirements as it has not been

registered for five years or more before the publication date of the applicant's mark, as per section 6A of the Act.

5. Both parties filed evidence. The opponent also filed submissions. Neither party requested to be heard. I now make this decision based on the papers before me.

PRELIMINARY ISSUES

6. In his counterstatement, the applicant has submitted that he owns a number of other registered trade marks containing the word 'citizen'. As each case must be assessed individually, this is not relevant to the matter before me so I cannot take that information into consideration.

7. The applicant emailed the Tribunal on 19 July 2017 expressing concern that the opponent had been 'allowed' to make further submissions in their letter of 7 July 2017 and that he wished to have an opportunity to reply to those submissions. I believe the applicant may have misunderstood the opposition process.

8. The Tribunal wrote to both parties on 9 June 2017 setting out the options available for the next stage of the opposition proceedings. This letter set out the options to either have a 'decision from the papers' or to request a hearing. Both parties were invited to make written submissions on or before 7 July 2017 if they were content with the 'decision from the papers' option. Only the opponent filed submissions.

9. The written submissions are an opportunity for both parties to submit any further points to the Tribunal that they would otherwise have made at a hearing. It is not the case that the applicant has been prevented from making a written submission. He was invited to do so in the Tribunal letter of 9 June 2017. Further, he also had an opportunity to file submissions (and/or evidence) during the evidence rounds, after the opponent had filed its evidence.

OPPONENT'S EVIDENCE

10. The opponent submitted extensive evidence pertaining to its wristwatches including invoices, catalogues, retailer lists, market research reports, social media posts and advertising campaign material. I do not intend to undertake a full summary of all the evidence submitted for reasons which will become apparent in the following decision.

APPLICANT'S EVIDENCE

11. The applicant also filed evidence in support of his application. This comprised copies of webpages, the trade mark details of his other registrations and copies of his business model. Having reviewed this evidence, I do not consider it to be of assistance to me as it does not show the contested trade mark and is irrelevant to the matter at hand.

DECISION

12. I shall deal first with the opposition based on Section 5(2)(b) of the Act which states:

“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.

13 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 AND SERVICES

14. The goods and services to be compared are:

Opponent's goods	Applicant's services
Class 25: Clothing, footwear, headgear. Class 28: Games and playthings; gymnastic and sporting articles not included in other classes.	Class 35: Retail services in relation to sporting articles; retail services connected with the sale of clothing accessories.

15. I intend to carry out the comparison only in respect of the opponent's goods in classes 25 and 28 as, if it does not succeed in relation to these goods against the retail services, then they will be in no stronger position in relation to their goods in classes 14 and 18.

16. With regard to the comparison of services, in the judgment of the Court of Justice of the European Union 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”.

17. 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.

18. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criteria capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal*

Market (Trade Marks and Designs) (OHIM), Case T-325/06, the General Court stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

19. In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the General Court (GC) held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

20. In *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services v goods. He said (at paragraph 9 of his judgment) that:

“9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent’s earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are ‘similar’ to goods are not clear cut.”

21. However, on the basis of the European courts' judgments in *Sanco SA v OHIM*¹, and *Assembled Investments (Proprietary) Ltd v. OHIM*², upheld on appeal in *Waterford Wedgwood Plc v. Assembled Investments (Proprietary) Ltd*³, Mr Hobbs concluded that:

- i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer's point of view, they are unlikely to be offered by one and the same undertaking;
- ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent's goods and then to compare the opponent's goods with the retail services covered by the applicant's trade mark;
- iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;
- iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

22. Taking account of the guidance of the guidance outlined above, I note that retail services for particular goods may be considered complementary to those goods and that such goods would be distributed via the services.

23. In the applicant's counterstatement, it is submitted that:

¹ Case C-411/13P

² Case T-105/05, at paragraphs [30] to [35] of the judgment

³ Case C-398/07P

“...from the first idea of Citizendiet.com to Citizenlabel.com, the Citizen label project was based on the idea of the citizen as related to sustainable way of life, promotion of gender equality, organic and healthy lifestyle with a creative mindset...”

24. The way in which the applicant uses his mark, and the reason for adopting it, is irrelevant to the consideration of whether the average consumer will confuse the marks (section 5(2)(b)), I must compare the parties' goods and services on the basis of notional and fair use of what has been listed in their specifications. In *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchen L.J. stated that:

“78.the court must.... consider a notional and fair use of that mark in relation to all of the goods or services in respect of which it is registered. Of course it may have become more distinctive as a result of the use which has been made of it. If so, that is a matter to be taken into account for, as the Court of Justice reiterated in *Canon* at paragraph [18], the more distinctive the earlier mark, the greater the risk of confusion. But it may not have been used at all, or it may only have been used in relation to some of the goods or services falling within the specification, and such use may have been on a small scale. In such a case the proprietor is still entitled to protection against the use of a similar sign in relation to similar goods if the use is such as to give rise to a likelihood of confusion.”

25. In addition in *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06, the Court of Justice of Justice of the European Union stated at paragraph 66 of its judgment that when assessing the likelihood of confusion under Section 5(2) it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered. In *Oakley v OHIM* (case T-116/06) it is made clear that consideration of likelihood of confusion is prospective and not to be restricted to the current marketing or trading patterns of the parties:

“...since the particular circumstances in which the goods covered by the marks are marketed may vary in time, and depending on the wishes of the proprietors of the trade marks, the prospective analysis of the likelihood of

confusion between the two marks, ...cannot be dependent on the commercial intentions, whether carried out or not – and which are naturally subjective –of the trade mark proprietors...”

26. The opponent’s specification for *sporting articles* is identical to the goods referred to in the applicant’s *retail services in relation to sporting articles* and will have the same channels of trade. I find that there is a relevant complementary relationship between the opponent’s goods and the applicant’s services resulting in at least a medium degree of similarity between them.

27. The opponent’s specification for *clothing, footwear, headgear* is at least similar to the goods referred to in the applicant’s *retail services connected with the sale of clothing accessories* as I view ‘clothing accessories’ as being goods which either assist the functionality of a garment such as a belt or enhance its aesthetic quality such as a scarf. Therefore I find that ‘clothing accessories’ fall under the umbrella term of ‘clothing’ at large. I find that there is a relevant complementary relationship between the opponent’s goods and the applicant’s services resulting in at least a medium degree of similarity between them.

AVERAGE CONSUMER AND THE PURCHASING PROCESS

28. I must now consider who the average consumer will be for the contested goods and services. 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*.

29. 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.”

30. The goods and services at issue in this case are clothing accessories, sporting articles and retail of same. 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.”

31. The average consumer for clothing accessories are the general public and for sporting articles it would those members of the general public with a particular interest

in sports participation. As stated by the GC, items of clothing vary in price and quality. The same would apply to clothing accessories. 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 an accessory. For sporting articles, a normal level of attention will be paid and the purchasing act is again likely to be visual and will be based on an article's suitability for use in a particular sporting activity. 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 especially for sporting articles if for example advice is sought from a specialist sports equipment supplier prior to purchase.

COMPARISON OF THE MARKS

32. The marks to be compared are:

Opponent's mark	Applicant's mark
	

33. 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 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.”

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

34. The opponent's mark consists of the capitalized word CITIZEN. The overall impression of the mark is based solely on this presentation. The applicant's mark consists of the capitalized word CITIZEN in a stylized font. The overall impression of the mark is based solely on this presentation.

35. In a visual comparison of the marks, both are clearly seen as the word CITIZEN. The point of visual difference arises from the fonts used in the marks. The opponent's mark is a standard font with serif finishes on each letter. The applicant's mark consists of a sans serif font, stated by the applicant to be Gogóia Deco, with additional flourishes on the letters I, Z and the E. The applicant refers to the specific red colour in their mark as being an additional point of difference. However, that is not a distinguishing factor because although the opponent's mark is registered in black and white, it could be used in the same colour red. Overall I find there to be a high degree of similarity.

36. In an aural comparison, the word CITIZEN is pronounced in the same way in both marks. They are aurally identical.

37. In a conceptual comparison, both marks consist of the same word CITIZEN, which is a well known English language word defined as an inhabitant or national of a state, city or country. The marks are conceptually identical.

DISTINCTIVE CHARACTER OF THE EARLIER MARK

38. 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:

“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).”

39. The opponent filed evidence showing use of the goods relied on in class 14. As I have made the goods comparison on the basis of classes 25 and 28, which presents the opponent’s best case under section 5(2)(b) of the Act, the use made in relation to the class 14 goods is not strictly relevant. For procedural economy, I will confine my assessment of distinctive character of the earlier mark to the class 25 and 28 goods, which is on an inherent distinctive character basis.

40. The word CITIZEN does not describe the relevant goods. I find there to be an average level of inherent distinctiveness.

LIKELIHOOD OF CONFUSION

41. 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*).

42. I have found that the marks are visually similar to a high degree and aurally and conceptually identical. In addition I have found that 'sporting articles' and 'clothing accessories' are complementary to a medium degree, in relation to retail of the same goods in class 35. Furthermore I have found the purchasing process is largely a visual one and that the average consumer will be paying a normal level of attention. With regard to the distinctiveness of the earlier mark, I have found there to be an average level of inherent distinctiveness. Both marks contain an identical English word albeit in a different font in each mark. However each having the identical word CITIZEN significantly increases the likelihood of the applicant's retail services being assumed to originate from the same commercial source as the opponent's goods. Taking these factors into account I find that there is a likelihood of confusion. Even if the consumer does not mistake one mark for the other, they are, at the very least, likely to believe that the respective goods and services come from the same or linked undertakings.

CONCLUSION

43. The opposition succeeds under section 5(2)(b) of the Act for the following services in class 35:

Retail services in relation to sporting articles; retail services connected with the sale of clothing accessories.

The application is refused for the above services but may proceed to registration for the remainder of the specification, i.e.:

Retail services in relation to headgear; Retail services in relation to cleaning articles; Retail services in relation to printed matter not including retail of printed publications; Retail services in relation to teas; Retail services in relation to horticulture products; Retail services in relation to gardening articles; Retail services in relation to art materials; Retail services in relation to sporting equipment; Retail services in relation to works of art; Retail services in relation to foodstuffs; Retail services in relation to dietary supplements; Retail services in relation to furnishings; Retail services in relation to coffee; Retail services in relation to sorbets; Retail services in relation to frozen yogurts; Retail services in relation to confectionery; Retail services in relation to desserts; Retail services in relation to baked goods; Retail services in relation to toys; Retail services in relation to horticulture equipment; Retail services in relation to food cooking equipment; Retail services in relation to footwear; Retail services connected with the sale of clothing; Retail store services in the field of clothing; Retail services in relation to fabrics; Retail services in relation to bags; Retail services in relation to stationery supplies; Retail services in relation to festive decorations; Retail services in relation to coffee; Retail services in relation to furniture; Retail services connected with the sale of furniture; Retail store services in the field of clothing; with the aim of promotion of all equalities including gender equality, promotion of women's empowerment and transgender equality in retail services.

44. I have not considered the grounds pleaded under section 5(3) as the opposition under section 5(2) has succeeded.

COSTS

45. As the opponent has been successful, it is entitled to a contribution towards its costs incurred in the proceedings. Using the guidance in Tribunal Practice Notice 4/2007 (which was in force when the opposition was filed) I make the following award:

£200 Official fee for filing the Notice of Opposition

£200 Preparing the Notice of Opposition

£200 Preparing written submissions

46. I am not awarding costs for the preparation of evidence as it was considered irrelevant to the decision made in this case.

47. I order Aboubekr Chikh to pay Citizen Holdings Kabushiki Kaisha also trading as Citizen Holdings Co., Ltd the sum of £600. 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 21 day of July 2017

June Ralph

For the Registrar,

The Comptroller General