

O-474-13

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2627344**

**BY**

**KIRBY FOOTWEAR LIMITED**

**TO REGISTER THE TRADE MARK**

**SOPHIA DE-MARTIN**

**IN CLASS 25**

**AND**

**THE OPPOSITION THERETO**

**UNDER NO 104047**

**BY**

**FASHION BRAND INTERNATIONAL**

## BACKGROUND

1. On 6 July 2012, Kirby Footwear Limited (the applicant) applied to register the above trade mark in class 25 of the Nice Classification system<sup>1</sup>, as follows:

### Class 25

Footwear; clothing; headgear

2. Following publication of the application, on 3 August 2012, Fashion Brand International (the opponent) filed notice of opposition against the application.

3. Following amendment, the grounds of opposition are brought under section 5(2)(b) of the Trade Marks Act 1994 (the Act) (grounds under sections 3(6), 5(3) and 5(4)(a) were deemed abandoned for non-filing of evidence). The opponent relies upon the mark and goods shown below:

Mark details and dates	Goods
CTM 9594921 Mark:  Filed: 14 December 2010 Registered: 26 August 2012 Colour claim: Magenta	<b>Class 18</b> Belts (leather shoulder); handbags; school bags; shopping bags; umbrellas; wallets (pocket); travel bags. <b>Class 25</b> Belts (clothing); Camisoles; Legging; linen (body garments); dressing gowns; singlets; slippers; underwear; yokes (shirt); footwear (for wear).

4. In its statement of grounds, with regard to 5(2)(b) the opponent submits:

*“4. The Application features the name “SOPHIA” which is a female Christian name derived from the Greek word for wisdom. SOPHIE is the French equivalent. The marks are visually and phonetically similar. The use of DE-MARTIN adds a French element to the application and as SOPHIE is the French equivalent of SOPHIA the marks are conceptually also similar. “Clothing, footwear and headgear” includes “Belts (clothing); Camisoles; Legging; linen (body garments); dressing gowns; singlets; slippers; underwear; yokes (shirt); footwear (for wear)” and the goods are therefore identical or highly similar.”*

5. On 24 January 2013, the applicant filed a counter statement. It denies the grounds upon which the opposition is based. It states:

<sup>1</sup> International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).

*“7. It is denied that the mark SOPHIE (stylised)...is similar to the applicant’s mark SOPHIA DE-MARTIN and denied there is any confusion or association between the marks.*

*There are over 40 UK and Community trade mark registrations in class 25 containing the words SOPHIE or SOPHIA...*

*Furthermore, Internet searches have established numerous SOPHIE and SOPHIA clothing brands/ranges available to the public in the UK...*

*As such, the opponent cannot claim a monopoly in the words SOPHIE and/or SOPHIA by virtue of a stylised CTM registration for SOPHIE.”*

6. The opponent's mark is an earlier mark not subject to proof of use because, at the date of publication of the application, it had not been registered for five years.<sup>2</sup>

7. Only the applicant filed evidence; the opponent opted to file submissions during the period allowed for filing evidence. Neither party asked to be heard or filed written submissions in lieu of attendance at a hearing.

## **EVIDENCE**

8. The applicant’s evidence comprises a witness statement by Jandan Aliss, a Trade Mark Attorney with Nucleus IP. It is dated 10 May 2013 and has three exhibits attached. The exhibits consist of trade mark database search results and internet searches. I do not intend to summarise the evidence here but will refer to it as necessary below.

## **DECISION**

9. Section 5(2)(b) of the Act reads as follows:

“5. - (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, or there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

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<sup>2</sup> See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations 2004: SI 2004/946) which came into force on 5th May 2004.

## Section 5(2)(b) case law

10. In his decision in *La Chemise Lacoste SA v Baker Street Clothing Ltd* - BL O/330/10 (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), the Appointed Person, Mr Geoffrey Hobbs QC, expressed the test under this section (by reference to the CJEU cases mentioned) on the basis indicated below:

### The CJEU cases

*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] F.S.R. 77; *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723; *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), Case T-6/01*; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04; *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P.*

### 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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 causes the public to 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

11. In making a comparison between the parties’ goods I will only consider the opponent’s goods in class 25 as they represent its best case.

12. The goods to be compared are as follows:

The opponent’s goods	The applicant’s goods
<b>Class 25</b> Belts (clothing); Camisoles; Legging; linen (body garments); dressing gowns; singlets; slippers; underwear; yokes (shirt); footwear (for wear).	<b>Class 25</b> Footwear, clothing, headgear

13. In comparing the goods, I bear in mind the following guidance provided by the General Court (GC) in *Gérard Meric v OHIM*, Case T-133/05:

“29. ...goods can be considered identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

14. The applicant’s specification includes the broad terms ‘clothing’ and ‘footwear’ which clearly include all of the opponent’s class 25 goods. In accordance with the decision in *Meric*, I find these goods to be identical. Given that the applicant’s goods are expressed in broader terms than those of the opponent, the applicant’s specification will include goods other than those present in the specification of the earlier mark. However, given that these goods will be footwear, clothing or headgear they will be at least similar to the opponent’s goods in class 25.

## **The average consumer and the nature of the purchasing act**

15. In accordance with the above cited case law, I must determine who the average consumer is and also identify the nature of the purchasing process. The average consumer is reasonably well informed and reasonably circumspect and observant but with a level of attention likely to vary according to the category of goods. The attention paid is likely to vary depending on price and, to some extent, the nature of the goods and the frequency of the purchase.

16. The average consumer of the goods at issue will be a member of the general public. The purchase is likely to be primarily visual as it is likely to be made from a website or directly from a shelf.

17. In considering the level of attention that will be paid to such a purchase and the nature of the purchasing act, I am mindful of the decision of the General Court (GC) 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, in which it commented:

"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."

18. The selection process for each of the goods is primarily visual, though I do not discount the fact that there may be an aural element given that some articles may be selected with the assistance of a member of staff. The goods may be purchased on the high street, online or by mail order and the level of attention paid will be reasonable, the consumer paying the attention necessary to obtain, inter alia, the correct size, colour and fit.

## Comparison of marks

19. The marks to be compared are as follows:

The opponent's mark	The applicant's mark
	SOPHIA DE-MARTIN

20. In making a comparison between the marks, I must consider the respective marks' visual, aural and conceptual similarities with reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components<sup>3</sup>, but without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

21. The opponent's mark consists of the single word 'SOPHIE'. The first four letters are presented in plain block capitals, while the remaining letters 'i' and 'e' are presented in lower case. The letter 'i' possess a small degree of stylisation in that the tittle above the letter 'i' takes the form of a heart. Even if it is noticed it is not dominant and does not detract from its being seen as a letter 'i', or prevent the word being seen as the single word 'SOPHIE'. The mark is presented in a shade of pink which is claimed in the opponent's registration to be 'magenta'. Fair and notional use would allow the applicant's mark to be used in the same colour, consequently, this is not a distinctive element of the mark. The distinctive and dominant element of the mark is the word 'SOPHIE'.

22. The applicant's mark consists of the words 'SOPHIA DE-MARTIN' in plain block capitals. The words hang together to create a name. No part of the words is stylised or emphasised in any way. Consequently, the mark does not possess any distinctive or dominant elements, the distinctiveness being in the mark as a whole.

### Visual similarities

23. In its submissions, dated 4 April 2013, the opponent states on page 3:

*"The first part of the mark is virtually identical/highly similar visually with the earlier mark."*

24. In its submissions, dated 10 May 2013, the applicant submits:

*"The marks are visually distinct as the mark applied for is twice the length of the opponent's mark and has the distinctive element DE-MARTIN."*

25. Any similarity between the marks rests in the first five letters, S O P H I, which begin both marks. The opponent's mark only contains one additional letter, 'E', which

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<sup>3</sup> *Sabel v Puma AG, para.23*

ends its six letter mark. The applicant's mark contains an additional 'A' to end the first word and the words DE-MARTIN. The applicant's mark is considerably longer. The minimal stylisation of the opponent's mark is likely to go unnoticed by the average consumer and the colour is not a relevant factor for the reasons given above. There is a general rule, clear from decisions such as joined cases T-183/02 and T-184/0274<sup>5</sup>, that the first parts of words catch the attention of consumers. However, it is also clear that each case must be decided on its merits. In this case the fact that the first five letters of each mark are the same provides a point of similarity but does not necessarily mean that the overall impression the marks give the average consumer is one of similarity. Taking these factors into account, I find there to be a moderate degree of visual similarity between the marks.

### **Aural similarities**

26. The opponent submits:

*"The phonetic comparison between the first part of the mark and the earlier mark is particularly important, not least because the goods are usually ordered or discussed verbally. The marks in question have significant and conclusive phonetic similarities due to the presence of the "SOPHIA" element in the applicant's mark that is virtually identical to the Opponent's mark."*

27. The applicant submits:

*"The marks are phonetically distinct due to the different pronunciations of the names SOPHIE and SOPHIA and due to the inclusion of the second element DE-MARTIN in the mark applied for."*

28. The opponent's mark consists of two syllables and will be pronounced, SO-FEE. The applicant's mark consists of six syllables and will be pronounced, SO-FEE-A DE-MAR-TIN. There is a natural break between the first three syllables and the second three. The first two syllables of both marks are the same. I find the marks to possess a moderate degree of aural similarity.

### **Conceptual similarities**

29. The opponent states:

*"SOPHIA is a female Christian name derived from the Greek word for wisdom. SOPHIE is the French equivalent. The addition of "DE" to the application in suit adds a French flavour to the mark. When used in combination with a surname it denotes nobility in the French language. 'MARTIN' is by common consent the most popular surname in France."*

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<sup>4</sup>

<sup>4</sup> II – 965, paragraph 81

<sup>5</sup>

<sup>5</sup> II – 965, paragraph 81

(MUNDICOR) [2004] ECR

(MUNDICOR) [2004] ECR

30. The applicant submits:

*“The opponent’s comparison of the marks...goes into an analysis of the origin of the names SOPHIA and SOPHIE and makes the assumption that the average consumer will make the mental jump that SOPHIE is the French equivalent of SOPHIA, that DE has a French connotation and will then know that MARTIN is the most common surname in France (for which no evidence is submitted). This is strongly refuted and goes against the practice of trade mark comparison set down in SABEL v PUMA in which it was held that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.”*

31. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.<sup>6</sup> The assessment must be made from the point of view of the average consumer. The average consumer cannot be assumed to know the meaning of everything. In the *Chorkee* case (BL O-048-08), Anna Carboni, sitting as the Appointed Person, stated in relation to the word CHEROKEE:

“36. ...By accepting this as fact, without evidence, the Hearing Officer was effectively taking judicial notice of the position. Judicial notice may be taken of facts that are too notorious to be the subject of serious dispute. But care has to be taken not to assume that one’s own personal experience, knowledge and assumptions are more widespread than they are.

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

32. Similarly in this case, I can ascertain the meanings of the opponent’s mark and the first word in the applicant’s mark fairly easily. However, in the absence of any evidence from the parties to the contrary, I am not able to take judicial notice of the fact that the average consumer for the goods at issue would know that either SOPHIE or SOPHIA means wisdom, or that they are derived from Greek or that SOPHIE is the French equivalent of Sophia.

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<sup>6</sup> This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R. 29.

33. The marks must be assessed from the point of view of the average UK consumer of the goods at issue. I have no doubt that both parties' marks will be seen as names. The opponent's will be seen as a fairly common first name for girls; the applicant's will be seen as a full name which has a surname which is not common in the UK, the overall impression of the mark being that of a European female name. In terms of the overall conceptual position, the only similarity rests in the fact that both marks will be seen as names, albeit different names. We are all used to distinguishing between persons or undertakings on the basis of names and, in particular, surnames. Consequently, I find there to be a fairly low degree of conceptual similarity.

### **Distinctive character of the earlier mark**

34. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been used as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

35. The opponent's mark is the word 'SOPHIE'. I have already concluded that the minimal stylisation is likely to go unnoticed by the average consumer. The mark does not have any meaning in respect of the goods but, in the case of clothing, the average consumer is used to encountering names of, inter alia, designers, retail companies and sponsors. I find the mark to have an average degree of distinctiveness.

### **Likelihood of confusion**

36. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them he has kept in his mind.<sup>7</sup> I must also keep in mind the average consumer for the goods, the nature of the purchasing process and have regard to the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa.

37. I have found the marks to have a moderate degree of visual and aural similarity and have found them to possess a fairly low degree of conceptual similarity. I have found an average inherent distinctive character in the earlier mark and have found the goods to be identical. I have identified the average consumer, namely a member of the general public, and have concluded that the purchase will be primarily visual. The level of attention paid to the purchase will be no more than average, to the extent that the consumer will ensure the correct size, fit, material, colour, and so on.

38. In its evidence, Jandan Aliss, a trade mark attorney acting for the applicant, has made a witness statement. It includes the results of searches conducted on the UK and CTM trade mark registers. Mr Aliss states that he has found "approximately 80

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<sup>7</sup> *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27.

marks in class 25 containing the terms SOPHIE, SOPHIA, SOFIE or SOFIA.” It has long been established that state of the register evidence of this type does not assist the applicant. It does not indicate whether the marks are being used, or give any indication of the goods on which there is use. It is not, therefore, an indicator of whether or not there will be confusion in the market place in relation to the respective trade marks.<sup>8</sup>

39. As I have concluded above, both parties’ marks are names. The applicant’s mark consists of a first and second name, the opponent’s of a first name. Consumers are used to distinguishing between names and using them to identify individuals and particular undertakings. In the context of the goods at issue in this case, it is fairly common practice, in my experience, for the goods to be sold by reference to the name of a person which may or may not be the name of the designer or retailer. Whilst there is a degree of similarity between the opponent’s mark and the first name in the applicant’s mark, they are not the same. The addition of the second name to the applicant’s mark, which is, in my view, fairly unusual in the UK, results in two marks which the average consumer will identify as two different individuals or undertakings.

40. Taking all of these factors into account, the differences between the parties’ respective marks are such that, even where the goods are identical and are frequent, low priced purchases demanding a lower than average level of attention, the marks in their totality are sufficiently different that there is no likelihood of confusion, whether direct (where one mark is mistaken for the other) or indirect (where the average consumer believes the respective goods and services originate from the same or a linked undertaking).

## **Conclusion**

41. The opposition fails.

## **Costs**

42. The opposition having failed, the applicant is entitled to a contribution towards its costs. I have taken into account that no hearing has taken place and the fact that though the applicant filed evidence, this did not assist me in making a decision in this case. I make the award on the following basis:

Preparing a statement and considering the other side’s statement	£200
Preparing and filing evidence	£200
Considering the other side’s submissions	£200
Total:	£600

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<sup>8</sup> see Jacob J in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 and the General Court in *Zero Industry Srl v Office of Harmonisation in the Internal Market (Trade Marks and Designs)(OHIM)*, Case T-400/06 and *GfK AG v Office of Harmonisation in the Internal Market (trade Marks and Designs)(OHIM)*, Case T-135/04

43. I order Fashion Brand International to pay Kirby Footwear Limited the sum of £600. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 26th day of November 2013**

**Ms Al Skilton  
For the Registrar,  
The Comptroller-General**