

O-475-14

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3041408 BY
JOUHAR APPAREL LTD**

TO REGISTER:

Arizona Club

**AS A TRADE MARK
IN CLASS 25**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 600000123 BY
OTTO (GMBH & CO KG)**

BACKGROUND

1. On 8 February 2014, Jouhar Apparel Ltd (“the applicant”) applied to register the trade mark shown on the cover page of this decision. The application was published for opposition purposes on 11 April 2014 for the following goods in class 25:

Clothing, Headgear, Footwear for Men's, Ladies and Children; Clothing, footwear, headgear.

2. The application is opposed by Otto (GmbH & Co KG) (“the opponent”) under the fast track opposition procedure. The opposition, which is directed against all of the goods in the application, is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), for which the opponent relies upon all of the goods in the following Community Trade Mark (“CTM”) registration:

CTM no. 8201915 for the trade mark:



which was applied for on 12 March 2009 and for which the registration process was completed on 22 February 2010:

Class 14 - Jewellery; horological and chronometric instruments.

Class 18 - Leather and imitations of leather, and goods made of these materials and included in class 18; trunks and travelling bags, holdalls, handbags, key cases, rucksacks, wallets, purses; umbrellas.

Class 25 - Clothing, footwear, headgear.

In its Notice of Opposition, the opponent states:

“2. The mark applied for, ARIZONA CLUB, is confusingly similar to the opponent’s earlier trade mark by virtue of the identity of the word ARIZONA. The additional word CLUB does nothing to distinguish the marks. With regard to the opponent’s mark the most prominent and distinctive part of the mark is the word ARIZONA. The stylisation contains non-distinctive elements. Furthermore, the mark applied for covers goods which are identical to those protected under the opponent’s earlier trade mark in class 25. With regard to classes 3 (sic) and 18 those goods are confusingly similar to goods in class 25 of the applicant.”

3. The applicant filed a counterstatement in which the basis of the opposition was denied. It stated:

In response of letter I have receive and with opposition no: OP60000123 , I am bit surprise that opponent is twisting the whole scenario and trying to give a shelter of some legal terms, I have extract some points from opponent correspondence which they have highlighted

1. Brand name similarity opponent point 2

Opponent has breakdown my brand name Arizona Club in two to make their point so it fall under classes 3 and 18 however the main strongest element in my brand is Club like I can give you some examples

Polo Club a famous clothing brand

Beverly hill polo club

And there are many more similar like these,

Further to explain my point what if we omit club from polo that will leave world polo that doesn't really make any sense likewise Beverly hill polo without Club doesn't make any sense likewise predominant element in brand is not polo or beverly hill it is club that complete the brand. Likewise Arizona Club is my brand and it is inspired by the above brands.

Similarly my opponent brand Arizona "wings logo " then established 1973 is one whole component and cannot be break it down and predominant element for this brand is Established 1973 and their log wings. Further as a consumer point of view it has no similarity with Arizona club .

SEE CONTINUATION SHEET

2. Opponent pint 3 confusion in the part of public when they are intend to purchase the goods.

I have been researching over the internet to make purchase of a product under brand name Arizona "wings logo" established 1973 , I found this brand under webpage called www.otto.de if you noticed extension of this web site is DE means it is in Germany and the whole web site is in german language , Arizona "wings logo" established 1973 one of the many they are selling under this web site . Only people who can make purchase from this web site must read german language , I couldn't see their presence in the UK , whereas my web site is

www.arizonaclub.co.uk which we already own and my intention is only to cover UK market. Therefore sirs opponent point 3 is not valid enough as we don't see any confusion at public part due to following reason

1.If public will go to website www.otto.de to buy this brand , they I believe can clearly distinguish between www.otto.de and www.arizonaclub.co.uk we don't see

2.www.otto.de is only in german language and only german resident can buy from there.

3.There is no similarity between www.otto.de and www.arizonaclub.co.uk

4.In the whole one can easily distinguish between (Arizona "wing logo" established 1973) and "Arizonaclub"

5.On opponent website I find predominant part of their brand is their logo "Wings" no word Arizona as word. Back of the garments there were wings , on their garment tops log "wings" that really stand-out on and they are mainly using their logo wings as their selling point that one can easily distinguish. Our requested brand Arizona club cannot create any confusion. However I find their wings logo more close to a famous fashion brand Armani that could create more confusion than Arizonaclub based in England under www.arizonaclub.co.uk

4. Rule 6 of the Trade Marks (Fast Track Opposition)(Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

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

5. The net effect of these changes is to require parties to seek leave in order to file evidence in fast track oppositions. In an official letter dated 12 August 2014, the Tribunal allowed the parties until 26 August 2014 to seek leave to file evidence and/or to request to be heard. A period expiring on 12 September 2014 was allowed for the parties to file written submissions. The opponent filed written submissions on 11 September 2014. On 24 September 2014, the Tribunal wrote to the applicant. The e-mail read as follows:

Please find below the link to the Practice Notice on evidence in fast-track proceedings, as requested:

<http://www.ipo.gov.uk/pro-types/pro-tm/t-law/t-tpn/t-tpn-2013/t-tpn-22013.htm>

Please note that, while you may make a request to file evidence, there is no guarantee that permission will be granted. Any request should be sent to tribunalsection@ipo.gov.uk.

On 24 September 2014, the applicant wrote to the Tribunal; it stated:

Dear Sirs,

I would like to make request to submit further Evidence on Trade Mark No: UK00003041408 , opposition No: OP600000123 Arizona Club.

further to opposition letter from opponent lawyer i believe again words has been twisted to prove the point , therefore shir i would like to submit some picture evidence which proves there are many selling with the name of brand Arizona further opponent products on their website predominant is their log which is wing not the word Arizona.

i request you to please grant me an opportunity to submit further evidence.

kind regards,

kashif.

The Tribunal responded to this request in an official letter dated 26 September 2014, the operative part of which reads:

“Our official letter of 12 August 2014 allowed both parties until **26 August 2014** to request leave to file evidence, therefore your request has been filed out of time.

Also our email to you of 24 September 2014 directed you to the Practice Notice on filing evidence in fast track proceedings, in particular paragraph 7 sets out the criteria required for requesting such leave. As you have not complied with this notice, and the request is late, it is the Registry’s preliminary view that your request to file further evidence is **refused.**”

The applicant was allowed until 10 October 2014 to request a hearing to challenge that decision; no such request was forthcoming. In that letter, the applicant was advised that the deadline to file written submissions had expired.

6. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (1) the Office requests it or (2) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise written arguments will be taken. A hearing was neither requested nor considered necessary. As indicated above, only the opponent filed written submissions, which I will refer to, as necessary, below.

DECISION

7. The opposition is based upon section 5(2)(b) of the Act, which reads as follows:

“5 (2) A trade mark shall not be registered if because -

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

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

8. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6.-(1) In this Act an “earlier trade mark” means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

9. In relation to various comments contained in the applicant’s counterstatement, the opponent states:

“We have considered the other points raised in the counter-statement of the applicant and submit that the points are irrelevant to this matter. The opponent has a Community trade mark registration which is validly registered. It does not matter if the opponent has a .de website nor is it relevant how goods are sold under this website. The comparison must be between the mark applied for and the mark which is registered and which has effect in the UK.”

10. In these proceedings, the opponent is relying upon the trade mark shown in paragraph 2 above, which qualifies as an earlier trade mark under the above provisions. As the opponent's earlier trade mark had not been registered for more than five years when the application for registration was published, it is not subject to proof of use, as per section 6A of the Act. As a consequence, not only is it not necessary for the opponent to have used its trade mark in the United Kingdom, it is also entitled to rely upon all of the goods for which its earlier trade mark is registered.

Section 5(2)(b) – case law

11. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

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

12. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05, the General Court (“GC”) stated:

“29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

Although the opponent’s trade mark also covers goods in classes 14 and 18, it is only the goods in class 25 upon which I need to comment. As the opponent’s trade mark is registered in class 25 for “Clothing, footwear, headgear” and as the specification of the application includes either the identical terms or sub-categories of those terms, the competing goods are, self evidently, identical.

The average consumer and the nature of the purchasing process

13. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods; I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. 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 average consumer of clothing is a member of the general public. As to how such an average consumer selects such goods, 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:

“50. The applicant has not mentioned any particular conditions under which the goods are marketed. 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. As the goods at issue are, in my experience, most likely to be the subject of self selection from traditional retail outlets on the high street, catalogues and websites, I agree that visual considerations are likely to dominate the selection process, but not to the extent that aural considerations can be ignored. The cost of the goods at issue can vary considerably. In *New Look*, the GC also considered the level of attention taken purchasing goods in the clothing sector. It 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.”

16. When selecting the goods at issue, factors such as material, size, colour, cost and compatibility with other items of clothing etc. may all come into play. The average consumer will, in my view, pay a reasonable level of attention when making their selection, a level of attention which is, in my view, likely to increase as the cost and importance of the item increases.

Comparison of trade marks

17. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union (“CJEU”) stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

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

Opponent’s trade mark	Applicant’s trade mark
	Arizona Club

18. The opponent’s trade mark consists of a number of elements. The first is a device of what both parties refer to as “wings”. This appears at the top of the trade mark and is, quite clearly, distinctive. The second element is the word ARIZONA presented in upper case. This word will be well known to the average consumer in the United Kingdom as a name of a state in the United States of America, not least because it is the state in which the popular tourist destination the Grand Canyon can be found. Although ARIZONA will be well known in this country, in the absence of evidence to indicate that it has a reputation for the goods at issue in these proceedings, it is, given its size and positioning in the opponent’s trade mark, in my view, a distinctive element. The third element is the phrase “ESTABLISHED SINCE 1973”. Given the positioning of this phrase combined with the fact that it does no more than indicate to the average consumer that either the trade mark concerned or the undertaking responsible for it (or both) came into being in 1973, it is neither a distinctive nor dominant element of the opponent’s trade mark. The fourth and final element is the border in which the various words and devices are presented. As this would be seen as a mere background, it is neither distinctive nor dominant. Whilst, in my view, the wings device and the word ARIZONA contribute roughly equally to the trade mark’s distinctive character, the overall impression created is, notwithstanding the presence of the device element, likely, in my view, to revolve around the presence in the trade mark of the word ARIZONA.

19. The applicant's trade mark also contains the word Arizona but is accompanied by the word Club (a word so well known it is unnecessary for me to define it here). Although I note the applicant's comments to the effect that the word Club is the most important part of its trade mark, I do not agree. As the applicant points out, the word Club is (not surprisingly) used by a range of undertakings. As a consequence, it is not, in my view, a distinctive or dominant element of the applicant's trade mark. Rather, in my view, the distinctive character of the applicant's trade mark lies not in the individual elements, but in the totality they create. Whilst the overall impression the trade mark creates is imprecise, it could, for example, relate to a club based in Arizona or a group of people with an interest in Arizona, the overall impression it is likely to convey to the average consumer will be of something Arizonian.

20. Considered from a visual perspective, the presence in both trade marks of the word ARIZONA/Arizona inevitably results in a degree of visual similarity between them. However, when one factors in the distinctive device in the opponent's trade mark and the word Club in the applicant's trade mark, the overall degree of visual similarity is, in my view, no more than moderate. Insofar as aural similarity is concerned, it is well established that when a trade mark consists of a combination of words and devices, it is by the word elements that the average consumer is most likely to refer to the trade mark; that is the case here. In my view, the opponent's trade mark will be referred to as ARIZONA (the words ESTABLISHED SINCE 1973 not being articulated) and the applicant's trade mark as Arizona Club. The presence of the word ARIZONA as the only element of the opponent's trade mark and the first element of the applicant's trade mark, results, in my view, in a fairly high degree of aural similarity between the competing trade marks. Finally, in relation to the conceptual comparison, although the applicant's trade mark also includes the word Club, to the extent that both trade marks will convey the overall impression of ARIZONA, there remains, in my view, a fairly high degree of conceptual similarity between them.

Distinctive character of the opponent's earlier trade mark

21. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. 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 registered 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.

22. These are fast track opposition proceedings in which it was not necessary for the opponent to provide evidence of the use it had made of its earlier trade mark, and in which the applicant's request to file evidence was refused. I have, as a consequence, only the inherent characteristics of the opponent's trade mark to consider. I have already concluded that the device element and the word ARIZONA are distinctive elements of the opponent's trade mark, that the words ESTABLISHED SINCE 1973 are descriptive, and that the border against which the device and words

are presented is neither dominant nor distinctive. Considered overall, the opponent's trade mark is, in my view, possessed, of a reasonable degree of inherent distinctive character.

Likelihood of confusion

23. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is 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. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind.

24. I have concluded, inter alia, that the competing goods are identical, that the competing trade marks are visually similar to a moderate degree and aurally and conceptually similar to a fairly high degree and that the opponent's earlier trade mark is possessed of a reasonable degree of inherent distinctive character. Having revisited those findings, I have further concluded that notwithstanding the degree of aural and conceptual similarity between the competing trade marks I have identified, that the visual differences between them is, given the nature of the purchasing act I have identified above, sufficient to avoid direct confusion i.e. where one trade mark is mistaken for the other. That leaves indirect confusion to be considered. In *L.A. Sugar Limited v By Back Beat Inc* (BL-O/375/10), the Appointed Person, Mr Iain Purvis Q.C, commented on the difference between direct and indirect confusion in the following terms:

“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).”

25. Although I have concluded that the competing trade marks will not be confused directly, the presence of the descriptive/non-distinctive word Club in the applicant’s trade mark falls, in my view, into category (b) above i.e. the later trade mark adds a non-distinctive element to the earlier trade mark. The consequence of that conclusion is that, in my view, the average consumer is likely to construe the applicant’s trade mark as a sub-brand or brand extension of the opponent’s trade mark and assume that the goods of the applicant are those of the opponent or some undertaking economically linked to them. The opposition under section 5(2)(b) of the Act succeeds accordingly.

Overall conclusion

26. The opposition based upon section 5(2)(b) of the Act succeeds in full and, subject to any successful appeal, the application will be refused.

Costs

27. The opponent has been successful and is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide, I award costs to the opponent on the following basis:

Preparing a statement and considering the applicant’s statement:	£200
Opposition fee:	£100
Written submissions:	£100
Total:	£400

28. I order Jouhar Apparel Ltd to pay to Otto (GmbH & Co KG) the sum of **£400**. 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 5th day of November 2014

C J BOWEN
For the Registrar
The Comptroller-General