

**O-536-17**

**TRADE MARKS ACT 1994  
IN THE MATTER OF APPLICATION No. 3169651  
BY AIDO INTERNATIONAL LIMITED  
TO REGISTER THE TRADE MARK  
AIDO  
IN CLASSES 3, 9, 14, 16, 25, 26, 35, 38 & 41**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER No. 407987 BY  
ALDO GROUP INTERNATIONAL AG.**

## **BACKGROUND**

1) On 15 June 2016, Aido International Ltd (hereinafter the applicant) applied to register the trade mark "Aido" in respect of the following goods and services:

In Class 3: Perfumery; essential oils; cosmetics; make-up; eye make-up; eyeliners; blushers; lipsticks; hair lotions; soaps.

In Class 9: Computer hardware; computer software; computer peripherals; electronic data processing equipment; computer networking and data communications equipment; computer components and parts; electronic memory devices; electronic control apparatus; programmed-data-carrying electronic circuits; wires for communication; electrodes; telephones; aerials; batteries; micro processors; keyboards; video films.

In Class 14: Precious metals; jewellery; precious stones; chronometric instruments.

In Class 16: Paper; cardboard; printed publications; printed matter; computer printers (Inking ribbons for -); bookbinding materials; books; adhesives for stationery or household purposes; artists' paint brushes; music sheets; music scores; periodical magazines; photographs; stationery and educational supplies; typewriters; Instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printing blocks.

In Class 25: Clothing; footwear; headgear; swimwear; sportswear; leisurewear; clothing for children; infant wear; articles of clothing for women; sleepwear, lingerie; hosiery; nightwear; sports clothing; gymwear; beach clothing; belts [clothing]; underwear; socks; gloves; men's and women's jackets, coats, trousers, vests.

In Class 26: Lace; embroidery; ribbons; braid; buttons; hooks and eyes; pins; needles; artificial flowers.

In Class 35: Advertising, business management and business administration, employment agency services relating to temporary and permanent placement of personnel; conducting skills evaluation for individuals; consultancy relating to personnel management; arranging subscriptions to telecommunications services for others; Presentation of goods on communication media, for retail purposes; Business management and organization consultancy;

Computerised file management; Publication of publicity texts; Rental of advertising space; Dissemination of advertisements.

In Class 38: Telecommunications and broadcast communication services; transmission and streaming of data content via computer and global information networks; operating of electronic communications networks; providing access to databases; providing access to online databases via portals; electronic data interchange; telecommunications services for providing access to computer databases; providing data access to databases for downloading information via electronic media.

In Class 41: Teaching, education, training and entertainment services; Production and distribution of television programs, shows and movies; provision of non-downloadable films and television programs via video-on-demand services; Arranging and conducting of workshops (education), congresses, lessons; Organization of exhibitions for cultural or educational purposes; Publication of electronic books and journals on-line.

2) The application was examined and accepted, and subsequently published for opposition purposes on 2 September 2016 in Trade Marks Journal No.2016/036.

3) On 1 December 2016 Aldo Group International AG., (hereinafter the opponent) filed a notice of opposition. The opponent is the proprietor of the following trade marks:

Mark	Number	Dates of filing & registration	Class	Specification relied upon
ALDO	2239781	19.07.00 29.12.00  Priority date 28.04.00 Priority country Canada	25	Men's women's and children's footwear; shoes, boots, walking boots, hiking boots, loafers, moccasins, sneakers, walking shoes, running shoes, jogging shoes, athletics shoes, sports shoes, sandals, slippers; insoles; men's and woman's clothing; coats, jackets, wind jackets, parkas, blazers, suits, trousers, pants, slacks, sweaters, shirts, vests, jerkins, waistcoats, braces, suspenders, belts, scarves, dresses, skirts, T-shirts, shorts, robes, socks, pantyhose, gloves; men's and

				women's sportswear; sweatshirts, sweat pants, sweat jackets, sweat suits; skiwear; jackets, sweaters, tops, pants, mittens, gloves, scarves, hats and goggles, all being skiwear; men's and women's rainwear; sleepwear; lingerie; men's underclothing; men's and women's leather and suede apparel; headgear; hats.
ALDO	2261001	12.02.01 09.11.01	35	The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods in a retail footwear, clothing and fashion accessories store.
ALDO	EU 9196742	23.06.10 10.02.15	3	Cosmetics, namely, nail polish, lip gloss, mascaras, blush, eyeshadows, perfumery, footwear and garment care products, namely shoe polish, aerosol and non-aerosol cleaners and protectors for leather, suede and fabric.
			14	Fashion accessories, namely jewelry and watches.
			26	Hair ornaments, hair bands, barrettes, ponytail holders

- a) The opponent contends that its mark 2239781 and the mark applied for are very similar and that the goods and services in classes 25 and 35 of the application are similar to its goods in class 25 and so the mark in suit offends against Section 5(2)(b) of the Act.
- b) The opponent contends that its mark 2261001 and the mark applied for are very similar and that the goods and services in classes 3, 14, 25, 26 and 35 of the application are similar to its services in class 35 and so the mark in suit offends against Section 5(2)(b) of the Act.
- c) The opponent contends that its mark 9196742 and the mark applied for are very similar and that the goods and services in classes 3, 14 and 26 of the application are similar to its goods in classes 3, 14 & 26 and so the mark in suit offends against Section 5(2)(b) of the Act.

4) On 6 February 2017 the applicant filed a counterstatement basically denying that the marks and goods and services are similar, and it denies that there is a likelihood of confusion. It puts the opponent to strict proof of use of its marks 2239781 & 2261001.

5) Only the opponent filed evidence. Both parties seek an award of costs in their favour. Neither side wished to be heard. Only the opponent provided further written submissions which I shall refer to as and when necessary in my decision.

## OPPONENT'S EVIDENCE

6) The opponent filed two witness statements. The first, dated 11 May 2017, is by Lucia Hargasova the Senior Director of Brand Development and Media for the Aldo Group Inc. a position she has held since December 2015. The opponent is a wholly owned subsidiary of her company and she is authorised to make the statement on behalf of the opponent and has access to the records of the opponent. She states that the company began as a footwear manufacturer and opened its first store in Canada, before expanding into the USA and other countries, opening its first store in the UK in 2002. It now has 3000 points of sale worldwide, and also offers clothing and fashion accessories such as jewellery, bags and belts. In addition to the ALDO brand the company also sells under other brands but these do not carry any reference to ALDO and so are not included in her statement. Although its mark 2261001 is slightly stylised the difference between this and its other marks is so slight that Ms Hargasova simply refers to use of ALDO as covering all the marks mentioned in paragraph 3 above, an approach I agree with. She states that as of the end of 2016 there were 23 retail stores in the UK operating under the ALDO mark, mostly in the South-East of England but also including the Midlands, The north of England and Northern Ireland. She states that the opponent's shops have consistently sold over the last five years the following products under the ALDO mark:

Women's products	Men's products
<i>Footwear:</i> Shoes, trainers, boots, sandals.	<i>Footwear:</i> Shoes, trainers, plimsolls, boots, sandals.
<i>Shoe care:</i> Shoe insoles, shoe cushions, shoe cleaners, shoe fresheners.	<i>Shoe care:</i> Shoe insoles, shoe cushions, shoe cleaners, shoe fresheners.
<i>Clothing:</i> Hats, caps, scarves, gloves, leggings, socks, belts.	<i>Clothing:</i> Hats, caps, gloves, socks, belts.

<i>Swimwear:</i> Bikinis, swimsuits.	
<i>Outwear:</i> Jackets, shirts.	
<i>Bags:</i> handbags, totes, backpacks, wallets, clutches.	<i>Bags:</i> back packs, lap top bags, duffle bags, wallets.
<i>Jewellery:</i> Chokers, ear rings, bracelets, necklaces, rings, watches.	<i>Jewellery:</i> bracelets, watches.

7) Ms Hargasova states that the mark ALDO appears on the products themselves or on their packaging. Shoes will be marked on the insole and the outer-sole; clothing will have labels sewn in and also hangtags; shoe care products will be marked on the containers. All goods are packaged in branded boxes and/or bags. She provides the following sales figures for the ALDO brand in the UK.

Year	Sales £million
Feb 2011 to end Jan 2012	43.3
Feb 2012 to end Jan 2013	47.6
Feb 2013 to end Jan 2014	50.1
Feb 2014 to end Jan 2015	48.4
Feb 2015 to end Jan 2016	43.7
Feb 2016 to end Jan 2017	39.7

8) Ms Hargasova states that the average breakdown of sales over the years 2013-2016 inclusive is as follows: Ladies footwear 55.6%; men's footwear 23.5%; Accessories 18.1% (including clothing) and shoe care 2.8%. She states that significant amounts are spent each year in the UK on advertising and promotion of the ALDO brand. She also states that the brand has a considerable social media following. She provides the following exhibits:

- LH1: Photographs of UK shop facades dated 2013-2016. These show stores in London, Manchester, Brighton, Essex and Oxford. All the shops have the name ALDO on their fronts and show shoes, bags and glasses being offered for sale.
- LH2: Samples of shoe carriers and bags issued by UK shops over the last five years. These are plain white or white and grey with the word ALDO in large print, the only other thing printed

on the bag is the word “accessories” which, when it appears is in smaller print and is underneath the word ALDO.

- LH3: Pages from the “waybackmachine” website dated 31 March 2007 – 3 November 2016. These all show use of the mark ALDO in respect of hats, scarves, gilets, shoes, bags, sunglasses, jewellery, socks and hosiery for men and women. A number of the pages are blank or poorly printed.
- LH4: Photographs of items such as bags, glasses, scarves and bikinis which all have labels showing the ALDO mark.
- LH5: Samples of invoices and receipts dated between January 2015 and December 2016. These all show the mark ALDO prominently, and show sales of scarves, bags, shoes, jewellery, socks, gloves, hats, boots, insoles, hosiery and trainers.
- LH6: International advertising campaigns that were run in the UK between 2014 and 2015 inclusive. These show women’s and men’s shoes and accessories being advertised.
- LH7: Examples of UK press coverage from 2016. These show shoes for men and women and handbags. The opponent chose not to highlight its products or its name amongst all of the items from various makers featured.

9) The second witness statement, dated 18 May 2017, is by Edmund Stephen Harrison, the opponent’s Trade Mark Attorney. He points out that the differences in the marks are not as pronounced as claimed by the applicant if they are written in lower case where the letter “L” becomes “l” and so ALDO appears as “aldo” and AIDO as “aido”. He also points out that the use of a font such as Arial (as I use in this decision) renders a letter (i) when in capital form as “l”. He also mocks up shop front photographs with the two sides’ marks but I do not find this helpful in my decision.

10) That concludes my summary of the evidence filed, insofar as I consider it necessary.

## **DECISION**

11) The only ground of opposition is under section 5(2)(b) which reads:

“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,

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

12) An “earlier trade mark” is defined in section 6, the relevant part of which states:

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

(a) a registered trade mark, international trade mark (UK) or Community trade mark 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.”

13) The opponent relies upon its trade marks listed in paragraph 3 above which are clearly earlier trade marks. The applicant requested that the opponent provide proof of use and, given the interplay between the date that the opponent’s marks were registered and the date that the applicant’s mark was published (2 September 2016), the proof of use requirement bites only on the opponent’s marks 2239781 and 2261001. Section 6A of the Act states:

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

(1) This section applies where-

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

(b) there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

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

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

(3) The use conditions are met if-

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

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

(4) For these purposes-

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

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

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

(7) Nothing in this section affects –

- (a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4) (relative grounds of refusal on the basis of an earlier right), or
- (b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

14) I must first consider whether the opponent has fulfilled the requirement to show that genuine use of its marks has been made. In the instant case the publication date of the application was 2 September 2016, therefore the relevant period for the proof of use is 3 September 2011 – 2 September 2016. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. summarised the case law on genuine use of trade marks. He said:

“I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, as follows:

- (1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].
- (2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29].
- (3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

15) The opponent has provided a very clear list of the goods sold in its shops in the UK in the last five years under the Aldo mark. It has provided photographs of stores in which the goods can be seen, invoices and receipts for the goods listed, instances of advertising both in print and on the internet which show photographs of these goods under the ALDO mark, it has provided sales turnover figures which, in terms of the industry for clothing, footwear, bags and jewellery, may not be market leading but they are respectable, being as they are, measured in the tens of £millions. I also take into account the fact that these claims by the opponent have not been challenged by the applicant by way of evidence or even submissions. As such I must consider the actual use shown against the opponent's specifications, which it is relying upon in this case and devise a fair specification that reflects such use as set out by Mr Geoffrey Hobbs Q.C. as the Appointed Person in *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, where he summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

16) I first consider the class 25 specification of mark 2239781 which reads: “Men's women's and children's footwear; shoes, boots, walking boots, hiking boots, loafers, moccasins, sneakers, walking shoes, running shoes, jogging shoes, athletics shoes, sports shoes, sandals, slippers; insoles; men's and woman's clothing; coats, jackets, wind jackets, parkas, blazers, suits, trousers, pants, slacks, sweaters, shirts, vests, jerkins, waistcoats, braces, suspenders, belts, scarves, dresses, skirts, T-shirts, shorts, robes, socks, pantyhose, gloves; men's and women's sportswear; sweatshirts, sweat pants, sweat jackets, sweat suits; skiwear; jackets, sweaters, tops, pants, mittens, gloves, scarves, hats and goggles, all being skiwear; men's and women's rainwear; sleepwear; lingerie; men's underclothing; men's and women's leather and suede apparel; headgear; hats”.

17) The use shown on Men's and Women's shoes, boots, trainers and sandals is clear and covers the following from the specification: Men's and women's footwear; shoes, boots, walking boots, hiking boots, loafers, moccasins, sneakers, walking shoes, running shoes, jogging shoes, athletics shoes, sports shoes, sandals, slippers. It does not cover “Children's footwear”.

18) The opponent’s contention to have used its mark on the following women’s goods: “Hats, caps, scarves, gloves, leggings, socks, belts, Bikinis, swimsuits, Jackets and shirts”; and Men’s goods: “Hats, caps, gloves, socks, belts” covers the following in its specification “Men’s mittens, gloves, scarves and hats, all being skiwear; headgear; hats, belts, scarves, socks, gloves”. In its submissions the opponent contended that it had shown use on men’s and women’s clothing in general. This does not, in my mind, equate with either the claims made by the opponent’s witness or the corroborating exhibits. The items of “clothing” listed above are but a small part of what the term “clothing” covers. As such I am reluctant to state that the mark has been used on a catch all term such as “clothing”.

19) I next turn to the class 35 services under mark 2261001; which is registered for “The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods in a retail footwear, clothing and fashion accessories store”. The evidence clearly supports this specification in full.

20) For the purposes of the comparison test I will rely upon the following goods and services:

Mark	Class	Goods
2239781	25	Women's jackets, shirts, sportswear, Bikinis, swimsuits, pantyhose and slacks; Men’s and Women's belts, scarves, socks, gloves; mittens, gloves, scarves and hats, all being skiwear; headgear; hats. Men's and women's footwear; shoes, boots, walking boots, hiking boots, loafers, moccasins, sneakers, walking shoes, running shoes, jogging shoes, athletics shoes, sports shoes, sandals, slippers.
2261001	35	The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods in a retail footwear, clothing and fashion accessories store.
EU 9196742	3	Cosmetics, namely, nail polish, lip gloss, mascaras, blush, eyeshadows, perfumery, footwear and garment care products, namely shoe polish, aerosol and non-aerosol cleaners and protectors for leather, suede and fabric.
	14	Fashion accessories, namely jewelry and watches.
	26	Hair ornaments, hair bands, barrettes, ponytail holders

21) When considering the issue under section 5(2)(b) I take into account the following principles which 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.

(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.

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

22) As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then determine the manner in which these goods and services 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.”

23) Both parties’ specifications cover a range of goods and services. The opposition is restricted to the opponent’s goods in classes 3, 14, 25 and 26 and its class 35 services. The goods concerned will be sold in, inter alia, traditional retail outlets on the high street, through catalogues and on the Internet. The average consumer of the goods at issue is a member of the general public. Such consumers are likely, in my opinion, to select the goods mainly by visual means, although I accept that they may seek advice from shop assistants or carry out research via friends and family or on the internet. The goods are, broadly, clothing, footwear, headwear and accessories such as jewellery. I take into account the comments of the General Court (GC) in *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03, where the GC stated that:

“49. However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (*BUDMEN*, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumer choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs.”

And

“50..... 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.”

24) For both the goods and services, the average consumer's level of attention will vary considerably depending on the cost and nature of the item /service at issue. However, to my mind, even when selecting routine inexpensive goods such as socks **the average consumer will pay at least an average degree of attention to precisely what good or service they are getting.**

### **Comparison of goods and services**

25) In the judgment of the Court of Justice of the European Union (CJEU) 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”.

26) In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the 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 fur 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”.

27) I also take into account the comments of Jacob J. in *Avnet Incorporated v. Isoact Ltd* [1998] FSR 16 where he said:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

28) I note that in its written submissions the opponent confirms that it has reduced its opposition against the class 35 services sought to be registered from the whole of the specification applied for to “Presentation of goods on commercial media for retail purposes”.

29) The goods and services to be compared are as follows:

Applicant’s specification	Opponent’s specification
3: Perfumery; essential oils; cosmetics; make-up; eye make-up; eyeliners; blushers; lipsticks; hair lotions; soaps.	3: Cosmetics, namely, nail polish, lip gloss, mascaras, blush, eyeshadows, perfumery, footwear and garment care products, namely shoe polish, aerosol and non-aerosol cleaners and protectors for leather, suede and fabric.
14: Precious metals; jewellery; precious stones; chronometric instruments.	14: Fashion accessories, namely jewelry and watches.
25: Clothing; footwear; headgear; swimwear; sportswear; leisurewear; clothing for children; infant wear; articles of clothing for women; sleepwear, lingerie; hosiery; nightwear; sports clothing; gymwear; beach clothing; belts [clothing]; underwear; socks; gloves; men's and women's jackets, coats, trousers, vests.	25: Women's jackets, shirts, sportswear, Bikinis, swimsuits, pantyhose and slacks; Men’s and Women's belts, scarves, socks, gloves; mittens, gloves, scarves and hats, all being skiwear; headgear; hats. Men's and women's footwear; shoes, boots, walking boots, hiking boots, loafers, moccasins, sneakers, walking shoes, running shoes, jogging shoes, athletics shoes, sports shoes, sandals, slippers.
26: In Class 26: Lace; embroidery; ribbons; braid; buttons; hooks and eyes; pins; needles; artificial flowers.	26: Hair ornaments, hair bands, barrettes, ponytail holders
35: Presentation of goods on commercial media for retail purposes.	35: The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods in a retail footwear, clothing and fashion accessories store.

30) I first turn to consider the goods in class 3. The applicant contends that:

“However, simply because common language is used in the list of goods and services specified does not suffice in and of itself to indicate that the goods and services provided to the public are identical”. To back up this contention it refers me to the ECJ case T336/03 MOBELIX v OBELIX).”

31) I disagree with the contention. I do not accept that the case relied upon by the applicant actually came to the view that it expresses above. Clearly, both specifications contain the words “Perfumery” and “cosmetics” and these must therefore be regarded as identical. To my mind, the term “cosmetics” in the opponent’s specification, although qualified by the term “namely” is highly similar to the terms “make-up; eye make-up; eyeliners; blushers; lipsticks” in the applicant’s specification. The term “cosmetic” applies to products which are designed to beautify the body, although “hair lotions”, “essential oils” and “soap” can be used simply for cleansing, they do also frequently have a beautifying effect or at least are claimed to have this result. These products must therefore be regarded as at least similar to the opponent’s “cosmetics”.

32) Moving onto the goods in class 14, the applicant’s specification of “jewellery; chronometric instruments” are clearly identical to the terms “Jewelry; watches” in the opponent’s specification. Jewellery is often made from precious metals and frequently includes precious stones e.g. the average engagement ring. I also note that retailers of jewellery commonly also deal in precious metals such as buying and selling bullion. To my mind, “precious metals” is at least similar to the opponent’s goods in class 14.

33) I next turn to the goods in class 25. The following are clearly identical and need no explanation:

Applicant’s goods	Opponent’s goods
Footwear.	Men's and women's footwear; shoes, boots, walking boots, hiking boots, loafers, moccasins, sneakers, walking shoes, running shoes, jogging shoes, athletics shoes, sports shoes, sandals, slippers.
Headgear.	Hats.
Swimwear; beach clothing.	Bikinis, swimsuits, sportswear.
Sportswear; sports clothing; gymwear.	Sportswear.

Leisurewear.	Sportswear, Women's jackets, shirts, slacks.
Articles of clothing for women.	Women's jackets, shirts, slacks.
Gloves.	Gloves.
Hosiery; socks.	Socks, pantyhose.
Women's jackets.	Women's jackets.
Clothing.	Women's jackets, shirts, slacks.
Belts [clothing].	Men's and Women's belts.

34) This leaves “clothing for children; infant wear; sleepwear, lingerie; nightwear; underwear; men's jackets, coats, trousers, vests” from the applicant’s specification. These items must be considered as being similar to a medium degree to the following items in the opponent’s specification: “Women's jackets, shirts, slacks, socks, pantyhose, gloves, sportswear and hats”.

35) Turning to the goods in class 26, the applicant contends merely that “the specifications are also notably different”. Whilst the opponent states:

“In Class 26, the opponent claims identity between the various products (*“lace; embroidery; ribbons braid; artificial flowers”*) covered by the later mark and the products of the earlier mark (for example *“hair ornaments”* and *“hair braids”*). This is on the basis that the products of the later mark may well be hair ornaments or hair bands, and be sold as such. The word “braid” has numerous meanings, but includes plaited hair tresses, which falls within “hair ornaments”. The opponent also claims similarity with “buttons; hooks and eyes; pins; needles” of the later trade mark, since these are all products which can be used to control, decorate and present air attractively. They are therefore similar to the hair ornaments and hair bands.”

36) I agree with the above contentions and find that the following terms in the applicant’s specification are identical to the opponent’s goods “Lace; embroidery; ribbons; braid; artificial flowers”. Whilst the following terms in the applicant’s specification are similar to a medium degree to the opponent’s goods “buttons; hooks and eyes; pins; needles”.

37) Turning to the services in class 35, the applicant comments: “Merely because the earlier mark is protected for a far reaching specification of services cannot imply per se that any other trademark

seeking protection for a specification of services in the same class should be denied by the Office.” It contends that the specifications of the two parties in class 35 are different, although this comment was made prior to the refining of the opposition. The applicant’s specification refers to using commercial media to retail goods, effectively using the internet, whilst the opponent’s specification refers to selling goods in a store. The opponent’s specification does not restrict it to physical retail outlets but would include on-line stores. Therefore, the specifications of both parties are at least similar if not highly similar.

**Comparison of trade marks**

38) 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 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.”

39) 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. The trade marks to be compared are:

Opponent’s trade mark	Applicant’s trade mark
<b>ALDO</b>	<b>Aido</b>

40) The applicant contends that visually the marks are dissimilar as the second letter is different “L” and “i”, and noting that the marks are both very short. It contends that phonetically the marks are

different despite both being two syllable marks. It states that the mark in suit will be pronounced “Ai-Do” whilst the opponent’s mark will be pronounced “Al-Do”. It states that both marks are conceptually neutral having no meaning in the UK. For its part the opponent contends that the marks are visually similar as the letter “i” when used in its capital form “I” looks highly similar if not identical to a lower case letter “i”. They contend that the similarities visually and aurally far outweigh any differences. The opponent also contends that the two marks are conceptually similar as they are both male names, but I note that no evidence has been put forward to support this view.

41) I do not agree fully with either party. To my mind the marks are clearly visually similar sharing as they do three out of four letters with only the second letter being different, but they are short marks and in such circumstances differences are often seen. There is some similarity between the letters even when the font does not make them look identical.

42) Aurally, I think the average consumer will probably pronounce the applicant’s mark AY-DO or AID-O, whereas the opponent’s mark will be AL-DO or ALD-O. In either case they have aural similarities. I agree with the applicant that the marks are conceptually neutral, as I am not aware of the terms being used as names in the UK and no evidence has been provided to show that the average consumer in the UK is aware that these words could be names. Overall I believe that the similarities outweigh the differences such that **the marks must be regarded as similar to a medium degree at least.**

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

43) 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).”

44) The opponent’s mark has no meaning for the goods and services for which it is sought to be registered. As I have said I do not accept that it will be recognised as a name. To my mind, the average consumer will consider the opponent’s mark to be an invented word and so it is **inherently distinctive to at least a medium degree**. The opponent has shown a respectable use of its mark, and **so would benefit from enhanced distinctiveness**.

#### **Likelihood of confusion**

45) 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 services 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 the trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods and services, 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. Earlier in this decision, I concluded that:

- the average consumer for the goods and services is a member of the general public who will select the goods and services by predominantly visual means, although I do not discount aural considerations and that they are likely to pay an average degree of attention to the selection of said goods and services.
- the marks of the two parties are similar to a medium degree.

- the opponent's mark has a medium level of inherent distinctiveness but also benefits from an enhanced distinctiveness through use.
- the goods and services of the two parties fall into a number of categories. The applicant's following goods and services are identical to those of the opponent:

Class	Goods or services
3	Perfumery; cosmetics.
14	Jewellery; precious stones; chronometric instruments.
25	Footwear; headgear; swimwear; beach clothing; sportswear; sports clothing; gymwear; leisurewear; articles of clothing for women; gloves; hosiery; socks; women's jackets; clothing; belts [clothing].
26	Lace; embroidery; ribbons; braid; artificial flowers.

- the following goods are highly similar to those of the opponent:

Class	Goods
3	Make-up; eye make-up; eyeliners; blushers; lipsticks;

- the following goods and services are similar to a medium degree to those of the opponent:

Class	Goods and services
3	Essential oils; hair lotions; soaps.
14	Precious metals.
25	Clothing for children; infant wear; sleepwear, lingerie; nightwear; underwear; men's jackets, coats, trousers, vests.
26	Buttons; hooks and eyes; pins; needles.
35	Presentation of goods on commercial media for retail purposes.

46) In view of all of the above, and allowing for the concept of imperfect recollection there is a likelihood of consumers being confused into believing that the goods and services listed above as being identical, highly similar or similar to a medium degree and provided by the applicant are those

of the opponent or provided by an undertaking linked to it. **The opposition under Section 5(2) (b) therefore succeeds in respect of those goods and services.**

47) However, I also note that a number of goods and services were not opposed.

## CONCLUSION

48) The opposition succeeds in respect of the following goods and services:

Class	Goods or services
3	Perfumery; essential oils; cosmetics; make-up; eye make-up; eyeliners; blushers; lipsticks; hair lotions; soaps.
14	Precious metals; jewellery; precious stones; chronometric instruments.
25	Clothing; footwear; headgear; swimwear; sportswear; leisurewear; clothing for children; infant wear; articles of clothing for women; sleepwear, lingerie; hosiery; nightwear; sports clothing; gymwear; beach clothing; belts [clothing]; underwear; socks; gloves; men's and women's jackets, coats, trousers, vests.
26	Lace; embroidery; ribbons; braid; buttons; hooks and eyes; pins; needles; artificial flowers.
35	Presentation of goods on communication media, for retail purposes;

49) The opposition did cover the following goods and services:

Class	Goods and services
9	Computer hardware; computer software; computer peripherals; electronic data processing equipment; computer networking and data communications equipment; computer components and parts; electronic memory devices; electronic control apparatus; programmed-data-carrying electronic circuits; wires for communication; electrodes; telephones; aerials; batteries; micro processors; keyboards; video films.
16	Paper; cardboard; printed publications; printed matter; computer printers (Inking ribbons for -); bookbinding materials; books; adhesives for stationery or household purposes; artists' paint brushes; music sheets; music scores; periodical magazines; photographs; stationery and educational supplies; typewriters; Instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printing blocks.

35	Advertising, business management and business administration, employment agency services relating to temporary and permanent placement of personnel; conducting skills evaluation for individuals; consultancy relating to personnel management; arranging subscriptions to telecommunications services for others; Business management and organization consultancy; Computerised file management; Publication of publicity texts; Rental of advertising space; Dissemination of advertisements.
38	Telecommunications and broadcast communication services; transmission and streaming of data content via computer and global information networks; operating of electronic communications networks; providing access to databases; providing access to online databases via portals; electronic data interchange; telecommunications services for providing access to computer databases; providing data access to databases for downloading information via electronic media.
41	Teaching, education, training and entertainment services; Production and distribution of television programs, shows and movies; provision of non-downloadable films and television programs via video-on-demand services; Arranging and conducting of workshops (education), congresses, lessons; Organization of exhibitions for cultural or educational purposes; Publication of electronic books and journals on-line.

## **COSTS**

50) As the opponent has been successful it is entitled to a contribution towards its costs.

Preparing a statement and considering the other side's statement	£300
Expenses	£100
Provision of evidence	£800
Written submissions	£300
<b>TOTAL</b>	<b>£1,500</b>

51) I order Aido International Limited to pay Aldo Group International AG. the sum of £1,500. This sum to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 24<sup>th</sup> day of October 2017**

**George W Salthouse**  
**For the Registrar,**  
**the Comptroller-General**