TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3038931 BY LONDON REBEL LIMITED

TO REGISTER:

RULE LONDON

AS A TRADE MARK IN CLASS 25

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NO. 600000129 BY LUIGI LA MURA & ROYCE GOODWIN

BACKGROUND

1. On 22 January 2014, London Rebel Limited ("the applicant") applied to register the trade mark shown on the cover page of this decision. The application was published for opposition purposes on 2 May 2014 for the following goods in class 25:

> Clothing, footwear, headgear; Ankle boots; ankle socks; anoraks [parkas]; aprons [clothing]; articles of clothing, footwear and headgear for babies and toddlers; ascots; athletic footwear; athletic uniforms; babies' bibs, not of paper; babies' bibs of plastic; babies' pants [clothing]; babies' shoes; baby bodysuits; baby booties; baby bottoms; baby bunting [clothing]; baby tops; balaclavas; ballet flats [flat shoes]; ballet slippers [dance shoes]; ball gowns; ballroom dancing shoes; bandanas [neckerchiefs]; baseball caps; baseball shoes; baseball uniforms; bathing caps; bathing suits; bath robes; bath slippers; beach clothes; beach shoes; belts [clothing]; berets; bib overalls; bibs, not of cloth or paper; bicycle gloves; bikinis; blazers; bloomers; blouses; boas [necklets]; bodices [lingerie]; body warmers; boleros; bomber jackets; bonnets; boots; boots and shoes; bowling shoes; boxer briefs; boxer shorts; bow ties; brassieres; breeches for wear; caftans; camisoles; canvas shoes; cap peaks; capri pants; caps [headwear]; cardigans; cargo pants; cashmere clothing; cashmere jackets; cashmere sweaters; casual footwear; casual wear; children's headgear; children's shoes; children's socks; children's underwear; climbing boots; climbing footwear; cloth bibs; clothing for sports; clothing, not being protective clothing, incorporating reflective or fluorescent elements or material; clothing of leather; clothing of leather or imitations of leather; coats; collars [clothing]; cyclists' clothing; denim clothing; detachable collars; dresses; dressing gowns; dress shields; ear muffs [clothing]; fishing vests; fittings of metal for footwear; fur clothing; fur hats; gabardines [clothing]; gaiters; galoshes; garters; girdles; gloves [clothing]; golf clothing, other than gloves; gymnastic shoes; half-boots; hat frames [skeletons]; hats; headbands [clothing]; headgear for wear; heelpieces for footwear; heelpieces for stockings; heels; hoods [clothing]; hosiery; jackets [clothing]; jeans; jerseys [clothing]; jodhpurs; jumper dresses; jumpsuits [clothing]; khakis [clothing]; kimonos; knitwear [clothing]; lace boots; layettes [clothing]; leather belts [clothing]; leather coats; leather headgear; leather jackets; leather shoes; leather slippers; leather suits; leather trousers; leggings [leg warmers]; leggings [trousers]; light-reflecting coats; light-reflecting jackets; linen clothing; lingerie; liveries; loungewear; maniples; mantillas; masquerade costumes; maternity clothing; miters [hats]; mittens; moccasins; money belts [clothing]; motorcyclists' clothing; motorists' clothing; muffs [clothing]; neckties; nightgowns; nightwear; non-slipping devices for footwear; one-piece playsuits; one-piece coveralls; outdoor clothing; overalls; overcoats; paper clothing; paper hats [clothing]; parkas; pelerines; pelisses; petticoats; playsuits; pockets for clothing; ponchos; raincoats; ready-made clothing; ready-made linings [parts of clothing]; rubbers [footwear]; running shoes; rugby shirts; sandals; saris; sarongs; sashes for wear; scarfs; school uniforms; shawls; shirts; shoes; short-sleeve shirts; shower caps; silk clothing; ski boots; ski gloves; skirts; sleep masks; slippers; slips [undergarments]; socks; soles for footwear; sports jerseys; sports shoes; stockings; stocking suspenders; studs for football boots; stuff jackets [clothing]; suits; sweat-absorbent stockings;

sweat-absorbent underwear; sweaters; tee-shirts; thermal clothing; tights; togas; top hats; tracksuits; training shoes; trousers; trouser straps; tunics; turbans; underpants; underwear; uniforms; veils [clothing]; vests; visors [headwear]; waterproof clothing; water-resistant clothing; welts for footwear; wet suits for water-skiing; wimples; windproof clothing; wind-resistant jackets; woollen clothing.

2. The application is opposed by Luigi La Mura & Royce Goodwin ("the opponents") 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"). Although the opponents rely upon all of the goods in the trade mark registrations shown below, I have, given the goods for which the applicant seeks registration, only reproduced below the opponents' goods in class 25.

UK no. 3016213 for the trade mark: **LONDON PRIZE RING RULES**; applied for on 31 July 2013 and for which the registration procedure was completed on 1 November 2013:

Clothing, footwear, headgear; aprons [clothing]; ascots; babies' pants [clothing]; bandanas [neckerchiefs]; bath robes; bath sandals; bath slippers; bathing caps; bathing trunks; beach clothes; beach shoes; belts [clothing]; berets; bibs, not of paper; boas [necklets]; bodices [lingerie]; boot uppers; boots; boots for sports; brassieres; breeches for wear; camisoles; cap peaks; caps [headwear]; chasubles; clothing; clothing for gymnastics; clothing of imitations of leather; clothing of leather; coats; collar protectors; combinations [clothing]; corselets; corsets [underclothing]; cuffs; cyclists' clothing; detachable collars; dress shields; dresses; dressing gowns; ear muffs [clothing]; esparto shoes or sandals; fishing vests; fittings of metal for footwear; football boots; footmuffs, not electrically heated; footwear; footwear uppers; fur stoles; furs [clothing]; gabardines [clothing]; gaiter straps; galoshes; garters; girdles; gloves [clothing]; gymnastic shoes; half-boots; hat frames [skeletons]; hats; headbands [clothing]; headgear for wear; heelpieces for footwear; heelpieces for stockings; heels; hoods [clothing]; hosiery; inner soles; jackets [clothing]; jerseys [clothing]; jumper dresses; knitwear [clothing]; lace boots; layettes [clothing]; leg warmers; leggings [trousers]; liveries; maniples; mantillas; masquerade costumes; miters [hats]; mittens; money belts [clothing]; motorists' clothing; muffs [clothing]; neckties; non-slipping devices for footwear; outerclothing; pants; paper clothing; paper hats [clothing]; parkas; pelerines; pelisses; petticoats; pocket squares; pockets for clothing; polo shirt; ponchos; pullovers; pyjamas; ready-made clothing; ready-made linings [parts of clothing]; sandals; saris; sarongs; sashes for wear; scarfs; shawls; shirt fronts; shirt yokes; shirts; shoes; short-sleeve shirts; shoulder wraps; shower caps; singlets; ski boots; ski gloves; skirts; skorts; skull caps; sleep masks; slippers; slips [undergarments]; smocks; sock suspenders; socks; soles for footwear; spats; sports shoes; stocking suspenders; stockings; stockings (sweat-absorbent -); studs for football boots; stuff jackets [clothing]; suits; suspenders; sweaters; sweatshirt; swimsuits; teddies [undergarments]; tee-shirts; tights; tips for footwear; togas; top hats; topcoats; track suit; trousers; turbans; underpants; underwear; underwear

(anti-sweat -); uniforms; veils [clothing]; vests; waterproof clothing; welts for footwear; wet suits for water-skiing; wimples; wooden shoes.

UK no. 3036585 for the trade mark: **LONDON RULES**; applied for on 3 January 2014 and for which the registration procedure was completed on 18 April 2014:

> Footwear, aprons [clothing]; ascots; babies' pants [clothing]; bath robes; bath sandals; bath slippers; bathing caps; bathing trunks; beach clothes; beach shoes; belts [clothing]; berets; bibs, not of paper; boas [necklets]; bodices [lingerie]; boot uppers; boots; boots for sports; brassieres; breeches for wear; camisoles; chasubles; clothing for gymnastics; coats; collar protectors; corselets; corsets [underclothing]; cuffs; cyclists' clothing; detachable collars; dress shields; dresses; dressing gowns; ear muffs [clothing]; esparto shoes or sandals; fishing vests; fittings of metal for footwear; football boots; footmuffs, not electrically heated; footwear; footwear uppers; fur stoles; furs [clothing]; gabardines [clothing]; gaiter straps; galoshes; garters; girdles; gloves [clothing]; gymnastic shoes; half-boots; hat frames [skeletons]; heelpieces for footwear; heelpieces for stockings; heels; hoods [clothing]; hosiery; inner soles; jackets [clothing]; jerseys [clothing]; jumper dresses; knitwear [clothing]; lace boots; layettes [clothing]; leg warmers; leggings [trousers]; liveries; maniples; mantillas; masquerade costumes; miters [hats]; mittens; money belts [clothing]; muffs [clothing]; neckties; non-slipping devices for footwear; pants; parkas; pelerines; pelisses; petticoats; pocket squares; pockets for clothing; ponchos; pullovers; pyjamas; ready-made linings [parts of clothing]; sandals; saris; sarongs; sashes for wear; scarfs; shawls; shirt yokes; shoes; shoulder wraps; shower caps; singlets; ski boots; ski gloves; skirts; skorts; skull caps; sleep masks; slippers; slips [undergarments]; smocks; sock suspenders; socks; soles for footwear; spats; sports shoes; stocking suspenders; stockings; stockings (sweat-absorbent -); studs for football boots; stuff jackets [clothing]; suits; suspenders; swimsuits; teddies [undergarments]; tights; tips for footwear; togas; top hats; topcoats; trousers; turbans; underpants; underwear; underwear (anti-sweat -); veils [clothing]; vests; waterproof clothing; welts for footwear; wet suits for water-skiing; wimples; wooden shoes

In relation to their first trade mark, the opponents state:

> “The applicant’s mark consists of the two words RULE LONDON. In our opinion the mark is clearly closely related to our earlier mark LONDON PRIZE RING RULES with the words LONDON and RULES being visually identical...even though presented in a different order...In addition, the applicant’s mark covers identical or similar goods to our mark.”

In relation to their second trade mark, the opponents state:

> “The applicant’s mark consists of the two words RULE LONDON. In our opinion the mark is clearly closely related in that it is both visually and phonetically similar to our earlier mark LONDON RULES with the words LONDON and RULE being presented in a different order but without the letter

S included in RULES...In addition, the applicant's mark covers identical or similar goods to our mark."

3. The applicant filed a counterstatement in which the basis of the opposition was denied. The applicant does, however, admit that:

> "the class 25 specification of the applicant's mark contains identical and similar terms to the class 25 specification of [the trade marks relied upon by the opponents]."

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. No leave was sought in respect of these proceedings.

6. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) 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; both parties 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."

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."

8. In these proceedings, the opponents are relying upon the two trade marks shown in paragraph 2 above, both of which qualify as earlier trade marks under the above provisions. As the opponents' earlier trade marks had not been registered for more than five years when the application for registration was published, they are not subject to proof of use, as per section 6A of the Act. As a consequence, the opponents are entitled to rely upon all of the goods for which their earlier trade marks are registered (although only the class 25 elements of the registrations are relevant for the purposes of these proceedings).

Section 5(2)(b) – case law

9. 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

10. 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)."

11. In its counterstatement, the applicant admits that its specification contains goods which are "identical and similar" to goods contained in the opponents' earlier trade marks. The applicant's specification begins with the words "Clothing, footwear, headgear" and then lists a range of goods which would be encompassed by one or more of these three broad terms. As the specification of the opponents' earlier trade mark no. 3016213 also begins with the words "Clothing, footwear, headgear" the competing specifications are clearly identical. Although the specification of the opponents' other earlier trade mark no. 3036585 is not expressed in the same terms, it does include a reference to "footwear" which is identical to the same term in the applicant's specification. In addition, as this trade mark also lists a wide range of goods that would be encompassed by the terms "clothing" and "headgear" in the

applicant's specification, the goods in earlier trade mark no. 3036585 must also be regarded as identical to the applicant's goods on the principles outlined in *Meric*.

The average consumer and the nature of the purchasing process

12. 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."

13. In its submission, the applicant states:

> "It is submitted that the nature of the goods for the respective marks are intended for all consumers – they are mass consumption goods which are not aimed at any particular cross section of society, but can be purchased by any and all consumers."

14. I agree with the applicant's submission; 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, in my experience, are 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 when 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 experience, 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."

18. It would be wrong, therefore, artificially to 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:

Opponents' trade marks	**Applicant's trade mark**
LONDON PRIZE RING RULES LONDON RULES	RULE LONDON

19. Although the opponents rely upon the two earlier trade marks shown above, the presence in the first trade mark of the additional words PRIZE and RING, inevitably

means that this trade mark is (at least) visually and aurally less similar to the applicant's trade mark than the second of the opponents' trade marks which does not include these words. If the opponent does not succeed in relation to its second earlier trade mark, it will not, in my view, succeed in relation to the first. As a consequence, I shall only compare the opponents' LONDON RULES trade mark with that of the applicant.

20. The opponents' trade mark consists of the two words LONDON and RULES presented as separate words in upper case; both words will be well known to the average consumer. As, in my view, these words "hang together", both will make a roughly equal contribution to the overall impression the integrated whole conveys. The applicant's trade mark also consists of two words presented as separate words in upper case. Although the word RULE appears as the first element in the applicant's trade mark, as, in my view, the words in its trade mark also "hang together", similar considerations to those mentioned above (in relation to the opponents' trade mark) also apply to the applicant's trade mark.

21. In relation to their LONDON RULES trade mark, the opponents submit:

> "5. Visually the marks are similar. Even though arranged opposite to each other it is very likely that at a glance or quick glance from an average consumer or a consumer in a hurry, the likelihood of confusion is very high. In effect the marks are just reversed with similar/common identical words. If together or side by side the similarity is even more so. The average consumer would have a general recollection of the trade mark not a precise one therefore the chances of confusion is very high.
>
> 6. [For the reasons stated above] phonetically the marks sound similar.
>
> 7. Conceptually the marks are very similar.
>
> (a) It is disputed that a relevant average consumer or even a consumer with boxing knowledge would associate London Rules, on its own, having anything to do with boxing. There is no example whatsoever in any context to include internet search and within the professional boxing circuit where The London Prize Ring Rules is otherwise known as solely London Rules. London Rules is its own brand and can be perceived in many different ways.
>
> (b)…London Rules as an example could be perceived as a suggestion that if in London you should consider wearing this fashion brand…"

In relation to the conceptual message conveyed by the applicant's trade mark, the opponents submit:

> "(a) It is disputed that the order of words would relate to a brand being a brand or not…Also it would be sensible to think that if the word London was in any brand you would associate that it was something to do with London no matter which order it appears i.e. New York Yankees (something to do with New York), L'Oreal Paris (something to do with Paris)…or similar.

(b) The applicant's RULE LONDON can be taken into the same context as Rule Britannia which certainly is not a brand but a statement that "Britannia is the greatest"…"nothing beats Britannia"…or similar…"

22. In its submissions, the applicant states:

"The visual and phonetic dissimilarities between [the competing trade marks] arise due to the words of each being reversed…

...In general it is accepted that the consumer attaches greater importance to the first part of a word…which means that the similarity or difference between the first part of the words is an important factor for assessment.

In respect of word marks which are relatively short, the central elements are as important as the beginning and end of the sign…

The signs at issue have very different beginnings, mid sections, and endings. The average consumer of the goods will easily recognise this."

In relation to the conceptual comparison, the applicant states:

"LONDON RULES would be understood by the average consumer of the goods at issue to be a clear statement…a value statement to London – a place which is associated with being a place of wealth, prosperity, a good place to live, a place where our sovereign "rules." This is a very obvious and natural meaning of the words, even for those individuals who may also understand the sign to convey some information as to the boxing rules which are known as the LONDON PRIZE RING RULES.

The average consumer of the products in question will be used to seeing these sorts of brands, and will understand that they are brands, but that they are also forms of statements.

RULE LONDON does not create an immediate concept in the mind of the average consumer in question. Further it is submitted that it is in any case different in any concept it does create on further consideration by the average consumer. Two trade marks are deemed different if they have distinct meanings…the signs at issue have very different and distinct conceptual meanings…"

23. Although in its submissions the applicant states that its trade mark "does not create an immediate concept in the mind of the average consumer", in its counterstatement, it suggested that its trade mark "would be perceived more as brand, with RULE being the label and its origins being in London" or "as a statement as to control, governance or dominion in respect of or over London."

24. The fact that both trade marks contain the same word i.e. LONDON and highly similar words RULES/RULE, and notwithstanding that the competing trade marks contain the words in differing positions, there is, in my view, at least a reasonable degree of visual and aural similarity between them. Insofar as the conceptual

position is concerned, I agree with the opponents that the average consumer is unlikely to interpret their trade mark as a reference to boxing. More likely, as the applicant submits, is that the words will be understood, as the applicant puts it, as a "value statement" about the positive attributes of London. In its counterstatement, the applicant suggests how its trade mark will be interpreted i.e. as a brand and geographical location or "as a statement as to control, governance or dominion in respect of or over London." As I have already concluded that the words create an integrated whole, it is the second of these options which appears to me to be the most likely. To the extent that the opponent's trade mark refers to London being the ruler and the applicant's trade mark to London being ruled, the competing trade marks are, in my view, conceptually similar to a fairly high degree.

Distinctive character of the opponents' LONDON RULES trade mark

25. 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.

26. These are fast track opposition proceedings in which it was not necessary for the opponents to provide evidence of the use they have made of their earlier trade mark; as a consequence, I have only the inherent characteristics of the opponents' LONDON RULES trade mark to consider. Although it consists of two well known words, as the integrated whole it creates is, as far as I am aware, neither descriptive of nor non-distinctive for goods in class 25, the opponents' earlier trade mark is, in my view, possessed of a normal degree of inherent distinctive character.

Likelihood of confusion

27. 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 opponents' 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.

28. Earlier in this decision, I concluded that:

- the competing goods are identical;
- the average consumer is a member of the general public who will select the goods by predominantly visual means and who will pay at least a reasonable degree of attention when doing so;
- the overall impression created by both parties' trade marks stems from the integrated wholes they create;
- there is at least a reasonable degree of visual and aural similarity and a fairly high degree of conceptual similarity between the competing trade marks;
- the opponents' LONDON RULES trade mark is possessed of a normal degree of inherent distinctive character.

29. In my view, the degree of visual, aural and conceptual similarity between the competing trade marks is likely, irrespective of the degree of care paid to the selection process, to lead the average consumer imperfectly to recall the competing trade marks which will, in turn, lead to a likelihood of direct confusion i.e. where one trade mark is mistaken for the other. In reaching the above conclusion, I have not overlooked either the various precedents referred to by the applicant or the examples which, in the applicant's view, demonstrates that:

> "the average consumer of the goods at issue are used to seeing brands **side by side** in retail settings, and are able to quickly distinguishing (sic) brands which may share common features." (my emphasis).

30. These submissions do not assist the applicant. Firstly, it is well established that each case must be judged on its own merits. Secondly, the average consumer rarely has the luxury of comparing trade marks side by side and must instead, as indicated above, rely upon the imperfect picture he has retained of them in his mind.

Overall conclusion

31. **The opposition based upon section 5(2)(b) of the Act in respect of the opponents' LONDON RULES trade mark succeeds in full and, subject to any successful appeal, the application will be refused.**

Costs

32. The opponents have been successful and are entitled to a contribution towards their costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide, but bearing in mind that they have not been professionally represented in these proceedings, I award costs to the opponents on the following basis:

Preparing a statement and considering the applicant's statement:	£100

Opposition fee:	£100
Written submissions:	£100
Total:	**£300**

33. I order London Rebel Limited to pay to Luigi La Mura and Royce Goodwin (jointly) the sum of **£300**. 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 19th day of December 2014

C J BOWEN
For the Registrar
The Comptroller-General