

O-583-17

TRADE MARKS ACT 1994

IN THE MATTER OF:

TRADE MARK APPLICATION 3160737

BY WEST 9 LONDON LIMITED

TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 25:

WEST 9
LONDON

&

OPPOSITION THERETO (No 407319) BY NINE WEST DEVELOPMENT LIMITED

Background and pleadings

1. The trade mark on the cover page of this decision was filed by West 9 London Limited (“the applicant”) on 21 April 2016 and it was published for opposition purposes on 3 June 2016. Registration is sought for “clothing” in class 25.
2. Registration of the mark is opposed by Nine West Development Limited (“the opponent”) under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). It relies on six earlier marks, five of which consist of, or contain, the number/word combination NINE/9 WEST. The sixth mark comprises the number/letter combination 9W. All but one of the earlier marks (UK 15188898) is registered for clothing in class 25. All but one of the earlier marks (EU 12294526) were registered more than five years prior to the date on which the applicant’s mark was published for opposition purposes, so meaning that they are subject to the proof of use provisions contained in section 6A of the Act.
3. The applicant filed a counterstatement denying the grounds of opposition. It elected not to put the opponent to proof of genuine use of its earlier marks. The consequence of this is that they may be taken into account in these proceedings for the goods on which the opponent relies.
4. Only the opponent filed evidence, however, it consists of nothing more than prints of the case details of the earlier marks, so I need make no further reference to the evidence filed. Neither side requested a hearing, but the opponent did file written submissions in lieu, of which I have had due regard. The opponent has been represented throughout the proceedings by Maucher Jenkins, the applicant has represented itself.
5. Although six earlier marks are pleaded, I will begin by considering the opponent’s case on the basis of earlier European Union Trade Mark (“EUTM”) 903419, the details of which are set out below. I will return to the other earlier marks only if it is necessary to do so:

Case number: **EUTM 903419**

For the mark: **9 WEST**

Relevant goods: **Clothing, footwear, headgear; aprons [clothing]; babies' diapers of textile / babies' napkins of textile; babies' pants; bandanas [neckerchiefs]; bath robes; bath sandals; bath slippers; bathing caps; bathing suits / swimsuits; bathing trunks / bathing drawers; beach clothes; beach shoes; belts [clothing]; berets; boas [necklets]; bodices [lingerie]; boot uppers; boots for sports; boots; brassieres; breeches [for wear]; camisoles; cap peaks / visors [hatmaking]; caps [headwear]; chasubles; clothing for gymnastics; clothing of imitations of leather; clothing of leather; clothing; coats; collar protectors; collars [clothing] / shoulder wraps; combinations [clothing]; corselets; corsets [underclothing]; cuffs / wristbands [clothing]; cyclists' clothing; detachable collars; dress shields; dressing gowns; ear muffs [clothing]; esparto shoes or sandals; fittings of metal for shoes and boots / iron fittings for shoes / iron fittings for boots; football shoes / football boots; footmuffs, not electrically heated; footwear uppers; footwear; frocks; fur stoles; furs [clothing]; gabardines [clothing]; galoshes / goloshes; garters; girdles; gloves [clothing]; gymnastic shoes; half-boots; hat frames [skeletons]; hats; headbands [clothing]; headgear for wear; heelpieces for boots and shoes / heelpieces for shoes/ heelpieces for boots; heelpieces for stockings / heel pieces for stockings; heels; hoods [clothing]; hosiery; inner soles; jackets [clothing]; jerseys [clothing]; jumpers [shirt fronts] / chemisettes [shirt fronts]; knitwear [clothing]; lace boots; layettes [clothing]; leggings; liveries; maniples; mantillas; masquerade costumes; mitres [hats] / miters [hats]; mittens; motorists' clothing; muffs [clothing]; neckties; non-slipping devices for boots and shoes / nonslipping devices for shoes / non-slipping devices for boots; outerclothing; overalls / smocks; overcoats / top coats / topcoats; pants / drawers [clothing]; paper clothing; parkas; pelerines; pelisses; petticoats; pockets for clothing; pullovers; pyjamas / pajamas (Am.); ready-made clothing; ready-made linings [parts of clothing]; sandals; saris; sashes for wear; scarves / scarfs; shawls; shirt fronts; shirt yokes; shirts; shoes; singlets / sports jerseys; ski boots; skirts; skull caps;**

slippers; slippers [undergarments]; sock suspenders; socks; soles for footwear; spats / gaiters; sports shoes; stocking suspenders; stockings; studs for football boots shoes; stuff jackets [clothing]; suits; suspenders / braces for clothing [suspenders]; sweat-absorbent stockings; sweat-absorbent underclothing [underwear] / antisweat underclothing / anti-sweat underwear; sweaters; teddies [undergarments]; tee-shirts; tights; tips for footwear; togas; top hats; trouser straps / gaiter straps; trousers; underpants; underwear / body linen [garments] / underclothing; uniforms; veils [clothing]; waistcoats / vests; waterproof clothing; welts for boots and shoes / welts for shoes / welts for boots; wet suits for water-skiing; wimples; wooden shoes; none of the afore-mentioned goods including bibs, not of paper.

Dates: **Filed on 13 August 1998 and entered on the register on 2 March 2000.**

Section 5(2)(b)

6. Section 5(2)(b) of the Act states that:

“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.”

7. The following principles are gleaned from the judgments 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 greater 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.

Average consumer and the purchasing act

8. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. 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.”

9. The conflicting goods are clothing items. The average consumer will be a member of the general public. Such goods are likely to be selected by predominantly visual

means, through self-selection, websites and brochures/catalogues. I will not, though, ignore the aural impacts of the marks completely. The goods are purchased reasonably frequently and are not prohibitively expensive (indeed, some items of clothing are low cost). However, some care will be taken to ensure the correct fit, colour, and to ensure fitness for purpose. I come to the view that these are the type of goods where neither a materially higher nor lower than average degree of care will be deployed by the average consumer.

Comparison of goods

10. The applicant seeks registration for “clothing”. As can be seen from the details of the earlier mark I am considering, the long list of goods for which the earlier mark is registered includes clothing. I note from the applicant’s counterstatement that a point is made about a difference between the goods the parties sells and that the applicant will not encroach on the goods of the opponent. However, the approach put forward by the applicant is not the correct one. Whether the goods are similar and whether there is a likelihood of confusion must be based on a notional assessment, based on the marks and goods for which the application has been made and for which the earlier mark is registered. Both application and registration cover clothing and, as such, identical goods are in play.

Comparison of marks

11. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The 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.”

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

The logo for 'WEST 9 LONDON' features the word 'WEST' in a large, bold, sans-serif font. A horizontal line underlines the word 'WEST', extending to the right and ending under the number '9'. The word 'LONDON' is written in a smaller, all-caps, sans-serif font directly below the '9'.

v

9 WEST

13. In terms of overall impression, the applicant's mark is made up of the word/number combination WEST 9 (in a particular yet unremarkable font), the word LONDON, and a minor aspect of stylisation comprising a partial underline of the word WEST. Given its size and impact, I agree with the opponent's submission that WEST 9 strongly dominates the overall impression of the mark. Whilst I would not go so far as to say that LONDON and the underline is negligible, I nevertheless consider that those elements have only a weak relative weight in the overall impression of the mark. The opponent's mark has only the number/word combination 9 WEST, with neither the word nor the number dominating the other.

14. Visually, it will be readily apparent that both marks contain the numeral 9 and the word WEST, albeit, the order is reversed. This creates, in my view, a clear and obvious aspect of visual similarity. There are, though, differences (the reversal, word LONDON, the partial underline and the unremarkable font) but given the overall

impression that I have identified, such differences do not counter the similarities to a significant extent. I consider there to be a reasonably high degree of visual similarity.

15. Aurally, the opponent's mark is likely to be articulated as NINE-WEST. In terms of the applicant's mark, it is unlikely, given its role in the mark, that the word LONDON will be articulated, so meaning that the mark will most likely be articulated as WEST-NINE. This means that both marks are made up of the same two syllables, albeit in reverse order. I consider that there is a reasonably high degree of aural similarity.

16. Conceptually, whilst neither mark has an exact meaning, both 9 WEST and WEST 9 are evocative of some form of location, possibly as a co-ordinate or street number/name. To that extent there is some conceptual similarity. Given the imprecision of the meaning, I pitch this similarity as medium. I accept, though, the opponent's point that a conceptual difference is not in play on the basis of one being perceived as a London postcode, the other not. The messages are not clear enough. Even if an evocative meaning is not perceived, there is still some conceptual similarity on the basis that both marks make reference to a number and a western direction.

Distinctive character of the earlier mark

17. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, based either on inherent qualities or because of use made, the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). 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 *WindsurfingChiemsee 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).”

18. The number/word combination 9 WEST has no particular significance or resonance in relation to the goods of the earlier mark. From an inherent perspective, the earlier mark has a medium degree of distinctive character. No evidence has been filed, so there has been no enhancement of distinctive character.

Likelihood of confusion

19. The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused. Confusion can be direct (which effectively occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same, but puts the similarity that exists between the marks/goods down to the responsible undertakings being the same or related). In terms of indirect confusion, this was dealt with by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10 where he noted that:

“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)."

20. The goods are identical and the earlier mark is distinctive to a medium degree. There is a reasonably high degree of visual and aural similarity and some conceptual similarity. Many of the points made by the applicant in its counterstatement are based on the actual use of marks. I have already attempted to explain that this is not the correct approach. Based on the marks/goods before the tribunal, and based on the assessments I have made, I consider that there is a likelihood of confusion. One of the factors that leads me to this conclusion is the concept of imperfect recollection. The

average consumer rarely compares marks side by side and must, instead, rely on the imperfect picture of them kept in mind. Given this, 9 WEST may be imperfectly recalled as WEST 9, or vice versa. Further, the stylisation and the presence of the word LONDON, given the significance of the elements, may well be overlooked as part of this imperfect recollection. As a consequence of all this, the marks may be mistaken for one another and direct confusion is applicable.

21. Even if the average consumer recalled the marks with greater precision, I still consider that there is a likelihood of indirect confusion as the differences that exist between the marks will be put down to some form of brand variant. The average consumer, because of the similarities between the marks will, therefore, believe that the respective goods are the responsibility of the same or a related undertaking.

Conclusion

22. Subject to appeal:

- i) The applicant's mark is to be refused registration.
- ii) There is no need to consider the other earlier marks/goods.

Costs

23. The opponent has been successful and is, therefore, entitled to a contribution towards its costs. My assessment, based upon the published scale, is set out below:

Official fee - £100

Preparing a statement of case and considering the counterstatement - £300

Final written submissions - £400

Total - £800

24. It should be noted that I have made no award in respect of the opponent's evidence. This is because it contained nothing other than prints of the opponent's earlier marks and was not, therefore, strictly necessary to file.

25. I order West 9 London Limited to pay Nine West Development Limited the sum of £800 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 21st day of November 2017

Oliver Morris

For the Registrar,

The Comptroller-General