

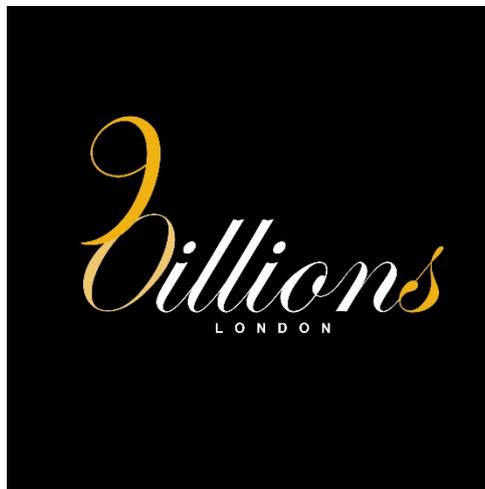
O/593/19

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NO. UK00003310884

TO REGISTER THE FOLLOWING TRADE MARK:



IN CLASS 25

BY BILLIONS LONDON LTD

AND IN THE MATTER OF CONSOLIDATED OPPOSITIONS THERETO

UNDER NO. 413714 AND 413754

BY BILLIONAIRE TRADEMARKS B.V. AND PHILIPP PLEIN

BACKGROUND AND PLEADINGS

1. On 15 May 2018, Billions London LTD (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 15 June 2018. Registration is sought for the following goods:

Class 25 Clothing, footwear, headgear.

2. The application was opposed by Billionaire Trademarks B.V. and Philipp Plein (together “the opponents”) based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”).

3. Billionaire Trademarks B.V. relies on the following trade marks:

BILLIONAIRE

UK registration no. 3040166

(“the First Earlier Mark”)

Filing date 31 January 2014; registration date 9 May 2014

Relying on some goods and services for which the mark is registered, namely:

Class 25 Clothing; leather and imitation leather clothing; coats; bathrobes; shoes, boots and slippers; short-sleeved shirts, shirts; headgear; overcoats; bathing suits; neckties, gloves (clothing), scarves; jackets; skirts; waterproof clothing; ready-made clothing; knitwear (clothing); underwear; hosiery; sweaters, trousers, pullovers; dresses; belts (clothing).

Class 35 Retail services connected with the sale of clothing, leather and imitation leather clothing, coats, bathrobes, shoes, boots and slippers, short-sleeved shirts, shirts, headgear, overcoats, bathing suits, neckties, gloves (clothing), scarves, jackets, skirts, waterproof clothing, ready-made clothing, knitwear (clothing),

underwear, hosiery, sweaters, trousers, pullovers, dresses, belts (clothing).

BILLIONAIRE

EU registration no. 12203031

("the Second Earlier Mark")

Filing date 8 October 2013; registration date 6 March 2014

Relying on some services for which the mark is registered, namely:

Class 35 Sales, including online, relating to the following goods: clothing, footwear, headgear.

4. Mr Plein relies on the following trade mark:



3 BILLIONAIRE

EU registration no. 15607245

("the Third Earlier Mark")

Filing date 1 July 2016; registration date 22 December 2017

Relying on some goods and services for which the mark is registered, namely:

Class 25 Clothing, footwear, headgear.

Class 35 Wholesaling and retailing, including via the internet, in the fields of clothing, footwear, headgear.

5. The opponents submit that there is a likelihood of confusion because the parties' respective goods and services are identical or similar and the marks are similar.

6. The applicant filed counterstatements denying the claims made.

7. The proceedings were consolidated following the filing of the opponents' evidence.

8. The opponents filed evidence in the form of two witness statements of Mr Plein, both dated 29 March 2019. No evidence was filed by the applicant. No hearing was requested and neither party filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

EVIDENCE

9. As noted above, the opponents' evidence consists of two witness statements provided by Mr Plein, both dated 29 March 2019. Both of these were accompanied by 7 exhibits. As these proceedings were not consolidated until after the filing of the opponents' evidence, both witness statements are (for the most part) identical. I have read Mr Plein's statements in their entirety and, in particular, I note as follows:

a) The opponents' brand was started in Italy in 2005, with a flagship store being opened in London in 2007;

b) Net sales figures in the UK are as follows:

2009	Over £2,500,000
2010	Over £3,500,000
2011	Over £4,000,000
2012	Over £4,500,000
2013	Over £4,500,000
2017	Over £160,000
2018	Over £330,000

c) The opponents' brand has been referenced in a number of articles including those published in GQ Magazine (between January 2017 and May 2018), the Financial Times (in April 2017), the Sunday Times (in December 2016 and February 2018), OK! Magazine (in November 2017), the Gentleman's Journal (in November 2017), the Times Magazine (in October 2017), Men's Health

Magazine (in October 2017), the Sunday Telegraph Fashion Man (in October 2017), Brides Magazine (in September 2017), Glass Magazine (in September 2017), Grazia (in June 2017), ES Magazine (in February 2017) and Harrods The Magazine (in October 2016)¹.

d) Between 1 October 2016 and 1 May 2018, the opponents' advertising spend in respect of the Billionaire brand for the UK amounted to over £700,000².

DECISION

10. Section 5(2)(b) of the Act states as follows:

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

(a) [...]

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

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

11. 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,

¹ Exhibit 6

² Exhibit 7

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.”

12. The trade marks upon which the opponents rely qualify as earlier trade marks under the above provisions. As the earlier marks had not completed their registration process more than 5 years before the publication date of the application in issue in these proceedings, they are not subject to proof of use pursuant to section 6A of the Act. The opponent can, therefore, rely upon all of the goods and services it has identified.

Section 5(2)(b) – case law

13. 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.

(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 to mind the earlier mark, 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 and services

14. The competing goods and services are as follows:

Opponents' goods and services	Applicant's goods
<p data-bbox="193 524 796 560">The First Earlier Mark</p> <p data-bbox="193 562 796 598"><u>Class 25</u></p> <p data-bbox="193 600 796 1115">Clothing; leather and imitation leather clothing; coats; bathrobes; shoes, boots and slippers; short-sleeved shirts, shirts; headgear; overcoats; bathing suits; neckties, gloves (clothing), scarves; jackets; skirts; waterproof clothing; ready-made clothing; knitwear (clothing); underwear; hosiery; sweaters, trousers, pullovers; dresses; belts (clothing).</p> <p data-bbox="193 1182 796 1218"><u>Class 35</u></p> <p data-bbox="193 1220 796 1771">Retail services connected with the sale of clothing, leather and imitation leather clothing, coats, bathrobes, shoes, boots and slippers, short-sleeved shirts, shirts, headgear, overcoats, bathing suits, neckties, gloves (clothing), scarves, jackets, skirts, waterproof clothing, ready-made clothing, knitwear (clothing), underwear, hosiery, sweaters, trousers, pullovers, dresses, belts (clothing).</p> <p data-bbox="193 1839 796 1874">The Second Earlier Mark</p> <p data-bbox="193 1877 796 1912"><u>Class 35</u></p>	<p data-bbox="798 524 1398 560"><u>Class 25</u></p> <p data-bbox="798 562 1398 598">Clothing, footwear, headgear.</p>

<p>Sales, including online, relating to the following goods: clothing, footwear, headgear.</p> <p>The Third Earlier Mark</p> <p><u>Class 25</u> Clothing, footwear, headgear.</p> <p><u>Class 35</u> Wholesaling and retailing, including via the internet, in the fields of clothing, footwear, headgear.</p>	
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15. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court 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 for 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.”

16. “Clothing” and “headgear” appear identically in the specifications of the First Earlier Mark, the Third Earlier Mark and the applicant’s mark.

17. The specification of the First Earlier Mark includes “shoes, boots and slippers” and the specifications of the Third Earlier Mark and the applicant’s mark both include the term “footwear”. These goods are identical, either self-evidently, or on the principle outlined in *Meric*.

18. As the specifications of the First Earlier Mark and the Third Earlier Mark cover terms identical to those in the applicant’s specification, I will proceed in respect of

these marks as they represent the opponents' best case (and, in any event, the Second Earlier Mark is identical to the First Earlier Mark).

The average consumer and the nature of the purchasing act

19. 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 *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”.

20. The average consumer for the goods will be a member of the general public. The goods are unlikely to be very expensive and will not be purchased infrequently. However, a number of factors will be taken into consideration during the purchasing process, such as material, cut and aesthetic appearance. I therefore consider that a medium degree of attention will be paid during the purchasing process for the goods.

21. The goods are most likely to be obtained by self-selection from a retail outlet or online or catalogue equivalent. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount that there will also be an aural component to the purchase of the goods, bearing in mind that advice may be sought from a sales assistant or representative.

Comparison of the trade marks

22. 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.”

23. 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.

24. The respective trade marks are shown below:

Opponents' trade marks	Applicant's trade mark
BILLIONAIRE (the First Earlier Mark)	



Overall Impression

First Earlier Mark

25. The First Earlier Mark consists of the word BILLIONAIRE. There are no other elements to contribute to the overall impression which lies in the word itself.

Third Earlier Mark

26. The Third Earlier Mark also consists of the word BILLIONAIRE. However, the letter B is highly stylised with parts of the letter missing. The overall impression of the mark lies in the combination of these elements.

Applicant's Mark

27. The applicant's mark consists of the letters ILLIONS. They are preceded by a device which may be viewed as a B (or, according to the applicant, may also be seen as numbers). The device and the letter S are presented in gold, with the rest of the text presented in white. The word is displayed in a cursive, stylised font on a black background. Beneath this word, in much smaller text, is the word LONDON. The word LONDON will be viewed as an indicator of geographical origin and will, therefore, be attributed little trade mark weight by the consumer. It will, therefore, play a much lesser

role in the overall impression of the mark, as will the background. The device and letters ILLIONS will play a greater role in the overall impression.

Visual Comparison

28. As noted above, the applicant argues that use of the device in its mark is ambiguous. It could be viewed as the number 90. Whilst I accept that there may be some consumers who do not recognise the letter B, I consider that a significant proportion will. When combined with the letters ILLIONS, and the consumer's natural inclination to identify words within marks, I consider that the word BILLIONS will be identified. The applicant's mark and the First Earlier Mark will, therefore, visually coincide in the first six letters BILLION-. The marks will differ in the presence of the letter -S in the applicant's mark and the letters -AIRE in the First Earlier Mark. The stylisation of the applicant's mark and the presence of the word LONDON are also points of visual difference. Although, as a word only mark, notional and fair use would cover use of the First Earlier Mark in standard fonts (and a cursive font may bring it closer to the font in the applicant's mark), the extent of the stylisation to the letter B in the applicant's mark is too much to be covered by notional and fair use. I consider the marks to be visually similar to between a low and medium degree.

29. The same points will also apply to the Third Earlier Mark. However, the stylisation of the B in that mark will act as a further point of visual difference. I consider the marks to be visually similar to a low degree.

Aural Comparison

30. The first part of the First Earlier Mark and the applicant's mark - BILLION - will be pronounced identically. The marks will differ in the pronunciation of the letter S in the applicant's mark and the letters AIRE in the First Earlier Mark. I consider the marks to be aurally similar to a medium degree.

31. The same points will apply to the Third Earlier Mark, as it will be pronounced identically to the First Earlier Mark.

Conceptual Comparison

32. The marks will all overlap conceptually to the extent that they all make reference to a particular amount of money i.e. a billion. However, they will differ in that the applicant's mark is a plural of that word (i.e. "billions of pounds") and the opponents' marks are a reference to an individual who possesses that amount of money. I consider the marks to be conceptually similar to a medium degree.

Distinctive character of the earlier mark

33. 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-2779, 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 promotion of 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)."

34. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

35. I must make an assessment of the inherent distinctiveness of the earlier marks as a whole. The First Earlier Mark consists of the ordinary dictionary word BILLIONAIRE. It is neither descriptive nor allusive for the goods. I consider the First Earlier Mark to have a medium degree of inherent distinctive character. The stylisation of the letter B in the Third Earlier Mark will mean that its inherent distinctive character is slightly higher.

36. The opponents have filed evidence to show that the distinctiveness of their marks has been enhanced through use. The opponents' evidence shows that until the last few years, their net sales were several million per year. Whilst not insignificant, this would not represent a particularly significant market share given, presumably, the extensive size of the clothing, footwear and headgear markets. I recognise that a reasonable amount has been spent on advertising and the opponents' marks have been consistently referenced in a number of magazines which are undoubtedly well-known in the UK. However, the opponent's evidence suggests that it only has one shop in the UK. I consider that the evidence, as a whole, is insufficient to demonstrate that the distinctiveness of the opponents' marks has been enhanced through use.

37. If I am wrong in this finding, then the distinctiveness of the opponents' marks will have been enhanced through use by only a moderate degree.

Likelihood of confusion

38. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment

where 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 necessary for me to keep in mind the distinctive character of the opponents' trade marks, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to 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 that he has retained in his mind.

39. Direct and indirect confusion were described in the following terms by Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

“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.”

40. I have found the applicant's mark and the First Earlier Mark to be visually similar to between a low and medium degree and aurally and conceptually similar to a medium degree. I have found the applicant's mark and the Third Earlier Mark to be visually similar to a low degree and aurally and conceptually similar to a medium degree. I have identified the average consumer to be a member of the general public who will purchase the goods primarily by visual means (although I do not discount an aural component). I have concluded that the average consumer will pay a medium degree

of attention when selecting the goods. The First Earlier Mark has a medium degree of inherent distinctive character, with the distinctiveness of the Third Earlier Mark being slightly higher due to its stylisation. I have found the goods to be identical.

41. Notwithstanding the principle of imperfect recollection, I consider that there are sufficient visual differences between the marks to avoid them being mistakenly recalled as each other. The different words and stylisation will not be overlooked by the average consumer. I do not consider there to be a likelihood of direct confusion.

42. Having recognised the differences between the marks, I see no reason why the average consumer would conclude that they originate from the same or economically linked undertakings; one is not a natural brand extension or variant of the other. A finding of indirect confusion should not be made merely because two marks share a common element; it is not sufficient that one mark merely calls to mind the other³. Taking all of the above factors into account, I do not consider there to be a likelihood of indirect confusion.

43. For the avoidance of doubt, even if the distinctiveness of the opponents' marks has been enhanced through use by a moderate degree, this is not sufficient to counteract the differences between them, even when used on identical goods. This would not have affected my overall finding that there is no likelihood of confusion.

CONCLUSION

44. The oppositions have failed in their entirety, and the application will proceed to registration.

COSTS

45. The applicant has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, and taking into account the economies achieved through

³ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

consolidation, I award the applicant the sum of **£800** as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Preparing statements and considering the opponents' statements	£300
Considering the opponents' evidence	£500
Total	£800

46. I therefore order Billionaire Trademarks B.V. and Philipp Plein (jointly and severally) to pay Billions London LTD the sum of £800. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 03rd day of October 2019

S WILSON
For the Registrar