

O-601-18

TRADE MARKS ACT 1994

IN THE MATTER OF OPPOSITION No. 409903

IN THE NAME OF UNDER ARMOUR, INC.

TO TRADE MARK APPLICATION No. 3225647

IN THE NAME OF DARA LAMBUELLA KNOX-HOOKE

DECISION

1. This is an appeal against a successful opposition to the registration of the following series of marks:

THE ARMOUR
THE ARMOUR

2. On 19 April 2017 the marks were sought to be registered in classes 18 and 25 for the following goods:

18: Leather handbags, clutch bag, back pack, totes, carry-all; Belt bags; Leather shoulder belts; Belts (Leather shoulder -); Fitted belts for luggage; Belt bags and hip bags.

25: Clothes; Footwear; Footwear for men and women; Casual footwear; Light-reflecting coats; Dust coats; Duffel coats; Evening coats; Sheepskin coats; Fur coats; Fur coats and jackets; Morning coats; Tail coats; Men's and women's jackets, coats, trousers, vests; Coats (Top -); Top coats; Coats of denim; Denim coats; Pea coats; Coats; Wind coats; Trench coats; Rain coats; Winter coats; Suit coats; Coats for women; Coats for men; Heavy coats; Frock coats; Leather coats; Cotton coats; Coats made of cotton; Belts made from imitation leather; Belts [clothing]; Belts of textile; Fabric belts; Belts for clothing; Leather belts [clothing]; Belts made of leather; Belts made out of cloth; Belts (Money -) [clothing]; Fabric belts [clothing]; Garter belts.

3. The Opposition succeeded on the basis of the Opponent's earlier EUTM No. 011978764 ARMOUR, registered on 14 January 2016, for goods in classes 18 and 25 as follows:

O-601-18

- 18:** Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery; small leather goods (leatherware); bags including all purpose sport bags, all-purpose athletic bags, all-purpose carrying bags, sports bags, duffle bags, backpacks, tote bags.
- 25:** Clothing; footwear; headgear; excluding golf clothing, golf footwear and golf headgear.
4. In his decision dated 18 April 2018 the Hearing Officer, Matthew Williams, upheld the opposition under s.5(2)(b) of the Trade Marks Act 1994, namely:
- 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.”
5. The decision was taken in the absence of an oral hearing but based on the papers and written submissions. At this appeal the Opponent/Respondent again did not appear but filed a written skeleton argument. The Applicant/Appellant filed a skeleton argument and also appeared in person, making submissions which were clear and concise.

STANDARD OF APPEAL

6. The Respondent referred to the principles set out in the decision of Daniel Alexander QC, sitting as the Appointed Person, in *TT Education Ltd v Pie Corbett Consultancy* [2017] RPC 17 at [52]. The Appellant accepted that this summarised the correct approach.
7. To this can be added the guidance set out in the decision of Ian Purvis QC, sitting as the Appointed Person in *ROCHESTER Trade Mark (O-079-17)*, where he stated:
33. I fear that far too much ink has been already spilled by Appellate Courts on these issues with diminishing returns, and I therefore do not propose to say a great deal more. So far as the particular context of this appeal is concerned, I would simply add that the reluctance of the Appointed Person to interfere with a decision of a Hearing Officer on likelihood of confusion is quite high for at least the following reasons:

O-601-18

- (i) The decision involves the consideration of a large number of factors, whose relative weight is not laid down by law but is a matter of judgment for the tribunal on the particular facts of each case
- (ii) The legal test 'likely to cause confusion amongst the average consumer' is inherently imprecise, not least because the average consumer is not a real person
- (iii) The Hearing Officer is an experienced and well-trained tribunal, who deals with far more cases on a day-to-day basis than the Appellate tribunal
- (iv) The legal test involves a prediction as to how the public might react to the presence of two trade marks in ordinary use in trade. Any wise person who has practised in this field will have come to recognize that it is often very difficult to make such a prediction with confidence. Jacob J (as he then was) made this point in the passing off case *Neutrogena v Golden* [1996] RPC 473 at 482:

'It was certainly my experience in practice that my own view as to the likelihood of deception was not always reliable. As I grew more experienced I said more and more "it depends on the evidence."

Any sensible Appellate tribunal will therefore apply a healthy degree of self-doubt to its own opinion on the result of the legal test in any particular case.

- 34. I shall therefore approach this appeal on the basis that in the absence of a distinct and material error of principle, I ought not to interfere with the decision of the Hearing Officer unless I consider that his view on the issue of likelihood of confusion was clearly wrong in the sense that it was outside the range of views which could have been reasonably taken on the established facts."
- 8. Thus appellants cannot come to this tribunal expecting the Appointed Person to substitute his or her view for that of the Hearing Officer in the absence of an error of principle or a decision that was outside the range of reasonably held views. The fact that another reasonable tribunal might have come to the opposite conclusion is insufficient and multifactorial decisions such as those under s.5(2)(b) of the Act will not be readily reversed.

THE PRINCIPLES OF LAW APPLIED BY THE HEARING OFFICER

- 9. The Hearing Officer applied the following principles to his decision, as summarised in §13:
 - (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

O-601-18

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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

10. In applying this to the facts of the case, he found as follows:

- (a) The average consumer for clothing, bags and so on was the general public, who will purchase the goods in shops or via the internet. The purchase would be primarily a visual one, but aural considerations may also play a part, such as on the basis of word of mouth recommendations, so the aural impact of the marks should also be taken account in the assessment (§16).
- (b) The level of attention of the average consumer in buying the goods specified in this case will be of a medium or average level (§17).
- (c) Some of the respective goods in class 18 were identical (§§20-21); for the remainder there was a medium degree of similarity (§24).

O-601-18

- (d) Similarly, in class 25 the goods were identical (§25) or similar to a medium degree (§§26-27).
- (e) The marks were visually similar to a high degree (§32), aurally similar to a high degree (§33) and conceptually similar to a very high degree (§34). The Opponent's ARMOUR mark was highly similar overall to the Applicant's series of marks (§35).
- (f) The Opponent's marks had a normal or average level of inherent distinctiveness (§37) – no evidence had been adduced in support of acquired distinctiveness.
- (g) The precise proposed use by the Applicant (to establish it as a Christian faith based brand excluding sporting attire) was not relevant since the test is a notional assessment based on the mark applied for and the mark as registered (§41).
- (h) The average consumer, paying a medium or average level of attention, seeing or hearing the marks used on goods that are identical or similar to a medium degree, may well directly confuse the two, mistaking one for the other (§42).

11. Accordingly he allowed the opposition.

THE APPEAL

- 12. The Appellant advanced a number of submissions in her appeal.
- 13. First she suggested that the Hearing Officer had improperly focussed on the wording of the respective marks, and had paid insufficient attention to the design, appearance, classes of goods and channels of trade in which the Appellant seeks to use the mark. In particular, she suggested that he placed insufficient weight on the visual differences between the marks and ignored the fact that "The" carries considerable weight. She accepted that in some circumstances the addition of "The" could not avoid confusion (giving the notional example of "THE GUCCI") but submitted that in the present case "armour" was descriptive and so the addition of "The" made a significant difference.
- 14. I reject this submission. As recorded above, the Hearing Officer assessed the visual, aural and conceptual impact of the marks, as he was required to do. He concluded that the marks were visually and aurally similar to a high degree and conceptually

O-601-18

similar to a very high degree. I consider that he was correct to do so. The word THE is insufficiently distinctive in the present case to be able to distinguish the marks to any significant degree. Even though “armour” is an English word that has some conceptual connection to some goods in classes 18 and 25, it has an average level of inherent distinctiveness and the Hearing Officer did not fall into any error when comparing the marks as a whole.

15. The Appellant next submitted that consumers used to using the internet were sophisticated enough to distinguish between the Appellant’s marks and the Opponent’s registrations. Thus she argued that consumers had been educated to recognise minute distinctions between marks and so there would be no confusion in the present case. She suggested that the fact that a search engine would give different results if the respective marks were typed in should have been a relevant factor in the Hearing Officer’s determination.
16. I reject this criticism too. Even if there had been any evidence to support the submission based on search-engine results, consumers do not only purchase goods in classes 18 and 25 in such a way. The Hearing Officer had to consider all notional use of the respective marks, including in conventional shops. I consider that the Hearing Officer correctly identified the characteristics of the average consumer in this case – the general public, who will purchase the goods in shops or via the internet – and attributed to them the correct level of attention.
17. Next the Appellant placed weight on the Opponent’s UNDER ARMOUR marks and submitted that consumers would identify the Opponent’s ARMOUR mark with these marks, thereby distinguishing them from the mark applied for. As a result she suggested that the consumer would know the difference between the marks in issue in the present case when shopping.
18. However, this was not a relevant consideration for the Hearing Officer. The Appellant accepted that the opposing mark was ARMOUR and not UNDER ARMOUR. Further, there was no evidence submitted about the actual perception of the Respondent’s marks. The Hearing Officer was therefore correct to proceed on the basis of notional use of the marks for the goods covered. He could only proceed on the basis that the registered mark was ARMOUR alone together with notional use of that mark.
19. The Appellant also relied on the state of the register, pointing to the registration of marks for ARMORY and THE ARMOURY in class 25. She argued that if these marks can co-exist then so should the mark applied for alongside the registrations

O-601-18

of the Opponent. She also used the presence of multiple registrations to argue that this meant that the mark had become so descriptive that the public will look to other elements to distinguish the source of the services.

20. This is a well-rehearsed argument in cases of this type which it is also well-established is irrelevant. See the observations of Jacob J. in *British Sugar Plc v James Robertson & Sons Ltd* [1996] R.P.C. 281 at 305:

Both sides invited me to have regard to the state of the register. Some traders have registered marks consisting of or incorporating the word "Treat". I do not think this assists the factual inquiry one way or the other, save perhaps to confirm that this is the sort of word in which traders would like a monopoly. In particular the state of the register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led the registrar to put the marks concerned on the register. It has long been held under the old Act that comparison with other marks on the register is in principle irrelevant when considering a particular mark tendered for registration, see e.g. *MADAME Trade Mark* and the same must be true under the 1994 Act. I disregard the state of the register evidence.

21. The Appellant accepted that there can be commercial agreements allowing registration of apparently conflicting marks that the consumer knows nothing about. That is why evidence of the state of the register cannot assist. For the same reason, I also reject the argument based upon entirely different marks (GRACE registrations in classes 9, 41 and 42) that the Appellant sought to rely upon.
22. Finally I conclude that the Hearing Officer was correct to reject the relevance of the suggestion that the mark was sought to be established as a Christian-based brand. There was no evidence that the public at large would be aware of any biblical reference. The Hearing Officer was correct not to include this consideration in his assessment of notional use.
23. In short, I reject the Appellant's submission that consumers encountering the mark applied for would be likely to perceive it as merely another entrant in the consumer market. I can identify no error on the part of the Hearing Officer. Given the very high level of similarity between the marks and the identity of similarity of the goods I do not consider that the Hearing Officer fell into error in concluding that there would be confusion in the present case. On the contrary I consider that he was entirely correct to allow the opposition in all the circumstances of the present case and I reject the appeal.

O-601-18

COSTS

24. The Hearing Officer ordered the Applicant to pay the Opponent £600 to be paid within fourteen days of the final determination of this case if the appeal was unsuccessful, made up as follows:

Reimbursement of the official fee for Notice of Opposition and Statement of Grounds:	£100
Preparing a statement of grounds and considering the other side's statement:	£200
Preparing submissions in lieu of a hearing:	£300
Total:	£600

25. On the appeal I award the Opponent the additional sum of £300 in relation to its costs of the preparation of submissions in lieu of attending the hearing.
26. Accordingly I order the Applicant to pay to the Opponent the sum of £900 within fourteen days of the date of this decision.

Thomas Mitcheson QC
The Appointed Person
25 September 2018

The Applicant represented herself.

The Opponent was represented by Gill Jennings & Avery.

The Registrar took no part in the Appeal.