

**O-630-18**

**TRADE MARKS ACT 1994  
IN THE MATTER OF  
TRADE MARK APPLICATION NO 3225005  
BY ETHEA LIMITED  
TO REGISTER**

**Ethea**

**AS A TRADE MARK  
IN CLASSES 3, 4, 5, 14,18, 20, 24, 25 & 35  
AND OPPOSITION THERETO (UNDER NO.409936)  
BY  
ERREA' SPORT S.P.A.**

## Background and Pleadings

1. Ethea Limited (“the applicant”) applied to register the trade mark **Ethea** on 13 April 2017. The mark was published on 5 May 2017 in classes 3, 4, 5, 14,18, 20, 24, 25 & 35. I will set out the goods and services later in this decision.

2. Errea’ Sport S.p.A (“the opponent”) opposes the application under sections 5(2)(b) and 5(3) of the Trade Mark Act 1994 (“the Act) on the basis of its earlier EU trade marks set out below. I will set out the registered goods and services the opponent relies on later in the decision.

EU TM 7008477



Filing date: 23 June 2008

Date of entry in register: 4 February  
2009

EU TM 9284191

**ERREA’**

Filing date: 30 July 2010

Date of entry in register: 1 April 2011

EU TM10757243



Filing date: 26 March 2012

Date of entry in register: 27 August  
2012

3. The opponent claims under section 5(2)(b) that the applied for mark is similar to its earlier marks and has similar goods to the earlier marks and there exists a likelihood of confusion. Under section 5(3) it claims that the applied for mark is similar to its earlier marks which have a reputation in the UK and EU and use of the applied for mark would take unfair advantage and be detrimental to the reputation of the earlier marks.

4. The opponent's above-mentioned trade marks have filing dates that are earlier than the filing date of the application and, therefore, they are earlier marks, in accordance with Section 6 of the Act. As the registration procedure for EU TM nos. 7008477 and 9284191 was completed more than 5 years prior to the publication date of the contested application, they are subject to the proof of use conditions, as per section 6A of the Act. The opponent made a statement of use in respect of all the goods it relies on. EU TM 10757243 is not subject to proof of use, having not been registered for five years prior to the publication date of the contested application.

5. The applicant filed a counterstatement in which it denied the grounds of opposition. In answer to question 7 of Form TM8 which states "Do you want the opponent to provide 'proof of use'?", the applicant ticked the "No" box. Consequently, the opponent is entitled to rely on the full breadth of the goods for which it made a statement of use.

6. In these proceedings the applicant represents itself and the opponent is represented by Stobbs IP.

7. Both parties provided evidence and written submissions in lieu of a hearing. I now make this decision from a consideration of the papers before me.

### **Applicant's evidence**

8. The applicant provided a witness statement from Catherine Almond, who holds the position of Director. Ms Almond appended 12 exhibits. I have reviewed the exhibits and the most pertinent point to note is that the applicant appears to provide an online marketplace for buyers and sellers of goods which would fall under class 35. It does not appear from the exhibits provided that the contested mark is used on

the goods for which it has coverage in the application such as class 3, 14, 18 and 25, but it merely retails third party goods in these classes.

### **Opponent's evidence**

9. The opponent provided a witness statement from Rosanna Fabbiani, who holds the position of Managing Director. Ms Fabbiani appended 15 exhibits.

10. Exhibit RF1 comprises a list of the opponent's live EU trade marks.

11. Exhibit RF2 comprises a screenshot dated January 2018 of the opponent's main website, [www.errea.com](http://www.errea.com). The word mark ending '191 and the figurative mark ending '477 are visible. Also included is a copy of a Wikipedia page relating to the opponent's company history and the development of the figurative mark's diamond device.

12. Exhibit RF3 is a list of what the declarant calls the opponent's 'core' marks.

13. Exhibit RF4 is a website traffic report dated March 2014 generated by a web monitoring company, alexa.com, relating to [www.errea.it](http://www.errea.it) website.

14. Exhibit RF5 comprises photos of various Middlesbrough FC footballers dated between 1994 and 2009. The declarant states the opponent was the technical sponsor of the team's kit between those dates. The opponent's figurative mark ending 477 is visible on the shirts and shorts.

15. Exhibit RF6 comprises a 2010/2011 season report on the global TV viewing figures for the English Premier League and Championship League football fixtures. The declarant states that this confirms the exposure of its marks to a wider audience.

16. Exhibit RF7 comprises a list of the current UK sports teams for which the opponent provides team kit and sportswear. These include Norwich City FC, Millwall FC, QPR FC, Inverness CT FC and a number of other football teams, Wigan

Warriors Rugby League team, Mahindra Formula E racing team, British Canoeing and the Scottish Volleyball Association.

17. Exhibit RF8 comprises photographs dated between 2004-2009 of various football and rugby players wearing the opponent's kit. The diamond device figurative mark is just visible on the shirts and shorts.

18. Exhibit RF9 comprises a number of technical sponsorship agreements between the opponent and various English and Scottish football league clubs which are dated between 2007 – 2016.

19. Exhibit RF10 comprises the opponent's brochures dates between 2010 and 2014 outlining the team kit and sportswear it provides. These brochures also highlight the number of national and international teams for which it provides the kit in a variety of different sports such as football, volleyball, basketball, fencing, cycling and for various national Olympic federations.

20. Exhibit RF11 comprises an article and photo dated December 2007 showing a Guinness world record event for the biggest ever football shirt which was manufactured by the opponent. The event was to tie in with the launch of a video game, ProEvolution Soccer 2008. The exhibit also comprises still graphic images from said video game which show the animated players wearing the opponent's kit.

21. Exhibit RF12 comprises a list of goods available in the UK from the largest of the opponent's authorised distributors. The goods shown are sportswear, namely football and rugby shirts, shorts, athletic vests, track suits, bibs, coats, jackets, sweatshirts, socks as well as goalkeeping gloves, shin pads and bags. Where prices are shown, they are in pounds sterling. In addition, the exhibit also includes a map of the UK showing a nationwide spread of customers.

22. Exhibit RF13 comprises the turnover for sales in the UK between 2009 to 2019 in Euros. The relevant figures are presented below.

United Kingdom	861.691,72	3.025.128,08	4.696.371,04	4.035.894,66	4.536.968,60	6.337.575,48	7.425.388,49
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23. Exhibit RF14 comprises promotional material relating to the opponent's trade stand at various sport expos and trade fairs in the UK between 2012-2014. In addition, the exhibit includes copies of advertisements in various sporting trade magazines and journals as well as on hoardings at sporting venues.

24. RF15 comprises copies of invoices dated between 2008-2017 for sportswear goods to customers in the UK.

25. That concludes my summary of the opponent's evidence. I note that no evidence was provided to support classes 3 and 14 at all and there was only a single example of use on bags (class 18) in exhibit RF12.

### **Section 5(2)(b)**

26. Section 5(2)(b) of the Act is 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.

27. The leading authorities which guide me are from the Court of Justice of the European Union ('CJEU'): *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 and services**

28. The case law relating to the comparison of goods and services is set out below. In *Canon*, the CJEU stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

29. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services
- c) The respective trade channels through which the goods or services reach the market
- d) In the case of self serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular

whether they are, or are likely to be, found on the same or different shelves;

- e) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

30. In relation to the assessment of the respective specifications, I note that in *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

31. In *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM Case T-133/05) ('Meric')*, the General Court ('GC') held:

"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).”

32. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

33. The goods and services to be compared are set out below. I have taken the specifications for EU TM 9284191 as this has the broadest coverage. I note that the applicant contends in its submissions that,

“Erreà supplies leather goods, whereas Ethea, since it is a vegan and cruelty-free website, only supplies vegan, imitation leather goods. This is the same for class 25 also, again emphasising differences between the types of products sold...”

34. Before going any further into this decision, it is necessary to explain why, as a matter of law, the point above about the applicant’s goods being ‘vegan and cruelty free’ has no bearing on the outcome of this opposition. A trade mark registration is essentially a claim to a piece of legal property, i.e. the trade mark. The goods for which a mark is registered sets some limits to the claim, although since marks can be protected against the use of the same or similar marks in relation to goods which are only similar to those for which the earlier mark is registered, the limits of the claim are not precise. Every registered mark is therefore entitled to legal protection against the use, or registration, of the same or similar trade marks for the same or similar goods, if there is a likelihood of confusion.

35. Until a trade mark has been registered for five years (when the proof of use requirements set out in Section 6A of the Act apply), it is entitled to protection in relation to all the goods for which it is registered. The opponent’s earlier marks are therefore entitled to protection against a likelihood of confusion with the applicant’s mark based on the ‘notional’ use of the earlier mark for the goods listed in the Notice of Opposition. The concept of notional use is set out in *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, where Kitchen L.J. stated that:

“78. ....the court must.... consider a notional and fair use of that mark in relation to all of the goods or services in respect of which it is registered. Of course it may have become more distinctive as a result of the use which has been made of it. If so, that is a matter to be taken into account for, as the Court of Justice reiterated in *Canon* at paragraph [18], the more distinctive the earlier mark, the greater the risk of confusion. But it may not have been used at all, or it may only have been used in relation to some of the goods or services falling within the specification, and such use may have been on a small scale. In such a case the proprietor is still entitled to protection against the use of a similar sign in relation to similar goods if the use is such as to give rise to a likelihood of confusion.”

36. The goods and services to be compared are:

<b>Opponent’s goods and services</b>	<b>Applicant’s goods and services</b>
Class 3: Perfumes and alcoholic and non-alcoholic perfumery; Eaux de toilette; Extracts (perfumes); Essential oils; Pre-moistened cosmetic towelettes; Toning lotions; Moisturising and nourishing creams; Lip gloss; Creams; Gels; Hand lotion; Moisturizer; Nutrients; Body scrub; Multi-purpose creams, water and oils for the body;	Class 3: Soap, perfume, essential oils, hair lotions, hair shampoo, hair conditioner, cosmetics, skin care, make up, skin moisturisers, skin cleanser, reed diffusers, hair dye, wax strips for removing body hair.

<p>Deodorants; Antiperspirants ;Depilatory creams; Sun creams; Gels; Lotions; Foams; Gels; Eaux de toilette; Hair shampoos and conditioners; Hair lacquers; Hair sprays and mousses; Body hygiene products; Including for example, solid soaps; Liquid and in powder; Shower and bath foam; Bath salts; Oils and make-up powder; Talcum powder and powders for sprinkling; Foot hygiene products; Products for personal hygiene; Products for dental hygiene; Dentifrices; Mouthwash; Breath freshening sprays</p>	
	Class 4: candles
	Class 5: Food for babies, Food for diabetics, Food for medically restricted diets.
Class 14: Clocks and watches; Chronometers; Chronographs; Alarm clocks; Jewellery and artificial jewellery.	Class 14: Jewellery, necklaces, rings, earrings, bracelets, watches.
18: Bags; Multipurpose sports bags; Handbags; Bags of leather and imitations of leather; Gentlemen's handbags; Canvas bags; Bags for balls; Bags; Bags for campers; Bags; Travelling rugs; Key holders; Beach bags; Bum-bags; Cosmetic bags sold empty; School rucksacks; Trunks; Travelling bags; Valises; Rucksacks; Umbrellas; Walking sticks; Parasols;	Class 18: Imitation leather (vegan) bags, imitation leather (vegan) travel bags, imitation leather (vegan) belts.

Leatherware; Briefcases; Leather and imitations of leather; Satchels; Business cards cases; Change purses; Not of precious metal; Notecases; Sports bags; Football bags; Wetsuit bags.	
	Class 20: furniture
	Class 24: textile goods
Class 25: Sports clothing and leisurewear for men, women and children; Jerseys; Undershirts; T-shirts; Tank-tops; Sweatshirts; Pullovers; Polo-neck jerseys; Shirts; Skirts; Trousers; Shorts; Bermuda shorts; Jackets; Coats; Jeans; Jerseys; Ties; Suits; Combinations (clothing); Full tracksuits for sports teams; Training suits; Sports kits; Including kits for football; Five-a-side football; Volleyball; Rugby; Basketball; Soccer clothing; Five-a-side football; Volleyball; Rugby; Basketball; Tennis; Cycling; Golf; Baseball; Spinning; Running and exercisewear in general not included in other classes; Trousers; Ski suits; Belts (clothing); Belts for sports; Footwear; Shoes; Sports shoes; Football boots and shoes; Five-a-side football; Volleyball; Rugby; Basketball; Tennis; Cycling; Golf; Baseball; Spinning; Running; Gymnastics and exercise in general not included in other classes; Ski boots; Swimshoes; Slippers; Headwear; Hats; Caps; Bonnets; Ear	Class 25: Clothing women's clothing men's clothing footwear; imitation leather (vegan) shoes.

muffs; Sweat and head bands; Hats and berets for sport in general; Bandannas; Gloves (clothing); Mufflers; Wristbands; Stockings; Socks; Sweat-absorbent stockings; Slippers; Panty hose; Underwear; Briefs; Brassieres; Singlets; Underpants; Boxer shorts; G-strings; Biancheria intima; In particular for sport; Namely leg warmers; Bermuda shorts; Elasticated t-shirts; Nightwear; Beach clothes and swimwear; Including bathing suits; Swimming trunks; Bath robes; Rainwear	
Class 35: Wholesaling and retailing of perfumery; Spectacles; Horological articles and jewellery; Stationery; Luggage; Clothing; Sporting articles; Electronic commerce of the aforesaid goods	Class 35: Advertising of internet sales.

37. I have grouped the applicant's goods together where necessary for the purpose of this assessment <sup>1</sup>.

38. *soap, perfume, essential oils, hair shampoo, hair conditioner; skin moisturisers.*

I find these goods to be identical to the following goods in the opponent's class 3 specification: *solid soaps; liquid and in powder; perfumes and alcoholic and non-alcoholic perfumery; eaux de toilette; extracts (perfumes); essential oils; hair shampoos and conditioners; moisturising and nourishing creams; moisturizer*

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<sup>1</sup> *Separode Trade Mark* BL O-399-10 (AP)

#### 39. *Hair Lotions*

I find these goods to be highly similar to *hair conditioners* in the applicant's class 3 specification on the basis that the goods share the same purpose that is to nourish and condition the hair. The goods will also be found in the same area or aisle of a retail establishment.

#### 40. *Hair dye*

These goods are also likely to be found the same area or aisle as other hair care products. The nature and purpose of these products is to change the hair colour rather than just improving the hair's condition, but there are other hair products such as shampoos which enhance hair colour and maintain the condition and colour of dyed hair which will be in competition with hair dyes. Taking these factors into account, I find these goods to be similar to a medium degree.

#### 41. *skin care, skin cleanser*

I find these goods will be covered by the following goods in the opponent's specification namely, *toning lotions, moisturising and nourishing creams; hand lotions; body scrub; shower and bath foam* are therefore identical on the *Meric* principle.

#### 42. *cosmetics; makeup*

I find these goods to be identical to *lip gloss, oils and make-up powder* in the opponent's specification on the *Meric* principle.

#### 43. *Wax strips for removing body hair*

I find these goods to be highly similar to *depilatory creams* in the opponent's specification as whilst the nature of the goods is different, one being a cream and the other a wax strip, their purpose is shared, ie the removal of body hair. They are also both sold in the same area or aisle of a retail establishment.

#### 44. *Reed diffusers*

The purpose of these goods are for perfuming a room. The opponent has *perfumery* at large in its specification so these goods are therefore identical on the *Meric* principle.

#### 45. *Imitation leather (vegan) bags, imitation leather (vegan) travel bags*

I find these goods to be identical to *bags* in the opponent's specification on the *Meric* principle.

#### 46. *imitation leather (vegan) belts*

Although the opponent has no equivalent to these goods in its class 18 specification, it does have *belts (clothing)* in its class 25. I find the nature and the purpose of clothing belts and the applicant's goods to be the same. In addition, they are likely to be found in the same area or aisle of a retail establishment. Overall, I find the goods to be highly similar.

#### 47. *Clothing; footwear*

I find these goods to be identical to all the goods in the opponent's class 25 specification on the *Meric* principle

#### 48. *Advertising of internet sales*

Bearing in mind the *Youview* guidance set out above regarding not unnaturally straining the language of the specification, I have to take these services at face value and find they are an advertising service rather than a retail service, which is possibly not what the applicant wanted coverage for when it made its application. However proceeding on the basis that the services are for advertising of sales (of goods), then I find there is a medium degree of similarity with the *wholesaling and retailing* services in the opponent's class 35 specification.

49. *Candles; Food for babies, Food for diabetics, Food for medically restricted diets*

I can see no similarity between the applicant's class 4 and 5 goods set out above and any of the opponent's goods and services, nor has the opponent made any submissions to that effect. Where there is no similarity at all, there is no likelihood of confusion to be considered.

50. *Furniture; textile goods*

In relation to the above goods, the opponent contends on page 5 of its written submissions dated 27 May 2018, that,

“The specific goods and related retail services covered by the earlier marks in classes 25 and 35 would be considered similar to the applicant's goods in classes 20 and 24. Such goods and retail services related to such goods may be considered substitutes as these goods are distributed through the same channel and are available at the same outlets to the same end consumers”.

51. Firstly in relation to *furniture* in the applicant's class 20 specification, I cannot see how furniture is similar to either clothing goods in class 25 or the retail of the following goods in the opponent's class 35 specification, namely *perfumery, spectacles, Horological articles and jewellery, Stationery, Luggage, Clothing, Sporting articles*. I do not find that any of these goods can be considered as a 'substitute' for furniture. Secondly with regard to *textile goods*, these are also not considered similar goods to ready made clothing in class 25 or the retail thereof in class 35. The users and the nature of textile goods is different as are the usual channel of trade by which the goods reach the relevant market. Overall I do not find any similarity between the applicant's class 20 and 24 goods with any of the opponent's goods or services.

## **Average consumer and the purchasing act**

52. I now consider who the average consumer is for the contested goods and services and how they are purchased. 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*.

27. 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.”

53. The average consumers for the contested goods and services will be the general public. Because of the range of products, there will undoubtedly be a variation of prices. Some of the contested goods and services could be very expensive purchases such as jewellery whilst others are lower in price. Ordinarily I would expect a normal to high level of attention being paid by the consumer during selection. The purchasing act will be primarily visual as both the goods and services can be selected in traditional bricks and mortar retail premises, or from perusal of Internet websites. However, I do not discount aural considerations such as word of mouth recommendations.

## **Comparison of the marks**

54. 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 Court of Justice of the European Union 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.”

55. 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.

56. The marks to be compared are:

Opponent's marks	Applicant's mark
<p>EU TM 7008477:</p> 	<p>Ethea</p>
<p>EU TM 9284191:</p> <p>ERREA'</p>	
<p>EU TM10757243:</p> 	

57. The applicant's mark is a word mark, **Ethea**, presented in title case. The overall impression of the mark resides solely in this word.

58. The opponent's figurative mark ending '477 is a composite arrangement of a double diamond type device in black with a white and black outline surmounted above the word **errea**, presented in lower case in a bold font. The size and positioning of the device element gives it a significant impact and both elements contribute equally to the overall impression of the mark.

59. The opponent's word mark ending '191 consists of **ERREA**' presented in capital letters followed by an apostrophe. I do not think the apostrophe will be seen as particularly significant as no letters follow it which would give it some meaning and in my view it is likely to be overlooked, coming as it does at the end of the word. The overall impression of this mark resides in the word **ERREA** itself.

60. The opponent's figurative mark ending '243 consists of the words **Errea Est 1988** in title case presented in a stylised manuscript style font. The words and numeral **Est 1988** are presented below **Errea** and are much smaller in scale. It is quite common for organisations to denote their dates of establishment in this format and consumers are used to seeing this particular information as part of marks, brands, advertising material etc so will not pay this element much attention. The overall impression of this mark will reside in the stylised word **Errea**.

### **Visual, aural and conceptual comparison to opponent's mark ending '477**

61. Visually, the applicant's and opponent's marks are both 5 letters long and share E, E and A as their first, fourth and fifth letters. The marks differ as to their second and third letters, which are TH in the applicant's mark and RR in the opponent's mark. The applicant's mark has no other aspect to it whereas the opponent's mark contains a substantial device element. Overall I find there to be a low to medium degree of similarity.

62. Aurally, the marks will be pronounced differently although both will begin and end with the same sound, i.e. an 'eh' sound to begin and an 'ee-ah' sound to end. The opponent's device element will not be verbalised so forms no part of an aural comparison. Overall I find there to be a low degree of similarity.

63. Conceptually, the opponent's mark will be seen as an invented word and as such has no concept. The applicant submits that **Ethea** is the plural of the word ethos and is a dictionary defined word. It may be the case that some consumers will know this definition but it is by no means a certain assumption and in my view most consumers will see it was an invented word. In which case I find the marks are conceptually neutral.

#### **Visual, aural and conceptual comparison to opponent's mark ending '191**

64. As stated in the previous visual comparison, the applicant's and opponent's marks are both 5 letters long and share E, E and A as their first, fourth and fifth letters. The marks differ as to their second and third letters, which are TH in the applicant's mark and RR in the opponent's mark. The only other visual difference is the additional apostrophe in the opponent's mark which I have previously found to have little overall significance within the mark. Overall, I find there is a low to medium degree of similarity.

65. As stated in the previous aural comparison, both marks will be pronounced differently although they begin and end with the same sound, i.e. an 'eh' sound to begin and an 'ee-ah' sound to end. The apostrophe element in the opponent's mark will not be verbalised so does not form part of any aural comparison. Overall, I find there to be a low degree of similarity.

66. With regard to a conceptual comparison, my previous finding is relevant here and I regard the marks as being conceptual neutral.

#### **Visual, aural and conceptual comparison to opponent's mark ending '243**

67. As stated in the previous visual comparison, the applicant's and opponent's dominant word element are both 5 letters long and share E, E and A as their first, fourth and fifth letters. The dominant word elements differ as to their second and third letters, which are TH in the applicant's mark and RR in the opponent's mark. In terms of visual difference, the opponent's mark has the additional **Est 1988** word and

numeral element. Moreover the manuscript style font makes the mark look different from the plain font of the applicant's mark. Overall, I find there is a low to medium degree of similarity.

68. As stated previously, the dominant word element of both marks will be pronounced differently although they begin and end with the same sound, i.e. an 'eh' sound to begin and an 'ee-ah' sound to end. The obvious aural difference is the additional word and numeral element, **Est 1988**, which may also be verbalised in the opponent's mark. Overall, I find there is a low degree of similarity between these particular marks.

69. Conceptually this particular mark of the opponent's has an additional element, ie **Est 1988**, which is likely to form a some kind of conceptual hook in that the element preceding it, **Errea**, was established in the year 1988. My previous finding as to the concept of the applicant's mark is relevant here and overall I find the marks to be conceptually different.

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

70. The distinctive character of the earlier mark must be considered. The more distinctive it is, either inherently or through use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

71. The opponent’s marks are invented words which have no meaning in relation to the good and services so I consider them to be inherently distinctive to a high degree. Although the opponent filed evidence showing use of the earlier marks, this does not put the opponent in any stronger position with regard to the distinctiveness of the earlier marks. In particular the evidence did not demonstrate any use in classes 3 and 14 and only a single instance of use in class 18. Although the evidence did demonstrate use in classes 25 and 35, the deficiencies such as a lack of information on market share means that it did not establish a knowledge threshold, still less an enhanced ability to distinguish its goods and services.

### **Likelihood of confusion**

72. I now draw together my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors and those outlined in paragraph 27:

- a) The interdependency principle, whereby a lesser degree of similarity between the goods may be offset by a greater similarity between the marks, and vice versa (*Canon*).
- b) The principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*).

- c) Imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer*).

73. Confusion can be direct (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”.

75. Whereas in *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., also sitting as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

76. So far, I have found that some of the contested goods and services are identical and some are similar to a low, medium and high degree. I also found that some of the applicant’s goods were dissimilar to the opponent’s goods and services. In addition, I found that average consumer will pay a normal to high level of attention

during a primarily visual purchasing process and that the earlier marks have a high level of inherent distinctiveness. In the comparison of the marks I found they were visually similar only to a low to medium degree, aurally similar to a low degree and conceptually neutral.

77. Although I have found that there are some visual similarities between the marks, sharing as they do three letters in common, these are outweighed by the visual, aural and conceptual differences. The visual differences created by the forms of presentation in the opponent's mark ending '477 and '243 are, in my view, sufficient for the average consumer not to mistake one mark for the others. The opponent's mark ending '191 has a minimal visual 'extra' in the form of the apostrophe but it is essentially a word mark so comes closer to the applicant's mark in a visual sense. But none of the marks have an immediately graspable concept so there is nothing to assist a consumer with fixing the marks in their mind. So taking the notion of imperfect recollection into account I do not consider there to be a likelihood of direct confusion between the applicant's mark and the opponent's marks, on the part of an average consumer paying a normal to high level of attention. I also do not consider that the average consumer is likely to believe that the respective goods come from the same or linked undertakings simply because the mark share three letters in common. I am guided by the Appointed Person's finding in the *Duebros* decision extract given above that one mark may call to mind the other marks but this is an association not indirect confusion.

77. The opposition fails under section 5(2)(b).

### **Section 5(3)**

78. I must now consider section 5(3). The opponent relies on its marks ending '477 and '191 under this ground. Section 5(3) of the Act states:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international

trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

79. The leading cases are the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Addidas-Salomon*, [2004] ETMR 10 and C-487/07, *L’Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark’s reputation and distinctiveness; *Intel*, paragraph 42

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be

assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel*, paragraphs 76 and 77.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel*, paragraph 74.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV*, paragraph 40.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks*

*and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure).*

## **Reputation**

80. In *General Motors* the CJEU stated:

“The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products of services covered by that trade mark”.

81. In my review of the evidence, I found that the opponent's evidence demonstrated use on sports clothing in class 25 and retail of same in class 35. Turnover figures were provided for sales in the UK but no context was provided as to size of the sportswear market in the UK and what market share is held by the opponent. Whilst Ms Fabbiani declares in paragraph 9 of her witness statement that the opponent is “...regarded as one of the leading brands in relation to such sportswear at both national and international level”, this is not contextualised or supported by evidence such as market share, evidence from trade bodies or from individuals with standing in the sportswear sector. I do not find that the opponent has demonstrated the necessary reputation so does not clear the first hurdle required for Section 5(3).

82. The opposition fails under section 5(3).

## **Conclusion**

83. The opposition fails in its entirety. The application may proceed to registration.

## **Costs**

84. The applicant has been successful and is therefore, in principle, entitled to a contribution towards its costs. As the applicant is unrepresented, at the conclusion of the evidence rounds the tribunal invited them, in the official letter dated 2 May 2018, to indicate whether they wished to make a request for an award of costs, and if so, to

complete a pro-forma including a breakdown of their actual costs, including providing accurate estimates of the number of hours spent on a range of given activities relating to the defence of the opposition; it was made clear to the applicant that if the pro-forma was not completed “no costs will be awarded”. The applicant did not respond to that invitation. Consequently, I make no order as to costs.

**Dated this 8<sup>th</sup> day of October 2018**

*J Ralph*

**June Ralph  
For the Registrar  
The Comptroller-General**