

O/696/18

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION UK3093228 IN THE NAME OF
BRAND PROTECTION LTD

FOR THE TRADE MARK

Banned Member

IN CLASSES 21 AND 25

AND

THE APPLICATION FOR DECLARATION OF INVALIDITY THERETO UNDER
NUMBER 501931

BY

BANNED APPAREL LTD

Background and Pleadings

1. Brand Protection Ltd (the Proprietor) is the registered proprietor of a UK trade mark No 3093228, shown on the front cover page of this decision, filed on the 7 February 2015, published for opposition on 10 April 2015 and registered on 24 July 2015, for the following goods:

Class 21: Household or kitchen utensils and containers; Water Bottles, Cups, Glasses, Plates, Bowls, combs and sponges; brushes (except paintbrushes); brush-making materials; articles for cleaning purposes; steel wool; electric and non-electric toothbrushes.

Class 25: Footwear, headgear; casual clothing, jeans, lined and unlined jackets, short sleeve and long sleeve shirts, baggy shorts, trousers, fleece pullovers, socks, skirts, shorts, scarves, gloves, Baby Sleep Suits, underwear.

2. Banned Apparel Ltd (the Applicant) filed an application for invalidation of the Proprietor's registration on the 3 January 2018 under section 47 of the Trade Marks Act 1994 ("the Act"). The ground for the application for invalidation is based on section 5(2)(b) of the Act. The invalidation is limited to goods in class 25.

3. The Applicant relies on ownership of its two earlier marks¹; UK registration number 2584420 (Mark 1) and EU registration number 11313533(Mark 2) in classes 18, 25 and 35. The Applicant's marks are detailed below:

UK2584420 MARK 1	EU011313533 MARK 2
BANNED	

¹ Originally registered under the name of Synil Syal but assigned to Banned Apparel Ltd on 30th January 2018

FILED: 14 JUNE 2011	FILED: 1 NOVEMBER 2012
PUBLISHED: 8 JULY 2011	PUBLISHED: 20 NOVEMBER 2012
REGISTERED: 16 SEPTEMBER 2011	REGISTERED: 27 FEBRUARY 2013

i. "BANNED" Mark 1

Class 18: Articles made of leather or imitation leather; bags, handbags, shoulder bags, holdalls, wallets, billfolds, belt bags, purses, credit card holders, wallets or cases incorporating cheque book holders; articles of luggage; baggage; luggage tags; briefcases, business card cases, key cases, gym bags, shopping bags; travelling bags, trunks, suitcases; satchels, haversacks, rucksacks, knapsacks, backpacks, beach bags, game bags, tote bags; umbrellas and parasols; vanity cases (unfitted); toiletry bags, cosmetic bags; parts and fittings for the aforesaid goods.

Class 25: Clothing, footwear, headgear

Class 35: Electronic shopping, retail and wholesale services, all connected with articles made of leather or imitation leather, bags, handbags, shoulder bags, holdalls, wallets, billfolds, belt bags, purses, credit card holders, wallets or cases incorporating cheque book holders, articles of luggage, baggage, luggage tags, briefcases, business card cases, key cases, gym bags, shopping bags, travelling bags, trunks, suitcases, satchels, haversacks, rucksacks, knapsacks, backpacks, beach bags, game bags, tote bags, umbrellas and parasols, vanity cases (unfitted), toiletry bags, cosmetic bags, clothing, footwear, headgear, parts and fittings for all the aforesaid goods.

ii. MARK 2



Class 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.

Class 25: Clothing, footwear, headgear.

Class 35: Electronic shopping, retail and wholesale services, all connected with articles made of leather or imitation leather, bags, handbags, shoulder bags, holdalls, wallets, billfolds, belt bags, purses, credit card holders, wallets or cases incorporating cheque book holders, articles of luggage, baggage, luggage tags, briefcases, business card cases, key cases, gym bags, shopping bags, travelling bags, trunks, suitcases, satchels, haversacks, rucksacks, knapsacks, backpacks, beach bags, game bags, tote bags, umbrellas and parasols, vanity cases (unfitted), toiletry bags, cosmetic bags, clothing, footwear, headgear, parts and fittings for all the aforesaid goods.

4. The Applicant relies on all its goods and services in class 18, 25 and 35 for which the earlier marks are registered claiming that there is a likelihood of confusion because the trade marks are similar and are registered for goods and services identical with or similar to those for which the earlier mark is registered.

5. The Proprietor filed a defence and counterstatement denying the claims made. Although Mark 1 has been registered for over five years on the date on which the application for a declaration was filed, the Proprietor has not put the Applicant to proof of use of earlier Mark 1. Consequently, it can rely upon all of the goods claimed.

Furthermore, in addition to the Applicant not being required to prove use of this mark, I consider that this mark represented the stronger case for the Applicant. If it cannot succeed under Mark 1, it will be in no better position in relation to Mark 2. Therefore, I will confine my assessment of the invalidation grounds to Mark 1.

6. The Proprietor is represented by Murgitroyd & Company, the Applicant is represented by Sanderson & Co. Neither party filed evidence. Neither party requested a hearing however the Applicant filed further submissions in lieu of hearing. The decision is taken upon the careful perusal of the papers and the parties' submissions.

Decision

7. Section 47(2) of the Act sets out the provisions upon which section 5(2)(b) apply namely:

47. - (2) The registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

8. The invalidation is based on section 5(2)(b) of the Act which states:

“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”.

9. An earlier trade mark is defined in section 6 of the Act, which states:

“6. - (1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

10. Given the filing date for the Applicant’s trade marks, they qualify as earlier trade marks by virtue of section 6 of the Act.

11. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a 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

12. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) 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 für 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”.

13. The Applicant limits its application for invalidation to the Proprietor's goods in class

25. The competing goods are as follows:

Class 25

Registered Proprietor	Applicant for Cancellation
Footwear; headgear; socks	Footwear, headgear
Casual clothing, jeans, lined and unlined jackets, short sleeve and long sleeve shirts, baggy shorts, trousers, fleece pullovers, socks, skirts, shorts, scarves, gloves, Baby Sleep Suits, underwear	Clothing

14. I note that all the goods in the Proprietor's specification are identical to the Applicant's goods by use of the identical words or according to the principles outlined in *Meric*. I need not therefore go on to consider the position based upon the goods and services in classes 18 and 35 as this would not put the Applicant in any better position and it is not challenging the mark in relation to goods in class 21.

Average consumer

15. When considering the opposing trade marks, I must determine first who the average consumer is for the identical goods and the purchasing selection process.

16. 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.”

17. The Proprietor submits that their clothing brand focuses on “*musicians, musical instruments and more generally music*” and that the “*target audiences and products offered are very distinct and couldn’t be further removed*”.

18. The Applicant submits that “*specialism in certain products is irrelevant*” as no evidence has been produced to limit the Proprietor’s use of its mark for targeted consumers. They add, even if there had been evidence filed as to use, the Proprietor’s goods would still fall within scope of identical goods within their general clothing classification.

19. The applicant is correct in its submissions. In *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06, the Court of Justice of the European Union stated at paragraph 66 of its judgment that when assessing the likelihood of confusion under Section 5(2) it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered.

20. I am also guided by *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P, where the Court of Justice of the European Union stated that:

“59. As regards the fact that the particular circumstances in which the goods in question were marketed were not taken into account, the Court of First Instance was fully entitled to hold that, since these may vary in time and

depending on the wishes of the proprietors of the opposing marks, it is inappropriate to take those circumstances into account in the prospective analysis of the likelihood of confusion between those marks.”

21. The average consumer for both sets of goods at issue is a member of the general public who is likely to choose the goods from a shop or online, through self-selection or by word of mouth recommendations. The purchasing process is more likely to be visual rather than aural. The purchasing process may be undertaken by business users namely wholesalers buying in bulk or negotiating contracts and they may therefore pay a slightly higher level of care in their selection process. However, considering the goods at issue, the average consumer will take into account the price, fit and quality of the clothing and pay an average level of care in that purchasing decision.

Comparison of trade marks

22. 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.”

23. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to consider 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 to be compared are shown below:

Proprietor's Mark	Applicant's Mark
Banned Member	BANNED

25. The Proprietor submits that there is

“No strong similarity between the logos, in terms of stylisation ours featuring musical notes which again reinforces the target market and ethos of the brand.”

26. I must compare the marks however as they have been registered not as they are used, as stated in *J.W.Spear & Sons Ltd and Others v Zynga Inc.* [2015] EWCA Civ 290, in which Floyd L.J. considered the CJEU's judgment in *Specsavers*, Case C-252/12, which was submitted as establishing that matter used with, but extraneous to, the earlier mark should be taken into account in assessing the likelihood of confusion with a later mark. The judge stated:

“46. Mr Silverleaf submitted that, in the light of this guidance, the proposition stated by Jacob LJ in *L'Oreal* can no longer be regarded as representing the law. He starts by recognising that acquired distinctiveness of a trade mark has long been required to be taken into account when considering the likelihood of confusion. He goes on to submit that *Specsavers* in the CJEU has made it clear that the acquired distinctiveness to which regard may properly be had included not only matter appearing on the register, but also matter which could only be

discerned by use. The colour, on which reliance could be placed in Specsavers, was matter extraneous to the mark as it appeared on the register. It followed that if something appears routinely and uniformly in immediate association with the mark when used by the proprietor, it should be taken into account as part of the relevant context.

47. I am unable to accept these submissions. The CJEU's ruling does not go far enough for Mr Silverleaf's purposes. The matter not discernible from the register in Specsavers was the colour in which a mark registered in black and white was used. It is true that in one sense the colour in which a mark is used can be described as "extraneous matter", given that the mark is registered in black and white. But at [37] of its judgment the court speaks of colour as affecting "*how the average consumer of the goods at issue perceives that trade mark*" and in [38] of "*the use which has been made of it [i.e. the trade mark] in that colour or combination of colours*". By contrast Mr Silverleaf's submission asks us to take into account matter which has been routinely and uniformly used "*in association with the mark*". Nothing in the court's ruling requires one to go that far. The matters on which Mr Silverleaf wishes to rely are not matters which affect the average consumer's perception of the mark itself."

27. The Proprietor's mark consists of two words "Banned Member" presented in conventional font in title case. Both words and their meanings will be well known to the average UK consumer. The word "banned" is a verb in the past tense qualifying the status of the noun "member". The average consumer however will not spend time considering whether the word or words in a mark is a verb or a noun but will simply look at the mark as a whole and will see the mark as meaning a member who is banned from something. The Proprietor submits that

"I refute the statement that the focus of our mark is on the word Banned – far from member being the much less conspicuous element as argued the two words should be seen in tandem not in solace. "

“Even the stylisation of the Banned Member logo demonstrates there is no emphasis placed on either word individually both are integral. “

28. I agree that neither word is more dominant than the other in the overall impression of the mark.

29. The Applicant’s mark consists of a single word “BANNED” presented in capital letters and again will be a well known English word meaning excluded or prohibited from something. The overall impression and distinctiveness of the mark rests in the totality of the word.

Visual

30. The common element and the only point of visual similarity is the word “Banned”, which is identical in both marks². The difference between the respective marks rests in the inclusion of the word “Member” which is in the Proprietor’s mark but which is absent from the Applicant’s. I consider that there is a medium degree of visual similarity between the two.

Aural

31. From an aural perspective the Applicant’s mark comprises of one word “BANNED”. This is identical in both marks with the Proprietor’s mark consisting of a further verbal element namely “member”. The component “banned” will be articulated in an identical manner in both marks. As a result, I determine that there is a good degree of aural similarity between the marks as “banned” is the first word which will be heard.

² Registration of a trade mark in capital letters covers use in a lower case, as stated by professor Ruth Annand, sitting as the Appointed person , in Bentley motors Limited v Bentley 1962 Limited BL O/158/17

Conceptual

32. Conceptually the word “banned” in both marks is the most distinctive and will be taken as a reference to an individual being prohibited from something. By adding the element “member” it merely qualifies the person being prohibited. “Banned” in isolation refers to a generalisation whereas the addition of the word “member” specifies who is banned; “member” by itself is unlikely to add any further conceptual element to the mark. Both allude to the user being someone who is excluded by not obeying the rules.

33. The Proprietor submits that

“Our use of the word Banned within banned member is clearly a play on the word band yet serves to highlight the offbeat, sometimes taboo slogans we utilise such as Drummers Love to Bang.”

For a conceptual message to be relevant it must be immediately obvious to the average consumer³. For the purpose of this comparison the mark must be considered in its registered form, without added contextual text or logos. Some consumers will immediately recognise the play on words when encountering the Proprietor’s mark and perceive it to mean “band member”, for others this will only arise when encountering the mark aurally. However, the average UK consumer would not necessarily understand or immediately recognise the play on words in either scenario. Where clothing is concerned the visual perception of the marks takes place prior to purchase.⁴

34. I therefore find that the marks are conceptually similar to a good degree if the Proprietor’s mark is simply seen as someone who is banned. If, however, the play on words is recognised, the conceptual similarity will still be medium because for the play

³ Ruiz Picasso v OHIM [2006] e.c.r.I-643; [2006] E.T.M.R.29.

⁴ New Look Limited v OHIM, joined cases T-117/03 to T-119/03 and T-171/03

on words to work, the consumer must also appreciate the meaning of banned as opposed to band.

Distinctiveness

35. The degree of distinctiveness of the earlier mark is important as this directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark the greater likelihood of confusion. As no evidence has been filed by the Applicant regarding use of its mark then the matter must be considered based on inherent characteristics.

36. 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).”

37. The earlier mark consists of the word “banned” which is clearly an English word. It has some allusive quality suggestive of something anti-establishment or prohibitive but does not have any direct meaning in relation to clothing. No evidence has been filed either, linking the word with the goods covered by the registration. The level of distinctive character is therefore average.

Likelihood of confusion

38. When considering whether there is a likelihood of confusion between the two marks I must consider whether there is direct confusion, where one mark is mistaken for the other or whether there is indirect confusion where the similarities between the marks lead the consumer to believe that the respective goods originate from the same or related source.

39. In determining whether there is a likelihood of confusion there are a number of factors to bear in mind. The first is the interdependency principle i.e. a greater degree of similarity between the respective goods and services may be offset by a lesser degree of similarity between the respective trade marks and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the Applicant’s trade mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must consider 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.

40. I consider that the conceptual meaning of 'banned member' is not sufficiently different to 'banned' to counteract the aural and visual similarities between the mark. If the play on words is not recognised, there is a good degree of conceptual similarity and, even if the play on words is recognised, the conceptual similarity is still medium, for the reasons given above. Factoring in the identical goods and a no more than average level of attention, the marks may be imperfectly recalled, causing a likelihood of confusion.

41. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained 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 recognised 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, I conclude that it is another brand of the owner of the earlier mark.”

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example.”

42. In case I am wrong about direct confusion, I will consider indirect confusion as explained in *L.A.Sugar*. The earlier mark has an average degree of distinctive character for the goods. The addition of the element “member” would not merely call to mind the other mark in the purchaser’s mind, but lead him to perceive the proprietor’s mark as a sub brand or extension of the earlier mark. There is sufficient similarity in the Proprietor’s mark to give the impression that it is a variant mark used by the same undertaking or linked trade source. There is therefore a likelihood of indirect confusion.

43. The application for cancellation therefore succeeds for goods in class 25. Under section 47(6) of the Act, the registration for the class 25 goods is deemed never to have been made. The proprietor’s trade mark remains validly registered for the goods in class 21, there being no objection raised for these goods.

44. The Applicant has been successful and is entitled to a contribution towards its costs, based on the scale are governed by Tribunal Practice Notice 2/2016 below:

Preparing an application for invalidation and
considering the counterstatement

£200

Preparing submissions in lieu of hearing	£300
Official Fee	£200
Total	£700

45. I order Brand Protection Ltd to pay Banned Apparel Ltd the sum of £700 as a contribution towards its costs. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case, if any appeal against this decision is unsuccessful.

Dated this 6th day of November 2018

Leisa Davies
For the Registrar