O/0589/24

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003935133
BY DEMIGODS GROUP LTD
TO REGISTER THE FOLLOWING TRADE MARK:

DEMIGODS

IN CLASS 25 AND 35

AND IN THE MATTER OF FAST TRACK OPPOSITION THERETO
UNDER NO. 600003065
BY ALEXA DEMIE

BACKGROUND AND PLEADINGS

1. On 18 July 2023, Demigods Group Ltd ("the applicant") applied to register the trade mark shown on the cover page of this decision, in the UK. The application was published for opposition purposes on 11 August 2023 and registration is sought for the following goods and services:

Class 25 Footwear; Shoes; Trainers [footwear]; Gym boots; Athletic shoes; Sport shoes; Sneakers [footwear]; Slip-on shoes; Espadrilles; Waterproof shoes; Hiking shoes; Walking shoes; Deck shoes; Shoes for leisurewear; Shoes for casual wear; Running shoes; Leather shoes; Golf shoes; Yoga shoes; Flip-flops; Sandals; Sandals and beach shoes; Slippers; Boot uppers; Footwear uppers; Soles for footwear; Inner soles; Tips for footwear; Studs for football boots [shoes]; Gymnastic footwear; Low-top shoes; Football shoes; cleats for attachment to sports shoes; Underwear; Socks; Toe socks; Belts; Headbands; Hats; Caps; Bandanas; Scarves; Sweatbands; Articles of sports footwear all included in Class 25.

Class 35 Retail services relating to footwear, underwear, socks, toe socks, belts, headbands, hats, caps, bandanas; scarves and sweatbands.

2. On 9 October 2023, the application was opposed under the fast track opposition scheme by Alexa Demie ("the opponent") based upon section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opponent relies upon IR no. 1585036 designating the UK for the mark **DEMIEGOD**.[1] The opponent's mark was registered on 6 February 2021 and, with effect from the same date, the opponent sought protection of the IR in the UK. Protection was subsequently granted on 12 August 2021. The opponent relies upon all goods for which the mark is registered, namely:

[1] Although the opponent's mark appears in a slightly different font on the UK Register, I note that it is listed as a word only mark.

Class 25 Shirts; sweatshirts; T-shirts.

3. The opponent claims that the respective marks are similar, and the goods are identical or similar, resulting in a likelihood of confusion.

4. The applicant filed a counterstatement denying the claims made.

5. Rule 6 of the Trade Marks (Fast Track Opposition (Amendment) Rules 2013, S.I. 2013 2235 disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but it provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

> "(4) The registrar may, at any time, give live to either party to file evidence upon such terms as the registrar thinks fit."

6. The effect of the above is to require parties to seek leave in order to file evidence in fast track oppositions. Further, Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it, or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken.

7. In this case, neither party sought leave to file evidence. A hearing was neither requested nor was it considered necessary. The opponent did, however, elect to file written submissions in lieu dated 15 February 2024. This decision is taken following a careful consideration of all papers on file.

REPRESENTATION

8. The opponent is represented by ip21 Limited and the applicant is represented by Briffa.

RELEVANCE OF EU LAW

9. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

DECISION

10. Sections 5(2)(b) and 5A are as follows:

> "5(2) A trade mark shall not be registered if because –
>
> > (a) […]
> >
> > (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,
>
> there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.
>
> […]
>
> 5A. Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only."

11. The mark relied upon by the opponent qualifies as an earlier trade mark pursuant to section 6 of the Act. As the earlier mark had not completed its registration process more than 5 years prior to the filing date of the application in issue, it is not subject to

the use provisions in section 6A of the Act. Consequently, the opponent can rely upon all of the goods for which the earlier mark is registered.

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

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

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

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

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

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

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

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

Comparison of goods

13. The competing goods are shown below:

Opponent's goods	**Applicant's goods**
Class 25 Shirts; sweatshirts; T-shirts.	Class 25 Footwear; Shoes; Trainers [footwear]; Gym boots; Athletic shoes; Sport shoes; Sneakers [footwear]; Slip-on shoes; Espadrilles; Waterproof shoes; Hiking shoes; Walking shoes; Deck shoes; Shoes

	for leisurewear; Shoes for casual wear; Running shoes; Leather shoes; ; Golf shoes; Yoga shoes; Flip-flops; Sandals; Sandals and beach shoes; Slippers; Boot uppers; Footwear uppers; Soles for footwear; Inner soles; Tips for footwear; Studs for football boots [shoes]; Gymnastic footwear; Low-top shoes; Football shoes; cleats for attachment to sports shoes; Underwear; Socks; Toe socks; Belts; Headbands; Hats; Caps; Bandanas; Scarves; Sweatbands; Articles of sports footwear all included in Class 25. <u>Class 35</u> Retail services relating to footwear, underwear, socks, toe socks, belts, headbands, hats, caps, bandanas; scarves and sweatbands.

14. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 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."

15. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) 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;

(f) 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.

16. In *Gérard Meric v OHIM,* Case T-133/05, the General Court stated that:

"29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by 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."

17. I bear in mind that it is permissible to group goods together for the purposes of assessment.[2]

Class 25

Underwear; Socks; Toe socks.

18. These are all items of clothing. They are likely to be sold through the same trade channels to the same users as the opponent's goods. They also overlap in nature, as they are likely to be made from the same materials and be fitted for wearing on the body. They will overlap in purpose, as they are all intended to cover the body for the purposes of warmth/comfort/modesty. The method of use will be similar, albeit they will be worn on different parts of the body. The goods are not in competition, given that they are items of clothing aimed at different partes of the body and are not complementary (as one is not important or indispensable for the other).[2] In my view, the goods are highly similar.

Footwear; Shoes; Trainers [footwear]; Gym boots; Athletic shoes; Sport shoes; Sneakers [footwear]; Slip-on shoes; Espadrilles; Waterproof shoes; Hiking shoes; Walking shoes; Deck shoes; Shoes for leisurewear; Shoes for casual wear; Running shoes; Leather shoes; Golf shoes; Yoga shoes; Flip-flops; Sandals; Sandals and beach shoes; Slippers; Gymnastic footwear; Low-top shoes; Football shoes; Articles of sports footwear all included in Class 25.

19. All of these goods are types of footwear. In my view, they are likely to be sold through the same trade channels, to the same users as the opponent's goods. Whilst I note that some of these goods are types of specialist footwear (such as gymnastics shoes or golf shoes) the opponent's goods might also include clothing aimed at those users. The method of use, nature and purpose of the goods will overlap with the opponent's goods to the extent that they are all applied to the body for the purposes of warmth and comfort. However, they differ in that they may be made of different materials and are worn on different parts of the body. The goods are not in competition, nor are they complementary. In my view, the goods are similar to a medium degree.

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[2] *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

Boot uppers; Footwear uppers; Soles for footwear; Inner soles; Tips for footwear; Studs for football boots [shoes]; cleats for attachment to sports shoes.

20. All of these goods are parts of footwear. There may be some overlap in trade channels in that a customer may return to the original seller (being a footwear/clothing retailer) for repairs/replacement parts. This is particularly likely in the case of, for example, sporting products. For example, it is likely that a retailer that sells sports t-shirts and football boots, might also provide replacement parts for those boots. Consequently, I consider that there may be some overlap in trade channels. There is also, plainly, an overlap in user. The nature, method of use and purpose of the goods differs. They are not in competition, nor are they complementary. In my view, they are similar to a low degree.

Belts; Headbands; Hats; Caps; Bandanas; Scarves; Sweatbands.

21. These are all goods that are likely to be sold through the same trade channels to the same users as the opponent's goods. The method of use, nature and purpose of the goods may overlap in that they may share some common materials and they are all worn on the body. However, there will be differences created by the fact that the goods are worn on different parts of the body. The goods are neither in competition, nor complementary. In my view, the goods are similar to a medium degree.

<u>Class 35</u>

Retail services relating to footwear, underwear, socks, toe socks, belts, headbands, hats, caps, bandanas; scarves and sweatbands.

22. For the same reasons set out above, I consider it likely that these retail services will be sold through the same trade channels to the same users as the opponent's goods. The nature, method of use and purpose of the goods clearly differ. They are not in competition, nor are they complementary. I consider them to be similar to a low degree.

The average consumer and the purchasing act

23. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then determine the manner in which the goods and services are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited,* [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

> "60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The word "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

24. The average consumer for the goods and services is likely to be a member of the general public. The goods and services are unlikely to be particularly expensive purchases. They are not likely to be purchased every day, although will be purchased reasonably frequently. For the goods, factors such as materials, aesthetics and comfort are likely to be taken into consideration. For the services, factors such as location, range of products and customer services standards are likely to be taken into consideration. Consequently, I consider that the average consumer will pay a medium (or average) degree of attention during the purchasing process.

25. The goods are likely to be purchased by self-selection from the shelves of a retail outlet, or online equivalent. Similarly, the services are likely to be purchased following perusal of a website or signage on physical premises. Consequently, visual considerations will dominate the selection process. However, I do not discount an aural component to the purchase given that advice may be sought from retail assistants and word-of-mouth recommendations may play a part.

Comparison of marks

26. It is clear from *Sabel* that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo*, 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 relevant 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."

27. It would be wrong, therefore, to dissect the trade marks artificially, although it is necessary to take into account the distinctive and dominant components of the trade 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.

28. The trade marks to be compared are as follows:

The opponent's mark	**The applicant's mark**
DEMIEGOD	DEMIGODS

29. Both marks consist of a single word in which the overall impression resides.

30. Visually, the marks coincide in the first four letters, DEMI-, which are in the same order. They also coincide in the presence of the word GOD within the mark. They differ in that there is a letter E separating the DEMI- and -GOD elements in the opponent's

mark, which has no counterpart in the applicant's mark. As submitted by the opponent, the impact of this additional letter is likely to be reduced by virtue of it appearing in the middle of the mark. Further, the last letter in the applicant's mark is S, which has no counterpart in the opponent's mark. In my view, the marks are visually highly similar.

31. Aurally, the opponent's mark is likely to be pronounced DEM-EEE-GOD. The applicant's mark is likely to be pronounced DEM-EEE-GODS. In my view, they are aurally highly similar.

32. Conceptually, I note the applicant's argument that the earlier mark is actually an invented word made up of the opponent's surname (DEMIE) and the word GOD. However, in my view, the opponent's mark is likely to be understood as referring to a Demigod, being someone who is half god and half human. I do not consider that the additional letter E will detract from this meaning. The applicant's mark will be understood as a reference to the same word, but pluralised. In my view, the marks are conceptually highly similar.

Distinctive character of the earlier mark

33. In *Lloyd Schuhfabrik Meyer* the CJEU stated that:

> "22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *WindsurfingChiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).
>
> 23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically

widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee,* paragraph 51)."

34. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods/services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

35. The opponent has not filed evidence of use of its mark and so I have only the inherent position to consider. The earlier mark consists of the word DEMIEGOD. There may be some average consumers who believe that this is the correct spelling of the word DEMIGOD, which refers to someone who is half god, half human. Otherwise, it will be recognised as a misspelling of the same word. It has some laudatory connotations for the goods and services, in my view, as it may be seen as referring to the fact that the appearance of the wearer of the goods (or the goods to which the services relate) will be somewhat superior. With this in mind, I consider the earlier mark to be inherently distinctive to between a low and medium degree.

Likelihood of confusion

36. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods/services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle, i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and

vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

37. I have found as follows:

a) The goods and services vary from being similar to a low degree to highly similar.

b) The average consumer for the goods/services is a member of the general public who will pay a medium, or average, degree of attention during the purchasing process.

c) The purchasing process is predominantly visual, although I do not discount an aural component to the purchase.

d) The marks are visually, aurally and conceptually highly similar.

e) The earlier mark is inherently distinctive to between a low and medium degree.

38. I bear in mind that the fact that the distinctiveness of the earlier mark is relatively low does not preclude a likelihood of confusion.[3] In my view, taking into account the principle of imperfect recollection, the similarities between the marks are such that the average consumer will mistakenly recall one for the other. Whilst I bear in mind that some of the goods and services are similar to only a low degree, when applying the interdependency principle, I consider that the distance between the goods and services is offset by the similarity of the marks. Consequently, I consider there to be a likelihood of direct confusion for all goods and services in the application.

CONCLUSION

39. The opposition is successful and, subject to any successful appeal, the application is refused.

COSTS

40. The opponent has been successful and is, therefore, entitled to a contribution towards her costs, based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award the opponent the sum of **£525**, calculated as follows:

Preparing a Notice of opposition and considering the applicant's counterstatement	£175
Written submissions	£250
Official fee	£100
Total	**£525**

41. I therefore order Demigods Group Ltd to pay Alexa Demie the sum of £525. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 24th day of June 2024

S WILSON
For the Registrar