

O-070-07

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2369557A
BY NIGEL GEORGE BOWERBANK
TO REGISTER THE TRADE MARK:**

MICHELE X

IN CLASSES 18 AND 25

AND

**THE OPPOSITION THERETO
UNDER NO 94165
BY MICHELE TEXTIL-VERTRIEBSGESELLSCHAFT MBH**

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by Michele Textil-Vertriebsgesellschaft mbH**

BACKGROUND

1) On 30 July 2004 Nigel George Bowerbank applied to register the trade mark ***MICHELE X*** (the trade mark). The original application, no 2369557, was divided. This divided application was published for opposition purposes in the *Trade Marks Journal* on 18 November 2005 with the following specification:

whips and canes;

clothing, footwear, headgear.

The above goods are in classes 18 and 25 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

2) On 17 February 2006 Michele Textil-Vertriebsgesellschaft mbH, which I will refer to as MTV, filed a notice of opposition to the application. MTV is the owner of United Kingdom trade mark registration no 1486075 for the trade mark:



The application for registration was made on 31 October 1994 and the registration process was completed on 14 July 1995. The trade mark proceeded to publication on the basis of distinctiveness acquired through use. It is registered for *trousers and slacks*. These goods are in class 25 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended. MTV claims that in the five years prior to the publication of Mr Bowerbank's application it has used the trade mark in respect of all of the goods of the registration. MTV claims that its trade mark and that of Mr Bowerbank are similar and that the class 25 goods of the application are similar or identical to the

goods of its registration. Consequently, there is a likelihood of confusion in respect of the class 25 goods and registration of the trade mark in respect of these goods would be contrary to section 5(2)(b) of the Trade Marks Act 1994 (the Act).

3) Mr Bowerbank filed a counterstatement. He accepted the statement of use made by MTV. Mr Bowerbank disputes that his trademark is similar to the trade mark “Michele THAT’S FASHION (& device)” and he disputes that the respective trademarks would be confused. He states that the trade mark MICHELE X has been in constant use in the United Kingdom since 1975 in relation to clothing, footwear and headgear. If the trade mark “Michele THAT’S FASHION (& device)” has been in use since 1994 there has been no confusion, as far as he is aware.

4) Neither side filed any evidence.

5) The sides were advised that they had a right to a hearing and that if neither side requested a hearing a decision would be made from the papers and any written submissions that were received. Neither side requested a hearing; Both sides filed written submissions.

DECISION

Likelihood of confusion – section 5(2)(b) of the Act

6) According to section 5(2)(b) of the Act a trade mark shall not be registered if because:

“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.”

Section 6(1)(a) of the Act defines an earlier trade mark as:

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

MTV’s trade mark is an earlier trade mark within the meaning of the Act. Mr Bowerbank has accepted the claim on the use made by MTV; consequently, there is no issue to be decided in relation to this matter and the case must be decided on the basis of the specification of the registration.

7) In determining the question under section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ)¹ in *Sabel BV v Puma AG* [1998] RPC

¹ All judgments of the ECJ and the CFI are available for free downloading at the Internet address <http://curia.europa.eu/jurisp/cgi-bin/form.pl?lang=en>

199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* [2000] FSR 77 and *Vedial SA v Office for the Harmonization of the Internal Market (trade marks, designs and models) (OHIM) C-106/03 P*.

Average consumer and nature of purchasing decision

8) Clothes are bought and used by everyone; the average consumer is the public at large. In my experience, clothes are bought with some care; the average consumer is very conscious of the label, which is a very important part of the purchasing decision. In relation to clothing, the visual impact and effect of the trade mark is of the greatest importance; see to this effect the judgment of the Court of First Instance (CFI) in *Leder & Schuh AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-32/03*:

“The Board of Appeal was thus right in finding that, generally, the purchase of an item of clothing involves a visual examination of the marks (paragraph 23 of the contested decision).”

This was also the position of Simon Thorley QC, sitting as the appointed person, in *React Trade Mark* [2000] RPC 285 where he stated:

“There is no evidence to support Ms Clark's submission that, in the absence of any particular reputation, consumers select clothes by eye rather than by placing orders by word of mouth. Nevertheless, my own experience tells me it is true of most casual shopping. I have not overlooked the fact that catalogues and telephone orders play a significant role in this trade, but in my experience the initial selection of goods is still made by eye and subsequent order usually placed primarily by reference to a catalogue number. I am therefore prepared to accept that a majority of the public rely primarily on visual means to identify the trade origin of clothing, although I would not go so far as to say that aural means of identification are not relied upon.”

Comparison of goods

9) The specification of the earlier registration is: *trousers and slacks*. The specification of the application in class 25 is: *clothing, footwear, headgear*. The specification of the earlier registration is encompassed by the term *clothing*. In *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-133/05* the CFI stated:

“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.”

Consequently, it must be held that *clothing* is identical to the goods of the earlier registration.

10) In *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* the ECJ held in relation to the assessment of the similarity of goods and/or services that the following factors, inter alia, should be taken into account: their nature, their intended purpose (the original incorrect translation of ‘Verwendungszweck’ in the English version of the judgment has now been corrected), their method of use and whether they are in competition with each other or are complementary. In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, Jacob J considered that the following should be taken into account when assessing the similarity of goods and/or services:

- “(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.”

11) *Trousers and slacks* and *footwear* and *headgear* are all items that are worn on the person; they all, therefore, serve the same basic purpose although clearly they are used for different parts of the body. It is common practice for shops that sell clothes such as *trousers and slacks* to also sell *footwear* and *headgear*; although the converse is, in my experience, not normally the case ie shoe shops do not normally sell *trousers* and *slacks*. In the former case there is a common channel of trade; however, *trousers and slacks* would normally be in a different area of the shop to *footwear* and *headgear*. One would not substitute the former goods with the latter goods; therefore, I cannot see that the respective goods are in competition. All of the goods could be made of the same material eg leather; however, this does not take the matter a good deal further, many and diverse items are made of leather. The question of complementary goods/services has been considered by the CFI in *Sergio Rossi SpA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-169/03 and *Eurodrive Services and Distribution NV c Office de l’harmonisation dans le marché intérieur (marques, dessins et modèles) (OHMI)* Case T- 31/04. In the former case the CFI stated:

“60 According to the definition given by OHIM in paragraph 2.6.1 in Chapter 2 of Part 2 of the Opposition Guidelines, referred to in paragraph 35 above, complementary goods are goods which are closely connected in the sense that one is indispensable or important for the use of the other so that consumers may think that the same undertaking is responsible for the production of both goods.

61 In the present case, the applicant has failed to establish that, in terms of their function, the goods in question are complementary in this way. As is clear from paragraph 2.6.2 in Chapter 2 of Part 2 of the Opposition Guidelines, referred to in paragraph 35 above, OHIM appears to concede that the goods are aesthetically, and therefore subjectively, complementary in a way which is determined by the habits and preferences of consumers to which producers’ marketing strategies or even simple fashion trends may give rise.

62 However, the applicant has failed to demonstrate, during either the proceedings before OHIM or those before the Court, that this aesthetic or subjective complementary nature has reached the stage of a true aesthetic ‘necessity’ in the sense that consumers would think it unusual or shocking to carry a bag which does not perfectly match their shoes. The Court takes the view, first of all, that the search for a certain aesthetic harmony in clothing is a common feature in the entire fashion and clothing sector and is too general a factor to justify, by itself, a finding that all the goods concerned are complementary and, thus, similar. The Court observes, in addition, that the facts and evidence submitted by the applicant for the first time before the Court cannot, in the present case, call into question the lawfulness of the contested decision as shown in paragraphs 19 et seq. above.

63 Moreover, the fact that consumers regard a product as a complement of or accessory to another is not sufficient for them to believe that those products have the same commercial origin. For that to be the case, consumers would also have to consider it usual for those products to be sold under the same trade mark, which normally implies that a large number of the producers or distributors of the goods are the same.”

The respective goods, in my view, neither have a symbiotic nor mutually dependent relationship; nor, in the terms of the CFI, is there a “true aesthetic necessity” in matching the respective goods. Consequently, I do not consider that the respective goods are complementary.

12) Consequent upon the above, I consider that *trousers and slacks* of the earlier registration and *footwear and headgear* of the application are similar but to a low degree.

Comparison of trade marks

13) The trade marks to be compared are:

MTV's trade mark:



Mr Bowerbank's trade mark:



14) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Sabel BV v Puma AG*). The visual, aural and conceptual similarities of the marks must, therefore, be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components (*Sabel BV v Puma AG*). Consequently, I must not indulge in an artificial dissection of the trade marks, although taking into account any distinctive and dominant components. The average consumer 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 he/she is deemed to be reasonably well informed and reasonably circumspect and observant (*Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV*). "The analysis of the similarity between the signs in question constitutes an essential element of the global assessment of the likelihood of confusion. It must therefore, like that assessment, be done in relation to the perception of the relevant public" (*Succession Picasso v OHIM - DaimlerChrysler (PICARO)* Case T-185/02).

15) The trade mark is clearly a Michele X mark; the stylisation is minimal. The question is how will MTV's trade mark be perceived by the average consumer. I note that the name of the opponent is Michele Textil-Vertriebsgesellschaft mbH; I also note that in his counterstatement Mr Bowerbank refers to MTV's trade mark as "Michele THAT'S FASHION (& device)". I, however, have a good deal of difficulty in seeing MTV's trade mark in a similar manner. I have looked at the trade mark of MTV for some considerable time and cannot see it as representing the word Michele. The beginning of the word appears to me to be either a stylised w or three capitals c's; the stylisation of the other letters in the name makes it difficult to identify certain of them. It appears to me that the disputant's perception of MTV's trade mark is being confused by the knowledge of the name of the opponent; a knowledge that the average consumer in the normal purchasing scenario will not enjoy. I have to consider the trade mark of MTV without the bag and baggage of knowledge of the name of the owner.

16) I consider that the distinctive and dominant component of MTV's trade mark is the word element above the words THAT'S FASHION, those words are devoid of any distinctive character in relation to the goods of the registration. The distinctive and dominant component of Mr Bowerbank's is the word Michele; as a well-known female forename this will lodge in the memory, it is also the beginning and the largest part by far

of the trade mark. (I note that the forename can be spelt with a single or a double l, I do not consider that for the average consumer anything turns upon this.) This is not to say that the X element is not of importance, however, it is not the dominant and distinctive component. Taking the trade mark as a whole it seems to me that the X element will be seen as a substitute for a surname, as is sometimes used in court reports. It seems to me the trade mark of Mr Bowerbank “hangs together”.

17) As the trade mark consists of the female forename Michele and the letter X there is no conceptual similarity with the earlier trade mark; in fact there is conceptual dissimilarity. Of course, if the earlier trade mark was seen as containing the word Michele there would be a degree of conceptual similarity but I have already discounted this. The visual effects of the trade marks cannot be divorced from the conceptual associations, the perception of the average consumer will be influenced by his or her experiences. As the CFI in *Ontex NV v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T- 353/04* commented:

“68 It must be pointed out that although, strictly speaking, the visual impression of a sign consists of the overall impression it produces, the fact that some of its constituents produce a greater or lesser visual impact cannot be ruled out. That is also true in a case such as the present, in which the sign consists of a single word. The sequence ‘e-u-r-o’ of the earlier mark immediately attracts the visual attention of consumers. That is due to the multiple repetition, in consumers’ everyday life, of situations in which they are led to perceive various words constituted by that sequence of letters, including, in particular, the word ‘euro’, relating to the single currency, or even the words ‘Europe’ and ‘European’. The visual attraction of the sequence in question is instinctive. It does not, therefore, depend on a conceptual analysis of the earlier mark by consumers or on the fact that they attribute a specific meaning to it.”

In this case the dominant word element of the earlier trade mark is in a very cursive script; so cursive, as previously commented upon, that it is difficult to discern the exact nature of several of the letters. On the other hand, the trademark is in very clear upper case letters with a minimum of stylisation. Even taking into account imperfect recollection, I do not consider, taking into account all the differences between the two trade marks, that they can be considered to be visually similar. Owing to the extreme difficulty in reading the main word element of the earlier trade mark it is difficult to speculate as to the manner in which it is likely to be pronounced. If one has to enunciate the main word element of the earlier trade mark I am of the view that the first “ letter” is most likely to be pronounced as the letter W. The letters i and c followed by a letter that might be seen as a letter g, or the letters e and r; I have difficulty seeing this letter as an h. The last two letters also give rise to problems as to what they represent; the penultimate letter could be a letter l or c or e and the last letter has more of a c about it than an e. I consider that the best case that MTV can claim is that its trade mark would be pronounced as “wishell”, in this case the first consonant is very different to that of Michele, as is the first vowel; one being spoken as a short i sound and the other as a long

e sound. So even in the best case scenario for MTV, there is only a very limited phonetic similarity.

Conclusion

18) In considering whether there is a likelihood of confusion various factors have to be taken into account. There is the interdependency principle – a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*). In this case certain of the goods are identical, however, in relation to others there is only a limited degree of similarity. It is necessary to consider the distinctive character of the earlier trade mark; the more distinctive the earlier trade marks (either by nature or nurture) the greater the likelihood of confusion (*Sabel BV v Puma AG*). The distinctive character of a trade mark can be appraised only, first, by reference to the goods or services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public (European Court of First Instance Case T-79/00 *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91). 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] ETMR 585). As I have indicated it is difficult to decide what the dominant component of the earlier trade mark represents; it has the appearance of letters and so the presumption of the average consumer will be that it is a word, whether that consumer will go to the trouble of trying to decipher the word is another matter. As the dominant component neither describes nor alludes to the goods of the registration it can be accepted that it has a reasonable degree of distinctiveness, if more as a design rather than a word.

19) There is conceptual dissimilarity; in relation to confusion this is of importance. The CFI in *Phillips-Van Heusen Corp v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (*OHIM*) Case T-292/01 [2004] ETMR 60 stated:

“54. Next, it must be held that the conceptual differences which distinguish the marks at issue are such as to counteract to a large extent the visual and aural similarities pointed out in paragraphs 49 and 51 above. For there to be such a counteraction, at least one of the marks at issue must have, from the point of view of the relevant public, a clear and specific meaning so that the public is capable of grasping it immediately. In this case that is the position in relation to the word mark BASS, as has just been pointed out in the previous paragraph. Contrary to the findings of the Board of Appeal in paragraph 25 of the contested decision, that view is not invalidated by the fact that that word mark does not refer to any characteristic of the goods in respect of which the registration of the marks in question has been made. That fact does not prevent the relevant public from immediately grasping the meaning of that word mark. It is also irrelevant that,

since the dice game Pasch is not generally known, it is not certain that the word mark PASH has, from the point of view of the relevant public, a clear and specific meaning in the sense referred to above. The fact that one of the marks at issue has such a meaning is sufficient - where the other mark does not have such a meaning or only a totally different meaning - to counteract to a large extent the visual and aural similarities between the two marks.”

So a conceptual similarity can mean that there is no likelihood of confusion even when there are visual and/or phonetic similarities. In this case I have concluded that the trade marks are not visually similar. It is also important to take into account, as I have noted above, that in relation to clothing the visual impression is of key importance. The ECJ in *Mülhens GmbH & Co KG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case C-206/04 P commented upon the interplay between phonetic similarity and conceptual dissimilarity:

“21 It is conceivable that the marks’ phonetic similarity alone could create a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94 (see, in respect of Directive 89/104, *Lloyd Schuhfabrik Meyer*, paragraph 28). However, it must be noted that the existence of such a likelihood must be established as part of a global assessment as regards the conceptual, visual and aural similarities between the signs at issue. In that regard, the assessment of any aural similarity is but one of the relevant factors for the purpose of that global assessment.

22 Therefore, one cannot deduce from paragraph 28 of the judgment in *Lloyd Schuhfabrik Meyer* that there is necessarily a likelihood of confusion each time that mere phonetic similarity between two signs is established.

35 That global assessment means that conceptual and visual differences between two signs may counteract aural similarities between them, provided that at least one of those signs has, from the point of view of the relevant public, a clear and specific meaning, so that the public is capable of grasping it immediately (see, to that effect, Case C-361/04 P *Ruiz-Picasso and Others v OHIM* [2006] ECR I-0000, paragraph 20).”

20) I have already decided that any phonetic similarity is limited; the conceptual dissimilarity, therefore, has even greater effect. Added to this is the visual dissimilarity, a key matter in relation to the goods in question. Of course, at all times I keep in mind that I have to judge the issue through the eyes of the average consumer bearing in mind the nature of the goods; I also have to take into account that the average consumer rarely has the chance to compare trade marks directly and so is prone to imperfect recollection. In this case, in relation to the trade mark, the consumer has a clear conceptual hook to aid his or her recollection which will further militate against confusion.

21) Mr Bowerbank has submitted that there have been no instances of confusion. No evidence has been submitted in relation to use of either trademark. Consequently, I have

no idea when, where, how or whether the trade marks have been used. I do not know on what particular goods the trademark of Mr Bowerbank is alleged to have been used. If the trade marks have been used, they might have been used in very different markets, different geographical areas, and at different times. There is also no indication as to the scale of use; therefore the claim that there has been no confusion tells me nothing. The courts on several occasions have stated that absence of confusion cannot be equated with there being no likelihood of confusion. In *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 Laddie J stated:

“It is frequently said by trade mark lawyers that when the proprietor's mark and the defendant's sign have been used in the market place but no confusion has been caused, then there cannot exist a likelihood of confusion under Article 9.1(b) or the equivalent provision in the Trade Marks Act 1994 ("the 1994 Act"), that is to say s. 10(2). So, no confusion in the market place means no infringement of the registered trade mark. This is, however, no more than a rule of thumb. It must be borne in mind that the provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to be a finding of infringement. Similarly, even when the proprietor of a registered mark uses it, he may well not use it throughout the whole width of the registration or he may use it on a scale which is very small compared with the sector of trade in which the mark is registered and the alleged infringer's use may be very limited also. In the former situation, the court must consider notional use extended to the full width of the classification of goods or services. In the latter it must consider notional use on a scale where direct competition between the proprietor and the alleged infringer could take place.”

In *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283 Millett LJ stated:

“Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff's registered trade mark”

22) Even taking into account where the goods are identical, the differences between the trade marks and the nature of the goods means that there is not a likelihood of confusion. Consequently, the opposition is dismissed.

COSTS

23) As Mr Bowerbank has been successful he is entitled to an award of costs. In *Adrenalin Trade Mark*, BL O/040/02, Simon Thorley QC, sitting as the appointed person, observed that:

“8 It is correct to point out that the Registrar’s practice on costs does not specifically relate to litigants in person but in my judgment it could not be that a litigant in person before the Trade Mark Registry could be placed in any more favourable position than a litigant in person before the High Court as governed by the CPR. The correct approach to making an award of costs in the case of a litigant in person is considered in CPR Part 48.6.”

Part 48.6 of the Civil Procedure Rules referred to in the above passage provides as follows:

“48.6—(1) This Rule applies where the court orders (whether by summary assessment or detailed assessment) that costs of a litigant in person are to be paid by any other person.

(2) The costs allowed under this Rule must not exceed, except in the case of a disbursement, two-thirds of the amount which would have been allowed if the litigant in person had been represented by a legal representative.”

As Mr Bowerbank has not been represented I will reduce the costs that would normally be awarded. I take into account the nature of the grounds of opposition, the counterstatement and Mr Bowerbank's written submissions; all of which were short and to the point. I consider that the sum of £300 is an appropriate amount of compensation. **I order Michele Textil-Vertriebsgesellschaft mbH to pay Nigel George Bowerbank the sum of £300.** This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 6th day of March 2007

**David Landau
For the Registrar
the Comptroller-General**