

O-335-09

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 2460252  
BY DREW BRADY & CO LIMITED TO REGISTER A  
TRADE MARK IN CLASS 25**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 97379 BY STREET ONE GmbH**

## BACKGROUND

1. On 3 July 2007 Drew Brady & Co Limited (DB) applied to register the trade mark STREET ZONE for a specification of goods in class 25 which read:

“Clothing, footwear, headgear.”

Following examination the specification was subsequently amended to read:

“Socks; underwear; scarves; gloves; hats,”

and the application was accepted and published for opposition purposes on 14 March 2008 in Trade Marks Journal No.6727.

2. On 16 June 2008 Street One GmbH (Street) filed a notice of opposition. This consists of a single ground based upon section 5(2)(b) of the Trade Marks Act 1994 (as amended) (the Act). In their Statement of Grounds Street indicate that the opposition is based upon the following trade marks:

Trade Mark	No.	Application Date	Registration Date	Goods and services
<b>Street One</b>	2330305	24.04.2003	23.04.2004	For a range of goods in classes: 3, 9, 14, 16, 18, 26 and which includes the following goods in class 25: Clothing, headgear and footwear; accessories for clothing, namely belts, sleeve bands, scarves, shawls, gloves, braces, stockings, socks, headbands.
<b>Street One</b>	E34439	01.04.1996	13.11.1998	For a range of goods in classes: 3, 9, 14, 16, 18, 23,24,26 and which includes the following goods in class 25: Clothing, footwear, headgear; clothing accessories, namely belts, expanding bands for holding sleeves, kerchiefs, gloves, belt buckles, buttons, braces, scarves, stockings, socks, headbands.

3. I note that the opposition is directed against all of the goods contained in the application for registration.

4. On 8 October 2008 DB filed a counterstatement which consists, in essence, of a denial of the ground upon which the opposition is based. I note that in their counterstatement DB comment on the distinctive character of the word STREET and highlight a range of trade marks in class 25 which incorporate the word STREET which they say are owned by “many different traders”. I will return to these points later in my decision.

5. Only Street filed evidence. While neither party asked to be heard, both parties filed written submissions which I will refer to as necessary below. After a careful consideration of all the material before me, I give this decision.

## **EVIDENCE**

### **Street’s evidence-in-chief**

6. This consists of a witness statement dated 2 April 2009 by Hugo Reissner, Street’s Chairman, a position he has held since March 2003; he confirms that the information in his statement comes from either his own knowledge or from company records.

7. Mr Reissner states that STREET ONE is his company’s principal brand, adding that the trade mark has been in use since 1983. It was first registered in Germany in 1983 and in the UK in 1989.

8. Mr Reissner explains that Exhibit HR2 consists of pages taken from his company’s website showing the range of products produced by Street under their STREET ONE trade mark. This exhibit consists of seven pages taken from the website [www.street-one.com/en](http://www.street-one.com/en) all of which are dated 8 April 2009 i.e. after the material date in these proceedings; all of the pages bear the trade mark the subject of Street’s registrations. I note they contain, *inter alia*, the following text:

“This makes Street One one of today’s leading and most successful brands in the Women’s Young Fashion sector” (page 3);

“Under the umbrella of CBR Holding, the brand employ more than 220 members of staff in more than twenty locations and countries throughout Europe. In 1994 we opened the First Street One shops in Hanover and Cologne. We now have an international presence of more than 1,500 Street One stores and shops and more than 2,750 multi-label retailers” (page 4);

“Street One offers trendy, easily combinable brand clothing for fashion conscious women. As well as the complete fashion range – from socks to trousers, T-shirts to outdoor jackets, through to knit pullovers and caps – Street One markets a

Bodywear range, consisting of under – and leisurewear, as well as night and sportswear products” (page 5).

9. Having stated that in 2007 his company achieved a total turnover of more than €4m, at exhibit HR3 Mr Reissner provides a range of sample products the vast majority of which bear the trade mark the subject of the registrations on both a sew in label and on, *inter alia*, the swing tags attached to them. The goods provided are: a beanie hat (x1) gloves (x3 pairs) scarves (x2) and items of underwear (x4). I note that all the items are priced in Euros and all appear (to me at least) to be for women.

10. Mr Reissner provides annual sales figures in Euros for 2004 to 2008 in the following countries: Luxembourg, Norway, France, Belgium, Netherlands, Germany, Italy, Sweden, Hungary, Switzerland, Austria, Ireland, Slovenia, Bosnia, Denmark, Spain, Czech Republic, Slovakia and Andorra. He says:

“The total sales value of the goods and services offered under the trade mark STREET ONE in Europe in the last five years amounts to €1,900,207,139 which is the total sales value between 2003 and 2008.”

11. He adds that the consequence of this use is that his company has acquired a reputation in Europe which translates to the STREET ONE trade mark being recognised in many of his company’s markets. The market share enjoyed by STREET ONE products in the following markets is provided (but not the year to which these percentages relate):

<b>Country</b>	<b>Market Share(%)</b>
Germany	4.6
Austria	2.4
The Netherlands	2.6
Belgium	2.9
Luxembourg	1.7
Switzerland	2.9
Denmark	0.8
Norway	0.6
Sweden	0.3

12. Finally, Mr Reissner states that the STREET ONE trade mark is particularly well known in Germany. He explains that in several brand awareness surveys which have taken place in Germany between 1995 and 2006 (exhibit HR4 refers), the level of brand awareness was as follows:

<b>Year</b>	<b>Brand Awareness (%)</b>
1995	11
1997	18
2002	38
2004	42
2006	50

13. That concludes my summary of the evidence filed to the extent that I consider it necessary.

## **DECISION**

14. Section 5(2)(b) of the Act read 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.”

15. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

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

(a) 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,

(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.”

16. In these proceedings Street is relying on the registered trade marks shown in paragraph 2 above, which have application dates of 1 April 1996 and 24 April 2003 respectively i.e. prior to that of the application for registration which was filed on 3 July 2007; as such, they both qualify as earlier trade marks under the above provisions. The application for registration was published for opposition purposes on 14 March 2008 and Street’s earlier trade marks were registered on 13 November 1998 and 23 April 2004. As a result, Street’s earlier trade mark No.E34439 is subject to The Trade Marks (Proof of Use, etc) Regulations 2004 whereas their later filed trade mark No. 2330305 is not.

17. Whilst I note that in their counterstatement DB ask Street to provide proof of use in relation to “Clothing and headgear” (and evidence of such use has been provided by Street), this request can only have been made in the context of registration No. E34439. As the respective trade marks on which Street rely in these proceedings are identical,

and as the specifications for which they stand registered in class 25 are to all intents and purposes also identical, it is, in my view, unnecessary for me to carry out the proof of use assessment in relation to registration No. E34439. I reach this conclusion as notwithstanding what use Street may have made of this registration, they will be in no better position than if the comparison is conducted solely on the basis of the goods contained in class 25 in registration No. 2330305, which is not subject to the proof of use provisions; I shall proceed on this basis.

### **Section 5(2)(b) – case law**

18. The European Court of Justice (ECJ) has provided guidance in a number of judgments germane to this issue. The principal cases are: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Mayer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05),

It is clear from all these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all the relevant factors: *Sabel BV v. Puma AG*, paragraph 22;

(b) the matter must be judged through the eyes of the average consumer of the good/services in question; *Sabel BV v. Puma AG*, paragraph 23, who is deemed to be reasonably well informed and 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*, paragraph 23;

(d) 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*, paragraph 23;

(e) when considering composite marks, it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element; *Shaker di L. Laudato & Co. Sas* (C-334/05), paragraph 42;

(f) an element of a mark may play an independent distinctive role within it without necessarily constituting the dominant element; *Medion AG V Thomson multimedia Sales Germany & Austria GmbH*, paragraph 30;

(g) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17;

(h) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*, paragraph 24;

(i) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*, paragraph 26;

(j) further, 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; *Marca Mode CV v. Adidas AG + Adidas Benelux BV*, paragraph 41;

(k) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.

### **The average consumer and the nature of the purchasing decision**

19. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods; I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade.

20. The goods at issue in these proceedings are all items of clothing or clothing accessories; the sort of goods which will be bought by the public at large; they then are the average consumer for such goods. I must proceed on the basis that the respective parties' trade marks will be used on all the goods for which they have either been applied or are registered and that the respective parties' goods could move through the same trade channels and be supplied to the same average consumer.

21. I have no evidence as to how the goods are likely to be purchased. In my experience however, the selection of the goods at issue is most likely (initially at least) to consist of a visual act made on the basis of self selection in either a retail environment, from a catalogue or on-line (see the comments of the Appointed Person in *React Trade Mark* [2000] RPC 285). Whilst this is likely, in my view, to be the principal means by which the goods are selected, I do not rule out that orders will be placed by telephone or that word of mouth recommendations will play a part in the selection process.

22. The cost of the goods at issue may vary from very small sums (for a pair of socks for example) to many thousands of pounds (for, for example, a bespoke suit). The factors the average consumer would be conscious of when selecting such goods are likely to be, *inter alia*, cost, design, material, size, colour, compatibility with other items of clothing and ultimately if the goods were suitable for their purposes. All of these factors point to the average consumer paying a reasonably high but not the highest level of attention to their purchase. As the cost of the goods increases so one assumes will the level of attention the average consumer is likely to pay to their purchase.

**Comparison of goods**


23. The goods to be compared are as follows:

<b>DB's goods</b>	<b>Street's goods</b>
Socks; underwear; scarves; gloves; hats	Clothing, headgear and footwear; accessories for clothing, namely belts, sleeve bands, scarves, shawls, gloves, braces, stockings, socks, headbands

24. As all of DB's goods are encompassed by the goods contained in Street's registration they are therefore identical.

**Comparison of trade marks**

25. For the sake of convenience, the trade marks to be compared are as follows

<b>DB's trade mark</b>	<b>Street's trade mark</b>
STREET ZONE	

26. It is well established that the average consumer is considered to be reasonably well informed, circumspect and observant, who perceives trade marks as a whole and who does not pause to analyse their various details. In addition, he/she rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he/she has kept in his or her mind. In reaching a conclusion on similarity, I must also identify what I consider to be the distinctive and dominant components of the respective trade marks.

27. In reaching a conclusion on the degree of similarity between the respective trade marks, I must, as the case law dictates, compare them from the visual, aural and conceptual perspectives. In their written submissions, the respective parties comment on the similarity between the trade marks under these various heads in the following terms.



28. Street say, inter alia:

“We submit that the registrar should note that the trade mark STREET ZONE is a plain block capital registration which may be used in any format and that normal and fair use of the mark extends to such use in a form in which the letters “S” and “Z” of “Street” and “Zone” are capitalised with the remainder of the mark represented in lower case lettering. Normal and fair use of the STREET ZONE registration would include use where the words STREET ZONE is represented with initial capitalisation and lower case letters in white on a black background. Marks in black on white are typically reversed on dark materials; therefore STREET ZONE will be likely to be represented in white on a dark background, some of the time, in normal use. Such a representation would be identical to the form of representation of the STREET ONE mark which is essentially a plain word mark represented in an extremely standard manner in white on black.

The term STREET is common within both marks and is the first word of each mark. It is well settled that more attention is paid to the first element of a mark. The respective marks are identical in their first verbal element. The second element of each mark consists of a word distinguished by one letter; ZONE and ONE are both resonant words with identical endings and very similar pronunciations. In ordinary speech more emphasis is placed on the first part of a term with the second word tending to be spoken more quietly. The overall marks are very similar phonetically.

Furthermore the marks are visually virtually identical and their similarity is emphasised when the opposed mark is used in the form of the earlier right of the Opponent as is likely to occur in ordinary use. Even where the STREET ZONE mark is represented in black on white and is compared with Street One in white on black, the marks are visually very close. The public is used to seeing these kinds of substitution and to recognising a mark even in a reversed form.

Conceptually the first element of the respective marks is identical. It is submitted that the public will conceptually link the marks because the first word creates such a conceptual link and because the overall marks have no real meaning capable of generating a conceptual distinction...There is no conceptual difference between the overall meaning of STREET ZONE or STREET ONE since neither mark has a meaning in relation to the goods; as mentioned above the consumer is likely to draw upon the conceptual equivalence of the first part of the marks placing greater reliance on the strong first element.

The Opponent submits that the respective marks are visually extremely close to the extent that the strong visual similarities outweigh any minor phonetical difference. Furthermore as the STREET ONE mark is likely to be remembered visually the aural difference will not be taken into account by the purchaser.”

29. Insofar as DB is concerned, having said:

“The only similarity between the marks is in the STREET element. However, as noted previously, this word has established descriptive meanings when used in respect of clothing, footwear and headgear. ..The average consumer is aware of such meanings and will therefore place little weight on the verbal element STREET. Certainly, the Opponent can claim no exclusive rights in STREET as such”,

they go on to say:

“In comparing the marks, therefore, more weight will be placed on the respective remaining elements “ZONE” and “One”. These verbal elements are very different.

In the Applicant’s mark, the prominent initial letter “Z” in “ZONE” provides a significant visual impact. Due to the fairly uncommon usage of the letter “Z”, words beginning with this letter tend to be easily noticed.

Furthermore, the initial letter “Z” results in the word “ZONE” having an entirely different pronunciation as compared with the word “One” (“ZOHN” versus “WUHN”). The respective marks are, therefore, phonetically dissimilar.

Finally, the words “ZONE” and “One” are conceptually very different in meaning.”

### **Visual/aural similarity**

30. DB’s trade mark consists of the dictionary words STREET and ZONE in black presented in upper case and as two separate words. Street’s Street One trade mark is also presented as two separate words. However, the initial letter of each word is capitalised and the words are presented in white on a black rectangular background.

31. Both trade marks feature the word STREET as their first element and differ in length by only one letter i.e. they are 10 and 9 letters long respectively. In addition, with the exception of the letter Z appearing as the first letter in the second word in DB’s trade mark, the letters in each trade mark are identical and appear in the same order. That said, I agree with DB when they say that the use of the letter Z is fairly uncommon and is unlikely to go unnoticed. Bearing all these factors in mind, there is still, in my view, a reasonable degree of visual similarity between the respective trade marks. The fact that Street’s trade mark is presented in white on a black rectangular background does nothing to change my view of the overall degree of visual similarity.

32. Presented as they are as separate dictionary words which would be well known to the average consumer, the way the respective trade marks will be spoken (and subsequently heard) is relatively easy to predict. While the word STREET appearing in each trade mark is likely to be spoken and heard in an identical fashion, the same is not true of the words ZONE and One. In this regard, I find myself disagreeing with Street when they say that these words have “very similar pronunciations”, and agreeing with

DB that the words would be pronounced quite differently. However, as the word STREET is the first word in each trade mark and as this word is likely to be spoken and heard in an identical fashion, and notwithstanding the differences between the words ZONE and One, when considered as totalities, there is still, in my view, a reasonable degree of aural similarity between the respective trade marks.

33. In summary, there is a reasonable degree of both visual and aural similarity between the respective trade marks.

### **Distinctive and dominant elements & conceptual similarity**

34. In their counterstatement DB say of the STREET element appearing in respective trade marks:

“Although the marks share the word element STREET, this alone is not sufficient to give rise to a likelihood of confusion as this term in itself is not distinctive of the goods at issue.

A well established descriptive usage of STREET is provided at the Dictionary.com web site ([www.dictionary.reference.com](http://www.dictionary.reference.com)): “suitable for everyday wear; street clothes; street dress”,

A more modern descriptive usage of STREET is evident from the information available at the Urban Dictionary web site ([www.urbandictionary.com](http://www.urbandictionary.com)): “of or pertaining to the urban” street” culture, underground, based around the core of hip-hop, skateboarding, bmx etc.: “You [sic] that dude was fly and dressed so street.”

Moreover, many different traders have adopted marks that include the word STREET. A brief search identified a significant number of STREET trade marks in Class 25 in force in the UK. These include, inter alia:”

[I note that 24 trade marks are identified all of which consist of two words and which have the word STREET as the first element].

DB go on to say:

“It is clear, therefore, that the Opponent can claim no monopoly right in STREET as such. The average consumer is well accustomed to many different STREET marks relating to the goods at issue. Consequently, the presence of the widely used STREET element in the Applicant’s and Opponent’s respective trade marks does not cause any likelihood of confusion.”

35. Insofar as conceptual similarity is concerned, in their counterstatement DB say:

“In the Opponent’s trade mark the STREET element when combined with ONE will be given its primary meaning of “a thoroughfare” by the average consumer, who is of course accustomed to the combination of words and numbers in this sense. On the other hand, the unusual combination of STREET with ZONE in the trade mark applied for results in the STREET element being given an adjectival meaning...”

36. In their written submissions Street respond to these comments in the following terms:

“The Applicant’s attorney suggests that the word STREET is not distinctive in relation to the goods at issue and refers to a meaning of the word STREET in its Counterstatement but provides no evidence that the meaning indicated is a true meaning. Furthermore its is submitted that the meaning indicated by the Applicant is not conveyed by either mark as a whole. When combined with the words ONE or ZONE the overall marks have no meaning in relation to the goods. There is no conceptual difference between the overall meaning of STREET ZONE or STREET ONE since neither mark has a meaning in relation to the goods..”

And:

“The Applicant has stated in its counterstatement that many different traders have adopted marks that include the word STREET and listed a number of such marks in its Counterstatement. It is however well settled that the state of the Register cannot be taken as an indication that marks that are co-existing on the Register are co-existing in use. Mere co-existence on the Register is not given great weight and may not reflect co-existence in the market place particularly when marks are not impeded from registration by earlier rights. It has been established that weight may be given to co-existence in use rather than on the Register. The Applicant has submitted no evidence to support the view that marks comprising of STREET are common in use in relation to the goods and no weight can be given to the submission in the absence of such evidence. The applicant identified a number of marks registered comprising of the word STREET combined with an additional term in its Counterstatement. However, none of the marks referred to are of the same level of similarity to STREET ONE as is the STREET ZONE mark. It is submitted that the Registrar should disregard co-existence on the Register and that, in the absence of any evidence showing that such marks co-exist in the market place, there is no justification for taking the view that the average consumer is well accustomed to many STREET marks in relation to the goods.”

37.DB’s arguments are an attempt to establish that the word STREET has no distinctive character in relation to the goods at issue, and would as a result not be relied upon by the average consumer as a distinguishing feature. This line of argument is (I presume) in their view endorsed by the list of trade marks they have provided in class 25 which

feature as their first element the word STREET, but which differ in their suffix elements and which they say co-exist on the trade marks register in the names of different traders.

38. To support their argument that the word STREET has no distinctive character DB have provided definitions which they say are taken from [www.dictionarreference.com](http://www.dictionarreference.com) and [urbandictionary.com](http://urbandictionary.com); although print outs from these dictionaries have not been provided. Similarly, no information has been provided on the nature or origin of these dictionaries, for example, whether they are US or UK based sources, nor do I have any information on how authoritative these dictionaries are considered to be. However, even if I had been provided with such information, the mere presence of a word in what appears to be non mainstream dictionaries does little to tell me anything about how that word would be construed by the average consumer. In short, the dictionary references do not assist DB.

39. DB's second line of argument is that as the word STREET appears in a number of trade marks in class 25 owned by different proprietors, no one trader is entitled to claim a monopoly in the word. While the trade mark numbers and mark text are provided in the counterstatement, full details of the trade marks (such as the name of the proprietor, the goods for which the mark stands registered and the basis of acceptance) are not. However, even if such information had been provided (and for the reasons highlighted by Street in their written submissions above), the state-of-the-register tells me nothing about what is actually happening in the market place and is in effect irrelevant. Jacob J (as he then was) confirmed the correctness of this approach in *British Sugar Plc v James Robertson & Sons Limited (Treat)* [1996] R.P.C. 281 when he said:

“Both sides invited me to have regard to the state of the register. Some traders have registered marks consisting of or incorporating the word "Treat". I do not think this assists the factual inquiry one way or the other, save perhaps to confirm that this is the sort of word in which traders would like a monopoly. In particular the state of the register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led the registrar to put the marks concerned on the register. It has long been held under the old Act that comparison with other marks on the register is in principle irrelevant when considering a particular mark tendered for registration, see e.g. [MADAME Trade Mark](#) [FN26] and the same must be true under the 1994 Act. I disregard the state of the register evidence.”

40. To summarise, the dictionary references and the state-of-the-register evidence provided by DB are insufficient for me to conclude (as DB would like me to) that the word STREET lacks distinctive character in relation to the goods at issue in these proceedings. That being the case, and absent persuasive evidence to the contrary, the word STREET appearing in both parties' trade mark must be considered as both a distinctive and (by virtue of its positioning) a dominant element. The second word in each trade mark i.e. ZONE and One are as a result of their positioning likely to be considered less dominant. When considered in isolation the word ZONE is not, as far as

I am aware, (and there is no evidence to the contrary), a word that has either a descriptive meaning or is devoid of distinctive character for the goods at issue; it is therefore also a distinctive element; the same may not be true of the word One which may describe a particular size (as in shoes for example).

41. In their written submissions Street argue that conceptually the first word appearing in each trade mark is conceptually identical; I agree. I also agree with DB that the conceptual meaning of the second word in each trade mark is very different. In reaching a conclusion on this point I must of course consider the respective trade marks in totality. Having considered the respective parties' comments on the conceptual messages the competing trade marks are likely to convey, I find myself agreeing with Street when they say that when considered as totalities neither trade mark has a conceptual meaning which would immediately present itself to the average consumer.

42. In summary, I have concluded that the STREET element is a distinctive and dominant component of both parties trade marks; the second element in each trade mark is by virtue of its positioning less dominant; while the word ZONE in DB's trade mark application is a distinctive element the same cannot be said of the One element appearing in Street's trade mark. I also concluded that while the word STREET in each trade mark is conceptually identical, when considered as totalities neither trade mark has a conceptual meaning which would immediately present itself to the average consumer.

### **Distinctive character of Street's Street One trade mark**

43. I must now assess the distinctive character of Street's Street One trade mark. As I mentioned in paragraph 17 above, I did not think it necessary for me to carry out the proof of use assessment in relation to Community trade mark registration No. E34439, given that the two marks on which Street relied in these proceedings were identical, were for (essentially) the same goods and bearing in mind that the later of the two earlier trade marks registration No. 2330305 was not subject to the proof of use requirements. While Street have provided evidence of the use they have made of their Street One trade mark, none of this evidence relates to use in the UK. As I am only considering the position in the UK, the use made by Street's in other jurisdictions and any improvement to the distinctive character of its Street One trade mark as a result of such use can have no bearing on my assessment of its distinctive character in the UK. That being the case, I have therefore only the inherent characteristics of the trade mark to consider.

44. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking, and thus to distinguish those

goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

45. While the words Street and One are well known dictionary words, it is the distinctive character which resides in the totality that I must assess. The presentation of Street's trade mark is unremarkable and gives little or no additional distinctive character to the trade mark as a whole. I have already concluded above that the combination of the words Street and One have no conceptual meaning in relation to the goods for which they stand registered. Taking all these factors into account, Street One is, in my view, absent use, a trade mark possessed of a reasonably high level of inherent distinctive character.

### **Likelihood of confusion**

46. In determining whether there is a likelihood of confusion, 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 vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the Street One trade mark, as the more distinctive this trade mark is the greater the likelihood of confusion. The distinctive character of the Street One trade mark must be appraised by reference to the goods for which it is registered and also by reference to the way it will be perceived by the average consumer. I must also keep in mind the average consumer for the goods and the nature of the purchasing process.

47. In summary, I have concluded that:

- (i) the respective goods at issue are identical (paragraph 24);
- (ii) the average consumer is a member of the general public (paragraph 20);
- (iii) given the nature of the goods at issue the visual aspect of the comparison is likely to be the most important although aural considerations will also play a part in the selection process (paragraph 21);
- (iv) the average consumer will pay a reasonably high level of attention to the selection of the goods (paragraph 22);
- (v) there is a reasonable degree of both visual and aural similarity between the respective trade marks (paragraphs 31 & 32);
- (vi) the STREET element is a distinctive and dominant element of both parties trade marks; that the second element in each trade mark is by virtue of its positioning less dominant, and while the word ZONE in DB's trade mark application is a distinctive element the same cannot be said of the One element appearing in Street's trade mark (paragraph 40);

(vii) when compared as totalities neither trade mark has a conceptual meaning which would immediately present itself to the average consumer (paragraph 41);

(viii) absent use Street's trade mark is possessed of a reasonably high level of inherent distinctive character (paragraph 45).

48. I must now apply the global approach advocated to my findings to determine whether direct confusion (where one trade mark is mistaken for the other) or indirect confusion (where the goods would be assumed to come from economically linked undertakings) is likely to occur. Having done so, I have concluded that given the identity in the goods, the reasonable degree of both visual and aural similarity, the lack of any conceptual message either trade mark will convey, the nature of the purchasing process, the traits of the average consumer when purchasing the goods at issue and the reasonably high level of inherent distinctive character residing in Street's Street One trade mark, that confusion, be it direct or indirect, is likely to occur.

**49. In summary, the opposition has been successful and the application should be refused in its entirety.**

#### **Costs**

50. As Street have been successful they are entitled to a contribution towards their costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide, I award costs to Street on the following basis:

Preparing a statement and considering the other side's statement:	£300
Official fee:	£200
Preparing evidence:	£500
Written submissions:	£400
<b>Total:</b>	<b>£1400</b>



51. I order Drew Brady & Co Limited to pay to Street One GmbH the sum of £1400. 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 27<sup>th</sup> day of October 2009**

**C J BOWEN  
For the Registrar  
The Comptroller-General**