

O-031-11

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION NO. 2495363
STANDING IN THE NAMES OF:
MICHAEL OBASOHAN, ELYDJAH HOHORIN & MEZVIN METTZETO
IN RESPECT OF THE FOLLOWING TRADE MARK IN CLASS 25:**



AND

**AN APPLICATION (NO. 83530) FOR INVALIDITY BY
BOI TRADING COMPANY LIMITED**

TRADE MARKS ACT 1994

**In the matter of registration no. 2495363 standing in the names of:
Michael Obasohan, Elydjah Hohorin & Mezvin Mettzeto**

and

An application (no. 83530) for invalidity by Boi Trading Company Limited

The background and the pleadings

1) Trade mark registration no. 2495363 was filed on 11 August 2008 and stands in the names of Michael Obasohan, Elydjah Hohorin & Mezvin Mettzeto. I will refer to them collectively as “the joint proprietors”. The trade mark was published in the Trade Marks Journal on 26 September 2008 and its registration procedure was completed on 2 January 2009. I set out below the mark, together with the goods for which it is registered:



Clothing, footwear and headgear

2) On 8 July 2009 Boi Trading Company Limited (“Boi”) applied for the above registration to be declared invalid. Boi’s initial grounds for invalidity were under sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). Boi subsequently withdrew its section 5(4)(a) ground. Under section 5(2)(b) Boi relies on a single trade mark of which it is the proprietor, namely Community Trade Mark (“CTM”) 4333738 consisting of the word BOI. Boi’s mark is registered for goods including “clothing, footwear and headgear”. It was filed on 7 March 2005 and it completed its registration procedure on 3 October 2006. The consequence of these dates is that: (1) Boi’s trade mark has an earlier date of filing and, therefore, it constitutes an earlier mark in accordance with the provisions of section 6 of the Act and, (2) that as of the date of publication of the joint proprietors’ mark it had not been registered for five years or more, so, the earlier

mark is not subject to the requirement to prove that it has been used¹ - the earlier mark may, therefore, be considered for its specification as registered.

3) The joint proprietors filed a counterstatement denying the grounds of opposition. It asked Boi to provide proof of use in respect of its earlier mark but, as indicated in the previous paragraph, there is no requirement for Boi to do so. The joint proprietors' defence is based on "different markets", "uniquely different branding" and that Boi forms only part of PAPERBOI and it is not, therefore, "confusingly similar".

4) Neither side filed any evidence. Boi filed written submissions at the evidence stage which will be borne in mind but not summarised separately. The matter was heard before me on 14 January 2011. At the hearing Boi was represented by Mr Alastair Rawlence of William A Shepherd & Son. One of the joint proprietors, Michael Obasohan, attended the hearing and gave submissions on their behalf.

Section 5(2)(b) of the Act

5) This section reads:

"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."

6) In reaching my decision I have taken into account the guidance provided by the European Court of Justice ("ECJ") in a number of judgments: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77, *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).

7) The existence of a likelihood of confusion must be appreciated globally, taking into account all relevant factors (*Sabel BV v Puma AG*). As well as assessing

¹ The requirements relating to proof of use are contained in section 6A of the Act, which was added to the Act by virtue of the Trade Marks (Proof of Use, etc.) Regulations) 2004 (SI 2004/946) which came into force on 5th May 2004.

whether the respective marks and the respective goods are similar, other factors are relevant including:

The nature of the average consumer of the goods in question and the nature of his or her purchasing act. This is relevant because it is through such a person's eyes that matters must be judged (*Sabel BV v Puma AG*);

That the average consumer rarely has the chance to make direct comparisons between trade marks and must, instead, rely upon the imperfect picture of them he or she has kept in mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*) This is often referred to as the concept of "imperfect recollection";

That the degree of distinctiveness of the earlier trade mark (due either to its inherent qualities or through the use made of it) is an important factor because confusion is more likely the more distinctive the earlier trade mark is (*Sabel BV v Puma AG*);

That there is interdependency between the various factors, for example, a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the respective goods, and vice versa (*Canon Kabushiki Kaisha v Metro- Goldwyn-Mayer Inc.*).

8) In terms of the goods covered by the respective marks there can be no dispute that the goods are identical. The specifications are worded in identical terminology.

9) One of the points referred to in the joint proprietors' counterstatement and also, to a degree, at the hearing, related to the markets at which their goods were aimed. The joint proprietors' goods are said to be aimed at the youth market. There is, of course, no evidence to this effect (neither party filed evidence), but the point is academic because Boi's mark is capable of being used in exactly the same market. There is, therefore, no differentiation. Even if there had been evidence showing that the joint proprietors targeted one part of the market and Boi another, even this would not have been relevant because marketing strategies are by their very nature temporal and can change with the passage of time. I must assess the matter notionally, on the basis of the goods sought to be registered, namely clothing, footwear and headgear. As the General Court ("GC") stated in *NHL Enterprises BV v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-414/05:

"71 The Court considers, first, that that assessment by the Board of Appeal is not called in question by the particular conditions in which the applicant's goods are marketed, since only the objective marketing conditions of the goods in question are to be taken into account when determining the respective importance to be given to visual, phonetic or

conceptual aspects of the marks at issue. Since the particular circumstances in which the goods covered by the marks at issue are marketed may vary in time and depending on the wishes of the proprietors of those marks, the prospective analysis of the likelihood of confusion between two marks, which pursues an aim in the general interest, namely that the relevant public may not be exposed to the risk of being misled as to the commercial origin of the goods in question, cannot be dependent on the commercial intentions of the trade mark proprietors – whether carried out or not – which are naturally subjective (see, to that effect, *NLSPORT*, *NLJEANS*, *NLACTIVE* and *NLCollection*, cited at paragraph 61 above, paragraph 49, and Case T-147/03 *Devinlec v OHIM – TIME ART (QUANTUM)* [2006] ECR II-11, paragraphs 103 to 105, upheld on appeal by the Court by judgment of 15 March 2007 in Case C-171/06 P *TIME ART v OHIM*, not published in the ECR, paragraph 59).”

The same reasoning can be seen in numerous other cases e.g., *Devinlec Développement Innovation Leclerc SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T- 147/03.


10) Clothing is bought by the public at large. The average consumer is, therefore, a member of the general public. The case-law informs me that the average consumer is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). The degree of care and attention the average consumer uses when selecting goods can, however, vary depending on the particular goods in question (see, for example, the judgment of the GC in *Inter-Ikea Systems BV v OHIM* (Case T-112/06)). The average consumer may try the goods on and is likely to inspect them for colour, size, style etc. All of this increases the potential exposure to the trade mark. That being said, the purchase is unlikely to be a highly considered process as clothing is purchased relatively frequently and, although cost can vary, it is, generally speaking, not a highly expensive purchase. The purchasing process is, therefore, a normal, reasonably considered one, no higher or lower than the norm.

11) Mr Rawlence stressed that any visual, aural and conceptual similarities were all important factors to bear in mind. Whilst they are, of course, important factors, I am conscious that the purchase of clothing is normally a visual act². Aural similarity will not be ignored completely, but any visual similarity/dissimilarity is likely to have more significance. Conceptual similarity/dissimilarity can, as the case-law³ indicates, increase or counteract any visual and aural similarity/dissimilarity and, thus, impact on the likelihood of confusion.

² See *Société provençale d'achat and de gestion (SPAG) SA v (OHIM)* Case T-57/03 and *React Trade Mark* [2000] RPC 285.

³ There are many cases in which this principle has been highlighted. See, for example: *Phillips-Van Heusen v OHIM – Pash Textilvertrieb und Einzelhandel (BASS)* [2003] ECR

12) That leads to a comparison of the marks. The competing marks, for ease of reference, can be seen in the table below:

Boi's mark	The joint proprietors' mark
BOI	

13) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account any distinctive and dominant components.

14) In terms of distinctive and dominant components, the trade mark BOI does not separate into distinctive and dominant components. It has only one constituent part. On the other hand, the joint proprietors' mark has more than one component, namely the device of someone riding a bicycle and the words PAPERBOI or PAPER BOI. There was a discussion at the hearing as to whether the words PAPER and BOI were separate or not. To my mind little turns on this as the word PAPER and BOI will be approximated by the average consumer to the word PAPERBOY. The device above the words will reinforce this approximation. In view of this, whether the words PAPER and BOI are split or not, they will be taken as a whole phrase, neither word retaining an independent role. This is so notwithstanding the fact that BOI is not spelt BOY as in PAPERBOY. Whilst I note this difference, I do not consider that this equates to the BOI element playing an independently distinctive role – it will still be tied to the word PAPER given the approximation I have referred to. In terms of dominant and distinctive elements, I consider that the two elements in the joint proprietors' mark have an equal degree of dominance and distinctiveness – neither element outweighs the others, indeed, they reinforce each other: the device (given the words below it) is likely to be perceived as a representation of a paperboy, and the device reinforces that the words PAPERBOI/PAPER BOI will be approximated to PAPERBOY.

15) In terms of the visual comparison, it is true that both marks contain the word BOI. This creates a degree of similarity. However, the device element, which has an equal degree of prominence to the verbal element, together with the addition of the word PAPER, creates a clear difference. This is so whether the BOI element is seen as a separate word or not because even if there is a split between PAPER and BOI it is wafer thin and does not make BOI stand out to any significant degree. I consider that any degree of visual similarity must be of only a low degree.

16) In terms of aural similarity, similar considerations apply albeit, the device element will not be pronounced. The respective marks, from an aural perspective, are BOY (for the mark BOI) and PA-PER-BOY (for PAPERBOI/PAPER BOI). There is a point of similarity and a point of difference. The difference is at the beginning of the mark. From an aural perspective, the word BOI is not particularly distinctive given that the goods relate to clothing which could be for boys. Given all these factors, whilst the degree of similarity is higher than the degree of visual similarity, I would still only pitch it at a moderate level.

17) In terms of concept, for a conceptual meaning to be relevant it must be one capable of immediate grasp⁴. The word BOI is likely to be perceived as an invented word, certainly from a visual perspective. In terms of aural use, and without having encountered the mark visually, the word will be taken as a reference to a boy. In terms of the PAPERBOI/PAPER BOI mark, it will, despite the word BOI not being presented as BOY, be perceived and recalled as a reference to a paperboy. This is so from a visual and aural perspective. All of this, to my mind, creates a conceptual difference. From a visual perspective one mark has a specific meaning (paperboy) and the other mark no meaning. From an aural perspective one mark has a specific meaning (paperboy) and the other mark a different meaning (simply a boy). Mr Rawlence felt that the concept of the unusual word BOI will also play a role. The word BOI has, though, no real concept of its own other than as an approximation to the word BOY when it is used aurally, so, I find it difficult to see how this can affect the conceptual analysis.

18) I have already stated that the degree of distinctiveness of the earlier mark is an important factor to consider. This is because the more distinctive the earlier mark (based either on its inherent qualities or because of the use made of it), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). No use of the earlier mark has been filed so I can only consider its inherent qualities. However, as an invented word, the earlier mark must be regarded as being reasonably high in distinctive character. The only reason why the mark is not deemed to be of any higher degree of distinctiveness is that the word is the

⁴ This is highlighted in numerous judgments of the GC and the ECJ including *Ruiz Picasso v OHIM* [2006] e.c.r. –I-643; [2006] E.T.M.R. 29.

phonetic equivalent of the word BOY and, at the very least, it will lose some distinctiveness when one considers aural use of the mark.

Conclusions on the likelihood of confusion

19) It is clear that all the relevant factors have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17) and that a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

20) I have found there to be a low degree of visual similarity, a moderate degree of aural similarity and for there to be a conceptual difference. The goods are identical. The earlier mark is reasonably high in inherent distinctiveness. There are two types of confusion to consider namely: 1) direct confusion, whereby the average consumer effectively mistakes one mark for the other and, 2) indirect confusion, whereby the average consumer puts any similarity between the marks (once all the other factors are considered) down to the suppliers of the goods being the same or that they are related⁵. In terms of direct confusion, this can, I feel, be ruled out quickly given the strong visual differences and the clear difference in concept - I hardly think that a reasonably informed and circumspect average consumer, even taking into account imperfect recollection, will directly confuse the marks in question.

21) Indirect confusion requires more analysis. This is because, notwithstanding the visual and aural differences and the difference in concept, the average consumer may notice that both marks contain the word BOI, a word which I have considered to be reasonably high in distinctiveness, and put this commonality down to the goods being the responsibility of the same or a related business. Whilst I recognize all this, I consider that when one bears in mind the nature of the purchasing act (invariably a visual one and one where the degree of attention is no higher than a normal, reasonably considered process) then the point of similarity based on the invented word BOI is unlikely to really register. This is more so when one factors in the concept of imperfect recollection – for example, the conceptual hook of the PAPERBOI/PAPER BOI mark is that of a paperboy and this is all that may really be recalled. Even if I am wrong on that and the average consumer does notice and recall that the joint proprietors' mark has the misspelt word BOI instead of BOY, I am far from satisfied that this will be put down to an economic connection with the BOI brand. In my view, the strong conceptual difference and the visual impact of the mark would lead such a person to see such similarity as merely co-incidental. Whilst I have focused more on the likelihood of confusion being caused through a visual encounter of the

⁵ This is a relevant form of confusion – see *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*.

respective marks, Boi is in no better position aurally given that less weight should be given to aural similarities and given that from an aural perspective the word BOI is simply BOY which, therefore, eliminates any distinctive co-incidence - the unusual spelling of BOI will not be apparent from an aural perspective. For all these reasons, I find that there is no likelihood of indirect confusion.

Costs

22) The application for invalidation having failed, the joint proprietors are entitled to a contribution towards their costs. I must bear in mind that the joint proprietors have not incurred the costs of having to employ a professional legal advisor and I therefore reduce by 50% what I otherwise may have awarded. I hereby order Boi Trading Company Limited to pay Michael Obasohan, Elydjah Hohorin & Mezvin Mettzeto the sum of £400. This sum is calculated as follows:

Preparing a statement and considering the other side's statement
£200

Attending the hearing
£200

23) The above sum should 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 01 day of February 2011

**Oliver Morris
For the Registrar,
The Comptroller-General**