

O-105-11

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION NO. 2480736 IN THE NAME OF
INDERJIT ATWAL IN RESPECT OF THE FOLLOWING SERIES OF TWO
TRADE MARKS IN CLASS 25:**

CATCH DENIM

Catch Denim

**AND AN APPLICATION FOR A DECLARATION OF INVALIDITY THERETO
UNDER NO 83663 BY BOI TRADING COMPANY LIMITED**

TRADE MARKS ACT 1994

**IN THE MATTER OF registration no. 2480736
in the name of Inderjit Atwal
in respect of the following trade marks in Class 25:**

**CATCH DENIM
Catch Denim**

and

**the application for a declaration of invalidity
thereto under no. 83663 by Boi Trading Company Limited**

BACKGROUND

1) Inderjit Atwal is the proprietor of the above mark (“the registration”). He applied for the registration on 26 February 2008 and the registration procedure was completed on 18 July 2008. The registration covers the following goods in Class 25:

Clothing, footwear and headgear

2) On 26 January 2010, Boi Trading Company Limited (hereafter “Boi”) of Units 1-7, The Eurocentre, 116-118 Bury New Road, Manchester, M8 8EB applied for the registration to be declared invalid. The single ground of the application is that Boi is the proprietor of an earlier mark, the relevant details being:

Relevant details	Specification of goods
2404637 CATCH 22 Filing date: 22 October 2005 Registration date: 7 April 2006	 Class 25: Clothing, footwear and headgear.

3) Boi say that given the similarity between their earlier marks and the registration, and the identity of the goods, the registration was contrary to section 5(2) (b) of the Trade Marks Act 1994 (“the Act”) and should be invalidated under Section 47(2) of the Act.

4) The applicant subsequently filed a counterstatement denying the opponent's claims.

5) Neither sides filed evidence in these proceedings, but they both filed written submissions. Both sides ask for an award of costs. The matter came to be heard on 9 March 2011 when the applicant for invalidation was represented by Mr Alastair Rawlence for William A Shepherd & Sons and the proprietor represented by Mr Eugene Pienaar for RevoMark.

DECISION

The legislation

6) The case has proceeded to final determination on the basis of Section 5(2) (b) of the Act, with such grounds being relevant in invalidation proceedings in view of the provisions of Section 47(2) of the Act. The relevant parts of Section 47 of the Act read as follows:

“47. - (1) ...

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

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

(b) ...

7) Section 5(2)(b) reads:

“(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.”

8) 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), 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.”

9) Of potential relevance to a ground of opposition under Section 5(2) are the provisions that relate to proof of use. Section 6A(1) details the circumstances where these provisions apply:

“6A Raising of relative grounds in opposition proceedings in case of non-use

(1) This section applies where –

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.”

10) Boi relies upon one earlier mark that is registered and therefore qualifies as an earlier mark as defined by Section 6 of the Act. This earlier mark completed its registration procedure on 7 April 2006. This is within five years of the publication of Mr Atwal’s mark (the relevant date) and as such, is not subject to the proof of use provisions.

11) In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the Court of Justice of the European Union (CJEU) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] FSR. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] ETMR 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P (LIMONCELLO). It is clear from these cases that:

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

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

(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*,

(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*,

(e) 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*,

(f) 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*,

(g) in determining whether similarity between the goods or services covered by two marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(h) 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*,

(i) 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 and Adidas Benelux BV*,

(j) 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*.

(k) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of

the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

(I) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM (LIMONCELLO)*

Comparison of goods

12) It is self evident that the respective lists of goods are identical. This was conceded by the proprietor at the hearing.

The average consumer

13) As matters must be judged through the eyes of the average consumer (*Sabel BV v. Puma AG*, paragraph 23) it is important that I assess who the average consumer is for the goods at issue.

14) In respect of these goods, I am mindful of the comments of Mr Simon Thorley, sitting as the Appointed Person, in *React trade mark* [2000] R.P.C. 285:

“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.”

15) The General Court (GC) has continued to identify the importance of visual comparison when considering the purchasing act in respect of clothing (see for example Joined Cases T-117/03 to T-119/03 and T-171/03 *New Look Ltd v OHIM (NLSPORT et al)* [2004] ECR II-3471 at [49]-[50] and Case T-414/05 *NHL Enterprises BV v OHIM (LA KINGS)* [2009] ECR II.). There is no evidence in the current case and therefore nothing that provides assistance in considering the nature of the purchasing act. In the absence of such evidence, it is reasonable that I apply Mr Thorley’s comments here. The purchasing act will, generally be described as consumer items and will involve a reasonable degree of care and attention but not the highest degree of attention. As Mr Thorley noted, the

purchasing process is primarily a visual one but I do not ignore the aural considerations that may be involved.

Comparison of marks

16) For ease of reference, the respective marks are:

Boi's mark	Mr Atwal's marks
CATCH 22	CATCH DENIM and Catch Denim

17) When assessing the extent of similarity between the respective marks, I must do so with reference to their visual, aural and conceptual similarities bearing in mind their distinctive and dominant components (*Sabel BV v. Puma AG*, para 23). I should say at this stage that nothing is determined by the differences between Mr Atwal's two marks in the series. My comments apply equally to both marks.

18) Before conducting this assessment, I note the argument made on behalf of Boi that the word DENIM in Mr Atwal's mark has descriptive connotations and that this, together with the fact that the word CATCH is the first element of the mark results in the word CATCH being the dominant distinctive element. The point that the average consumer will not consider a descriptive element of a compound mark as its distinctive and dominant element has been established by the GC in Case T-129/01 *Alejandro v OHIM – Anheuser-Busch (BUDMEN)* [2003] ECR II-2251. However, I am also mindful of the following comments of the General Court (GC) in *CM Capital Markets Holding, SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-563/08:

“39. ... Owing to their weak, or even very weak, distinctive character, descriptive elements of a trade mark are not generally regarded by the public as being dominant in the overall impression conveyed by that mark, That does not mean, however, that the descriptive elements of a mark are necessarily negligible in the overall impression conveyed by that mark. It is necessary, in particular, to examine whether other elements of the mark are likely to dominate, by themselves, the relevant public's recollection of that mark

45 ..., as regards the word element of the earlier marks, it must be observed that although ... the expression 'capital markets', which is descriptive of the services covered by the earlier marks, is not generally likely to dominate the overall impression conveyed by the earlier marks, it

is nevertheless a relevant element for the purposes of a comparison of the signs at issue because, inter alia, it is as prominent, visually, as the graphic element.”

19) It is clear from this guidance that while the word DENIM is not the dominant and distinctive element of Mr Atwal’s mark, it cannot be said that it is negligible. Applying the above guidance, I must consider it as a relevant element of the mark even though it is not the dominant distinctive element. This is clearly the word CATCH.

20) From a visual perspective the respective marks begin with the word CATCH and this is an obvious point of similarity. Boi’s mark is combined with the numeral 22 and Mr Atwal’s has the word DENIM. The number “22” is short, consisting of two digits, whereas the word DENIM consists of five letters. The difference in length of these two elements provides an additional point of difference. Taking all these points together and noting that CATCH is at the beginning of both marks, I conclude that the marks share a reasonably high level of visual similarity.

21) Aurally, the marks share the first word/syllable CAT-CH. BOI’s mark has the additional three syllables TWENT-TEE TO. Mr Atwal’s mark has the additional two syllable word DEN-IM. Taking these similarities and differences into account, I conclude that the respective marks share a reasonably high level of aural similarity.

22) From a conceptual perspective, it is argued on behalf of Mr Atwal that the phrase CATCH 22 is commonly understood to mean “a no win situation” or “a double blind” of any type. This is confirmed by reference to a dictionary where it is defined as “a dilemma or difficult circumstance from which there is no escape because of mutually conflicting or dependent conditions: [as modifier]: a catch-22 situation”¹. At the hearing, Mr Rawlence argued that the word CATCH alone has a similar meaning to the phrase CATCH 22, hence the occurrence of CATCH in the phrase. It is true that one meaning of CATCH is “a hidden problem or disadvantage in an apparently ideal situation”². This is a similar but subtly different meaning to the phrase CATCH 22. Further, such a meaning is less likely to be attributed to the word CATCH when it is followed by the word DENIM. Here, the meaning of the word CATCH within the mark, as a whole, becomes more

¹ "catch-22". Oxford Dictionaries. April 2010. Oxford Dictionaries. April 2010. Oxford University Press. **9 March 2011** <http://oxforddictionaries.com/view/entry/m_en_gb0129250>.

² "catch". Oxford Dictionaries. April 2010. Oxford Dictionaries. April 2010. Oxford University Press. **9 March 2011** <http://oxforddictionaries.com/view/entry/m_en_gb0129110>.

ambiguous and does not immediately bring any one meaning to mind. Taking this into account, I conclude that the respective marks are not conceptually similar.

23) I must factor these findings into an assessment of overall similarity. I have found that the respective marks share a reasonably high level of visual and aural similarity and that they are not conceptually similar. These factors combine so that, overall, the marks share a moderately high level of similarity.

Distinctive character of the earlier trade mark

24) I have to consider whether Boi's marks has a particularly distinctive character either arising from the inherent characteristics of the marks or because of the use made of it. There is no evidence of use, therefore, I only need to consider its inherent distinctive character. The mark consists of the word CATCH and numerals 22. This has a clear meaning in English, as already identified above, but in respect of the relevant goods the phrase has no connection. As such, the mark enjoys a reasonably high degree of inherent distinctive character.

Likelihood of confusion

25) I must adopt the global approach advocated by case law and take into account that marks are rarely recalled perfectly with the consumer relying instead on the imperfect picture of them he has in kept in his mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27).

26) At the hearing, Mr Pienaar drew my attention to the numerous marks on the register that contain the word CATCH. I note this, but I am mindful of the comments of Jacob J in *British Sugar* [1996] R.P.C. 281 at 305 where he confirmed that such "state of the register" evidence should be discarded when considering a particular mark because it "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." I therefore reject Mr Pienaar's argument.

27) In the written submissions it is argued, on behalf of Mr Atwal, that if there is no conceptual similarity, there can be no likelihood of confusion. On the other hand Boi's representatives draw attention to the comments of the GC in its judgment T-147/03, *Devinlec Développement Innovation Leclerc SA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, and in particular, paragraph 98, where it stated:

"98 It is true that, according to case-law, a conceptual difference between the marks at issue *may* [my emphasis] be such as to counteract to a large extent the visual and aural similarities between those signs [Case T-292/01, *Phillips-Van Heusen Corp. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) (BASS)*, para 54]."

28) This appears to envisage that conceptual dissimilarity MAY counteract visual and aural similarities, but does not lay down a principle where this must also apply. I am also mindful of two further relevant cases. The first of these is Case C- 206/04, *P Mülhens GmbH & Co. KG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, where the CJEU commented:

“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.”

29) The second is Case T-488/07, *Cabel Hall Citrus Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, where the GC commented:

“52 In that connection, it should be noted that although, in general, it cannot be ruled out 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, the existence of such a likelihood must be established as part of a global assessment as regards the visual, conceptual and phonetic similarities between the signs at issue. Thus, the assessment of any phonetic similarity is but one of the relevant factors for the purpose of that global assessment. Therefore, it cannot be accepted that there is a likelihood of confusion each time that a certain phonetic similarity can be established between the marks at issue (Case C-206/04 *P Mülhens v OHIM* [2006] ECR I-2717, paragraphs 21 and 22).”

30) In considering the guidance in these judgments, it is clear to me that whilst conceptual similarity (or otherwise) is an important factor that may, in some circumstances, be the deciding issue, I must also consider all other factors including a visual and aural comparison of the marks as part of the global approach as advocated by the established case law.

31) In this respect, I note that the conceptual identity of Boi’s mark means a “no win situation”. There has been no evidence presented to show that this meaning is commonly understood by the average consumer. That said, the consumer will recognise CATCH 22 as a whole, as a known term, even if its precise meaning is not understood. I believe my view here is consistent with the approach advocated by Ms. Anna Carboni sitting as the Appointed Person in *Cherokee*, BL O-048-08. On the other hand, no clear conceptual meaning will be attributed to the mark CATCH DENIM.

32) At the hearing, Mr Rawlence also argued that as the common element CATCH appears at the beginning of both marks, this increases the likelihood of confusion. It is established that the first part of words catch the attention of consumers (see joined cases T-183/02 and T-184/02 *El Corte Inglés v OHIM – González Cabello and Iberia Líneas Aéreas de España (MUNDICOR)* [2004] ECR II-965, paragraph 81). As the UK consumer reads from left to right, it can be inferred that this guidance extends to where the first part of the *marks* are the same (as opposed to the first part of a *word*). With this guidance in mind, I am minded to concur with Mr Rawlence's submission.

33) The established case law, referred to earlier, requires that the global assessment of the likelihood of confusion is based on the overall impression given by the marks, bearing in mind the distinctive and dominant components of each mark. I have found that the respective marks share a reasonably high level of visual and aural similarity but that they are not conceptually similar. I concluded that these combine to result in the respective marks sharing a moderately high level of similarity overall. I also found that the earlier mark enjoys a reasonably high degree of distinctive character. Further, I have found that the respective goods are identical and that the purchasing act is primarily a visual one that involves a reasonable degree of care and attention, but that I must not ignore the aural considerations.

34) The point at issue can therefore be reduced down to assessing if the lack of conceptual similarity is sufficient, or not, to overcome the obvious visual and aural similarities. Whilst I do not find such an assessment an easy one to make, taking all of the above into account, and on the balance of probability, I find that the visual and aural similarities are such as to outweigh the lack of conceptual similarity. In reaching this conclusion, I bear in mind that the common element of both marks appears at the beginning of the marks and that imperfect recollection is a factor. Therefore, the average consumer will confuse the marks or at least assume that the goods provided under the respective marks originate from the same or linked undertaking. Clothing, footwear and headgear can all be made from denim or denim effect materials and in such circumstances confusion becomes even more likely.

35) In light of these findings, the invalidation action is successful in its entirety.

COSTS

36) The invalidation action having been successful, Boi is entitled to a contribution towards its costs. I take account that neither party filed evidence but did provide written submissions and that a hearing has taken place. I award costs on the following basis:

Preparing Application and statement and considering statement in reply
£400

Preparing and attending hearing
£500

TOTAL £900

37) I order Inderjit Atwal to pay Boi Trading Company Limited the sum of £900. 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 17 day of March 2011

**Mark Bryant
For the Registrar,
the Comptroller-General**