

O-139-11

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION 2525533  
BY ROOTICAL DUBBER ENTERPRISES LTD TO REGISTER THE TRADE  
MARK**

**FREEITY**

**IN CLASSES 9, 25, AND 41**

**AND IN THE MATTER OF OPPOSITION  
THERE TO UNDER NO 99990  
BY BARBARA GARDUNO, ALSO KNOWN AS 'NINA'**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF Application No 2525533**

**By Rootical Dubber Enterprises Ltd to register the trade mark**

**FREEITY**

**And**

**IN THE MATTER OF opposition thereto under No 99990 by Barbara Garduno (also known as Nina)**

**BACKGROUND AND PLEADINGS**

1. On 7<sup>th</sup> September 2009, Rootical Dubber Enterprises Ltd (“Rootical”) of Flat A, 38 Claribel Road, Lambeth, London SW9 6TJ applied to register the mark FREEITY in Classes 9, 25, and 41. The goods, the subject of these proceedings are in Class 25 only, in respect of:

“Clothing, footwear, headgear”

2. The application was allocated number 2525533 and was published in the Trade Marks Journal on 9<sup>th</sup> October 2009, and on 11<sup>th</sup> January 2010 Barbara Garduno (also known as ‘Nina’) of 3289 Carse Drive, Los Angeles, California 90068, USA lodged an opposition against the goods specified above.
3. Ms Garduno has opposed on the sole basis of section 5(2)(b), citing the following earlier mark:

Mark. Filing and registration dates	Goods and services relied upon under section 5(2)(b)
CTM 4192944 FREE CITY 15 <sup>th</sup> December 2004 27 <sup>th</sup> October 2006	<b>Class 25:</b>  Clothing Footwear Headgear

4. In her pleadings, Ms Garduno says the respective marks are visually and aurally virtually identical. Although FREEITY has no conceptual meaning, it can easily be mistaken for FREE CITY, which does have a meaning. Given

that the respective goods are identical, on a global assessment there would be a likelihood of confusion. She also says this is made all the more likely as she has acquired an extensive reputation under her mark in the UK.

5. Rootical filed a counterstatement saying, in particular, FREE CITY has a clear conceptual meaning, referring to a conurbation through which it is possible to move without restriction or at no financial cost. There is no such conceptual meaning attached to FREEITY. It also says that, given the visual and aural dissimilarities, overall there would be no likelihood of confusion, notwithstanding that the respective goods are identical.
6. Evidence was filed by both parties which, insofar as it is factually relevant, I shall summarise below.
7. Written submissions were received from the opponent which I shall take into account. No hearing was requested by either party and so I give my decision based upon a careful reading of the papers.

### **Opponent's evidence**

8. This takes the form of a witness statement, dated 29<sup>th</sup> June 2010, by Barbara Garduno, who is the founder and creator of the "lifestyle concept" and clothing and accessories brand, FREE CITY. She launched this brand in 2002.
9. She says she has been a fashion designer for 30 years with a pre-eminent reputation for setting trends in the world of fashion. Reference is made to her in articles published in TIME MAGAZINE, 2007 and THE NEW YORK TIMES of November 2006. The latter reference reads:

"Ms Garduno made her reputation in the 90's by presenting strong mixes of men's sportswear. She saw early on the chic of vintage denim from Japan, and, around 2000, began studded jeans, setting off a trend that has not entirely abated."

10. The brand FREE CITY has been used in over 14 countries, including in the UK and across the EU.
11. In the EU, FREE CITY has been sold in department and fashion stores in countries such as France, Germany, Greece, Italy, Spain and the UK. The specific store mentioned in the UK is SELFRIDGES. Other stores are mentioned in France, Germany and elsewhere.
12. She says FREE CITY clothing is also sold online in the EU through several websites, such as [www.conleys.de](http://www.conleys.de). Exhibit NG3 shows screenshots of this website showing the range of clothing available through this outlet. There are, in particular, sportswear such as sweatpants, jogging bottoms and

jackets. The words FREE CITY appear very prominently on the articles, which are priced in Euros.

13. She also has her own website at [www.freecitysupershop.com](http://www.freecitysupershop.com), through which consumers can order FREE CITY goods which are shipped to their country of choice. Exhibit NG4 shows screenshots from this website showing a fuller range of garment, including T-shirts, pants, shoes, bobble hats and hooded shirts. Most of the garments are emblazoned with the mark FREE CITY. The exhibit also shows that the goods can be shipped direct to the UK, amongst a wide variety of countries. The screenshots reflected the position as at 29<sup>th</sup> June 2010.
14. Other websites, such as [www.ronherman.com](http://www.ronherman.com) and [www.shopbop.com](http://www.shopbop.com) also stock FREE CITY clothing.
15. At Exhibit NG6 there is a selection of press articles, including W Magazine of March 2006, OK! Magazine of December 2008, ELLE Magazine of December 2005 and November 2004 and MALIBU Magazine of April/May 2007. The following is taken from OK! Magazine of December 15<sup>th</sup> 2008:

“The latest brand to hit tinseltown, Free City, isn’t your regular sweats and T-Shirt line. Worn by a string of stars, including Gwyneth Paltrow and Jake Gyllenhaal, every piece is handmade, unique and created under one roof in Los Angeles.”

16. She mentions other famous clients such as: David and Victoria Beckham, Brad Pitt, Paris Hilton, Jennifer Aniston, and some of these appear in paparazzi type photographs in, eg OK! Magazine, wearing the brand.
17. The fact the brand is worn by such high profile figures has meant that more traditional means of advertising and promotion have not been needed or relied upon. Publicity and exposure has been guaranteed by the nature and profile of the people wearing the clothes themselves. Ms Garduno terms this ‘viral marketing’, and it includes further exposures through blogs and commentaries, as well as promotion through social networking sites such as FACEBOOK, TWITTER and MYSPACE.
18. Annual sales figures for the EU are given as follows:

Year	Annual sales (US \$)
2008	1,820,000
2007	1,570,000
2006	1,310,000

19. Finally she explains why, in particular, she is concerned about the registration of the application, noting in particular internet usage of the term FREE CITY which is conjoined and commonly referred to as 'Freecity' or 'freecity', without any space between the words.

### **Applicant's evidence**

20. This takes the form of a witness statement, dated 27<sup>th</sup> August 2010, from Mr Peter Boreland who is Managing Director and Chief Executive of Rootical. He explains that the FREEITY name was created on 9<sup>th</sup> June 2008 and derives from a musical composition of his which was created on a piece of music software called CUBASE 4. This has been registered with the collecting society, Phonographic Performance Ltd.

21. 'FREEITY' stands for:

F – Freedom to achieve and be all that is possible  
R – Rooted deep in the divine diaspora  
E – Encompassing time and mental brilliance  
E – Exceeding the expectations of those inclined  
I – Introducing the best that can be offered  
T – Tempering pleasure with serious thoughts  
Y- Yielding the unexpected and making yeoman contribution to life, love and ambition.

22. At the time of his composition he had not heard of the FREE CITY brand and had remained in ignorance until the date of the opposition. Even if he had been aware he would have still chosen 'FREEITY' as he does not believe the two are likely to be confused.

23. The remainder of his evidence is submission in response to Ms Garduno's evidence which I shall take into account in due course.

### **DECISION**

#### **Section 5(2)(b)**

24. The opposition is founded upon Section 5(2) (b) of the Act. This 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.”

25. The earlier trade mark in this case has a filing date of 15<sup>th</sup> December 2004 and date of registration of 27<sup>th</sup> October 2006. It is therefore an earlier mark in accordance with section 6(1) of the Act, and given that its registration date is under five years prior to the date of publication of the application in suit, it is not subject to proof of use requirements under section 6A of the Act.

26. 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] 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* 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 trade 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*

(l) 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*

### **The average consumer and nature of the purchase**

27. The average end consumer for both parties' products, in a notional sense, will be the clothes buying general public. There is identity as far as the respective 'pools' from which the average consumer's for both parties' goods will be drawn.

28. The level of attention paid in the purchasing process by a consumer of clothing may vary depending on cost and the occasion; in general, though, clothing is a reasonably considered purchase as it is personal and items may

be tried on first, but it is not necessarily a highly considered purchase (as with certain specialist or technical goods).

29. Buying clothes is also predominantly a visual activity, as supported by case law, eg General Court Case T-57/03 *SPAG SA v OHIM* and *REACT* Trade Mark [2000] RPC 285. This does not mean of course that, in my later analysis, aural and conceptual comparisons can be ignored, or even downplayed, but the public is used to clothing selection by sight, whether that be in a traditional high street retail environment or online. I need to keep both major retail environments in mind in my later considerations. These observations will, as I have said, be factored into my considerations below, as and when appropriate.

### **Comparison of marks**

30. The case law makes it clear I must undertake a full comparison (taking account of visual, phonetic and conceptual similarities and dissimilarities), from the perspective of the average consumer. Both marks need to be considered in their totalities and overall impression (see authority (k) above in para 26), taking account of distinctive and dominant elements.

### ***Visual comparison***

31. Ms Garduno's mark is a two word mark, the first word, FREE, is of four letters and the second, CITY, is also of four letters. Both words are recognisable, dictionary words. It is a plain word only mark with no other matter, and the script is a normal, upper-case script.
32. Rootical's mark is a single, unrecognisable word mark, FREEITY. The word has seven letters and is in plain, upper case script with no other matter. Ms Garduno asks me, in effect, to consider normal and fair use of her mark to include the conjoined version, 'FREECITY', as this is often used on the internet, eg as in the website [www.freecitysuperstore.com](http://www.freecitysuperstore.com) or by third parties (ie consumers) searching for particular terms in search engines. It is clear why she should make such a submission as its consequence is that her mark becomes a single word mark, as well as the two words in which form it is registered. I am not persuaded by this; her mark was registered as two clear and separate words, no conjoined version was registered. I do not believe then that usage in the context of a domain name, or the particular way consumers may enter search terms, comprise grounds to depart from, or rather enlarge upon, the precise form of the mark as it has been chosen to be registered. So, in the two word version of Ms Garduno's mark, the additional difference would be that one is a two word mark and the other a one word mark. In either case, and taking all factors into account I find that, visually, the respective marks are highly similar.



### **Phonetic comparison**

33. Ms Garduno's mark will be pronounced 'FREE SITIE', the 'c' being pronounced in a soft way, as with the letter 's'. There are a number of possible alternatives as far as Rootical's mark is concerned. It could be pronounced 'FREE – ITEE', 'FREE-TEE', or even, but much less likely, 'FRAY-TEE'. The last version might be possible since the joining of an 'e' and 'i' can be pronounced as an 'a', as in, eg 'freight', but the double 'ee' in the word may well conspire against the possibility of this version. Given the slightly unusual conjunction of vowels, 'e' and 'i', in the middle of the word, it is not easy to say which of the first two pronunciations is the most likely as far as the average English-speaking consumer is concerned; the first which sounds the 'i' in the middle, and the second which does not. On balance I take the view that the 'i' will be sounded, as in the first example. Even if sounded, however, given its conjunction and blurring with the preceding 'e' letters it will not necessarily be plainly enunciated. On that basis, taking the similarities and dissimilarities into account, notably the absence of the 'c' in Rootical's mark (which undoubtedly will be sounded and not 'lost'), I find that phonetically the respective marks are similar to a reasonable degree. I should mention that even if we to be found wrong on the most likely pronunciation, it would not impact upon my overall consideration of the similarity of the marks, still less the global assessment of likelihood of confusion.

### **Conceptual comparison**

34. By conceptual similarity, it is meant 'semantic' conceptual similarity. Ms Garduno's mark has a clear semantic meaning – that of a city 'through which it is possible to move without restriction or at no financial cost'. I have borrowed those words from Rootical's counterstatement. They are unchallenged by Ms Garduno and appear to me to express the underlying concept evoked by the words. Alternative meanings may be possible, such as a city which is free of charge, but this seems too literal and therefore only a remote possibility at best. Given the context in which the words would be used, in respect of clothing, Rootical's expression of the underlying concept seems to me the most plausible.
35. By contrast, Rootical's mark will convey no such semantic concept; the word is made up and does not even have any resonance with a known word. Certainly, it is highly unlikely the average consumer will perceive 'FREEITY' as being an acronym or abbreviation derived from the beliefs of the author as set out in para 21 above. Given its length and absence of, eg full stops or gaps between the letters, it is unlikely it will be seen as *any* acronym or abbreviation.

36. So, whilst it is not possible to conclude that the respective marks are conceptually dissonant (as one has no meaning at all), neither can it be said that they are conceptually alike or similar, either. I shall further consider below what impact this has on my assessment of overall similarity of the marks.

### **Overall similarity of the marks**

37. At this point I need to make a finding in respect to 'overall impression' of the respective marks, having regard to any distinctive, dominant elements. Neither mark is 'complex', in terms of it having multiple elements which may not have equal distinctiveness and/or dominance.

38. The critical question in this case is whether the absence of any finding, as far as conceptual similarity is concerned, is sufficient to counteract the findings as far as visual and phonetic similarities are concerned. There is a strand of authority derived from European authorities in particular, which may suggest this can be the case, eg General Court Case T-292/01 *Phillips-Van-Heusen Corp v OHIM*, para 54 ("*Phillips*"). That said, there is always a danger to deriving an immutable legal principle from a case invariably decided on its own facts and circumstances. Such cases do not say, emphatically, that in all cases an absence of conceptual similarity (or, as in this case, any finding at all) will outweigh or counteract visual and phonetic similarity. It *may* do.

39. In this particular case, I believe there is another factor which plays a part in my overall assessment of similarity of marks from the average consumer's perspective, and that is that the human eye tends to see what the brain expects it to see. That is to say, that the word 'FREEITY' has no obvious meaning and may well, as I have said, be pronounced in different ways. Because of its length, the possibility that it may be any acronym or abbreviation, let alone the one intended by the applicant, is remote. It is quite possible then, that some average consumers may well actually try to make some sense of it, arriving at the words 'FREE CITY', especially if they merely glance briefly at the word, as, eg, in particular, in an internet scenario. This factor is something recognised in the authorities also, most recently in *OCH-ZIFF Management Europe Ltd and OZ Management LP v OCH Capital LLP and others* [2010] EWHC 2599 (Ch), para 120. As with the *Phillips* case above however, I am not saying that such a factor will always and inevitably take precedence over other, possibly competing factors. I am merely saying that in this particular case and in my view such a factor has some relevance. I have already said, for example, that clothing is primarily a visual selection, and that use on the internet is a factor to be considered. It is also the case that the earlier mark is not a single, short word of obvious meaning, but rather, two words conveying slightly less clear meaning when used in combination and, with the exception of the absence of the letter 'c', the later mark is absolutely identical in the letters used and their order.

40. In all the circumstances, taking the visual, aural and conceptual assessments *overall*, I find the respective marks share a high degree of similarity.

### **Comparison of the goods**

41. It is beyond dispute that the relevant goods are identical.

### **Likelihood of confusion**

42. Before proceeding to bring all my findings together in an overall global assessment, I need to make an assessment of the distinctive character of the earlier mark. An invented word having no derivation from known words is, in its inherent characteristics, very high on the scale of distinctiveness, KODAK of course being the prime example.

43. The earlier mark is the dictionary words 'FREE CITY', which will be understood by the average consumer, but which nonetheless bears no obvious allusion or direct connection with the goods of the specification. On that basis, the earlier mark can be said to be inherently distinctive on a moderate level. I need to consider also whether the inherent distinctiveness has been enhanced through use. Plainly, Ms Garduno's mark has been used in the UK and in particular, received 'exposure' through, eg magazine articles showing celebrities wearing the clothes, but there is nothing to put this exposure into a sales context as far as the overall clothing trade in the UK is concerned. Moreover, such turnover figures as are given relate to the EU, rather than the UK *solus*. The only high street retailer in the UK mentioned as stocking the clothing is SELFRIDGES. As far as the websites are concerned, although a capability to ship to the UK is demonstrated, there are no figures as far as UK only sales are concerned. In all the circumstances, I find that the inherent distinctiveness of the earlier mark has not been enhanced through use in the UK.

44. At this point I need to remind myself of my various findings and bring them together in a global assessment taking into account the doctrine of imperfect recollection, namely that consumers rarely have the opportunity to compare marks side by side.

45. I have found that the respective goods are identical. I have found the earlier mark to be distinctive on a moderate level. I have made observations on the respective average consumers, namely that they are also identical and I have found the purchasing process to involve considered purchasing, based predominantly upon visual inspection but not ignoring aural and conceptual factors. Finally, I have found the respective marks to share a high degree of similarity. Needless to say that in making a global assessment, it is not a 'tick

box' exercise, whereby if I find more factors in Ms Garduno's favour, she wins. All factors must be weighed in the evaluation of likelihood of confusion.

46. Nonetheless, in all the circumstances I find there is a likelihood of confusion in this case and the opposition is successful in its entirety.

### **Costs**

47. Ms Garduno has been totally successful in her opposition. Accordingly, she is entitled to a contribution towards her costs and neither party sought costs off the normal scale. In the circumstances I award Barbara Garduno the sum of £1200 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

1. Filing opposition and considering counterstatement - £400
2. Filing evidence - £ 400
3. Filing submissions - £400

Total £1200

48. I order Rooticals Dubber Enterprises Ltd to pay Barbara Garduno the sum of £1200. The 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 26 day of April 2011**

**Edward Smith  
For the Registrar,  
the Comptroller-General**