

O-341-12

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2594309
BY
DAVID BELL-GAM
TO REGISTER THE TRADE MARK**



IN CLASSES 16, 18 AND 25

AND

**THE OPPOSITION THERETO
UNDER NO 102832
BY
STRELLSON AG**

Background and pleadings

1. David Bell-Gam applied to register the trade mark shown below on 12 September 2011, for goods in classes 16, 18 and 25:



Class 16: *Paper, cardboard and goods made from these materials; printed matter; book binding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters; packaging materials; printers' type; printing blocks; disposable nappies of paper for babies; printed publications; paint boxes for children; cheque book holders.*

Class 18: *Leather and imitations of leather; animal skins, hides; trunks and travelling bags; handbags, rucksacks, purses; umbrellas, parasols and walking sticks; whips, harness and saddlery; clothing for animals.*

Class 25: *All variations of clothing and footwear items.*

2. The application was published on 28 October 2011 in the *Trade Marks Journal*, following which an opposition was filed by Strellson AG (“the opponent”). The opponent claims that the application offends sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”). These sections state:

“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.”

(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community

trade mark or international trade mark (EC), in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

3. Under section 5(2)(b), the opponent relies upon the following two Community Trade Marks (“CTMs”):

(i) 7524069

JOOP

Class 16: Loose-leaf binders for office use; albums; announcement cards; cabinets for stationery [office requisites]; Paintings [pictures], framed or unframed; paper sheets (stationery); pencils; pencil sharpeners (electric or non electric); pencil sharpeners (electric or non electric); pads (stationery); paperweights; letter trays; stationery paper; brochures; books; bookends; office requisites (other than furniture); printed matter; penholders; fountain pens; greeting cards; envelopes (stationery); jackets for papers; holders (passport); hat boxes of cardboard; calendars; coasters (of paper); cards; cardboard; lithographic works of art; bookmarks; nibs; punches (office requisites); magazines (periodicals); paper knives (office requisites); scrapers (erasers) for offices; pencil leads; pencil lead holders; jotters; packing paper; stationery; face towels of paper; paper towels; paper napkins; paper handkerchiefs; paper bags; photographs; photoengravings; posters; portraits; postcards; prospectuses; erasers; rosaries; boxes of cardboard or paper; signs of paper or cardboard; patterns for dressmaking; pen cases; inkstands; writing instruments; writing books; writing sets with writing paper; writing materials; place mats of paper; paper table covers; table cloths of paper; table linen of paper; coasters of paper; cardboard articles; wrapping paper; drawing materials; drawing pads; drawing boards; drawing sets; drawing instruments; drawings; periodicals; newspapers; cigar bands.

Class 18: Briefcases, document wallets, beach bags, packaging bags (envelopes, pouches) of leather, trimmings of leather for furniture, wallets, camping bags, horse blankets, coverings of skins (furs), attaché cases, boxes of leather or leatherboard, boxes and cases of vulcanised fibre, net bags for shopping, shopping bags; key cases (leatherwear); casings of leather for springs, skins (furs), umbrellas cases, purses (pouches), chain mail purses (not of precious metal), travelling bags, handbags, hunting bags, card cases (wallets), cases of leather or leatherboard, garment bags for travel, suitcases, trunks, vanity cases, umbrellas, travelling bags, rucksacks, boxes of leather or leatherboard, school satchels, school bags, parasols, walking sticks, wheeled bags, haversacks, toolbags of leather (empty), kid leather.

Class 25: *Suits, babywear, swimsuits, bathing trunks, bathrobes, swimming caps, bath sandals, bath slippers, bandanas (neckerchiefs), clothing of imitation leather, motorists' clothing, clothing, clothing of paper, iron fittings for boots, bodies, brassieres, belts (garments), clothing for gymnastics, gymnastic shoes, ankle boots (half-boots), scarves, gloves (clothing), slippers, shirt fronts, shirts, pants, braces, hats, jackets, jerseys (clothing), garment bags, designer clothing, headgear, camisoles, corsets, ties, bibs (not of paper), clothing of leather, underwear, coats, corselets, dressing gowns, muffs (clothing), caps, outerclothing, earmuffs (garments), combinations (clothing), slippers, parkas, pelerines, furs (garments), petticoats, jumpers, pyjamas, cyclists' clothing, raincoats, skirts, sandals, scarves, pyjamas, veils (garments), wimples, knickers, lace-up boots, shoes, footwear, aprons, ski boots, briefs, socks, sock suspenders, boots for sports, boots, lace-up boots, headbands (garments), esparto shoes or sandals, shawls, beachwear, beach shoes, garters, stockings, tights, sweaters, T-shirts, togas (clothing), knitwear, sports jerseys, overcoats, underwear, underpants, body linen (garments), linen (clothing), wetsuits for water-skiing, waistcoats, hosiery.*

Application date: 15 January 2009

Date registration procedure completed: 29 July 2009

(ii) 9222142

JOOP!

Class 16: *Loose-leaf binders for office use; albums; announcement cards; stickers (papetery goods); cabinets for stationery [office requisites]; Paintings [pictures], framed or unframed; paper sheets (stationery); pencils; pencil sharpeners (electric or non electric); pencil sharpeners (electric or non electric); pads (stationery); paperweights; letter trays; stationery paper; brochures; books; bookends; office requisites (other than furniture); printed matter; penholders; fountain pens; greeting cards; envelopes (stationery); jackets for papers; holders (passport); hat boxes of cardboard; calendars; coasters (of paper); cards; cardboard; lithographic works of art; bookmarks; nibs; punches (office requisites); magazines (periodicals); paper knives (office requisites); scrapers (erasers) for offices; pencil leads; pencil lead holders; jotters; packing paper; stationery; face towels of paper; paper towels; paper napkins; paper handkerchiefs; paper bags; photographs; photoengravings; posters; portraits; postcards; prospectuses; erasers; rosaries; boxes of cardboard or paper; signs of paper or cardboard; patterns for dressmaking; pen cases; inkstands; writing instruments; writing books; writing sets with writing paper; writing materials; place mats of paper; paper table covers; table cloths of paper; table linen of paper; coasters of paper; cardboard articles; wrapping paper; drawing materials; drawing pads; drawing boards; drawing sets; drawing instruments; drawings; periodicals; newspapers; cigar bands; document cases.*

Class 18: *Briefcases; beach bags; pouches of leather, for packaging; trimmings of leather for furniture; wallets; bags for campers; horse blankets; coverings of skins (furs); document cases; boxes of leather or leatherboard; boxes of vulcanised fibre; net bags for shopping; tote bags; key cases (leatherwear); sleeves, of leather, for springs; fur skins; umbrella covers; purses; mesh purses (not of precious metal); suitcases; handbags; game bags; card holders (wallets); cases of leather or leatherboard; garment bags for travel; luggage boxes; travel cases; beauty cases; umbrellas; travelling bags; rucksacks; Boxes of leather or leather board; satchels; bags for school; parasols; walking sticks; wheeled shopping bags; haversacks; tool bags (empty); kid.*

Class 25: *Suits; layettes (clothing); swimming costumes; bathing trunks; bathrobes; bathing caps; bath sandals; bath slippers; bandanas (scarves); clothing made from imitations of leather; motorists' clothing; clothing; paper clothing; fittings of metal for shoes and boots; teddies (undergarments); brassieres; belts (clothing); clothing for gymnastics; gymnastic shoes; ankle boots; neckerchiefs; gloves (clothing); slippers; ladies' shirts; shirts; trousers; braces; hats; jackets; jersey clothing; pockets for clothing; ready-made clothing; headgear; camisoles; corsets; ties; bibs (not of paper); leather clothing; underwear; coats; corselets; dressing gowns; muffs [clothing]; caps; outerclothing; ear muffs (clothing); jump suits; mules; parkas; wraps; furs (clothing); petticoats; pullovers; pajamas (am); cyclists' clothing; raincoats; skirts; sandals; shawls; sashes for wear; pyjamas; veiling (clothing); wimpels; breeches [for wear]; lace boots; shoes; footwear; aprons; ski boots; briefs; socks; sock suspenders; sports shoes; boots; lace boots; headbands (clothing); esparto shoes or sandals; stoles; beach clothes; beach shoes; garters; stockings; tights; sweaters; t-shirts; togas; knitwear [clothing]; maillots; topcoats; underwear; underpants; underwear; Body linen (garments); wet suits for water skiing; waistcoats; Hosiery.*

Application date: 5 July 2010

Date registration procedure completed: 10 December 2010.

4. These are earlier trade marks which are not subject to proof of use¹ because at the date of publication of the opposed application (28 October 2011) they had been registered for less than five years. The significance of this is that the opponent's marks can be taken into account across the full breadth of the goods relied upon, on the basis of notional and fair use of the terms in its specifications.

5. The earlier marks are also relied upon for the section 5(3) ground, in respect of a claim to reputation in "Clothing, footwear, luggage, travelling bags and handbags, wallets, purses and key cases."

¹ See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations) 2004 (SI 2004/946) which came into force on 5th May 2004.

6. Under section 5(2)(b), the opponent claims that the distinctive and dominant element of the applied for mark is J.O.O, which is how it will be referred to, this element being very similar aurally to the opponent's marks JOOP/JOOP! The opponent claims that the marks are strongly similar visually, conceptually and especially aurally and that the goods are identical or similar. The opponent contends that, consequently, there is a likelihood of confusion. Under section 5(3), it claims that the earlier marks enjoy a strong reputation in the European Community and that there would be a link between the parties' marks. The opponent claims that use without due cause of the application would free-ride upon its reputation, would tarnish its reputation if the goods were inferior, and would dilute the distinctive character of the opponent's marks.

7. Mr Bell-Gam filed a counterstatement in which he denies the grounds of opposition. Mr Bell-Gam states that there is a clear and significant difference in the marks' appearances. He says the letters in his mark are separated by diamond shapes which highlight the fact that the three-letter combination is an acronym, not a word. He also states that the mermaid device is equally as prominent in his mark as the letters and this puts further distance between the marks. Finally, Mr Bell-Gam states that he has no intention of trying to benefit from the opponent's "established brand/trademark" or to deceive consumers into believing they are linked.

8. Both sides filed evidence and submissions and were content for a decision to be made from the papers on file rather than attend a hearing.

Evidence

9. The opponent's evidence comes from its trade mark attorney, Catherine Wolfe. Her witness statement serves to bring in observations filed in relation to proceedings involving JOOP! GmbH² before the Office for Harmonisation in the Internal Market ("OHIM") (the proceedings did not involve Mr Bell-Gam and the observations were filed by Ms Wolfe's German instructing attorneys). Ms Wolfe refers to paragraph three of the observations as being the source of the data referred to in her written submissions filed in the instant case. She does not refer to the remainder of the OHIM observations, which are in the nature of evidence; the supporting exhibits have not been filed in the instant case. I am therefore proceeding on the basis that only paragraph three of the OHIM observations has been adduced as evidence. There are no exhibits to support paragraph 3, which reads:

"The designation "JOOP!" is well-known in Germany, in the European Union and worldwide. "JOOP!" products are regularly depicted and described in magazines, in particular in fashion magazines in Germany and worldwide. Furthermore, JOOP! GmbH frequently exhibits its

² Ms Wolfe states, in her written submissions, that the present opponent is the successor in title to JOOP! GmbH.

“JOOP!” products at trade fairs worldwide (e.g. in Düsseldorf, Berlin, Milano).

Among the top-selling products are women’s and men’s clothing. During the years 1998 to 2007, JOOP! GmbH gained an average turnover with the sales of both women’s and men’s clothing, leather goods, shoes and accessories under the trade mark “JOOP!” in the amount of a double-digit million Euro sum per annum in Europe”

JOOP! GmbH expended and continues to expend – both in Germany and worldwide – substantial amounts of money, time and effort in advertising, promoting and popularising its “JOOP!” trade marks. The same applied to licensees of JOOP! GmbH. From 1998 to 2007, JOOP! GmbH spent more than €100 million for advertising of the “JOOP!” brand.”

10. The OHIM opposition division decision is annexed to Ms Wolfe’s written submissions. Ms Wolfe also exhibits an extract from the Oxford English Dictionary of English, Third edition 2010, at the page for words beginning with JOO.

11. Mr Bell-Gam has filed a witness statement and exhibits. Mr Bell-Gam explains that J.O.O is an acronym for the west African historical figure, Jaja of Opobo (who founded the city-states Opobo, where Mr Bell-Gam’s father was born). The mermaid device symbolizes the African diaspora’s Mami Wata deity and the crown symbolizes the status of Jaja of Opobo’s status as historical king. He states that he acknowledges the opponent’s commercial achievements, but that he “attained absolutely no influence” from the opponent’s trade marks when he created his own trade mark.

12. The remainder of Mr Bell-Gam’s witness statement forms submissions rather than fact, which I bear in mind but will not summarise as evidence. He has also refers to how he envisages the mark being used and evolving. This is not relevant because the comparison must be made on the basis of what has been applied for.

Decision

13. The leading authorities which guide me in this ground are from the Court of Justice of the European Union (“CJEU”): *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, *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 for 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) 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*

f) 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*.

(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*,

(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*,

(i) 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*,

(j) 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*,

(k) 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*,

(l) 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.*

Comparison of goods

14. It is necessary for me to determine the level of similarity between the parties' goods on account of the interdependency principle, whereby a lesser degree of similarity between the goods and services may be offset by a greater degree of similarity between the trade marks, and vice versa, as a factor in the global appreciation of the likelihood of confusion³.

15. In comparing the respective specifications, all relevant factors should be considered, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* where the CJEU stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

‘Complementary’ was defined by the General Court (“GC”) in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-325/06*:

“82 It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking...”.

16. Additionally, the criteria identified in *British Sugar Plc v James Robertson & Sons Limited* (“*Treat*”) [1996] R.P.C. 281 for assessing similarity between goods and services included an assessment of the channels of trade of the respective goods or services. Specifications should not be given an unnaturally narrow meaning, as per *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267. Finally, if goods or services fall within the ambit of terms within the competing specification, they are

³ As per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*

considered to be identical, as stated by the GC in *Gérard Meric v OHIM*, case T-133/05⁴. I will compare Mr Bell-Gam's goods with those of the opponent, class by class.

17. I list below, in italics, the goods in Mr Bell-Gam's specifications which are identical to goods in the opponent's specifications (in bold), either because the term is identical or because the goods of one party fall within the ambit of a wider term featuring in the other party's specification. For Mr Bell-Gam's class 16 goods:

<i>Paper</i>	Paper sheets; stationery paper
<i>Cardboard</i>	Cardboard
<i>Goods made from paper and cardboard</i>	Wrapping paper; cardboard articles
<i>Printed matter</i>	Printed matter
<i>Photographs</i>	Photographs
<i>Stationery</i>	Stationery
<i>Adhesives for stationery or household purposes</i>	Stationery
<i>Artists' materials</i>	Drawing materials
<i>Typewriters</i>	Office requisites
<i>Packaging materials</i>	Packing paper
<i>Printed publications</i>	Printed matter

18. The remaining goods in Mr Bell-Gam's class 16 specification are *book binding material; paint brushes; printer's type; printing blocks; disposable nappies of paper for babies; paintboxes for children; cheque book holders. Paint brushes*

⁴ "29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 Oberhauser v OHIM – Petit Liberto (Fifties) [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 Vedral v OHIM – France Distribution (HUBERT) [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 Koubi v OHIM – Flabesa (CONFORFLEX) [2004] ECR II-719, paragraphs 41 and 42)."

and *paintboxes for children* are sold alongside stationery. They have a similar purpose to coloured pencils and felt-tips which are items of stationery. Paint and paint-brushes are used by both artists and children instead of pencils and other coloured materials. Mr Bell-Gam's *paint brushes* and *paintboxes for children* are highly similar to the opponent's *stationery*.

19. *Printer's type* are specialist goods for use in typesetting . These are not covered by any of the opponent's terms and are not similar to any of the goods listed. *Printing blocks* are covered by the terms *office requisites* and *stationery* as *printing blocks* covers all manner of blocks and stamps which leave a printed impression. These are identical.

20. The closest goods in the opponent's specifications to *disposable nappies of paper for babies* are *babywear* and *bibs* in class 25. Baby items are grouped together in supermarkets. The users are clearly the same, although the nature and purpose of the goods are clearly not and they are not in competition, nor are they complementary (except that one would not clothe a baby without putting a nappy on first). There is a low level of similarity between *disposable nappies of paper for babies* and the opponent's *babywear* and *bibs*.

21. There is a good deal of similarity between Mr Bell-Gam's *cheque book holders* and the opponent's *holders (passport)* (class 16). These items are sold cheek-by-jowl, have a very similar nature (apart from dimensions) and an identical purpose (to keep the item clean, dry and tidy).

22. To the extent that *book binding material* covers glue and paper sheets, there is a low degree of similarity with the opponent's *stationery* and *paper sheets (stationery)* on the basis of shared nature and purpose. I put it no higher than low because book binding is a specialist skill and the materials used are unlikely to be sold in a stationer's or alongside stationery and office requisites.

23. For Mr Bell-Gam's class 18 goods:

<i>Leather</i>	Kid leather
<i>Animal skins, hides</i>	Skins (furs)
<i>Trunks and travelling bags</i>	Trunks; travelling bags
<i>Handbags</i>	Handbags
<i>Rucksacks</i>	Rucksacks
<i>Purses</i>	Purses
<i>Umbrellas</i>	Umbrellas

Parasols

Parasols

Walking sticks

Walking sticks

Clothing for animals

Horse blankets

24. The remaining goods are *imitations of leather* and *whips, harness and saddlery*. Imitations of leather are the artificial version of leather, used as a direct alternative to leather. If not strictly identical, there is a near-identical level of similarity with the opponent's kid leather and trimmings of leather for furniture (imitation leather is commonly used in furniture).

25. *Whips, harness and saddlery* are equestrian goods, as are the opponent's *horse blankets*. Although not in completion and not complementary, all these goods will be sold side-by-side in equestrian equipment shops, will be bought by the same people for the purpose of horse-riding and maintaining a horse's health in order to ride it. There is a good deal of similarity between the goods.

27. Mr Bell-Gam's class 25 specification reads "*all variations of clothing and footwear items*". The opponent's specification lists many items of clothing and footwear (including togas and wimples). Mr Bell-Gam's specification encompasses all of the specific items listed in the applicant's specification. The goods of both parties are identical because the specific items listed in the applicant's specification fall within the ambit of Mr Bell-Gam's specification.

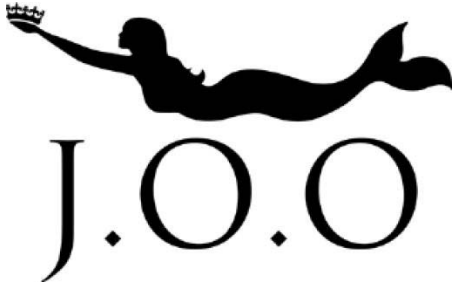
Average consumer and the purchasing process

28. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect, but his/her level of attention is likely to vary according to the category of goods. The average consumer for the great majority of the parties' goods is the general public. These are consumer items which vary greatly in price and attention levels (an HB pencil will not cause the same amount of circumspection as the purchase of a leather travelling case or a suit). A reasonable level of attention will be paid to the purchase of the majority of goods. The purchase of the goods will be primarily visual, aesthetic considerations being relevant for many of the items, but I do not discount the potential for oral use of the mark.

Comparison of trade marks

29. The above authorities direct that, in making a comparison between the marks, I must have regard to each mark's visual, aural and conceptual characteristics. I have to decide which, if any, of their components I consider to be distinctive and dominant, without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

30. The marks to be compared are:

Opponent's marks	Application
<p>JOOP</p> <p>JOOP!</p>	

31. JOOP is the dominant and distinctive element of each of the opponent's marks. Mr Bell-Gam's mark comprises two elements, the mermaid and the letters J.O.O (with small diamonds between the letters). Both of these elements have substantial visual impact. Both are distinctive. The letters are more dominant because they are slightly higher than the device, but this dominance is marginal because both elements are, proportionately, roughly equal and strike the eye together.

32. The only point of similarity between the marks is the letter element of Mr Bell-Gam's mark. Mr Bell-Gam's letters, J.O.O, are the first three letters, out of a total of four, in the opponent's marks. The opponent's marks comprise a word, albeit an invented word, which is easily pronounced. The letters in Mr Bell-Gam's mark are punctuated by diamond shapes which, in a letter combination which is not a known word, creates an impression of an acronym, rather than a word. Acronyms are, by definition, letters rather than words. Although there are visual similarities between JOOP/JOOP! and J.O.O, the differences between the parties' word elements, combined with the large device of a mermaid in Mr Bell-Gam's mark, mean that the level of visual similarity is limited.

33. The mermaid device will not be referred to orally. It is possible, as Mr Bell-Gam himself submits, that his mark will be referred to as JOO. If it is, then the marks are close aurally. However, as I have said, the punctuation between the letters in his mark means it is likely that they will be seen as separate letters, and therefore pronounced separately, in which case there is no aural similarity between them.

34. The word and letter elements of the marks do not have any meaning. Mr Bell-Gam's device is recognisable as a mermaid. His mark, as a whole, does not have a concept because there is no conceptual link between the mermaid and J.O.O. The parties' marks are conceptually neutral in comparison with one

another. Overall, there is a certain level of similarity between the marks. I will consider the impact of the differing levels of visual, aural and conceptual similarity when deciding whether there is a likelihood of confusion.

Distinctiveness of the earlier marks

35. It is important that I consider the distinctive character of the earlier mark because the more distinctive it is, either by inherent nature or by use (nurture) the greater the likelihood of confusion⁵. The distinctive character of the earlier trade mark must be assessed by reference to the goods for which it is registered and by reference to the way it is perceived by the relevant public⁶. The opponent's evidence of use is perfunctory: there are no exhibits and the sole reference to EU-wide turnover is to be found in observations filed at OHIM. There is no breakdown by category of goods and the evidence, such that it is, relates to clothing, footwear and "accessories". The opponent is not entitled, on the basis of the evidence filed in these proceedings, to claim enhanced distinctive character as a result of the use made of the mark in the UK. As the application is for the UK only, it is necessary to consider the establishment of reputation in the UK. Any reputation that the marks may have within the EU generally is not evidence of reputation in the UK. The assessment of distinctiveness is therefore made with regard to the inherent distinctive character of JOOP and JOOP! These are not dictionary words and are not reminiscent of any dictionary word commonly known to the average consumer. As invented words, the opponent's marks have a high degree of inherent distinctive character.

Likelihood of confusion

36. In deciding whether there is a likelihood of confusion between the marks, I must weigh the various factors I have identified (I have already mentioned the principle of interdependency in paragraph 14). I bear in mind the whole mark comparison and the dominant and distinctive elements within the marks. I should guard against dissecting the marks so as to distort the average consumer's perception of them; the average consumer perceives trade marks as wholes and rarely has the opportunity to compare marks side by side, relying instead upon the imperfect picture he has of them in his mind.

37. One of the factors to consider in the global appreciation is the weight which I should attach to the type of purchasing process. The relevance of this point is that sometimes the characteristics of the purchasing process for some goods and services are more aural than visual. The opponent has referred to *Phildar SA v OHIM* Case T-99/06 as support for its position that, even in situations where

⁵ *Sabel BV v Puma AG* [1998] RPC 199.

⁶ *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

certain goods are purchased visually, there may be a likelihood of confusion aurally. The opponent claims that the marks are aurally similar and that, for example, if a consumer hears about the latest “JOOP” clothing range, may consider that Mr Bell-Gam’s mark originates from the opponent, or is linked to the opponent. The part of the judgement to which the opponent refers reads:

“82 In that regard, it must be pointed out, first, that the importance of certain visual dissimilarities may be diminished by the fact that the average consumer only rarely has the chance to make a direct comparison between the different marks at issue but must rely on the imperfect picture of them that he has retained in his mind. Secondly, the consumer may be prompted, as submitted by the applicant, to choose goods from the categories in question in response to a television advertisement, for example, or because he has heard them being spoken about, in which cases he might retain the aural impression of the mark in question as well as the visual aspect. It has already been held that mere aural similarity may, in certain cases, lead to a likelihood of confusion (see paragraph 58 above). It is possible that the consumer might let himself be guided in his choice by the imperfect aural impression that he has retained of the earlier mark which may, inter alia, remind him of something in common with a ‘thread’. The importance of the aural aspect was mentioned only in respect of some of the goods concerned such as the ‘strings’ in Class 22, the various goods in Class 23 and those in Class 26, with regard to which the Board of Appeal accepted that they are generally sold over the counter, that is to say, orally (paragraphs 26 to 28 of the contested decision).”

That was a case in which the goods were sold over the counter and in which the Board of Appeal was criticised by the General Court for disregarding the potential for aural use of the mark in the purchasing process and the consequent effect on imperfect recollection. In *New Look Ltd v OHIM* Joined cases T-117/03 to T-119/03 and T-171/03, the GC stated:

“49 However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (*BUDMEN*, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumer choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other

hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs.

50. The applicant has not mentioned any particular conditions under which the goods are marketed. Generally in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly the visual aspect plays a greater role in the global assessment of the likelihood of confusion.”

38. I do not disregard the potential for aural confusion but, as in the *New Look* case cited above, I must bear in mind the importance of the visual aspect to the purchasing process and its consequential weight in the global analysis. In the instant case, the average consumer’s selection and contact with the parties’ marks will be overwhelmingly visual, so the level of visual similarity is more important than the aural similarity. The opponent has not submitted that there are any particular conditions in which its goods are marketed which mean that aural considerations are particularly pertinent; in fact, its own evidence suggests the opposite:

“JOOP!” products are regularly depicted and described in magazines, in particular in fashion magazines in Germany and worldwide.

39. 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,⁷ but the overall impression conveyed to the relevant public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components. Allowing for the moderate dominance in Mr Bell-Gam’s mark of the letter element, there are not only differences between the opponent’s marks and the letters on account of the punctuation, but considerable differences between the opponent’s marks and the whole of Mr Bell-Gam’s mark. Even if I were to consider that there is close aural similarity between the marks, the visual aspect to the purchasing process puts enough distance between the overall impressions of the parties’ marks so that any potential for imperfect recollection on the basis of aural referencing of the marks (as the opponent puts it, a consumer hearing about the latest JOOP clothing range), will be mitigated, even in relation to goods eliciting only average levels of attention. **There is no likelihood of confusion.**

40. The opponent has attached two OHIM opposition decisions which went in its favour. I bear in mind what was said by Mr Geoffrey Hobbs Q.C., sitting as the

⁷ *Shaker di Laudato & C. Sas v OHIM*.

Appointed Person in *Zurich Private Banking* BL 0/201/04, on the matter of decisions in different jurisdictions:

“However, the position as between different national registries and the Community Trade Marks Office is that they are not competent to adjudicate on the correctness of each other’s determinations and, as a corollary of that, not required to treat each other’s determinations as binding upon them in the independent exercise of their own powers. That is not to say that each of them should or will simply ignore the determinations of the others. The general principle is that each of them should give determinations of the others such weight (if any) as they might fairly and properly be said to bear in the decision-taking processes they are required to undertake independently of one another.”

41. I have considered whether either of these cases causes me to alter my view that there is not a likelihood of confusion between JOOP/JOOP! and Mr Bell-Gam’s mark. The marks being compared in the first case were the opponent’s JOOP! mark and



(for clothing). There is no punctuation in the composite mark shown above and the relative proportions of the elements are very different to the instant case. I am not persuaded that the details of this OHIM decision can be applied usefully to the comparison between the opponent’s and Mr Bell-Gam’s marks. The marks compared in the second case were JOOP! and LOOP (classes 20, 24 and 27). The circumstances here are so far away from those which I have to consider that this decision is of no assistance at all.

Section 5(3)

42. It is a pre-requisite of this section of the Act that the earlier mark has the necessary reputation at the relevant date, as per *General Motors Corporation v Yplon SA* [1999] E.T.M.R. 950. I have discussed above the problems in relation to whether the opponent has a reputation in the marks and, if so, its extent because there is lack of evidence about the turnover in relation to the goods relied upon and there is a lack of information about market share.

43. Even if I were to find that the opponent has a reputation in the marks, and I note that Mr Bell-Gam refers in his counterstatement to the opponent’s “established brand/trademark”, proving that there is a sufficient reputation is only the first step in the conditions necessary for success under section 5(3) of the Act. The opponent must also establish that there would be a link between the

marks, as per the CJEU's judgment in *Intel Corporation Inc. v CPM United Kingdom Limited*, Case C-252/07⁸.

44. Although it is unnecessary to find that there is a likelihood of confusion in order to find that there is a link, my comments in relation to the similarity of marks also lead me to conclude that there is insufficient similarity⁹, even in relation to identical goods (as opposed to dissimilar goods), to cause the average consumer to bring the opponent's marks to mind. **The section 5(3) ground fails.**

Outcome

45. The opposition fails.

Costs

46. Mr Bell-Gam has been successful and is entitled to a contribution towards the cost of the time he has spent on these proceedings. The Registrar usually operates on a published scale of costs¹⁰. However, since Mr Bell-Gam has not been professionally represented during the proceedings, an award made from

8. "1. Article 4(4)(a) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks must be interpreted as meaning that whether there is a link, within the meaning of Case C-408/01 *Adidas-Salomon and Adidas Benelux*, between the earlier mark with a reputation and the later mark must be assessed globally, taking into account all factors relevant to the circumstances of the case.

2. The fact that, for the average consumer, who is reasonably well informed and reasonably observant and circumspect, the later mark calls the earlier mark with a reputation to mind is tantamount to the existence of such a link, within the meaning of *Adidas-Salomon and Adidas Benelux*, between the conflicting marks."

⁹ *Ferrero SpA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case C-552/09 P: "53 It is true that those provisions differ in terms of the degree of similarity required. Whereas the implementation of the protection provided for under Article 8(1)(b) of Regulation No 40/94 is conditional upon a finding of a degree of similarity between the marks at issue such that there exists a likelihood of confusion between them on the part of the relevant section of the public, the existence of such a likelihood is not necessary for the protection conferred by Article 8(5) of that regulation. Accordingly, the types of injury referred to in Article 8(5) may be the consequence of a lesser degree of similarity between the earlier and later marks, provided that it is sufficient for the relevant section of the public to make a connection between those marks, that is to say, to establish a link between them (see, to that effect, *Adidas-Salomon and Adidas Benelux*, paragraphs 27, 29 and 31, and *Intel Corporation*, paragraphs 57, 58 and 66).

54 On the other hand, it is not apparent either from the wording of those provisions or from the case-law that the similarity between the marks at issue must be assessed in a different way, according to whether the assessment is carried out under Article 8(1)(b) of Regulation No 40/94 or under Article 8(5)."

¹⁰ Tribunal Practice Notice 4/2007.

the published scale might be larger than his actual expenditure. In BL O/160/08 *South Beck*, Mr Richard Arnold QC, sitting as the appointed person, stated:

“32. Secondly, counsel for the opponent submitted that, if CPR r. 48.6 was applicable, the hearing officer had misapplied it. In support of this submission he pointed out that CPR r. 48.6(4) provides:

The amount of costs to be allowed to the litigant in person for any item of work claimed shall be-

(a) where the litigant can prove financial loss, the amount that he can prove he has lost for time reasonably spent on doing the work; or

(b) where the litigant cannot prove financial loss, an amount for the time reasonably spent on doing the work at the rate set out in the practice direction.

The Part 48 Practice Direction provides at paragraph 52.4 that the amount which may be allowed to a litigant in person under rule 46.8(4) is £9.25 per hour. Counsel submitted that the hearing officer appeared to have awarded the applicant two-thirds of the scale figure which he would have awarded a represented party, and that this could not be justified since the opponent had not proved any financial loss and was very unlikely to have spent over 160 hours on the matter.....

36. In my judgment the approach which should be adopted when the Registrar is asked to make an award of costs in favour of a litigant in person is as follows. The hearing officer should direct the litigant in person pursuant to r. 57 of the 2000 Rules to file a brief schedule or statement setting out (i) any disbursements which the litigant claimed he has incurred, (ii) any other financial losses claimed by the litigant and (iii) a statement of the time spent by the litigant in dealing with the proceedings. The hearing officer should then make an assessment of the costs to be awarded applying by analogy the principles applicable under r. 48.6, but with a fairly broad brush. The objective should be to ensure that litigants in person are neither disadvantaged nor overcompensated by comparison with professionally represented litigants.”

Under the current practice direction, the amount allowed to a litigant in person is £18 per hour.

47. Consequently, Mr Bell-Gam should produce an estimate of his costs, including the number of hours that he has spent on these proceedings, broken down by category of activity, i.e. reviewing the notice of opposition, completing the counterstatement, reviewing the opponent’s evidence and submissions and compiling his own evidence and submissions. This should be filed within 21 days

of the date of this decision and should be copied to the opponent who will have 10 days from receipt of the estimate to provide written submissions. I will then issue a supplementary decision covering the costs of these proceedings.

48. The period for any appeal against this decision will run concurrently with the appeal period for the supplementary decision on costs and so will not commence until the supplementary decision is issued.

Dated this 12th day of September 2012

**Judi Pike
For the Registrar,
the Comptroller-General**