

O-101-14

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2628833  
BY  
WESLEY MICHAEL WILKINSON  
TO REGISTER:**



**&**



**AS A SERIES OF TWO TRADE MARKS IN CLASS 25**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO 103903  
BY  
AHMET EROL**

## BACKGROUND

1) On 19 July 2012 Wesley Michael Wilkinson ('the applicant') applied to register a series of two trade marks, as shown on the cover page of this decision, for the following goods in class 25:

*Clothing; headgear; shirts; t-shirts; sweatshirts; scarves; clothing accessories.*

2) The application was published on 10 August 2012 in the Trade Marks Journal and notice of opposition was subsequently filed by Ahmet Erol ('the opponent'). The opponent claims that the application offends under section 5(2)(b) of the Trade Marks Act 1994 ('the Act'). The opposition is directed against all of the goods in the application.

3) One earlier UK trade mark registration is relied upon, details of which are as follows:

<b>Mark details</b>	<b>Services relied upon</b>
<p data-bbox="204 882 632 913"><b>UK registration no: 2617973</b></p>  <p data-bbox="204 1509 587 1541"><b>Filing date: 18 April 2012</b></p> <p data-bbox="204 1585 683 1653"><b>Date of entry in the register: 03 August 2012</b></p>	<p data-bbox="778 882 1350 913"><b><i>Class 25: Clothing, footwear, headgear.</i></b></p>

4) The opponent's mark has a filing date of 18 April 2012 and completed its registration procedure on 03 August 2012. The consequences of these dates, in relation to the applicant's mark, are i) the opponent's UK registration constitutes an earlier mark in accordance with section 6 of the Act and ii) it is not subject to the proof of use conditions contained in section 6A of the Act.

5) The applicant filed a counterstatement in which it states, inter alia, the following:

'The respective goods are identical.

The applicant's mark is a representation of 'scissors' as used in the well-known game of 'Paper-Rock-Scissors' whereas the opponent's mark is a representation of the Union Jack flag superimposed upon the two-finger peace sign. Thus, the respective marks wholly dissimilar, both visually and conceptually.

It is requested that the Opposition be rejected in its entirety with an award of costs in favour of the applicant.'

6) No evidence or submissions were filed during the evidential rounds. Neither party opted to be heard with both preferring to file written submissions in lieu. I will refer to certain of the parties' submissions as, and when, I consider it appropriate in the decision which follows.

## **DECISION**

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

7) This section of the Act provides:

'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.'

8) The leading authorities which guide me 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 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**

9) It is apparent from the comments in the counterstatement that the applicant concedes the respective goods are identical.

## **Average consumer and the purchasing process**

10) It is necessary to consider these matters from the perspective of the average consumer of the goods at issue (*Sabel BV v. Puma AG*). 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.

11) The average consumer for the goods at issue in this case is the general public. In *New Look Ltd v Office for the Harmonization in the Internal Market (Trade Marks and Designs)* Joined Cases T-117/03 to T-119/03 and T-171/03 the General Court (GC) stated:

'43 It should be noted in this regard that the average consumer's level of attention may vary according to the category of goods or services in question (see, by analogy, Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 26). As OHIM rightly pointed out, an applicant cannot simply assert that in a particular sector the consumer is particularly attentive to trade marks without supporting that claim with facts or evidence. As regards the clothing sector, the Court finds that it comprises goods which vary widely in quality and price. Whilst it is possible that the consumer is more attentive to the choice of mark where he or she buys a particularly expensive item of clothing, such an approach on the part of the consumer cannot be presumed without evidence with regard to all goods in that sector. It follows that that argument must be rejected.'

12) As stated by the GC, the goods are those which will vary greatly in price and therefore the purchase may not always be particularly considered. Nevertheless, as the consumer may wish try on the goods or to ensure that they are of a certain colour, size or material, it is likely that at least a reasonable degree of attention is still likely to be afforded, even for those goods which sit on the lower end of the cost scale. The purchasing act will be primarily visual as the goods in question are commonly bought based on their appearance; they are likely to be selected after perusal of racks/shelves in retail establishments, or from photographs on Internet websites or catalogues.

## **Notional and fair use**

13) The opponent states:


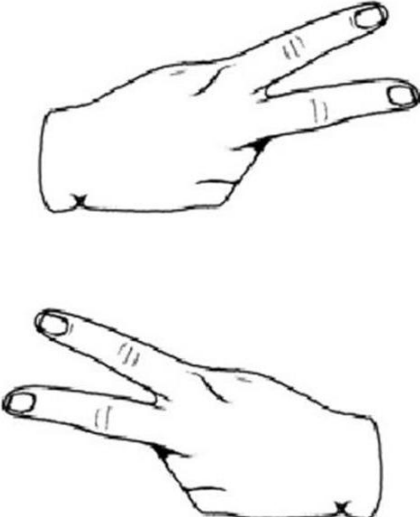
'Despite the differences of orientation between the respective marks as represented in the registration and application, respectively, this does not preclude the possibility that they may appear in exactly the same way on labels, tickets, packaging, or the goods themselves. The fact that the Applicant seeks registration for its mark as a series of two demonstrates that the Applicant seeks a certain degree of flexibility as to the manner of use (particularly, the orientation) of its mark. This increases the scope for confusion.'

14) I will, of course, bear in mind acceptable forms of notional and fair use which are unlikely to affect the identity of the trade marks in approaching the assessment of

similarity of marks and likelihood of confusion. However, as will be evident from the comments which follow, the orientation of the respective marks in the instant case is an important factor as regards the concept that each is likely to portray. To my mind, visualising the opponent's mark in a horizontal position or the applicant's mark in a vertical position (for example) is likely to alter their respective concepts. As altering the concept will also alter the identity of the trade mark, such use, to my mind, would not fall within the scope of notional and fair use. This is borne in mind in the assessment which follows.

**Comparison of marks**

15) For ease of reference, the respective marks are shown in the table below:

Opponent's mark	Applicant's marks
	

16) The average consumer normally perceives a mark as a whole and does not proceed to analyse its details. The visual, aural and conceptual similarities 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*).

17) I bear in mind that the application consists of two marks. However, as the only difference between these marks is their orientation, and a difference in orientation which does not affect the identity of the trade mark, I will refer to the marks in the singular as one mark.

18) The applicant's mark consists of a line drawing of the back of a human hand presented in black and white. The index and middle finger are extended and parted; the other fingers and thumb are folded over into the palm so as not to be visible. The hand is orientated horizontally with the extended fingers pointing outwards to the side. The opponent's mark, presented in colour, consists of the front of a stylised human hand with the index and middle finger extended, parted and pointing upwards, so as to resemble the letter 'V'. The other fingers appear to be folded over and the outline of a thumb can be seen crossing diagonally over the palm. The

image of part of the Union Jack flag is present on the hand. In my view, neither mark lends itself to deconstruction into distinctive and dominant components; the distinctiveness of each mark lies in its totality.

19) The opponent's submissions on the similarities between the marks are brief. They are set out, in full, below:

'The Opponent's Mark consists of the representation of a human hand performing a two-fingered "victory" salute. The Applicant's Mark also consists of a graphic representation of a human hand performing a two-fingered victory salute. The two marks included with the Applicant's series application differ only in that the first mark in the series shows the hand pointing from left to right, whereas the second mark in the series shows the hand pointing from right to left. The Opponent's Mark shows the hand performing precisely the same two-fingered salute, but pointing upwards, and seen from behind, so that the thumb and folded fingers are visible. The Opponent's Mark also incorporates a combination of the colours red, white and blue arranged in a "Union flag" pattern, superimposed upon the Hand device. The Applicant's Marks is not limited as to colour.

The respective marks are visually and conceptually highly similar.'

20) The applicant states:

'As regards visual similarity the marks are clearly dissimilar. It cannot be denied that the respective marks are representations of hands in which the middle and index fingers are parted, but that is where the similarity ends and the differences begin. The upright (vertical) orientation of the earlier mark is such that the parting of the middle and index fingers represents the letter V whereas the orientation of the opposed marks is horizontal.

Quite apart from the obvious difference of orientation, the other major and probably more significant difference between the marks is the presence of the representation of a Union Jack flag, in colour, superimposed upon the whole of the device of a hand. The Applicant's device of a hand is unadorned and not in colour.

Since both marks are purely figurative containing no verbal elements then the issue of aural similarity does not arise.

As regards conceptual similarity the respective marks are clearly dissimilar. The earlier marks will be seen as a V sign or two-finger salute upon which is superimposed the Union Jack flag and at first glance many consumers may see it as an offensive gesture as it takes a much close inspection of the representation of the mark to see that it might be viewed by some consumers as a sign of peace upon which is superimposed the Union Jack flag. On the other hand, the Applicant's marks will be seen by the majority of consumers as representations of 'scissors' as used in the well-known game of 'Rock-Paper-Scissors...'

21) In terms of visual similarity, the colour in the opponent's mark is not a distinguishing factor.<sup>1</sup> Both marks consist of a representation of a human hand with the same two fingers extended and parted. However, as the applicant submits, the marks differ in their orientation, with one showing the hand in a vertical position and the other in a horizontal position with the former appearing to show the front of the hand and the latter clearly showing the back of the hand. Their respective stylisation is also quite different; the opponent's mark contains the prominent image of the Union Jack flag, whereas the applicant's mark is an unadorned simple line drawing. Taking all factors into account, I consider there to be only a moderate degree of visual similarity between the marks.

22) The opponent has made no submissions on aural similarities and the applicant has expressly stated that the 'issue of aural similarity does not arise'. I agree that the aural aspect does not come into play. In *Dosenbach-Ochsner AG Schuhe und Sport v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T- 424/10, the GC stated:

'45 The fact none the less remains that, contrary to what the applicant submits, a phonetic comparison is not relevant in the examination of the similarity of a figurative mark without word elements with another mark (see, to that effect, Joined Cases T-5/08 to T-7/08 *Nestlé v OHMI – Master Beverage Industries (Golden Eagle and Golden Eagle Deluxe)* [2010] ECR II-1177, paragraph 67).

46 A figurative mark without word elements cannot, by definition, be pronounced. At the very most, its visual or conceptual content can be described orally. Such a description, however, necessarily coincides with either the visual perception or the conceptual perception of the mark in question. Consequently, it is not necessary to examine separately the phonetic perception of a figurative mark lacking word elements and to compare it with the phonetic perception of other marks.'

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<sup>1</sup> In *Specsavers International Healthcare Limited & Others v Asda Stores Limited* [2010] EWHC 2035 (Ch) Mann J stated:

'119. It is not clear to me that this is a debate which advances the case very much, but the position seems to me to be as follows. As a matter of principle the exercise involves comparing the offending sign with the registered mark and assessing the likelihood of confusion or association. The two things have to be compared. Since we live in a visual world, and signs are visual, some form of appearance has to be considered. If the registered mark is limited to a colour, then the mark that is used has to be compared, as used, to the mark that is registered, as registered (and therefore in colour). If the registered mark is unlimited as to colour then it is registered for all colours. This means that the colour of the offending sign becomes irrelevant. It will not be possible to say that its colour prevents there being an infringement. At this point one can take one of two courses, each of which ought to have the same result. The first is to imagine the registered mark in the same colour as the offending sign. The second is to drain the colour from the offending sign. Either way one then has the material for comparison. One could even imagine them both in a third colour. It does not matter. So in a sense both Mr Purvis and Mr Bloch are right. As a matter of visual convenience it seems to me to be easier to imagine the registered mark in a colour than to imagine the offending sign drained of colour, and I propose to adopt that course.'

Also see *Mary Quant Cosmetics Japan Ltd v Able C & C Co Ltd* BL O/246/08.



23) Turning to the conceptual aspect, given the orientation of the hand in the opponent's mark, it is possible that it may be seen as an offensive 'V' gesture, however, I think it more likely that it will be perceived as a hand performing a 'victory' or 'peace' sign<sup>2</sup> emblazoned with the flag of the United Kingdom. In reaching this view, I have not overlooked the comments of the Appointed Person, Ms Anna Carboni, in *Chorkee* (BL O/048/08) to the extent that I should not impute knowledge to the average consumer based solely on the state of my own knowledge.<sup>3</sup> However, in my view, the average consumer will have been reasonably frequently exposed to such a gesture over the years by way of, for example, television programmes, films and the internet and is likely to be familiar with its meaning being one of 'peace' or 'victory'. As for the applicant's mark, I do not agree with the opponent's submission that it will also be perceived as 'victory'. The applicant's mark clearly shows the back of a hand in a horizontal position. I see no reason to suppose that the average consumer would immediately perceive a 'victory' or 'peace' sign from such a gesture. Further, whilst the applicant's mark may possibly be perceived as being reminiscent of 'scissors', it may also portray no concept at all beyond that of simply a hand with two fingers extended. Bearing in mind all of the aforesaid, whilst there is a certain degree of conceptual similarity on account of both marks consisting of a hand with two fingers extended, the overall degree of conceptual similarity is, all things considered, fairly low.

### **Distinctive character of the earlier mark**

24) I must consider the distinctive character of the earlier mark. The more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion

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<sup>2</sup> 2000 'V-sign' in *Collins English dictionary*, Collins, London, United Kingdom. Accessed: 21 February 2014, from Credo Reference: 1. (in Britain) an offensive gesture made by sticking up the index and middle fingers with the palm of the hand inwards as an indication of contempt, defiance, etc. 2. **a similar gesture with the palm outwards meaning victory or peace.** (my emphasis added)

<sup>3</sup> In *Chorkee* (BL O/048/08) Ms Carboni stated:

'37. I have no problem with the idea that judicial notice should be taken of the fact that the Cherokee Nation is a native American tribe. This is a matter that can easily be established from an encyclopaedia or internet reference sites to which it is proper to refer. But I do not think that it is right to take judicial notice of the fact that the average consumer of clothing in the United Kingdom would be aware of this. I am far from satisfied that this is the case. No doubt, some people are aware that CHEROKEE is the name of a native American tribe (the Hearing Officer and myself included), but that is not sufficient to impute such knowledge to the average consumer of clothing (or casual clothing in the case of UK TM no. 1270418). The Cherokee Nation is not a common subject of news items; it is not, as far as I am aware, a common topic of study in schools in the United Kingdom; and I would need evidence to convince me, contrary to my own experience, that films and television shows about native Americans (which would have to mention the Cherokee by name to be relevant) have been the staple diet of either children or adults during the last couple of decades.

38. I therefore agree with the Opponent that the Hearing Officer was wrong to find that the earlier trade marks would give rise to the concept of the native American tribe by the same name in the mind of the average consumer and that he should not have relied on his own knowledge and experience to do so.'

(*Sabel BV v Puma AG*). The distinctive character of a trade mark must be assessed by reference to the goods or services for which it is registered and by reference to the way it is perceived by the relevant public (*Rewe Zentral AG v OHIM (LITE)* Case T-79/00 [2002] ETMR 91).

25) As no evidence of use has been filed by the opponent, I have only the inherent level of distinctiveness to consider. The opponent's mark is not descriptive or allusive of any characteristic of the goods covered by the registration. In my view, it is possessed of an average (neither high nor low) level of inherent distinctiveness.

### **Likelihood of confusion**

26) I must now feed all of my earlier findings into the global assessment of the likelihood of confusion. That assessment requires that I also keep in mind the following factors:

- i) the interdependency principle, whereby a lesser degree of similarity between the goods/services may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*);
- ii) the factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V*), and;
- iii) the more distinctive the opponent's mark, the greater the likelihood of confusion (*Sabel BV v Puma AG*).

27) The marks share a moderate degree of visual similarity and a fairly low degree of conceptual similarity; the aural aspect does not come into play. The respective goods are identical and the average consumer of those goods will be the general public who are likely to pay, at least, a reasonable degree of attention during the, mainly visual, purchasing act. It must therefore be borne in mind that the degree of visual similarity is of particular significance.<sup>4</sup> I must also bear in mind that the earlier mark is possessed of an average degree of inherent distinctive character.

28) Having drawn all of my findings together, and bearing in mind, in particular, that at least a reasonable degree of attention will likely be paid during the mainly visual purchase (militating against imperfect recollection) and that there is only a moderate degree of visual similarity between the marks, the average consumer is unlikely to mistake one mark for the other; there is therefore no likelihood of direct confusion. I also do not consider that the similarities between the marks are strong enough to

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<sup>4</sup> In *New Look Ltd v OHIM* - T-117/03 to T-119/03 and T-171/03 the GC stated:

'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.'

lead the consumer to believe that the respective goods emanate from the same or linked undertaking(s) i.e. there is no likelihood of indirect confusion.

**The opposition fails.**

## **COSTS**

29) The applicant has been successful and is entitled to an award of costs. In its submissions, the applicant states the following (clearly where the applicant refers to the 'Opponent' rather than the 'Applicant' in the first line below, this is an error):

'Further, we request that the Opponent be awarded his costs in these proceedings and we request that such costs be off the current scale on account of additional costs incurred arising as a result of the Opponent's failure to handle the instigation of these proceedings in an efficient and proper manner'

30) On the matter of costs off the scale, Tribunal Practice Work Manual (Chapter 7) states:

### **'5.6 Costs off the scale**

It is vital that the Tribunal has the ability to award costs off the scale, approaching full compensation, to deal proportionately with wider breaches of rules, delaying tactics or other unreasonable behaviour. In *Rizla Ltd's application* [1993] RPC 365 (a patent case) it was held that the jurisdiction to award costs, derived from section 107 of the Patents Act 1977, conferred a very wide discretion on the Comptroller with no fetter other than to act judicially. It is considered that the principles outlined in Rizla's application apply also to Tribunal proceedings. Thus, if the Tribunal felt that a case had been brought without any bona fide belief that it was soundly based or, if, in any other way, its jurisdiction was being used for anything other than resolving genuine disputes; it has the power to award compensatory costs. It would be impossible to outline all of the situations which may give rise to such an award; however, Hearing Officers have stated that the amount should be commensurate with the extra expenditure a party has incurred as the result of unreasonable behaviour on the part of the other side. This "extra costs" principle is one which Hearing Officers will take into account in assessing costs in the face of unreasonable behaviour. Hearing Officers should act judicially in all the facts of a case. It is worth clarifying that just because a party has lost, this is not indicative, in itself, of unreasonable behaviour. Any claim for costs approaching full compensation or for "extra costs" will need to be supported by a bill itemising the actual costs incurred.'<sup>5</sup>

31) The applicant's request appears to stem from the fact that the opponent (who was without legal representation at that time) was provided with a number of opportunities to adequately particularize its notice of opposition before it could be

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<sup>5</sup> Accessible at: <http://www.ipso.gov.uk/tmmanual-chap7-law.pdf>

deemed admissible. I am far from persuaded that this factor alone is illustrative of unreasonable behaviour on the opponent's part which would warrant departure from the standard scale. The request for costs off the scale is dismissed. I award costs to the applicant on the following basis:

Considering the notice of opposition and preparing a counterstatement:	£200
Written submissions:	£300
<b>Total:</b>	<b>£500</b>

32) I order Ahmet Erol to pay Wesley Michael Wilkinson the sum of **£500**. 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 5<sup>th</sup> day of March 2014**

**Beverley Hedley  
For the Registrar,  
the Comptroller-General**