

O-036-15

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 3003096  
BY  
THE ROYAL ACADEMY OF ARTS  
TO REGISTER THE TRADE MARK**

The image shows the letters 'RA' in a very bold, black, sans-serif font. The letters are centered and take up a significant portion of the page's width. The 'R' and 'A' are connected at the top and bottom, with a slight gap in the middle. The font is clean and modern.

**IN CLASSES 02, 09, 14, 16, 18, 20, 21, 24, 25, 27, 28,  
30, 34, 36, 39, 40, 41 & 43**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO 401111  
BY  
ERREA' SPORT S.P.A.**

## BACKGROUND

1) On 22 April 2013, The Royal Academy of Arts ('the applicant') applied to register the trade mark shown on the cover page of this decision in respect of the following goods and services:

**Class 2:** *Paints, varnishes and lacquers.*

**Class 9:** *Sound, video and data recordings; recorded television and radio programmes; cinematographic films and photographic films; apparatus for recording, transmission or reproduction of sound or images; sunglasses, sun visors and sunshades; instructional and teaching apparatus and instruments; records, discs, tapes, cassettes, cartridges, cards and other carriers bearing or for use in bearing sound recordings, video recordings, data, images, games, graphics, text, programs or information; memory carriers, interactive compact discs and CD-ROMS; magnets; calculators; computer software; computer games; electrically, magnetically and optically recorded data for computers; mouse pads and wrist pads, all being accessories for keyboards; video game software and video game cartridges; tape measure; parts and fittings for use with all the aforesaid.*

**Class 14:** *Articles of precious metal and their alloys, and articles coated with precious metal and their alloys, not included in other classes; jewellery; badges made of precious metal or coated with precious metal; tie clips; tie pins; jewellery pins; cufflinks; earrings; brooches; bracelets; pendants; medals; chronometric and horological instruments; clocks; watches; money clips; belt buckles; key fobs; key rings; key chains; trinkets; medallions.*

**Class 16:** *Paper; printed matter; stationery; wrapping paper; calendars; advent calendars; desk accessories; writing instruments; pens, pencils, crayons; artists' materials; face paints; erasers; rulers; pencil sharpeners; pencil boxes and cases; pencil holders; posters; photographs; pictures; photograph albums; ring binders; folders; notebooks; notepads; diaries; personal organisers; postcards; greetings cards; stickers and transfers; stencils; printed publications; books; bookmarks; periodical publications; magazines; catalogues; guides; carrier bags; paper bags; pamphlets; leaflets; brochures; news sheets; printed programmes; instructional and teaching materials; printed computer programs; paper tape and cards for use in data processing; coasters of paper or cardboard; paper napkins; passport holders; parts and fittings for all the aforesaid goods.*

**Class 18:** *Leather goods and goods made of imitation leather; key rings, fobs and cases; card holders; cases; wallets; purses; belts; boxes; bags; handbags; briefcases; backpacks; umbrellas.*

**Class 20:** Furniture, mirrors, picture frames, photo frames; articles made of wood, plastic, which are not included in other classes; garden furniture, pillows and cushions.

**Class 21:** Household and kitchen utensils and containers; glass, china, porcelain, pottery, ceramic and earthenware; crockery; mugs; cups; drinking glasses; plates; wine coolers; hip flasks; enamel boxes; pots; figurines and ornaments; combs; sponges; brushes; perfume atomizers; coasters; plates; serving trays; goblets; flasks; tankards, napkin holders; vases.

**Class 24:** Textiles and textile goods; flags, handkerchiefs; household linen; bed linen; bedspreads; table linen; napkins; table cloths; bed and table covers; cushion covers; place mats; coasters of textile; towels; curtains; blinds of textile; wall hangings of textile; banners; bunting.

**Class 25:** Articles of clothing, footwear and headgear; t-shirts, shirts, jeans, jumpers, coats, jackets, suits, skirts, sarongs, dresses, pullovers, blouses, trousers, slacks, shorts, dungarees, sweatshirts, sweaters; hats and caps; articles of underclothing; stockings, tights; neck-ties, scarves, headsquares, aprons, belts, socks, gloves, swimwear and beachwear, pyjamas, nightdresses, bathing and shower caps, bath robes, bath sandals and bath slippers, clothing for babies and for toddlers, bibs; footwear; slippers, boots and shoes.

**Class 27:** Carpets; rugs; wallpaper.

**Class 28:** Games, toys and playthings; face paints; soft toys; puzzles; jigsaw puzzles; ordinary playing cards; Christmas decorations; Christmas crackers; boules; kites; boomerangs; masks; chess sets; gymnastic and sporting articles; games, apparatus for games and amusement apparatus, all for use with a television screen, video monitor or electronic display apparatus; parts and fittings for all the aforesaid goods.

**Class 30:** Coffee; tea; cocoa.

**Class 34:** Cigarette cases, ashtrays.

**Class 36:** Fundraising services; charitable fundraising services; charitable collections; organisation of charitable fundraising and charitable collections; provision of financial aid in the form of charitable grants.

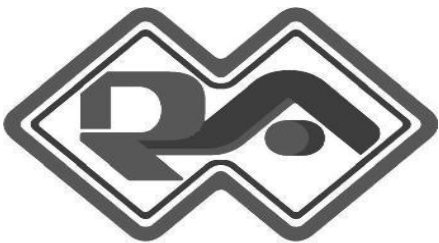
**Class 39:** Travel services; travel agency and tourist services; arranging of tours and excursions; booking of seats and travel reservations for travel and for tickets; advisory and information services relating to transportation, travel and tourism.

**Class 40:** Framing of works of art; bespoke picture framing.

**Class 41:** *Provision of education, training and entertainment; education, training, entertainment and cultural activities relating to art; art galleries; arranging conferences, seminars and workshops; publication of books; organisation of exhibitions for cultural, artistic and educational purposes; museum facilities; television, radio and film entertainment services; entertainment information services; production of television programmes and films; production of radio programmes; production of sound and video recordings; provision, distribution, recording, rental, presentation, processing, networking and syndication of all the aforesaid programmes and recordings; organisation, production and presentation of competitions, contests, games, quizzes, events, theatrical performances, shows, road shows and audience participation events; education and instruction by or relating to radio and television; production and rental of educational and instructional materials; publishing; provision of information relating to any of the aforesaid services.*

**Class 43:** *Services for providing food and drink; cafés; cafeterias; catering; restaurants; bars; providing facilities for exhibitions; booking and reservation services for restaurants.*

2) The application was published on 26 July 2013 in the Trade Marks Journal and notice of opposition was subsequently filed by ERREA' SPORT S.p.A. ('the opponent'). The opponent claims that the application offends under Sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 ('the Act'). It directs its opposition against classes 09, 14, 16, 18, 24, 25, 28 and 41 of the application only. In support of both grounds, it relies upon the following three community trade marks ('CTM'):

CTM details	Goods and services relied upon
<p><b>CTM No: 007076862 ('862')</b></p>  <p><b>Filing date: 21 July 2008</b>  <b>Date of entry in the register: 18 February 2009</b></p>	<p><b>Class 3:</b> <i>Alcohol- and non-alcohol-based perfumes and perfumery, toilet water, perfume extracts, essential oils; face tissues, toners; moisturising and nourishing creams; lip gloss; hand creams, gels and lotions; moisturising, nourishing and exfoliating preparations for the body; multi-purpose creams, waters and oils for the body; deodorants, antiperspirants, depilatory creams, sun creams; hair gels, lotions, foams, gels, water, shampoos and conditioners, hair lacquers, sprays, mousses; body hygiene products, namely solid, liquid and powdered soaps, bath and shower foam; salts, powders and oils, talcum powder and powders for sprinkling; foot hygiene products; products for personal hygiene; dental hygiene products, dentifrices, mouthwashes, breath</i></p>

*freshening sprays.*

**Class 9:** *Spectacles, sunglasses, spectacle cases and frames, blank CD-ROMs and DVDs for audio and/or video recording.*

**Class 14:** *Clocks, chronometers, chronographs, alarm clocks, jewellery.*

**Class 16:** *Adhesive tapes for stationery purposes, ball-point pens and fountain pens, pen-holders for writing, calendars, rubber erasers, diaries, note books, paint brushes, pencils, greeting cards, coasters, mouse pads (stationery), handkerchiefs of paper, tablecloths of paper, paper, cardboard and goods made from these materials, not included in other classes, stationery, rulers (stationery).*

**Class 18:** *Bags, multipurpose sports bags, handbags, bags of leather and imitations of leather, gentlemen's handbags; canvas bags, bags for balls, bags, bags for campers, beach bags, travelling bags; key holders; beach bags; bum-bags; cosmetic bags sold empty; school satchels, trunks, travelling bags, suitcases, rucksacks; umbrellas, walking sticks, parasols; Leatherware; briefcases, leather and imitations of leather, satchels; business cards cases; purses, not of precious metal; notecases.*

**Class 25:** *Clothing for men, women and children; sportswear and leisurewear for men, women and children, including jumpers, tee-shirts, vests, sweatshirts, pullovers, polo shirts, shirts, skirts, trousers, shorts, Bermuda shorts, jackets, coats, jeans, jerseys, neckties, suits, jump suits (clothing), full tracksuits for sports teams, training suits, sports kits, including kits for football, five-a-side football, volleyball, rugby and basketball, clothing for football, five-a-side football, volleyball, rugby, basketball, tennis, skiing, cycling, golf, baseball, spinning,*

*running and exercisewear in general not included in other classes; belts (clothing), belts for sports; footwear, shoes, sports shoes, including shoes for football, five-a-side football, volleyball, rugby, basketball, tennis, skiing, cycling, golf, baseball, spinning, running, gymnastics and exercise in general not included in other classes, ski boots, swimshoes, slippers; headgear, including hats, berets, bonnets, ear muffs, headbands and sweat bands, hats and berets for sport in general, bandanas; gloves (clothing), sashes for wear, wristbands; stockings, socks, sweat-absorbent stockings, slippers, tights; underwear, including briefs, bras, camisoles, underpants, boxers, thongs, underwear, in particular for playing sport, namely leg warmers, Bermuda shorts, elasticated tee-shirts, nightwear; beach clothes and bathing clothes, including bathing suits, bathing trunks, bath robes; rainwear.*

**Class 28:** *Bags adapted for carrying sporting articles, bags for sports, football bags, wetsuit bags, apparatus for gymnastics, training and body building, gymnastic and sporting articles not included in other classes; balls for games, play balloons, gloves for goalkeepers and sport in general, gloves (accessories for games), shin guards (sports articles), knee guards (sports articles), bands for sports, sports equipment.*

**Class 35:** *Wholesaling and retailing of perfumery, spectacles, clocks and jewellery, stationery, luggage, clothing, sporting articles, electronic sale of the aforesaid goods.*

**Class 41:** *Organisation of sports competitions; education, providing of training; amusements; sporting and cultural activities.*

CTM No: 007008477 ('477')



Filing date: 23 June 2008  
Date of entry in the register: 04  
February 2009

**Class 3:** Alcohol- and non-alcohol-based perfumes and perfumery, toilet water, perfume extracts, essential oils; facial tissues, toning lotions; moisturising and nutrient creams; lip gloss; hand creams, gels and lotions; moisturising, nutrient and exfoliating preparations for the body; multi-purpose creams, water and oils for the body; deodorants, antiperspirants, depilatory creams, sun creams; hair gels, lotions, foams, gels, water, shampoos and conditioners, hair lacquers, sprays, mousses; body hygiene products, namely solid, liquid and powdered soaps, bath and shower foam; salts, powders and oils, talcum powder and powders for sprinkling; food hygiene products; products for personal hygiene; dental hygiene products, dentifrices, mouthwashes, breath freshening sprays.

**Class 9:** Spectacles, sunglasses, spectacle cases and frames, blank CD-ROMs and DVDs for audio and/or video recording.

**Class 14:** Clocks, chronometers, chronographs, alarm clocks, jewellery.

**Class 16:** Adhesive tapes for stationery purposes, ball-point pens and fountain pens, pen cases for typewriters, calendars, rubber erasers, diaries, note books, paint brushes, pencils, greeting cards, coasters, mouse pads (stationery), handkerchiefs of paper, tablecloths of paper, paper, cardboard and goods made from these materials, not included in other classes, stationery, rulers (stationery).

**Class 18:** Bags, multipurpose sports bags, handbags, bags of leather and imitations of leather, gentlemen's handbags; canvas bags, bags for balls, bags, bags for campers, beach bags, travelling bags; key holders; beach bags; bum-bags; cosmetic bags sold

*empty; school satchels, trunks, travelling bags, suitcases, rucksacks; umbrellas, walking sticks, parasols;*

*Leatherware; briefcases; leather and imitations of leather; satchels; business cards cases; purses, not of precious metal; notecases.*

**Class 25:** *Clothing for men, women and children; sportswear and leisurewear for men, women and children, including jumpers, T-shirts, vests, sweatshirts, pullovers, polo shirts, shirts, skirts, trousers, shorts, Bermuda shorts, jackets, coats, jeans, jerseys, neckties, suits, jump suits (clothing), full tracksuits for sports teams, training suits, sports kits, including kits for football, five-a-side football, volleyball, rugby and basketball, clothing for football, five-a-side football, volleyball, rugby, basketball, tennis, skiing, cycling, golf, baseball, spinning, running and exercisewear in general not included in other classes; belts (clothing), belts for sports; footwear, shoes, sports shoes, including shoes for football, five-a-side football, volleyball, rugby, basketball, tennis, skiing, cycling, golf, baseball, spinning, running, gymnastics and exercise in general not included in other classes, ski boots, swimshoes, slippers; headgear, including hats, berets, bonnets, ear muffs, headbands and sweat bands, hats and berets for sport in general, bandanas; gloves (clothing), scarves, wristbands; stockings, socks, sweat-absorbent stockings, slippers, tights; underwear, including briefs, bras, camisoles, underpants, boxers, thongs, underwear, in particular for playing sport, namely leg warmers, Bermuda shorts, elasticated T-shirts, nightwear; beachwear and swimwear, including swimming costumes, swimming trunks, beach robes; rainwear.*

**Class 28:** *Bags adapted for carrying sporting articles, bags for sports, football bags, wetsuit bags, apparatus for gymnastics, training and body building,*



	<p><i>gymnastic and sporting articles not included in other classes; balls for games, play balloons, gloves for goalkeepers and sport in general, gloves (accessories for games), shin guards (sports articles), knee-pads, bands for sports, sports equipment.</i></p> <p><b>Class 35:</b> <i>Wholesaling and retailing of perfumery, spectacles, horological instruments and jewellery, stationery, luggage, clothing, sporting articles; electronic commerce of the aforesaid goods.</i></p> <p><b>Class 41:</b> <i>Organisation of sports competitions; education, providing of training; amusements; sporting and cultural activities.</i></p>
<p><b>CTM No: 009284191 ('191')</b></p> <p><b>ERREA'</b></p> <p><b>Filing date: 30 July 2010</b>  <b>Date of entry in the register: 01 April 2011</b></p>	<p><b>Class 3:</b> <i>Perfumes and alcoholic and non-alcoholic perfumery; Eaux de toilette; Extracts (perfumes); Essential oils; Pre-moistened cosmetic towelettes; Toning lotions; Moisturising and nourishing creams; Lip gloss; Creams; Gels; Hand lotion; Moisturizer; Nutrients; Body scrub; Multi-purpose creams, water and oils for the body; Deodorants; Antiperspirants; Depilatory creams; Sun creams; Gels; Lotions; Foams; Gels; Eaux de toilette; Hair shampoos and conditioners; Hair lacquers; Hair sprays and mousses; Body hygiene products; Including for example, solid soaps; Liquid and in powder; Shower and bath foam; Bath salts; Oils and make-up powder; Talcum powder and powders for sprinkling; Foot hygiene products; Products for personal hygiene; Products for dental hygiene; Dentifrices; Mouthwash; Breath freshening sprays.</i></p> <p><b>Class 9:</b> <i>Spectacles; Sunglasses; Spectacle cases and frames; Blank CD-ROMs and DVDs for sound and/or video recording</i></p>

**Class 14:** Clocks and watches; Chronometers; Chronographs; Alarm clocks; Jewellery and artificial jewellery.

**Class 16:** Adhesive tapes for stationery purposes; Ball-point pens, fountain pens; Pen cases; Calendars; Rubbers; Diaries; Writing or drawing books; Paint brushes; Pencils; Greeting cards; Coasters; Mouse pads (stationery); Handkerchiefs of paper; Paper table covers; Paper; Cardboard and goods made from this material, not included in other classes; Stationery; Rulers (stationery).

**Class 18:** Bags; Multipurpose sports bags; Handbags; Bags of leather and imitations of leather; Gentlemen's handbags; Canvas bags; Bags for balls; Bags; Bags for campers; Bags; Travelling rugs; Key holders; Beach bags; Bum-bags; Cosmetic bags sold empty; School rucksacks; Trunks; Travelling bags; Valises; Rucksacks; Umbrellas; Walking sticks; Parasols; Leatherware; Briefcases; Leather and imitations of leather; Satchels; Business cards cases; Change purses; Not of precious metal; Notecases; Sports bags; Football bags; Wetsuit bags.

**Class 25:** Sports clothing and leisurewear for men, women and children; Jerseys; Undershirts; T-shirts; Tank-tops; Sweatshirts; Pullovers; Polo-neck jerseys; Shirts; Skirts; Trousers; Shorts; Shorts; Bermuda shorts; Jackets; Coats; Jeans; Jerseys; Ties; Suits; Combinations (clothing); Full tracksuits for sports teams; Training suits; Sports kits; Including kits for football; Five-a-side football; Volleyball; Rugby; Basketball; Soccer clothing; Five-a-side football; Volleyball; Rugby; Basketball; Tennis; Cycling; Golf; Baseball; Spinning; Running and exercisewear in general not included in other classes; Trousers; Ski suits; Belts (clothing); Belts for sports; Footwear; Shoes; Sports shoes; Football boots and shoes; Five-a-

	<p><i>side football; Volleyball; Rugby; Basketball; Tennis; Cycling; Golf; Baseball; Spinning; Running; Gymnastics and exercise in general not included in other classes; Ski boots; Swimshoes; Slippers; Headwear; Hats; Caps; Bonnets; Ear muffs; Sweat and head bands; Hats and berets for sport in general; Bandannas; Gloves (clothing); Mufflers; Wristbands; Stockings; Socks; Sweat-absorbent stockings; Slippers; Panty hose; Underwear; Briefs; Brassieres; Singlets; Underpants; Boxer shorts; G-strings; Biancheria intima; In particular for sport; Namely leg warmers; Bermuda shorts; Elasticated t-shirts; Nightwear; Beach clothes and swimwear; Including bathing suits; Swimming trunks; Bath robes; Rainwear.</i></p> <p><b>Class 28:</b> <i>Bags adapted for carrying sporting articles; Appliances for gymnastics; Training and body building; Gymnastic and sporting articles not included in other classes; Balls for games; Playground balls; Gloves for goalkeepers; Gloves for games; Shin guards (sports articles); Knee guards; Bands for sports; Sports equipment.</i></p> <p><b>Class 35:</b> <i>Wholesaling and retailing of perfumery; Spectacles; Horological articles and jewellery; Stationery; Luggage; Clothing; Sporting articles; Electronic commerce of the aforesaid goods.</i></p> <p><b>Class 41:</b> <i>Organisation of sports competitions; Education; Providing of training; Amusements; Sporting and cultural activities.</i></p>
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3) All of the opponent's marks have earlier filing dates than the contested mark and have completed their registration procedures; they are therefore earlier marks in accordance with section 6 of the Act. Further, as they had all been registered for less than five years prior to the publication date of the opposed trade mark, none are subject to the proof of use conditions contained in section 6A of the Act.

4) The applicant filed a counterstatement in which it denies that there is any visual similarity between its mark and the opponent's marks. It also denies that there is any phonetic similarity between its mark and the opponent's CTM Nos 191 and 477. It admits that its mark is phonetically identical to the opponent's CTM No 862 but argues that this is of limited relevance given that its mark is a device mark.

5) Both sides filed evidence. The opponent's evidence consists of a witness statement, dated 25 March 2014, in the name of Rosanna Fabbiani, Managing Director of the opponent, and Exhibits RF1-RF13 thereto. The applicant's evidence consists of a witness statement, dated 3 June 2014, in the name of Mila Phillips, Legal Assistant of the applicant, and Exhibits MP1-MP13 thereto. I do not consider it necessary to summarise the evidence here. Rather, I will refer to it during my decision when it is necessary and relevant to do so. Neither side requested a hearing with both opting to file written submissions in lieu, which I will bear in mind. I now make this decision based on the papers before me.

## **DECISION**

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

6) This section of the Act states:

“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.”

7) The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

### **The principles**

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, 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, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(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;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) 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;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### **Comparison of goods and services**

8) It is clear that a number of the contested goods and services in classes 09, 14, 16, 18, 25, 28 and 41 are identical to the goods and services in the corresponding classes upon which the opposition is based (as conceded by the applicant in its counterstatement and written submissions). Owing to the findings in this decision, and for reasons of procedural economy, I will not undertake a full comparison of all of the parties' goods and services. I will proceed on the assumption that all of the contested goods and services are identical or at least highly similar as contended by the opponent.

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

9) It is necessary to determine who the average consumer is for the respective goods and services and the manner in which they are likely to be selected.

In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

10) The average consumer for the goods and services at issue in this case is the general public. The specifications are wide ranging such that the level of attention will vary. For example, in relation to goods such as ‘pens and pencils’ the attention afforded will likely be low given that they are generally low cost items which may be purchased reasonably frequently. As regards goods such as ‘articles of clothing’, even though the cost is likely to vary considerably (a polyester t-shirt being considerably less expensive than a pure cashmere jumper, for example), I would expect at least a reasonable level of attention to be afforded, regardless of the exact price tag borne by the goods, given that these are items which are purchased to be worn on the person and therefore a number of considerations will likely come into play such as size, colour, warmth, pattern and suitability for occasion etc. For other goods such as ‘jewellery’, this would cover not only inexpensive items of costume jewellery, but also expensive items such as platinum diamond rings, for which the price may be considerable and the resultant level of attention high. Services such as ‘education and training’ are likely to attract at least a reasonable degree of attention given that the consumer may take into consideration factors such as the variety of courses on offer, the content of syllabuses, tuition fees, etc.

11) I would expect the purchasing act to be primarily visual in relation to all of the goods and services, and particularly so for those goods such as clothing, jewellery and handbags which are commonly bought on the basis of aesthetic appeal. However, that is not to say that aural considerations are disregarded as they too may play a part in the selection process. For example, the relevant goods may sometimes be requested orally over a counter after initial selection by eye (such as in jewellers where goods are often stocked in windows inaccessible to the public) and the services at issue, may also, on occasion, be the subject of oral recommendations and/or discussions prior to purchase.



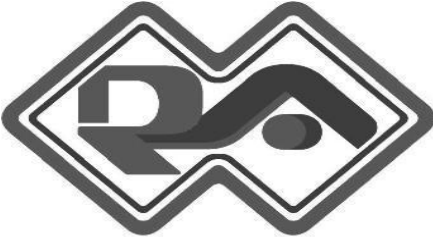
## **Comparison of marks**

12) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall

impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“...it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

It would therefore be wrong to artificially dissect the marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks. The marks to be compared in the instant case are set out in the table below.

Opponent's marks	Applicant's mark
<p>191:</p> <p>ERREA'</p>	
<p>477:</p> 	
<p>862:</p> 	

13) Neither the applicant's mark nor earlier marks 191 and 862 readily lend themselves to deconstruction into separate components; each mark forms a unified whole upon which the overall impression is based. Earlier mark 477 does, however,

clearly consist of two components; the first is the device element of what appears to be two overlapping diamond shapes, the second is the stylised word 'errea'. Both components are distinctive and have considerable visual impact such that I would put the relative weight of each in the overall impression of the mark as roughly equal.

14) I now turn to consider the visual, aural and conceptual similarities between the respective marks, dealing firstly with those that exist between earlier mark 191 and the applicant's mark. The mere fact that the respective marks have the letters 'R' and 'A' in common does not, in the light of the other clear and marked differences between them, make them visually similar. On the contrary, they are visually dissimilar. Aurally, the applicant's mark will be pronounced as the two letters 'R' 'A'. The opponent contends that its mark is a word of Italian origin which will be pronounced "arr-ay" and that the respective marks therefore sound similar to the ear. Ms Amanda Michaels, sitting as the Appointed Person, in *Toppy Trademarks Limited v Cofra Holding AG*, BL O/092/11 stated:

"25. .... What the Hearing Officer had to consider was how the mark would be perceived by the average UK consumer. Whilst of course there are many persons whose mother tongue is not English who live and work in the UK, such persons are not the average UK consumer for the purposes of considering the pronunciation or meaning of a word."

Bearing in mind Ms Michael's comments and, in the absence of evidence before me to persuade me that the average UK consumer is likely to pronounce the mark as "arr-ay", I am unable to conclude that it is likely to be vocalised in such a manner. To my mind, the average UK consumer is likely to pronounce the mark either as "air-ree-ah" or, perhaps, "eerie-ah". Either way, the respective marks are not aurally similar to the ear. As for the conceptual aspect, neither mark has any immediately graspable concept; the conceptual position is neutral. Bearing all of this in mind, I find that the respective marks are not similar; indeed, they are dissimilar overall. It naturally follows that earlier mark 477 is even more dissimilar to the applicant's mark given the additional difference created by the device element.

**15) A pre-requisite for a likelihood of confusion is that there is, at least, some degree of similarity between the marks. As I have found that earlier marks 191 and 477 are dissimilar to the applicant's mark, the opposition under section 5(2)(b), insofar as it is based on them, must fail, in accordance with the judgment of the CJEU C-106/03 P- *Vedial SA v OHIM, France Distribution* [2005] E.T.M.R. 23. I will therefore make no further mention of those earlier marks in this decision.**

16) I now turn to consider the similarities between earlier mark 862 and the applicant's mark. The opponent contends:

**"Visually**

The application is for the stylised letters 'RA' in a plain capitalised and bold font. The earlier Community Trade Mark No. 007076862 is also for the stylised letters RA in capitals inside a bordered device. Visually, the signs are therefore similar to the extent that they coincide in the combination of the



letters RA. On the other hand, they differ in the figurative element of the opponent's earlier mark which consists of a bordered and jagged device element.

On an overall impression, the earlier Community Trade Mark No. 007076862 referred to is therefore visually similar to the Application, to the extent they share the identical letters RA in capital letters.

### **Phonetically**

The Application is phonetically identical to the earlier mark for RA (stylised), CTM No. 007076862, as both marks are for the letters "RA" only.

...

### **Conceptually**

Conceptually, neither of the signs has a meaning as a whole for the public in the UK. However, the letters R and A have the concept of two letters as such, in both signs. Therefore, the signs are conceptually identical.

In conclusion, taking into account the abovementioned visual, aural and conceptual coincidences, it is considered that the signs under comparison are similar."

17) The applicant states:

"The Applicant's mark is ... visually very different to the Opponent's Community trade mark no. 7076862 (RA and device) because the Opponent's Community trade mark no. 7976862 (RA and device) is a highly stylised logo which bears no visual resemblance to the Applicant's Mark.

The Applicant admits that the Applicant's Mark is phonetically identical to the Opponent's Community trade mark no. 7076862 (RA and device) but ... the phonetic similarities are of limited relevance given that it is a device mark."

18) It is noted that the applicant admits that the opponent's mark will be understood as consisting of the letters 'RA' and that it will therefore be vocalised in the same manner as its mark. The marks are aurally identical. Nevertheless, the applicant states that, visually, the marks are very different because the opponent's mark is highly stylised. I agree. The letters 'RA' in the applicant's mark are presented in a bold and fairly standard font. Contrastingly, the same letters in the opponent's mark are very heavy stylised and are surrounded by a stylised border. The marks are very different to look at. They are not visually similar. As to concept, on the one hand the opponent contends that neither mark has any meaning but on the other it states that the marks are nevertheless conceptually identical since they both portray the concept of two letters as such. To my mind, the former argument is more persuasive than the latter. A conceptual message is only relevant if it is capable of immediate

grasp<sup>1</sup>. Although both marks contain the same two letters, as those letters do not evoke any immediately graspable concept, the conceptual position is, effectively, neutral.

### **Distinctive character of earlier mark 862**

19) I must consider the distinctive character of earlier mark 862. 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).

20) In its submissions, the applicant states:

“The Applicant submits that the Opponent has not shown any use of or reputation in Community trade mark no. 7076862 (RA and device).”

I agree. The opponent’s evidence does not show any use of the relevant mark. Accordingly, I can only take into account the inherent level of distinctiveness. In doing so, I am mindful of the following comments of Mr Iain Purvis Q.C., sitting as the Appointed Person, in *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, where he pointed out that the level of distinctive character is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it. “

21) The opponent contends that the distinctiveness of its mark lies primarily in the letters ‘RA’ and that the “additional figurative element has only a limited impact”. I disagree. To my mind, the letters ‘RA’ per se are not particularly high in distinctiveness given that there is a propensity for many undertakings to adopt letters as indicators of trade origin. It is the heavy stylisation which contributes far more significantly to the distinctiveness of the mark. Accordingly, whilst I conclude that the mark, as a whole, is reasonably high in distinctiveness, this is attributable to its particular graphic presentation.

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<sup>1</sup> This is highlighted in numerous judgments of the GC and the CJEU, including *Ruiz Picasso v OHIMi* [2006] e.c.r. –I-643; [2006] E.T.M.R. 29.

## Likelihood of confusion

22) Having considered the content of the applicant's evidence, I note that, in the main, it seeks to show that the applicant has a substantial and long-standing reputation in the United Kingdom in the initials RA and that it operates in a very different field to the opponent. Whether or not the applicant has the reputation it purports to have is irrelevant. Furthermore, I must assess the likelihood of confusion notionally and objectively rather than subjectively; that is to say, on the basis of the trade marks and goods and services listed before me, not on the basis of the actual commercial activities of the parties.<sup>2</sup> Therefore, none of the applicant's evidence assists me or has any bearing on the decision which follows.

23) I must now remind myself of all my earlier findings and feed them into the global assessment of the likelihood of confusion and, when conducting that assessment, I must also keep in mind the following established principles:

- i) the interdependency principle, whereby a lesser degree of similarity between the goods or 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 principle that the more distinctive the opponent's mark is, the greater is the likelihood of confusion (*Sabel BV v Puma AG*).

24) Earlier in this decision I found that earlier mark 862 is not visually similar to the contested mark but it is aurally identical and conceptually, the position is neutral. I have proceeded on the assumption that the goods are either identical or similar as contended by the opponent. The average consumer is the general public whose level of attention will vary from low, to reasonable, to high depending on the exact goods and services in question (as identified in paragraph 10). The purchasing act will be primarily visual for all of the goods and services at issue but I bear in mind the potential for aural use also. As for the distinctiveness of the earlier mark, I have concluded that this is reasonably high but that this level of distinctiveness is attributable to the mark's particular stylised presentation. .

25) Although the marks are aurally identical, and the goods and services are either identical or highly similar, both of which are factors weighing in the opponent's favour, there is one factor, in particular, which weighs strongly against the opponent, namely, my finding that the marks are not visually similar. This is of particular importance in the global assessment of the likelihood of confusion given that the purchasing act is likely to be primarily visual for all of the goods and services at issue.<sup>3</sup> Furthermore, although I have found that the earlier mark is possessed of a

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<sup>2</sup> By way of example, see *Oakley, Inc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-116/06*, paragraph [76].

<sup>3</sup> 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

reasonably high degree of distinctive character, this is attributable to the heavy stylisation of the mark, rather than to the letters within the mark per se; there is no such stylisation or similar stylisation in the contested mark. Bearing all of this in mind, I come to the conclusion that, notwithstanding that for certain of the goods at issue the level of attention is likely to be low there is no likelihood of confusion, either directly or indirectly, in respect of any of the goods and services at issue.

**26) The ground of opposition under section 5(2)(b) of the Act fails.**

### **Section 5(3)**

27) Section 5(3) states:

“(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.”

28) The conditions required for a successful opposition under section 5(3) are cumulative<sup>4</sup>. Firstly there must be sufficient reputation; secondly, there must be a link made between the marks; thirdly, one of the three heads of damage must succeed. As I have already stated, there is a complete absence of any evidence in relation to earlier mark 862. Accordingly, the claim under 5(3) falls at the first hurdle insofar as it is based on this mark. There is nothing before me to show that it has the requisite reputation. Turning to earlier marks 191 and 477, even if I was to conclude that the evidence was sufficient to show that the opponent has the requisite reputation in those marks, bearing in mind my earlier comments in paragraph 14 and my finding that the respective marks are not similar, a link would clearly not be made. Without a link, there can be no damage. **The opposition under section 5(3) of the Act fails.**

### **COSTS**

29) As the applicant has been successful, it is entitled to an award of costs. In approaching the award, I bear in mind that, although the applicant filed evidence, none of it has assisted me or had any bearing on my decision. Taking account of the guidance provided in Tribunal Practice Notice 4/2007, I award costs to the applicant on the following basis:

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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.”

<sup>4</sup> *Intel Corporation Inc v CPM United Kingdom Ltd* [2009] RPC 15.

Considering the notice of opposition  
and filing the counterstatement £200

Written Submissions £300

**Total: £500**

30) I order ERREA' SPORT S.p.A. to pay The Royal Academy of Arts 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 23rd day of January 2015**

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