

O-234-15

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NOS 2653637 & 2653404
BY SHOP DUTTY LIMITED TO REGISTER THE TRADE MARKS



AND

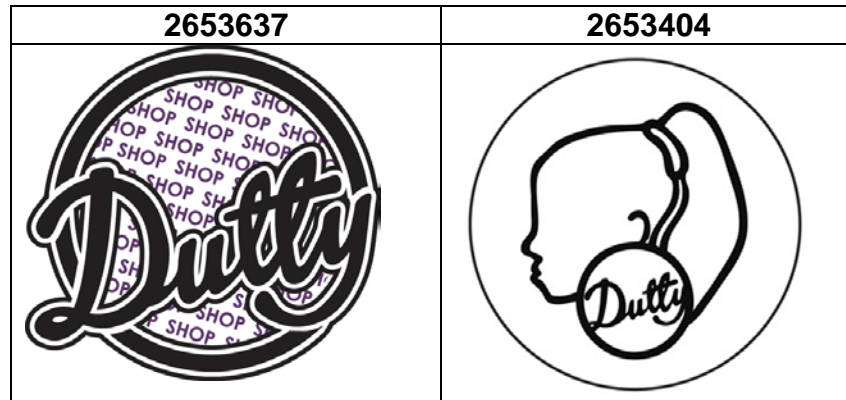


IN CLASS 25

AND IN THE MATTER OF CONSOLIDATED OPPOSITIONS
THERE TO UNDER NOS 400518 & 400829
BY GRUPO MASSIMO DUTTI, SA

BACKGROUND

1) On 21 February 2013, Shop Dutty Limited (“the applicant”) applied under the Trade Marks Act 1994 (“the Act”) for registration of the following two marks:



2) The applications are both in respect of *Clothing* in Class 25.

3) The applications were published in the Trade Marks Journal and on 5 July 2013, Grupo Massimo Dutti, S.A. (“the opponent”) filed notice of opposition to the applications. There are two grounds of opposition. The first is that the applications both offend under Section 5(2)(b) of the Act because there is a likelihood of confusion with the following four earlier marks in the name of the opponent:

CTM¹ 2220481

Dutti sport

by Massimo Dutti

Relevant goods: *Clothing, footwear, headgear* in Class 25

Filing date: 14 May 2001

Date of entry in register: 18 July 2002

¹ Community Trade Mark

CTM 4454476

Massimo Dutti
personal tailoring

Relevant goods: *Ready-made articles of clothing for women, men and children, footwear (except orthopedic footwear), headgear* in Class 25

Filing date: 18 May 2005

Date of entry in register: 23 October 2006

CTM 32516

MASSIMO DUTTI

Relevant goods: *Clothing, footwear, headgear* in Class 25

Filing date: 1 April 1996

Date of entry in register: 19 December 2000

IR(EU)² 1100292

DUTTI SPORT

Relevant goods: *Clothing, footwear, headgear* and other goods in Class 25

International registration date: 27 September 2011

Date of Designation of the EU: 27 September 2011

4) All of these marks are registered and with dates of application earlier than that of the contested marks. Consequently, they are all “earlier marks” as defined by Section 6 of the Act. The first three earlier marks completed their registration procedures more than five years before the publication of the contested marks and are therefore become liable to the proof of use provisions in Section 6A of the Act.

5) The second ground of opposition against both marks is that they offend under Section 5(3) of the Act because they are similar to the opponent’s CTM 32516 MASSIMO DUTTI that the opponent claims has a reputation.

6) The applicant subsequently filed a counterstatement denying the respective marks are similar. It admits that the respective goods are similar or identical.

² International Registration designating the European Union

Further, whilst three of the opponent's marks are liable to the proof of use provisions, the applicant does not put it to such proof. The significance of this is that the opponent may rely upon the full lists of goods it relies upon for these proceedings. The applicant also accepts that the opponent has a reputation in respect of its CTM 32516 MISSIMO DUTTI. The applicant states that it is not aware of any confusion in the market place, nor has seen any evidence of the same.

7) Both sides filed evidence in these proceedings. Both sides ask for an award of costs. The matter came to be heard on 10 March 2015 when the opponent was represented by Ms Jessie Bowhill of Counsel, instructed by Taylor Wessing LLP and the applicant represented by Mr Michael Brown of Alpha and Omega.

Opponent's Evidence

8) This is in the form of a witness statement by Ms Lorna May Caddy, a lawyer at Taylor Wessing LLP, the opponent's representatives in these proceedings. Ms Caddy introduces into evidence the following exhibits:

- Exhibit LMC1 consists of extracts from the opponent's website apparently showing its MASSIMO DUTTI stores in the UK, but no stores appear. A blank drop-down box appears alongside a search box headed "search stores";
- Exhibit LMC2 consists of an online listing downloaded from Yell-Reviews of Newspapers & Magazines in Bath. The relevance of this exhibit is not explained, nor is it obvious. No mention is made of the opponent or its marks;
- Exhibit LMC3 is a printout from the Internet archive site "Wayback Machine" showing the opponent's website was first captured on 22 October 1999. The extract shows that the website <http://massimodutti.com> was saved 649 times between this date and 10 June 2014;
- Exhibit LMC4 is a printout from the same website showing that it was saved 32 times between 15 August 2010 and 31 May 2014;
- Exhibit LMC5 consists of printouts of the first page of search results from a search executed on *Bing* using the search term "Dutti". Most hits retrieved relate to MISSIMO DUTTI;
- Exhibit LMC6 are Internet extracts illustrating the meaning of the word DUTTY in the UK. The first is from the website www.internetslang.us that appears to record that DUTTY means "dirty". The second is appears to be a blog where someone has offered the view that DUTTY "is slang for dirty". The website address is not legible;

- Exhibit LMC7 consists of printouts of an “on-line textline search of the words ‘DUTTY GIRL’”. Twenty five documents are provided. Many refer to DUTTY GIRL in the context of being Bristol based DJs. One refers to DUTTY GIRL being a sponsor of a hip-hop event. Others include:
 - a reference to DUTTY GIRL clothing featuring in fashion show in Bristol in April 2010;
 - a DUTTY GIRL stall at the St Nicholas Market (the article was retrieved from The Bristol Post and is dated 12 August 2008);
 - A reference to DUTTY GIRL first opening its store at St Nicholas Market in November 2005. The article appeared in The Bristol Post and is dated 19 March 2007;

Applicant’s Evidence

9) This consists of two witness statements. The first of these is by Ms Louisa Mary Jones, director of the applicant, a post she has held since the company was formed in July 2008. Ms Jones explains why the name DUTTY GIRLS was chosen in 2005. It was used as the name of a female club night. Later the same year, she opened a small shop in St Nicholas’ Market in Bristol called “The Dutty Girl Shop” selling vintage clothing and DUTTY GIRL merchandise such as hoodies and t-shirts. An article that appeared in the Bristol & Bath magazine (dated 16 October 2005) and referring to the shop is provided at Exhibit LMJ1.

10) Ms Jones explains that following a move to new premises, the shop was re-named SHOP DUTTY. At Exhibit LMJ2, Ms Jones provides a further extract from the Bristol & Bath magazine, dated 5 to 14 December 2008 that carries an advert for the new shop and features the mark subject of the 2653637 application.

11) Ms Jones provides turnover figures for the shop for the years 2010 to 2013. These are in the region of £50,000 to £100,000 each year. Further online sales amount to around £10,000.

12) Ms Jones repeats the claim made in the counterstatement that she is not aware of any instances in which the clothing sold at her shop has been assumed to have been designed or made by the opponent.

13) The second witness statement is by the applicant’s representative, Mr Brown. He provides Internet extracts demonstrating that DUTTY is the Jamaican English word for “dirty”.

DECISION

Section 5(2)(b)

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

“(2) A trade mark shall not be registered if because –

(a) ...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

15) 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:

(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

16) It is common ground that the respective goods are identical or similar, all being items of clothing.

The average consumer

17) The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*. 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.”

18) The General Court (“the GC”) has continued to identify the importance of visual comparison when considering the purchasing act in respect of clothing (see for example Joined Cases T-117/03 to T-119/03 and T-171/03 *New Look Ltd v OHIM (NLSPOORT et al)* [2004] ECR II-3471 at [49]-[50] and Case T-414/05 *NHL Enterprises BV v OHIM (LA KINGS)* [2009] ECR II.). There is nothing before me that provides assistance in considering the nature of the purchasing act. In the absence of such evidence or submissions, it is reasonable that I apply Mr Thorley’s comments here. The purchasing act will, generally be described as consumer items and will involve a reasonable degree of care and attention but not the highest degree of attention. As Mr Thorley noted, the purchasing process is primarily a visual one but I do not ignore that aural considerations may be involved.



Comparison of marks

19) 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.”

20) It would be wrong, therefore, to artificially dissect the marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

21) For the purposes of this comparison, I will consider the similarity of the applicant’s marks with the opponent’s IR(EU)1100292 DUTTI SPORT. If the opponent cannot succeed when relying on this earlier mark, it will not succeed in respect of its other earlier marks. The respective marks are:

Opponent's mark	Applicant's marks
DUTTI SPORT	<p data-bbox="824 260 976 289">"first mark"</p>  <p data-bbox="1016 684 1068 714">and</p> <p data-bbox="824 753 1024 783">"second mark"</p> 

22) The applicant's marks are readily divided into separate components. In its first mark, the word DUTTY is in large letters and superimposed over the other elements of the mark. DUTTY is clearly the dominant and distinctive element, but I don't ignore the other elements of the mark, namely, the recurring word SHOP appearing within the circular background. In its second mark, there are two equally dominant elements, the word DUTTY within the smaller circle and the silhouette of a woman's head with her hair in a pony tail.

23) The opponent's mark divides into its two elements, the name DUTTY and the descriptive and non-distinctive word SPORT. It follows that the dominant and distinctive element is the word DUTTY.

24) Comparing the respective marks from a visual perspective, the appearance of the word SPORT in the opponent's mark is absent in both of the applicant's marks. The word SHOP repeated in the applicant's first mark is absent in the opponent's mark as are the logo elements present in the applicant's marks. These are therefore all points of difference. There is also a point of similarity between the respective marks, namely the occurrence of the word DUTTY or DUTTI in both sides' marks. They differ only in their last letter where, in the

opponent's mark, the word ends in a letter "Y", but the word ends in a "I" in the applicant's marks. Taken account of these differences and similarities, I conclude that that in respect of the applicant's first mark, there is a low to medium level of visual similarity with the opponent's mark. In respect of the applicant's second mark, I find that the visual similarity is slightly lower because the word DUTTY is smaller than in its other mark and because of the visual impact of the pony-tailed woman's head.

25) In respect of aural similarity, it is not normal for the device elements of marks to be articulated. As a consequence, both of the applicant's marks will be referred to as the two syllables DUT-EE or DOOT-EE. The letter "Y" at the end of the word DUTTY in the applicant's mark and the letter "I" at the end of the word DUTTI in the opponent's mark will both be pronounced the same. Of course, the opponent's mark also includes the word SPORT and the mark as a whole will be articulated as either DUT-EE SPORT or DOOT-EE SPORT. The word SPORT is a point of aural difference, but because the first word is likely to be articulated in an identical way, I conclude that the respective marks share a high level of aural similarity.

26) Conceptually, there is some evidence that the word DUTTY, present in both of the applicant's marks, is slang for "dirty" but it is equally clear from the evidence on this point that, if this is the case, it is not generally known by the average consumer of clothing in the UK. Therefore, the words DUTTY and DUTTI will not be understood by the average consumer as having any particular meaning. The opponent's mark also includes the word SPORT that has a universally known meaning that is absent in the applicant's marks. The applicant's first mark has a background consisting of the word SHOP repeated within a circular border. Such an everyday word departs a concept upon the mark that is absent in the opponent's mark. The applicant's second mark includes the device of a pony-tailed woman's head that will provide a conceptual hook to that mark. Consequently, there are a number of elements in the respective marks that convey some conceptual characteristic to each mark, but there is no overlap across the marks. Consequently, there is no conceptual similarity.

27) Overall, despite there being little by way of visually or conceptual similarity, because of the occurrence of the word DUTTY in the applicant's marks and the word DUTTI in the opponent's mark, they share a medium level of similarity when viewing the respective marks as a whole.

Distinctive character of the earlier trade mark

28) I must consider the distinctive character of the earlier mark because the more distinctive it is, either by inherent nature or by use the greater the likelihood of confusion (*Sabel BV v Puma AG* [1998] RPC 199). 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 public (*Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91).

29) The mark I have selected as representing the best case for the opponent has not got any claim to use or of a reputation, therefore, I must only consider the marks inherent level of distinctive character. In this respect, the word DUTTI has no meaning and will, therefore, be perceived as a made up word or possibly a surname. As such, when this word is combined with the non-distinctive word SPORT, the mark has a reasonably high level of inherent distinctive character.

Likelihood of confusion

30) I must adopt the global approach advocated by case law and take into account that marks are rarely recalled perfectly with the consumer relying instead on the imperfect picture of them he has in kept in his mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). I must take into account all factors relevant to the circumstances of the case, in particular the interdependence between the similarity of the marks and that of the goods or services designated (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*)

31) The applicant states that it is unaware of any confusion in the market place. This is noted but there is a tranche of case law to the effect that lack of confusion in the market place is indicative of very little. See, for example, *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283, *Rousselon Freres et Cie v Horwood Homewares Limited* [2008] EWHC 881 (Ch), *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 and *Aceites del Sur-Coosur SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case C-498/07 P*. In *The European Limited v The Economist Newspaper Ltd* Millet LJ stated:

“Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff's registered trade mark.”

32) In *Compass Publishing BV v Compass Logistics Ltd* Laddie J stated:

“22. It is frequently said by trade mark lawyers that when the proprietor's mark and the defendant's sign have been used in the market place but no confusion has been caused, then there cannot exist a likelihood of confusion under Article 9.1(b) or the equivalent provision in the Trade Marks Act 1994 ("the 1994 Act"), that is to say s. 10(2). So, no confusion in the market place means no infringement of the registered trade mark. This is, however, no more than a rule of thumb. It must be borne in mind that the provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a case must involve

considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to be a finding of infringement. Similarly, even when the proprietor of a registered mark uses it, he may well not use it throughout the whole width of the registration or he may use it on a scale which is very small compared with the sector of trade in which the mark is registered and the alleged infringer's use may be very limited also. In the former situation, the court must consider notional use extended to the full width of the classification of goods or services. In the latter it must consider notional use on a scale where direct competition between the proprietor and the alleged infringer could take place.”

33) In the current case, the evidence adduced by the opponent illustrates that it does not trade from any premises in Bristol and it is equally clear from the applicant's evidence that it trades from a single premises in Bristol. This fact alone may explain why they are unaware of any actual confusion. Further, it is also possible that the mark DUTTI SPORT has not yet been used. Taking all of this into account together with the above mentioned guidance, I dismiss the applicant's claim of no confusion in the market place. It is a factor that is not determinative in these proceedings.

34) It is common ground between the parties that the respective goods are identical and it follows that the average consumers will also be the same. I have noted that the purchasing act is predominantly visual in nature, but I must also keep in mind that aural considerations may play a part. The differences in the respective marks are sufficient to ensure that the average consumer will not mistake one mark for the other, so called direct confusion. However, the occurrence of the virtually identical DUTTY/DUTTI elements in the respective marks, together with the fact that these elements are the word elements most likely to be used by the average consumer to indicate trade origin (the other words, namely SPORT in the opponent's mark and SHOP in the applicant's first mark do little to assist the average consumer in this respect) leads me to find that there is a likelihood of indirect confusion. This is where the average consumer, whilst noticing that the marks are not identical, will still be likely to be confused in the sense that he will believe that clothing provided under the respective marks originate from the same or linked undertaking.

35) In summary, the oppositions against both of the applicant's marks are successful in their entirety.

Section 5(3)

36) In light of my findings in respect of the grounds based upon Section 5(2)(b), the opponent cannot improve upon the outcome and, consequently, it is not necessary for me to also consider the grounds based upon Section 5(3).

COSTS

37) The opponent has been successful and is entitled to a contribution towards its costs, according to the published scale in Tribunal Practice Notice 4/2007. I keep in mind that both sides filed evidence and that a hearing took place. I award costs as follows:

Preparing a statement and considering the counterstatement	£300
Opposition fee	£200
Evidence	£300
Preparing for, and attending hearing	£700
Total:	£1500

38) I order Shop Dutty Limited to pay Grupo Massimo Dutti, SA the sum of £1500 which, in the absence of an appeal, should be paid within 14 days of the expiry of the appeal period.

Dated this 23rd day of July 2015

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