

O-439-15

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO.3054098
BY LOCAL BOY'Z LIMITED TO REGISTER
THE SERIES OF TWO MARKS
HARD CORE / HARDCORE
IN CLASSES 9, 18 & 25
AND**

**IN THE MATTER OF OPPOSITION
THERE TO UNDER No.403388 BY
THE BSS GROUP LIMITED**

BACKGROUND

1) On 2 May 2014 Local Boy'z Limited (hereinafter LBL) applied to register the series of two trade marks HARD CORE / HARDCORE in respect of the following goods:

Class 9: Abdomen protectors for protection against injury [other than parts of sports suits or adapted for use in specific sporting activities]; Anti-dazzle shades; Anti-glare glasses; Anti-glare visors; Anti-pollution masks for respiratory protection; Armbands [luminous] for protection against accident or injury; Asbestos clothing for protection against fire; Asbestos gloves for protection against accidents; Aviators (Protective suits for-); Bullet-proof waistcoats; Clothes for protection against injury; Clothing for protection against accidents, irradiation and fire; Clothing for protection against fire; Diving suits; Electrically heated clothing for protection against accident or injury; Eye protection; Eyeglasses; Eyeshades; Face guards for protection against accident or injury; Face-shields (Workmen's protective-); Fire (Clothing for protection against -); Fire protection apparatus; Garments and clothes for protection against fire; Garments for protection against fire; Gloves for divers; Gloves for industrial purposes for protection against injury; Gloves for protection against accidents; Gloves for protection against injury; Gloves for protection against X-rays for industrial purposes; Goggles for sports; Head protection; Helmets (Protective-); Insulated clothing for protection against accident or injury; Knee-pads for workers; Leather clothing for protection against accident or injury; Life belts; Life jackets; Masks (Protective-); Nets for protection against accidents; Optical lenses; Plugs (Ear-); Protection devices against X-rays, not for medical purposes; Protection devices for personal use against accidents; Protection masks; Protective helmets for sports; Protective clothing; Protective helmets; Protective masks; Protective suits for aviators; Protective work clothing for protection against accident or injury; Reflecting discs for wear, for the prevention of traffic accidents; Safety boots for use in industry for protection against accident or injury; Safety clothing for protection against accident or injury; Safety footwear for protection against accident or injury; Safety gloves for protection against accident or injury; Safety restraints other than for vehicle seats and sports equipment; Safety tarpaulins; Shin guards for protection against injury other than sports articles or parts of sports suits; Shoes for protection against accidents, irradiation and fire; Socks, electrically heated; Solderers' helmets; Spark-guards; Spectacle cases; Spectacle frames; Spectacle glasses; Spectacles [optics]; Sports (Goggles for-); Sports (Protective helmets for-); Sunglasses; Teeth protectors; Thermal protective aids [clothing] for protection against accident or injury; Thermal suits for protection against accident or injury; Visors for the protection of welders; Waistcoats (Bullet-proof -); Waling glasses; Workmen's protective face-shields; X-rays (Protection devices against-), not for medical purposes.

Class 18: Animal skins; Furniture coverings of leather; Garment bags for travel; Handbags; Imitation leather; Leather shoulder belts; Leather straps; Leather, unworked or semi-worked; Moleskin [imitation of leather]; Pocket wallets; Pouches, of leather, for packaging; Purses; Rucksacks; School bags; School satchels; Shopping bags; Shoulder belts [straps] of leather; Skins (Animal-); Skins (Cattle-); Straps (Harness-); Straps (Leather-); Straps (Leather shoulder-); Straps of leather [saddlery]; Suitcase handles; Suitcases; Tool bags of leather, empty; Travelling bags; Travelling sets [leatherware]; Travelling trunks; Trimmings of leather for


furniture; Trunks [luggage]; Valises; Valves of leather; Vanity cases, not fitted; Wallets of leather; Wheeled shopping bags; Whips.

Class 25: Clothing; footwear; headgear.

2) The application was examined and accepted, and subsequently published for opposition purposes on 12 September 2014 in Trade Marks Journal No.2014/038.

3) On 11 December 2014 the BSS Group Ltd (hereinafter BSS) filed a notice of opposition (subsequently amended). The grounds of opposition are in summary:

a) BSS is the proprietor of the following trade mark:

Mark	Number	Dates of Filing & Registration	Class	Goods
 The logo for 'Hard Core Safety Footwear' features the words 'HARD CORE' in a large, bold, black, distressed font. The letters are contained within a rectangular frame that looks like a piece of metal or a heavy-duty strap, with some diagonal lines suggesting wear or tension. Below 'HARD CORE', the words 'SAFETY FOOTWEAR' are written in a smaller, clean, sans-serif font.	2593920	06.09.11 19.06.15	9	Clothing for protection against injury, accident, irradiation or fire.

b) BSS contends that the marks and goods of the two parties are identical and /or similar such that the marks in suit offend against section 5(2)(b).

4) On 16 February 2015 LBL filed a counterstatement (subsequently amended) which states that the marks and goods are different. It does not put BSS to strict proof of use of its mark.

5) Neither side filed evidence or written submissions. Both parties seek an award of costs in their favour. Neither side wished to be heard.

DECISION

6) There is only one ground of opposition which is under section 5(2)(b) which reads:

“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) An “earlier trade mark” is defined in section 6, the relevant part of which states:

“6.-(1) In this Act an "earlier trade mark" means -

- (a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.”

8) BSS is relying upon its trade mark listed in paragraph 3 above which is clearly an earlier trade mark as it was applied for on 6 September 2011 whereas LBL did not apply for its mark until 2 May 2014. Given the interplay between the dates that BSS' mark was registered (19 June 2015) and the date that LBL's mark was published (12 September 2014), section 6A of the Trade Marks Act does not come into play. BSS is therefore entitled to rely on its earlier mark for the goods as registered.

9) When considering the issue under section 5(2)(b) I take into account the following principles which 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.

The average consumer and the nature of the purchasing decision

10) As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods; I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. 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.”

11) LBL's specification is, broadly speaking, clothing, footwear and headgear including protective clothing in class 9 and also bags and other goods in class 18, whilst BSS has only protective clothing in class 9. I shall first consider the class 25 clothing aspect. Such goods will be sold in, inter alia, traditional retail outlets on the high street, through catalogues and on the Internet. As neither party's specifications are limited I must keep all of these trade channels in mind. The average consumer of the goods at issue is a member of the general public who is likely, in my opinion, to select the goods mainly by visual means. The term “general public” also includes businesses, such as the retail outlets who must obtain their stock from somewhere. I accept that more expensive items may, for example, be researched or discussed with a member of staff, the latter bringing aural considerations into play. In this respect I note that in *New Look Ltd v OHIM Cases T-117/03 to T-119/03 and T-171/03*, the General Court (GC) said this about the selection of clothing:

“50. 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.”

12) In the same case the Court also commented upon the degree of care the average consumer will take when selecting clothing. It said:

“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 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.”

13) Clearly, the average consumer’s level of attention will vary considerably depending on the cost and nature of the item at issue. However, to my mind even when selecting routine inexpensive items of clothing such as socks, the average consumer will pay attention to considerations such as size, colour, fabric and cost. **Overall the average consumer is likely to pay a reasonable degree of attention to the selection of items of clothing. To my mind it is obvious that the same considerations apply to both footwear and headgear.**

14) Turning to consider protective clothing in class 9 it is clear that due to its specialised nature in protecting the body against specific threats such as fire or irradiation it will be chosen with a great deal of care. The average consumer will be those working in hazardous professions such as firemen, glass handlers or forestry workers. The items will typically be purchased by both the workers and also their employers. Although no evidence was provided on the topic it is not unreasonable to assume that they will choose the clothing in much the same manner as normal items of clothing are chosen via traditional retail outlets on the high street or specialist retailers, through catalogues and on the Internet. It is entirely possible that advice might be sought from a sales assistant or indeed from fellow workers in the same profession. They will therefore select the goods mainly by visual means, although I cannot ignore aural considerations. **Overall the average consumer for safety clothing is likely to pay a high degree of attention to the selection of items of clothing.**

15) Lastly I consider the goods in class 18. To my mind, these will mostly be purchased in the same manner as clothing in class 25 and therefore the same selection criteria will apply. **Overall the average consumer is likely to pay a reasonable degree of attention to the selection of goods in class 18.**

Comparison of goods

16) In the judgment of the Court Justice European Union (CJEU) in *Canon*, Case C-39/97, the court stated at paragraph 23:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their

method of use and whether they are in competition with each other or are complementary”.

17) The relevant factors, identified by Jacob J. (as he then was) in the *Treat* case [1996] R.P.C. 281, for assessing similarity are:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services;
- c) The respective trade channels through which the goods or services reach the market;
- d) In the case of self serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- e) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

18) The goods of the two parties are:

BSS 's goods	LBL's goods
Class 9: Clothing for protection against injury, accident, irradiation or fire.	Class 9: Abdomen protectors for protection against injury [other than parts of sports suits or adapted for use in specific sporting activities]; Anti-dazzle shades; Anti-glare glasses; Anti-glare visors; Anti-pollution masks for respiratory protection; Armbands [luminous] for protection against accident or injury; Asbestos clothing for protection against fire; Asbestos gloves for protection against accidents; Aviators (Protective suits for-); Bullet-proof waistcoats; Clothes for protection against injury; Clothing for protection against accidents, irradiation and fire; Clothing for protection against fire; Diving suits; Electrically heated clothing for protection against accident or injury; Eye protection; Eyeglasses; Eyeshades; Face guards for protection against accident or injury; Face-shields (Workmen's protective-); Fire (Clothing for protection against -); Fire protection apparatus; Garments and clothes for protection against fire; Garments for protection against fire; Gloves for divers; Gloves for industrial purposes for protection against injury; Gloves for protection against accidents; Gloves for protection against injury; Gloves for protection against X-rays for industrial purposes; Goggles for sports; Head protection; Helmets (Protective-); Insulated clothing for protection against accident or injury; Knee-pads for workers; Leather clothing for protection against accident or injury; Life belts; Life jackets; Masks (Protective-); Nets for protection against accidents; Optical lenses; Plugs (Ear-); Protection devices against X-rays, not for medical purposes; Protection devices for personal use against accidents; Protection masks; Protective helmets for sports;

	<p>Protective clothing; Protective helmets; Protective masks; Protective suits for aviators; Protective work clothing for protection against accident or injury; Reflecting discs for wear, for the prevention of traffic accidents; Safety boots for use in industry for protection against accident or injury; Safety clothing for protection against accident or injury; Safety footwear for protection against accident or injury; Safety gloves for protection against accident or injury; Safety restraints other than for vehicle seats and sports equipment; Safety tarpaulins; Shin guards for protection against injury other than sports articles or parts of sports suits; Shoes for protection against accidents, irradiation and fire; Socks, electrically heated; Solderers' helmets; Spark-guards; Spectacle cases; Spectacle frames; Spectacle glasses; Spectacles [optics]; Sports (Goggles for-); Sports (Protective helmets for-); Sunglasses; Teeth protectors; Thermal protective aids [clothing] for protection against accident or injury; Thermal suits for protection against accident or injury; Visors for the protection of welders; Waistcoats (Bullet-proof -); Waling glasses; Workmen's protective face-shields; X-rays (Protection devices against-), not for medical purposes.</p>
	<p>Class 18: Animal skins; Furniture coverings of leather; Garment bags for travel; Handbags; Imitation leather; Leather shoulder belts; Leather straps; Leather, unworked or semi-worked; Moleskin [imitation of leather]; Pocket wallets; Pouches, of leather, for packaging; Purses; Rucksacks; School bags; School satchels; Shopping bags; Shoulder belts [straps] of leather; Skins (Animal-); Skins (Cattle-); Straps (Harness-); Straps (Leather-); Straps (Leather shoulder-); Straps of leather [saddlery]; Suitcase handles; Suitcases; Tool bags of leather, empty; Travelling bags; Travelling sets [leatherware]; Travelling trunks; Trimmings of leather for furniture; Trunks [luggage]; Valises; Valves of leather; Vanity cases, not fitted; Wallets of leather; Wheeled shopping bags; Whips.</p>
	<p>Class 25: Clothing; footwear; headgear.</p>

19) To my mind the following items in LBL's specification in class 9 are clearly items of **protective clothing and so are identical to the goods of BSS.**

“Class 9: Abdomen protectors for protection against injury [other than parts of sports suits or adapted for use in specific sporting activities]; Armbands [luminous] for protection against accident or injury; Asbestos clothing for protection against fire; Asbestos gloves for protection against accidents; Aviators (Protective suits for-); Bullet-proof waistcoats; Clothes for protection against injury; Clothing for protection against accidents, irradiation and fire; Clothing for protection against fire; Diving suits; Electrically heated clothing for protection against accident or injury; Fire (Clothing for protection against -); Garments and clothes for protection against fire; Garments for protection against fire; Gloves for divers; Gloves for industrial purposes for protection against injury; Gloves for protection against accidents; Gloves for protection against injury; Gloves for protection against X-rays for industrial purposes; Insulated clothing for protection against accident or injury; Leather clothing for protection against accident or injury; Life belts; Life jackets; Protective clothing; Protective suits for aviators; Protective work clothing for protection against accident or injury; Reflecting

discs for wear, for the prevention of traffic accidents; Safety clothing for protection against accident or injury; Safety gloves for protection against accident or injury; Socks, electrically heated; Thermal protective aids [clothing] for protection against accident or injury; Thermal suits for protection against accident or injury; Waistcoats (Bullet-proof -);”

20) Helmets, footwear, masks, pads, glasses and visors are not strictly clothing, but would form part of a uniform and be supplied by companies specialising in protective clothing as they complete the outfitting of workers who need protection against injury. **Therefore, the following are similar to a medium degree to the protective clothing in BSS’ specification:**

“Anti-dazzle shades; Anti-glare glasses; Anti-glare visors; Anti-pollution masks for respiratory protection; Eye protection; Eyeglasses; Eyeshades; Face guards for protection against accident or injury; Face-shields (Workmen’s protective-); Fire protection apparatus; Goggles for sports; Head protection; Helmets (Protective-); Masks (Protective-); Optical lenses; Plugs (Ear-); Protection masks; Protective helmets for sports; Protective helmets; Protective masks; Safety boots for use in industry for protection against accident or injury; Safety footwear for protection against accident or injury; Shoes for protection against accidents, irradiation and fire; Solderers’ helmets; Spectacle cases; Spectacle frames; Spectacle glasses; Spectacles [optics]; Sports (Goggles for-); Sports (Protective helmets for-); Sunglasses; Teeth protectors; Visors for the protection of welders; Waling glasses; Workmen’s protective face-shields; Knee-pads for workers; Shin guards for protection against injury other than sports articles or parts of sports suits.”

21) This leaves the following:

“Protection devices against X-rays, not for medical purposes; X-rays (Protection devices against-), not for medical purposes; Protection devices for personal use against accidents; Safety restraints other than for vehicle seats and sports equipment; Safety tarpaulins; Nets for protection against accidents; Spark-guards.”

22) The items listed at paragraph 21 do not, to my mind, appear to be connected to protective clothing. They appear to be items installed around machinery, such as guards and nets. **As such I regard these items as not similar to the goods of BSS.**

23) Turning to the class 25 goods of LBL I take into account the comments in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, where the GC stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM-Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

24) I am content that the class heading should not be the final determinative. However, to my mind there is a difference between what could be described as heavy duty or hard wearing work wear rather than protective clothing designed to prevent injury. By way of an

example, a leather padded motorcycle jacket which could be worn as a fashion item or as protective clothing. However, if the jacket were truly designed to protect a rider of a motorcycle it would have slider pads on the elbows and a back and neck protector which gives the impression of a hump on one's back which is not flattering and which is unlikely to be worn as a fashion item. Whilst there is an overlap in that they are both articles of clothing, the purpose and users differ. **To my mind, there is a very low degree of similarity between the class 25 goods of LBL and the class 9 goods of BSS.**


25) Lastly I look to the class 18 specification of the mark in suit. Whilst it is possible that some of the items of protective clothing may be made of **leather I do not regard this as sufficient to find any similarity between any of the class 18 goods of LBL and the class 9 goods of BSS.**

Comparison of trade marks

26) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade 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.”

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

BSS's trade mark	LBL's series of two trade marks
	<p>HARD CORE</p> <p>HARDCORE</p>

28) The only difference between LBL's two marks is that one has the words "Hard" and "Core" conjoined whilst the other has a gap between them. They are to all intents identical and so I shall carry out the comparison test using just one of the marks. The marks of both

parties clearly contain the words “HARD CORE”. The only difference between them is the additional words “SAFETY FOOTWEAR” and device elements in the mark of BSS. The device element consists of a border which will not be particularly noticed by the average consumer and the device of three lines which give the appearance of being shatter marks as the lettering is slightly out of alignment either side of these lines. However, by far the most distinctive and dominant element of BSS’ mark are the words HARD CORE. The device elements will be noticed by most consumers but will not play a major role in identifying the origin of the goods. Similarly the term “SAFETY FOOTWEAR” when used on safety clothing etc. will be taken as an indication that the manufacturer conducts a trade in, inter alia, these goods. Given its size and positioning and as it will be purely descriptive, it has very little if any relative weight in the overall impression BSS’ trade mark conveys. **To my mind, there is a medium level of visual and aural similarity between the marks.** Conceptually both marks call to mind an image of toughness and are therefore **conceptually very similar.**

Distinctive character of the earlier trade mark

29) In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

30) Whilst in *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person 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.’

40. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask ‘in what does the distinctive character of the earlier mark lie?’ Only after that has been done can a proper assessment of the likelihood of confusion be carried out”.

31) However the independent and distinctive element does not need to be identical. In *Bimbo SA v OHIM*, Case T-569/10, the GC held that:

“96. According to the case-law, where goods or services are identical there may be a likelihood of confusion on the part of the public where the contested sign is composed by juxtaposing the company name of another party and a registered mark which has normal distinctiveness and which, without alone determining the overall impression conveyed by the composite sign, still has an independent distinctive role therein (Case C-120/04 *Medion* [2005] ECR I-8551, paragraph 37). There may also be a likelihood of confusion in a case in which the earlier mark is not reproduced identically in the later mark (see, to that effect, Joined Cases T-5/08 to T-7/08 *Nestlé v OHIM – Master Beverage Industries (Golden Eagle and Golden Eagle Deluxe)* [2010] ECR II-1177, paragraph 60).”

32) **BSS’s earlier trade mark is possessed of a reasonable to high degree of inherent distinctive character.** BSS has not filed evidence of its earlier trade mark in the UK and so cannot **benefit from enhanced distinctiveness through use in respect of its marks in respect of the UK.**

Likelihood of confusion

33) In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of BSS’s trade mark as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind. Earlier in this decision, I concluded that:

- the average consumer of safety clothing is likely to pay a high degree of attention to their selection;
- The class 9 goods of BSS are not similar to the class 18 goods of LBL, whilst they are similar to a very low degree with the class 25 goods of LBL.
- Turning to the class 9 goods of the two parties the goods in paragraph 19 are identical, the goods in paragraph 20 are similar to a medium degree whilst those in paragraph 21 are not similar.

- there is a medium level of visual and aural similarity between the marks, whilst conceptually they are very similar;
- BSS's earlier trade mark is possessed of a reasonable to high degree of inherent distinctive character, but cannot benefit from enhanced distinctiveness.

34) I also take into account the comments of Mr Iain Purvis Q.C, acting as the Appointed Person in *L.A. Sugar Limited v By Back Beat Inc* (BL-O/375/10), where he commented on the difference between direct and indirect confusion in the following terms:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

35) In my opinion, taking all the factors above into account, there is a likelihood of consumers being indirectly confused into believing that the following goods in class 9 of LBL are those of BSS or provided by some undertaking linked to them. **The opposition under Section 5(2) (b) therefore succeeds in respect of these goods in class 9.**

Class 9: Abdomen protectors for protection against injury [other than parts of sports suits or adapted for use in specific sporting activities]; Armbands [luminous] for protection against accident or injury; Asbestos clothing for protection against fire; Asbestos gloves for protection against accidents; Aviators (Protective suits for-); Bullet-proof waistcoats; Clothes for protection against injury; Clothing for protection

against accidents, irradiation and fire; Clothing for protection against fire; Diving suits; Electrically heated clothing for protection against accident or injury; Fire (Clothing for protection against -); Garments and clothes for protection against fire; Garments for protection against fire; Gloves for divers; Gloves for industrial purposes for protection against injury; Gloves for protection against accidents; Gloves for protection against injury; Gloves for protection against X-rays for industrial purposes; Insulated clothing for protection against accident or injury; Leather clothing for protection against accident or injury; Life belts; Life jackets; Protective clothing; Protective suits for aviators; Protective work clothing for protection against accident or injury; Reflecting discs for wear, for the prevention of traffic accidents; Safety clothing for protection against accident or injury; Safety gloves for protection against accident or injury; Socks, electrically heated; Thermal protective aids [clothing] for protection against accident or injury; Thermal suits for protection against accident or injury; Waistcoats (Bullet-proof -); Anti-dazzle shades; Anti-glare glasses; Anti-glare visors; Anti-pollution masks for respiratory protection; Eye protection; Eyeglasses; Eyeshades; Face guards for protection against accident or injury; Face-shields (Workmen's protective-); Fire protection apparatus; Goggles for sports; Head protection; Helmets (Protective-); Masks (Protective-); Optical lenses; Plugs (Ear-); Protection masks; Protective helmets for sports; Protective helmets; Protective masks; Safety boots for use in industry for protection against accident or injury; Safety footwear for protection against accident or injury; Shoes for protection against accidents, irradiation and fire; Solderers' helmets; Spectacle cases; Spectacle frames; Spectacle glasses; Spectacles [optics]; Sports (Goggles for-); Sports (Protective helmets for-); Sunglasses; Teeth protectors; Visors for the protection of welders; Waling glasses; Workmen's protective face-shields; Knee-pads for workers; Shin guards for protection against injury other than sports articles or parts of sports suits."

36) In my opinion, taking all the factors above into account, there is no likelihood of consumers being indirectly confused into believing that the following goods in class 9 of LBL are those of BSS or provided by some undertaking linked to them. **The opposition under Section 5(2) (b) therefore fails in respect of the following goods in class 9.**

"Protection devices against X-rays, not for medical purposes; X-rays (Protection devices against-), not for medical purposes; Protection devices for personal use against accidents; Safety restraints other than for vehicle seats and sports equipment; Safety tarpaulins; Nets for protection against accidents; Spark-guards."

37) Further, even though there is a medium level of similarity between the marks, the low degree of similarity between LBL's goods in class 25 and BBS's goods in class 9 is such that there is no likelihood of consumers being confused into believing that the goods provided by LBL are those of BSS or provided by some undertaking linked to them. **The opposition under Section 5(2) (b) therefore fails in respect of the class 25 goods.**

38) Equally given that the goods of LBL in class 18 are not similar the **opposition under Section 5(2) (b) therefore fails in respect of the class 18 goods.**

CONCLUSION

39) I have found that:

- **The opposition under Section 5(2) (b) succeeds in respect of the following class 9 goods:**

“Abdomen protectors for protection against injury [other than parts of sports suits or adapted for use in specific sporting activities]; Armbands [luminous] for protection against accident or injury; Asbestos clothing for protection against fire; Asbestos gloves for protection against accidents; Aviators (Protective suits for-); Bullet-proof waistcoats; Clothes for protection against injury; Clothing for protection against accidents, irradiation and fire; Clothing for protection against fire; Diving suits; Electrically heated clothing for protection against accident or injury; Fire (Clothing for protection against -); Garments and clothes for protection against fire; Garments for protection against fire; Gloves for divers; Gloves for industrial purposes for protection against injury; Gloves for protection against accidents; Gloves for protection against injury; Gloves for protection against X-rays for industrial purposes; Insulated clothing for protection against accident or injury; Leather clothing for protection against accident or injury; Life belts; Life jackets; Protective clothing; Protective suits for aviators; Protective work clothing for protection against accident or injury; Reflecting discs for wear, for the prevention of traffic accidents; Safety clothing for protection against accident or injury; Safety gloves for protection against accident or injury; Socks, electrically heated; Thermal protective aids [clothing] for protection against accident or injury; Thermal suits for protection against accident or injury; Waistcoats (Bullet-proof -); Anti-dazzle shades; Anti-glare glasses; Anti-glare visors; Anti-pollution masks for respiratory protection; Eye protection; Eyeglasses; Eyeshades; Face guards for protection against accident or injury; Face-shields (Workmen’s protective-); Fire protection apparatus; Goggles for sports; Head protection; Helmets (Protective-); Masks (Protective-); Optical lenses; Plugs (Ear-); Protection masks; Protective helmets for sports; Protective helmets; Protective masks; Safety boots for use in industry for protection against accident or injury; Safety footwear for protection against accident or injury; Shoes for protection against accidents, irradiation and fire; Solderers’ helmets; Spectacle cases; Spectacle frames; Spectacle glasses; Spectacles [optics]; Sports (Goggles for-); Sports (Protective helmets for-); Sunglasses; Teeth protectors; Visors for the protection of welders; Waling glasses; Workmen’s protective face-shields; Knee-pads for workers; Shin guards for protection against injury other than sports articles or parts of sports suits.”

- **but fails in respect of the following class 9 goods:**

“Protection devices against X-rays, not for medical purposes; X-rays (Protection devices against-), not for medical purposes; Protection devices for personal use against accidents; Safety restraints other than for vehicle seats and sports equipment; Safety tarpaulins; Nets for protection against accidents; Spark-guards.

- **The opposition under Section 5(2) (b) fails in respect of the class 18 and 25 goods:**

COSTS

40) As both sides have achieved a measure of success I do not propose to favour either side with an award of costs.

Dated this 16th day of September 2015

**George W Salthouse
For the Registrar,
the Comptroller-General**