

**O-536-15**

TRADE MARKS ACT 1994


IN THE MATTER OF APPLICATION NUMBER 3 069 635 FOR THE TRADE MARK:  
GORILLA CAMP IN CLASS 25

AND IN THE MATTER OF OPPOSITION THERETO UNDER NUMBER 403 401

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### Background and pleadings

1. Prince Yeboah (the applicant) applied to register the trade mark GORILLA CAMP under Number 3 069 635 in the UK on 21 August 2014. It was accepted and published in the Trade Marks Journal on 12 September 2014 in respect of the following goods: *clothing, footwear and headgear* in Class 25.
2. B and J Garcia, SL (the opponent) opposes the trade mark under Number 403 401 on the basis of Section 5(2) (b) of the Trade Marks Act 1994 (the Act). This is on the basis of its earlier Community Trade Marks ("CTMs") number 1

863 844 GORILA and 108 869 51:  **Gorilla**

3. The following goods are relied upon in this opposition:

CTM 1 863 844:

**Class 10**

Orthopaedic footwear.

**Class 25**

Clothing, footwear, in particular footwear with rubber soles, headgear.

CTM 108 869 51:

**Class 10**

Orthopaedic footwear.

**Class 18**

Leather and imitations of leather, and goods made of these materials and not included in other classes; Animal skins, hides; Trunks and travelling bags; Umbrellas and parasols; Walking sticks; Whips, harness and saddlery.

**Class 25**

Clothing, footwear, headgear.

4. The opponent argues that the respective goods are identical or similar and that the marks are similar.
5. The applicant filed a counterstatement denying the claims made (and requesting that the opponent provides proof of use of its earlier trade mark CTM 1 863 844 relied upon).
6. Only the opponent filed evidence in these proceedings. This will not be summarised but its contents have been duly noted.

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7. The opponent is represented by Jensen & Son, Patent and Trade Mark Attorneys. The applicant is self represented albeit via in house representative, Lamin Conta.
8. Only the opponent filed written submissions which will not be summarised but will be referred to as and where appropriate during this decision. No hearing was requested and so this decision is taken following a careful perusal of the papers.

### DECISION

9. This decision will focus in the first instance upon earlier trade mark number 108 869 51 as it not subject to the proof of use provisions<sup>1</sup> and return to the remaining earlier trade mark if necessary.

### Section 5(2) (b)

10. Sections 5(2) (b) of the Act is as follows:

“5(2) A trade mark shall not be registered if because-

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

### Comparison of goods

11. The goods in each of the trade marks are expressed in identical terms (clothing footwear, headgear) in Class 25. They are identical.

### 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 Court of Justice of the European Union stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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<sup>1</sup> See Section 6A of the Trade Marks Act 1994.

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“.....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.”

13. It would be wrong, therefore, to artificially dissect the trade 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.

14. The respective trade marks are shown below:

	GORILLA CAMP
Earlier trade mark	Contested trade mark

15. As regards distinctive and dominant components in the earlier trade mark, it is the pictorial representation of a Gorilla which catches the eye first. It appears above the word GORILA and is relatively larger in size. It is also a distinctive element. The word GORILA is also clear and memorable and despite the misspelling it would be understood as meaning GORILLA; indeed it is reinforced by the illustration of a Gorilla; it is also a distinctive element. In respect of the later mark, there are two elements: GORILLA and CAMP. It is considered likely that the word GORILLA will be seen as the most memorable element as it catches the eye first and then goes on to qualify the element CAMP. It is considered therefore to have greater relative weight.

16. The marks coincide in respect of GORILA/GORILLA and differ in respect of the Gorilla illustration and the word CAMP respectively. It is noted that GORILA in the earlier mark is a misspelling and so this provides another point of difference. There is considered to be visual similarity between the signs, but this is pitched as being at the lower end of the spectrum.

17. Aurally, the earlier sign is most likely to be articulated as GOR-IL-LA and this is also the case in respect of the beginning of the later mark. The marks

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therefore coincide to this extent. They differ in respect of the word CAMP in the later mark. They are aurally similar to a moderate to high degree.

18. Conceptually, the earlier trade mark will clearly understood as the primate animal. The later mark may be understood as a location involving the primate animal in some way. However, it is considered that this is not absolutely clear and in any case, a specific location, such as a camp, is qualified by the word GORILLA. This is the clear overall context. As such, it is considered that the addition of the word CAMP in the later mark does not result in a clear and unequivocal difference in concept. Rather, they are conceptually similar to a moderate degree.

### **Average consumer and the purchasing act**

19. 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*.

20. 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.”

21. The average consumer is the public at large. The goods in question are clothing, footwear and headgear. They are predominantly visually selected, with at least an average degree of care and attention being displayed in order to check fit, style etc.

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

22. 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

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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).”

23. The earlier trade mark does not make any claim to enjoying an enhanced degree of protection as a result of use made. In any case, the evidence provided is not UK based and so it is difficult to see how this would elevate the opponent's case. Here, this does not matter as the word element is GORILA which would be understood as the animal and this is reinforced by the graphical illustration. It has no meaning in respect of the goods here. Indeed it is unusual and somewhat fanciful. The earlier mark is considered to be of above average distinctiveness in respect of the goods in question here.

### **GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.**

24. 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;

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(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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

25. The relevant goods have been found to be identical, being *clothing, footwear and headgear* and so the following cases are noted: *New Look Limited v*

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*OHIM*, joined cases T-117/03 to T-119/03 and T-171/03 and *Quelle AG v OHIM*, Case T-88/05. These cases considered the greater relative weight that should be accorded where the purchasing process is primarily visual in nature. It has already been found that visually, the marks are similar to only a lower degree. However, this is bolstered by a moderate to high degree of aural similarity and a moderate degree of conceptual similarity.

26. The earlier trade mark has also been found to have an above average degree of distinctiveness in respect of the relevant goods. Further, it is the primate animal, a gorilla, that provides the key spark of distinctiveness in each of the trade marks. In this regard, see *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".

27. It is true that the later trade mark contains CAMP, but for the reasons already described above, this does not provide a conceptual gap sufficient to ensure the public at large will be able to distinguish between the marks. They therefore coincide in respect of the most memorable distinctive element.
28. It is also noted that the average consumer would display an average degree of attention during the purchasing process. This does have an impact, but is it sufficient to avoid confusion? Bearing in mind all of the aforesaid and in reaching a conclusion on likelihood of confusion, the following is taken into account:
29. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, Mr Iain Purvis Q.C. as the Appointed Person noted that:



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“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).”

30. As already stated, it is the representation of a primate animal which provides the strikingly distinctive element in the earlier mark. This is also present verbally in the later mark. It is considered to be entirely reasonable to conclude that the later trade mark will be seen as emanating from the same or linked undertaking. The addition of CAMP does not prevent this. Rather, GORILLA CAMP is also considered likely to be seen as a brand extension. It is therefore considered that the respective trade marks here fall within category a) and also potentially c) as described above. As such, confusion is considered likely to occur and so the opposition succeeds in its entirety.

### Final Remarks

31. As this earlier trade mark leads to the opposition being successful in its entirety, there is no need to consider the remaining trade marks upon which the opposition is based.

**COSTS**

32. The opponent has been successful and is entitled to a contribution towards its costs. In the circumstances I award the opponent the sum of £900 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Opposition fee: £100  
Considering statement of case: £300  
Filing evidence and written submissions: £500

33. I therefore order Prince Yeboah to pay B and J Garcia, SL the sum of £900. The above sum should be paid within seven days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 18th day of November 2015**

**Louise White**

**For the Registrar,**