

O-547-15

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3112524
BY TROYS SHOE COMPANY LTD**

TO REGISTER THE TRADE MARK:

Troys

IN CLASSES 18 and 25

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 600000310
BY CBM CREATIVE BRANDS MARKEN GMBH**

BACKGROUND AND PLEADINGS

1. On 9 June 2015, Troys Shoe Company Ltd (“the applicant”) applied to register the trade mark **Troys** for the following goods in classes 18 and 25:

Class 18 Leather and imitations of leather; animal skins, hides; trunks and travelling bags; handbags, rucksacks, purses; umbrellas, parasols and walking sticks; whips, harness and saddlery; clothing for animals.

Class 25 Clothing, Footwear, Headgear.

The application was published for opposition purposes on 10 July 2015.

2. The application is opposed by CBM Creative Brands Marken GmbH (“the opponent”) under the fast-track opposition procedure.

3. The opposition, which is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), is directed against all of the goods in the application. The opponent relies upon its Community Trade Mark (“CTM”) registration no. 9253485 for the trade mark **CROYS**, applied for on 16 July 2010 and for which the registration procedure was completed on 27 December 2010. The opponent relies upon the following goods in its trade mark registration:

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, bags, handbags, pocket wallets, purses, key cases, rucksacks, bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.

Class 25 Clothing, footwear, headgear.

4. On 15 September 2015, the applicant filed a counterstatement in which it denies the basis of the opposition. As I have no other submissions from the applicant, its counterstatement is reproduced in full, below:

“The oppositions trade mark “CROYS” has no relation to our trade mark “TROYS” apart from the similarity in the wording. The meaning of the two is completely different and has no apparent relation to each other at all.

The reason I chose the word “TROYS” was due to the reason that I wanted to carry on a historical legacy and the way to do this way to take after the name of the area the history had occurred, hence the reason the trademark “TROYS”.

5. Rules 20(1)-(3) of the Trade Marks Rules (TMR) (the provisions which provide for the filing of evidence) do not apply to fast track oppositions but Rule 20(4) does. It reads:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit”.

6. The effect of the above is to require parties to seek leave in order to file evidence (other than the proof of use evidence which is filed with the notice of opposition) in fast track oppositions. No leave was sought in respect of these proceedings.

7. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the Registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost. Otherwise, written arguments will be taken.

8. A hearing was neither requested nor considered necessary. Only the opponent filed written submissions, which I have read carefully and will refer to as necessary, below.

DECISION

9. The opposition is based upon section 5(2)(b) of the Act which reads 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,

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

10. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

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

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) 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,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered”.

11. In these proceedings, the opponent is relying upon the trade mark shown in paragraph 3, which qualifies as an earlier trade mark under the above provisions. As

this trade mark had not completed its registration process more than 5 years before the publication date of the application in suit, it is not subject to proof of use, as per section 6A of the Act. The opponent can, as a consequence, rely upon all of the goods it has identified.

Section 5(2)(b) – case law

12. 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.

The average consumer and the nature of the purchasing act

13. 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”.

14. I have no submissions from the applicant on this point. The opponent asserts in its written submissions that:

“36. The goods against which the opposition is directed are all goods which run a broad spectrum of prices, including everyday items. The average consumer is therefore the general public.

37. For goods are [sic] at the lower end of the costs spectrum a purchase is unlikely to be given lengthy consideration. The level of care and attention taken by the consumer will be relatively low, or at most average.

38. An assessment based on goods at the lower end of the costs spectrum must be included in the global appreciation and constitutes notional and fair use”.

15. I agree with the opponent that the average consumer of the conflicting goods in classes 18 and 25 is a member of the general public.

16. In my experience, these goods are generally sold through bricks and mortar retail premises and their online equivalents. In terms of how the goods will be selected, this will normally be via self-selection from a rail or shelf (or the online equivalents) or perhaps chosen from catalogues/brochures. While I do not rule out that there may be an aural component (advice may, for example, be sought from a shop assistant), when considered overall, the selection process will be mainly visual.

17. Before addressing the level of care and attention paid by the average consumer, I remind myself of the comments of the Court of Justice of the European Union (“CJEU”) in *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06. At paragraph 66 it stated that:

“Once a mark has been registered its proprietor has the right to use it as he sees fit so that, for the purposes of assessing whether the application for registration falls within the ground for refusal laid down in that provision, it is necessary to ascertain whether there is a likelihood of confusion with the opponent’s earlier mark in all the circumstances in which the mark applied for might be used if it were to be registered”.

18. I also bear in mind the findings of the General Court (“GC”) in *New Look Ltd v OHIM* (Joined cases T-117/03 to T-119/03 and T-171/03), where it stated that:

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

It is clear that, without evidence, I am not able to find that the average consumer of the goods at issue will pay a particularly low degree of attention based on an assumption that the average consumer is especially concerned with goods at the lower end of the costs spectrum.

19. I accept that some of the goods at issue, for example, saddlery, may be bought infrequently and that they may be technical in nature, and I accept that a slightly higher than average degree of attention may be paid in the selection of these goods. I also

accept that there may be wide variations in the price and quality of the goods and that the level of attention may vary accordingly. However, I do not consider that, overall, the goods will be bought with the highest degree of care and attention. I am of the view that the average consumer will pay an average degree of attention in choosing the vast majority of the goods at issue.

Comparison of goods

20. The competing goods are as follows:

Opponent's goods	Applicant's goods
<p><u>Class 18</u></p> <p>Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags, bags, handbags, pocket wallets, purses, key cases, rucksacks, bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.</p>	<p><u>Class 18</u></p> <p>Leather and imitations of leather; animal skins, hides; trunks and travelling bags; handbags, rucksacks, purses; umbrellas, parasols and walking sticks; whips, harness and saddlery; clothing for animals.</p>
<p><u>Class 25</u></p> <p>Clothing, footwear, headgear.</p>	<p><u>Class 25</u></p> <p>Clothing, Footwear, Headgear.</p>

21. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*, the CJEU stated at paragraph 23 of its judgement:

“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”.

22. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- 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.

23. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, 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 the 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. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

25. In relation to complementarity, I also bear in mind the guidance given by Mr Daniel Alexander QC, sitting as the Appointed Person, in case BL O/255/13 *LOVE* where he warned against applying too rigid a test:

“20. In my judgment, the reference to “legal definition” suggests almost that the guidance in *Boston* is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to *Boston*.”

26. It is self-evident that, with the exception of “clothing for animals” in class 18 of the applied for mark, the contested goods in classes 18 and 25 are identical. “Clothing for animals” would include items such as coats or protective overcoats for animals made of leather and is encompassed by the broad term “leather and imitations of leather, and goods made of these materials and not included in other classes” in the specification of the earlier right. Applying the principle in *Meric*, these goods are identical. I recognise that “clothing for animals” would, notionally speaking, also cover goods not made of leather. However, no fall-back specification has been provided to limit to such goods and, in any event, such goods would still, in my view, be highly similar: the users, channels of trade and intended purpose are identical; the nature of the goods may differ, with animal clothing being made from synthetic materials rather than leather, but they may be in competition and they may be complementary (for example, coats for dogs may be designed specifically to be worn with a lead or harness).

Comparison of trade marks

27. 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 judgement 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 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.

28. The trade marks to be compared are as follows:

Opponent’s trade mark	Applicant’s trade mark
CROYS	Troys

29. The opponent’s trade mark consists of the single five-letter word “CROYS”, presented in capital letters. There are no other elements to contribute to the overall impression and distinctiveness, which is contained in the word itself.

30. The applicant's mark is the single five-letter word "Troys", with the initial 'T' in upper case and the remaining letters in lower case. It has no other elements, its overall impression and distinctiveness lying in its totality.

31. Visually, the marks differ in their first letter but share the same final four letters. Bearing this in mind, as well as the fact that the different element is at the beginning of the marks (a point to which I will return when I consider the likelihood of confusion), I consider there to be a medium degree of similarity between the marks.

32. Aurally, the opponent's mark will be pronounced as it is written ("T-ROYS"), and the applicant's mark will be pronounced with a hard 'c' ("K-ROYS"). There is a difference in the initial letter but identity for the remaining four letters. I am of the view that there is a medium degree of aural similarity.

33. Conceptually, the opponent's mark is, as far as I am aware, an invented word. I consider that the average consumer would attribute no particular meaning to the mark. As for the applied for mark, the applicant states that the mark was chosen "to take after the name of the area the history had occurred [sic]". I take this to refer to the city of Troy and the Trojan Wars. The opponent disputes whether the average consumer will attribute any conceptual meaning to the applied for mark.

34. I am not persuaded that the average consumer would make a positive link between the mark "Troys" and the city of Troy. It is far from usual for place names to be pluralised. As a consequence, I do not think that the average consumer would perceive "Troys" as referring to a place, though I accept that there may be some people who would know of Troy and would wonder if a connection was intended. Nor do I consider it likely that the average consumer would perceive "Troys" as relating to the male forename "Troy": it is not a common forename and the absence of an apostrophe to indicate possession, in my view, further reduces the likelihood that the average consumer would perceive the mark in this way. I therefore consider that the average consumer would attribute no particular meaning to the applied for mark. As neither of the marks has a distinct conceptual meaning, there is neither conceptual similarity nor conceptual dissimilarity and the position is neutral.

Distinctive character of the earlier trade mark

35. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. 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-2779, 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).”

36. I have indicated at paragraph 33 that I consider that the earlier mark is an invented word. As a result, I find that it is inherently highly distinctive.

Likelihood of confusion

37. 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 the opponent’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.

38. I have found that the parties’ marks are visually and aurally similar to a medium degree, that they are conceptually neutral and that the earlier mark has a high degree of inherent distinctive character. I have identified the average consumer to be a member of the general public, who will select the goods primarily by visual means (though I do not discount an aural component), and I have concluded that the degree of attention paid will, in the main, be average. I have found the parties’ goods to be identical or highly similar.

39. In making my decision, I bear in mind the comments of the GC in *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, where it noted that the beginnings of words tend to have more visual and aural impact than the endings. Given that both the applied for mark and the earlier mark are short, monosyllabic words, I consider that the different first letter will have a particularly significant impact on the average consumer, especially given the mainly visual nature of the purchase and what I have found to be, in the main, the average degree of attention paid by the average consumer to the selection of the goods at issue. Having considered this impact in light of all of the other competing factors, I find that there is no likelihood of confusion.

40. I found at paragraph 34 of this decision that the applied for mark would not convey a distinct conceptual message. In case I am wrong in this, I will consider briefly the impact of a finding that the applicant's mark does convey a conceptual message.

41. I first remind myself of the comments of the CJEU in *The Picasso Estate v OHIM*, Case C-361/04 P, where it stated that:

“20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law.”

42. Neither party has suggested that “CROYS” is anything other than an invented word; as a consequence, it conveys no conceptual meaning. However, in the event that “Troys” is considered to evoke either the concept of the city or the male forename in the mind of the average consumer, this would act as a conceptual hook to assist the average consumer's recall and would further assist it in distinguishing the applicant's mark from, among others, the mark of the opponent. Consequently, if, in relation to the applicant's mark, my primary conclusion regarding the conceptual position is wrong, it acts as a further reason why there would be no likelihood of confusion.

Conclusion

43. The opposition has been unsuccessful and the application will proceed to registration.

Costs

44. As the applicant has been successful it is entitled to a contribution towards its costs. Neither party filed evidence. Awards of costs are governed by Annex A of Tribunal Practice Notice 4 of 2007. Using that TPN as a guide but bearing in mind that the

applicant has not been professionally represented, I award costs to the applicant on the following basis:

Preparing a statement and
considering the other side's statement: £100

Total: £100

45. I order CBM Creative Brands Marken GmbH to pay Troys Shoe Company Ltd the sum of **£100**. This sum is to be paid within fourteen 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 23rd day of November 2015

**Heather Harrison
For the Registrar
The Comptroller-General**